

O-696-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3291550
FOR THE FOLLOWING TRADE MARK:



IN THE NAME OF
SCRATCH MEALS LIMITED

IN CLASSES 29 AND 30

AND OPPOSITION THERETO UNDER NO. 412785
BY LO-DOUGH LIMITED

Background and pleadings

1) On 21 February 2018 (“the relevant date”) Scratch Meals Limited (“the applicant”) applied in the UK to register the trade mark shown on the front cover of this decision. It was accepted and published in the Trade Marks Journal on 16 March 2018 in respect of the following goods:

Class 29: Meat, meat substitutes, poultry, game, fish, seafood; prepared vegetables; prepared fruits; eggs; dairy products; prepared, pre-prepared and pre-packaged meals consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; chilled meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; food products prepared for human consumption made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; prepared foodstuffs in the form of meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; nutritionally balanced low-calorie prepared meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; stir fry prepared meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood or vegetables, and also including pasta, rice or noodles; soups and preparations for making soups; snacks made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; meat based snack foods; poultry based snack foods; game based snack foods; fish based snack foods; seafood based snack foods; vegetable based snack foods; fruit based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, and also including pastry, pasta, rice or noodles together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal.

Class 30: Pasta and pasta products; pasta sauces; prepared, pre-prepared or pre-packaged pasta meals; prepared, pre-prepared or pre-pack pizzas; pizza sauces; prepared, pre-prepared or pre-packaged pizza meals; prepared, pre-prepared or pre-packaged meals made from pastry, rice, pasta or noodles; prepared, pre-prepared or pre-packaged meals containing principally of pastry, pasta, rice or noodles; prepared foodstuffs in the form of sauces; prepared, pre-prepared or pre-packaged meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; foodstuffs prepared in the form of meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; nutritionally balanced low-calorie prepared meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; prepared stir fry meals, made from or predominantly made from pasta, rice or noodles pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; preparations made from cereals for food for human consumption; bread; pastries; cereal based snack foods; rice based snack foods; pasta based snack foods; noodle based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of pastry, pasta, rice or noodles but also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal; non-medicated confectionery products.

2) On 15 June 2018, Lo-Dough Limited (“the opponent”) opposed the trade mark on the basis of Section 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is based on its earlier UK Trade Mark, the pertinent details of which are below:

Mark (Series of two): LO-DOUGH and LO DOUGH

UK trade mark registration no: 3140593

Date of filing: 14 December 2015
Date of entry in register: 11 March 2016
Classes¹: 5, 16, 29, 30, 42 and 43

Mark: LO-DOUGH
EU trade mark registration no: 16050007
Date of filing: 16 November 2016
Date of entry in register: 17 March 2017
Classes²: 5 and 30

3) The opponent argues that the respective goods are identical or similar. It also argues that since “the dominant and distinctive element of the later filed Application is the word NO DOUGH on the basis that the wording PIZZA CO is purely descriptive of the goods covered under the Application...”, there exists a likelihood of confusion.

4) The opponent also opposes the application under section 5(4)(a) of the Act. This is based on its alleged earlier rights in the signs LO-DOUGH and LO DOUGH. It claims to have been selling various food products (I shall list them in full later in this decision) under this sign since December 2015 and has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

5) The applicant filed a counterstatement denying the claims made.

6) Both sides filed evidence. This will be summarised to the extent that it is considered necessary. The opponent also filed written submissions which I have read but will not summarise.

7) A hearing took place via video-link on 31 July 2019, with the opponent represented by Ms Jacqueline Reid of Counsel, instructed by Shoosmiths LLP and

¹ A full list of the goods and services relied upon are provided at Annex A

² A full list of the goods and services relied upon are provided at Annex B

the applicant by Mr Christopher Hall of Counsel, instructed by Waterfront Solicitors LLP.

Evidence

Opponent's evidence

8) The opponent's evidence consists of a witness statement from Mr Robert Wales and 11 accompanying exhibits. Mr Wales is a director of the opponent, a position he has held since September 2014.

9) Mr Wales states that the opponent has used its LO-DOUGH sign in respect of new, low calorie, low carbohydrate, high fibre, gluten free bread and pasty alternative products. He then goes on to state that "Products bearing the LO-DOUGH and LO-DOUGH Stylised signs were first made available to the public in the UK in May 2017, following the official marketing launch of the brand. In the time since its launch, the Company has achieved over 80,000 customers under the brand, generating significant revenue, with over 78% of overall revenue rising from the calendar year 2018 to date, demonstrating the huge rise in sales and customers of products branded with LO-DOUGH and LO-DOUGH Stylised in the UK in a relatively short period of time."³ It is noted that specific turnover figures have not been provided.

10) Mr Wales states that the opponent now lists around 190 recipes on its website including 50 pizza recipes plus wraps, pies, dumplings, breads, tarts, cakes, quiches, tacos, samosas, pudding, pancakes, pasties and naans. To demonstrate such use, he has submitted numerous website extracts. However, they are not dated and so it can not be decided whether they are prior to the relevant date. Further, Mr Wales states at paragraph 5 that:

"Since its development in 2017, the Company's website at www.lodough.co has attracted a very high number of views. Viewing figures for the calendar year of 2018 to date have been over 2.8 million page views, averaging at around c.250,000 page views per month."

³ Para. 3 of the witness statement

11) Mr Wales states that his company are “aware of at least one instance of high-profile confusion”⁴ between the applicant and the opponent. This involved a Facebook video whereby the presenter and Celebrity Master Chef Nadia Sawalha independently reviewed the opponent’s LO-DOUGH products. At the time of filing the evidence the video had 35,000 views. Exhibit RW11 to the witness statement is an extract of the comments relating the undated video. I duplicate the post below. As can be seen, a consumer asks, “Where can you buy Lo-Dough?”. The post shows three responses to this question, namely 1) “Asda sell them ready made”, 2) a photograph is posted of one of the applicant’s ready-made pizza bases, and 3) the goods are “only online Sarah the photo is not the same as Nadia is using”. Mr Wales argues that this is actual marketplace confusion which demonstrates real confusion. I shall address this later in my decision.



⁴ Para 16 of the witness statement

12) With regard to advertising and marketing, no figures have been provided. Mr Wales does claim that the opponent has extensively used social media, primarily Facebook with 31,000 followers, and Instagram with 42,500 followers. He claims that “overall reaching” is 4.4 million UK consumers. It also relies upon its email database of over 75,000 people who regularly receive email communications. The position prior to the relevant date has not been specified. One example of use prior to the relevant date is an advertisement showing the stylised mark placed on the front of The Guardian Diabetes Magazine dated November 2017. I duplicate the advertisement below:



13) That concludes my summary of the opponent’s evidence.

Applicant’s evidence

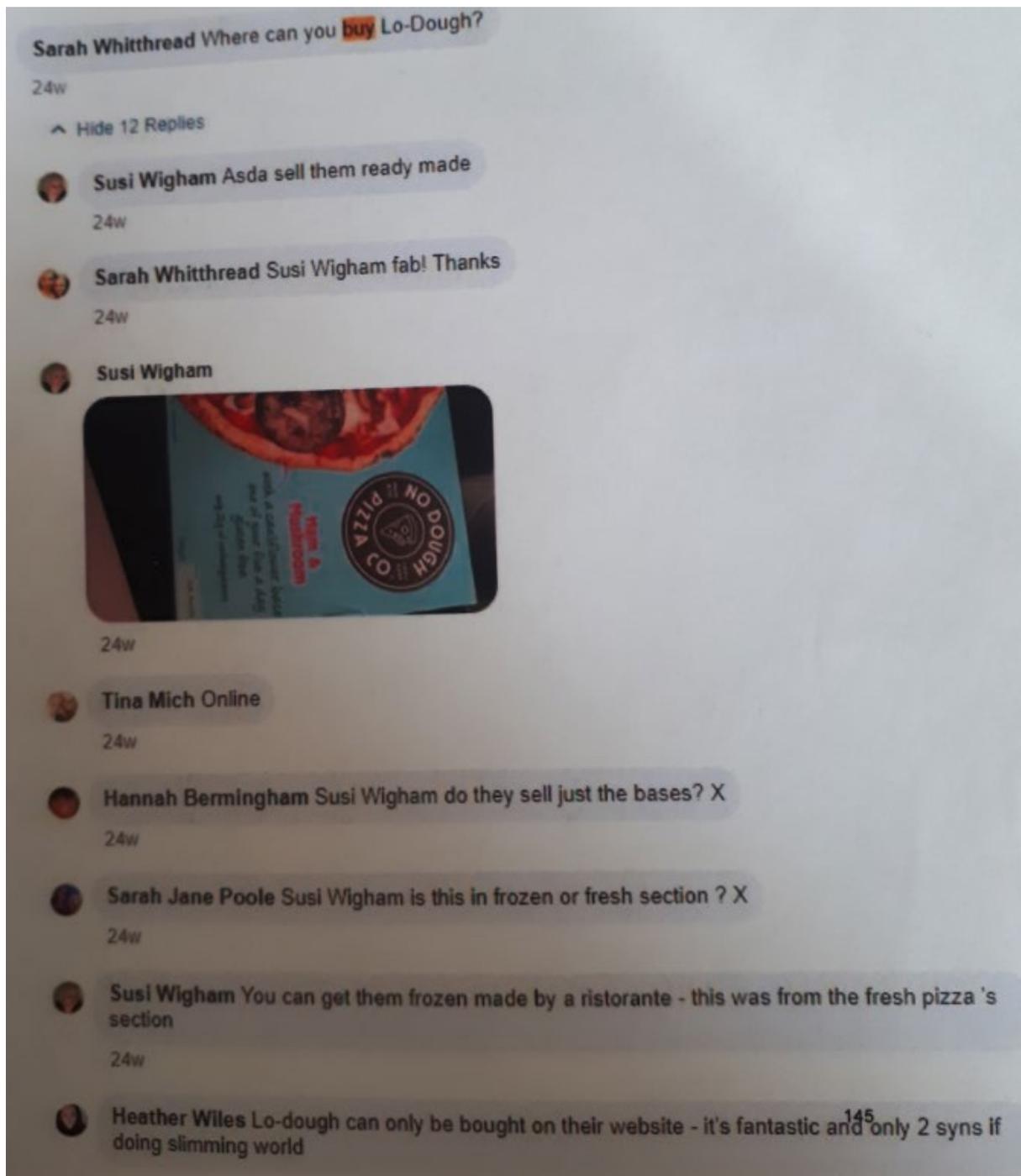
14) The applicant’s evidence consists of a witness statement and 10 exhibits from Mr Antony Hovanessian, who is a director for the applicant.

15) With regard to the opponent’s claim that there has been an “instance of actual confusion” involving the celebrity Nadia Sawalha, Mr Hovanessian states that:

“I disagree with Mr Wales’ assertion that this “instance of confusion” could have reached over 135,000 of the Company’s customers and potential customers”, or that it amounts to a high-profile instance of confusion.” This is because 1) the first post was made by a member of the public and not a celebrity, 2) the confusion was corrected on the same day by a different poster and so there was no actual confusion, 2) The “postings were comments to a video which appear as hidden replies with a chain of replies of

“Where can you buy Lo-Dough” and so viewers of the Facebook video post, of which there were 35,000, are likely to only view the video itself, it is unlikely that they will scroll through each of the individual comments, especially those which are hidden.”

16) Mr Hovanessian also provides a copy of the post at Exhibit AH10, which I duplicate below:



17) Mr Hovanesian's witness statement also includes submissions relating to, 1) who he considers to be the average consumer for the respective goods, 2) the party's respective goods (including the trade channels), and 3) the business operations and goods being sold by the opponent. I confirm that I have read these submissions and I shall bear them in mind when reaching my various conclusions. However, for the section 5(2)(b) claim I am required to make an assessment based on the application, as applied for, and the earlier marks, as registered. Therefore, the actual use made of the mark does not have any impact on this assessment. That concludes my summary of the applicant's evidence.

DECISION

Section 5(2)(b)

18) 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”.

19) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

20) The respective goods and services are reproduced below:

Applicant's goods	Opponent's goods and services
<p>Class 29: Meat, meat substitutes, poultry, game, fish, seafood; prepared vegetables; prepared fruits; eggs; dairy products; prepared, pre-prepared and pre-packaged meals consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; chilled meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; food products prepared for human consumption made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; prepared foodstuffs in the form of meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; nutritionally balanced low-calorie prepared meals made from or</p>	<p>Class 5 Slimming bread and bread products for medical purposes; Dietetic foodstuffs for medical purposes; Bread products for diabetics; Vitamin enriched bread for therapeutic purposes; Pharmaceutical preparations and dietetic preparations, all for use in slimming.</p> <p>Class 29 Crisps; Light crisp style bite snacks.</p> <p>Class 30 Snack foods consisting principally of bread; Bread; Breadsticks; Breadcrumbs; Bread biscuits; Pitta bread; Naan bread; Bread mixes; Ginger bread; Malt bread; Bread buns; Fresh bread; Stuffed bread; Rolls (Bread -); Bread doughs; Bread sticks; Garlic bread; Flat bread; Currant bread; Multigrain bread; Bread pudding;</p>

<p>predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; stir fry prepared meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood or vegetables, and also including pasta, rice or noodles; soups and preparations for making soups; snacks made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; meat based snack foods; poultry based snack foods; game based snack foods; fish based snack foods; seafood based snack foods; vegetable based snack foods; fruit based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, and also including pastry, pasta, rice or noodles together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal.</p> <p>Class 30: Pasta and pasta products; pasta sauces; prepared, pre-prepared or</p>	<p>Crisp breads; Fruit breads; Pre-baked bread; Soft rolls [bread]; Bread and buns; Filled bread rolls; Semi-baked bread; Low-salt bread; Gluten-free bread; Dairy-free bread; Vegetarian bread; Sandwich wraps [bread]; Bread flavoured with spices; Bread-based stuffing mixes; Unleavened bread in thin sheets; Burgers contained in bread rolls; Mixes for the preparation of bread; Hot sausage in bread rolls; Dough; Doughnuts; Dough mix; Pizza dough; Frozen dough; Ready-to-bake dough products; Fried dough twists; Foodstuffs made from dough; doughs, batters, and mixes therefor; Sandwiches; Open sandwiches; Filled sandwiches; Croissants; Pastries; Pizza; Pizza bases; Fresh pizza; Uncooked pizzas; Chilled pizzas; Preserved pizzas; Frozen pizzas; Pre-baked pizzas crusts; Prepared meals in the form of pizzas; Pizza mixes; Preparations for making pizza bases; Pizza flour; poppadoms; Bakery goods; Crumpets; Crusty rolls; Pikelets; Scones; Fruited scones; Crackers; crispbread snacks; crispbread; Salt crackers; Crackers flavoured with fruit; Crackers flavoured with meat; Crackers flavoured with spices; Crackers flavoured with herbs; Crackers flavoured with cheese; Crackers filled with cheese; Crackers flavoured with vegetables; Cereal snacks; Cereal bars and energy</p>
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<p>pre-packaged pasta meals; prepared, pre-prepared or pre-pack pizzas; pizza sauces; prepared, pre-prepared or pre-packaged pizza meals; prepared, pre-prepared or pre-packaged meals made from pastry, rice, pasta or noodles; prepared, pre-prepared or pre-packaged meals containing principally of pastry, pasta, rice or noodles; prepared foodstuffs in the form of sauces; prepared, pre-prepared or pre-packaged meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; foodstuffs prepared in the form of meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; nutritionally balanced low-calorie prepared meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; prepared stir fry meals, made from or predominantly made from pasta, rice or noodles pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; preparations made from cereals for food for human consumption; bread; pastries; cereal based snack</p>	<p>bars; Cereal cakes for human consumption; Cereals; Processed cereals; Breakfast cereals, porridge and grits; Cereals prepared for consumption by humans; Chocolate-based ready-to-eat food bars.</p> <p>Class 43: Preparation of food and drink; Provision of information relating to the preparation of food and drinks; Services for the preparation of food and drink; Preparation and provision of food and drink for immediate consumption; Catering services; Restaurants; Restaurant services; Take-out restaurant services; Self-service restaurants; Mobile restaurant services.</p>
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<p>foods; rice based snack foods; pasta based snack foods; noodle based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of pastry, pasta, rice or noodles but also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal; non-medicated confectionery products.</p>	
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21) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22) In the judgment of the Court of Justice of the European Union (“the CJEU”) 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”.

23) 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.

24) Prior to carrying out specific comparisons of goods and reaching a conclusion for each of the applied for goods, I shall make some general observations. All the goods in question are foodstuffs, either ready to eat or require cooking. Simply because the various items all fall into the broad category of food does not in itself make them all similar. I accept that all the goods are eaten by consumers to satisfy hunger, for nutritional purposes and/or for pleasure, but finding similarity on this basis would be too superficial. A closer link is required.

25) For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

Class 29

26) The opponent argues that its earlier class 29 goods (*Crisps; Light crisp style bite snacks*) are identical to the applied for *prepared fruits; prepared vegetables; snacks made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; meat based snack foods; poultry based snack foods; game based snack foods; fish based snack foods; seafood based snack foods; vegetable based snack foods; fruit based snack foods*. I agree that the earlier goods are also snack type foods in the form of crisps. However, the nature of the respective goods differ since one set of goods are crisps and the other prepared items which serve differing dietary requirements. Therefore, I find the respective goods to be similar to a medium degree.

27) All of the following applied for goods are all pre-prepared meals which are either ready to eat or simply require heating prior to consumption:

Prepared, pre-prepared and pre-packaged meals consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; chilled meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; food products prepared for human consumption made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; prepared foodstuffs in the form of meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; nutritionally balanced low-calorie prepared meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products; stir fry prepared meals made from or predominantly made from meat, meat substitutes, poultry, game, fish, seafood or vegetables, and also including pasta, rice or noodles; soups and preparations for making soups; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; soups; snacks made from meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy

products; meat based snack foods; poultry based snack foods; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, and also including pastry, pasta, rice or noodles together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal.

28) The opponent's earlier goods include prepared meals in the form of pizza, burgers contained in bread rolls and hot sausages in bread rolls (in class 30), which are also pre-prepared meals which are either ready-to-eat or require heating up. Therefore, they are similar in nature and purpose. The end users of the goods are also likely to be the same, i.e. consumers who wish to purchase pre-prepared convenience meals. They are also in competition with one another since the consumer may be faced with the choice of convenience foods. They are similar to a medium degree.

29) The applied for class 29 *meat, meat substitutes, poultry, game, fish, seafood* are clearly dissimilar to the opponent's earlier class 29 goods within the same class. With regard to the opponent's earlier class 30 goods, they include *burgers contained in bread rolls; hot sausage in bread rolls*. These goods are essentially a combination of cooked burgers or sausages (i.e. hotdogs) placed in bread rolls which are ready to be consumed. They are effectively prepared meals containing cooked meat. I consider the end users of meat to also be consumers of the earlier referred to goods. Therefore, they are similar to a low to medium degree. Since burgers contained in bread rolls may also include chicken and vegetarian burgers, I also find a low to medium degree of similarity between the earlier *burgers contained in bread rolls* and meat substitutes and poultry. The meat within conventional burgers do not typically contain *game, fish or seafood* and therefore I do not find any similarity with these goods.

30) I do not see any point of similarity between the applied for *preparations for making soups, eggs and dairy products* and any of the earlier opponent's goods or services. They are dissimilar

31) To summarise, I find that all the applied for class 29 goods to be at least similar to the earlier goods with the exception of *game, fish, seafood; eggs; preparations for making soups; dairy products*, which are dissimilar.

Class 30

32) Applying the principle set out in *Meric*, the applied for *pre-prepared or pre-pack pizzas; prepared, pre-prepared or pre-packaged pizza meals* are all included, and therefore, identical to the earlier *Pizza*.

33) Both lists include the identical terms *bread* and *pastries*. I also consider the applied for *preparations made from cereals for food for human consumption* to be identical to the earlier *cereals prepared for consumption by humans*.

34) The opponent argues that the applied for *non-medicated confectionery products* are identical to the earlier *Chocolate-based ready-to-eat food bars*. I agree.

35) The applied for *cereal based snack foods* are clearly identical to the earlier *cereal snacks*.

36) The applied for *pizza sauces* are an ingredient of the earlier finished article, pizza. There is some difference in nature, purpose and method of use. However, pizza sauces will be required for the preparation of pizzas and it would not be unreasonable to expect a producer of pizzas to also sell their own pizza sauces. The goods are, therefore, complementary and there is a potential competition to the extent that a consumer may purchase individual ingredients for a pizza so that they can make their own pizza, rather than purchasing a ready-made pizza. They are similar to a medium degree.

37) The opponent's goods include the term foodstuffs made form dough which I understand to be sufficiently broad to include pasta. For the same reasons as listed above in relation to pizza sauces, I find there to be a medium degree of similarity between the respective goods.

38) I consider the applied for *pasta and pasta products; prepared, pre-prepared or pre-packaged pasta meals* to be similar to the earlier *pizzas*. They share the same purpose, i.e. convenience food, and so they are in competition with one another. Further. many producers of pizza will also produce pasta, and vice versa. Therefore, the channels of trade coincide. They are similar to a medium degree.

39) For the same reasons I find the earlier *pizzas* to be similar to the applied for *prepared, pre-prepared or pre-packaged meals made from pastry, rice, pasta or noodles; prepared, pre-prepared or pre-packaged meals containing principally of pastry, pasta, rice or noodles; prepared, pre-prepared or pre-packaged meals containing principally of pastry, pasta, rice or noodles; prepared foodstuffs in the form of sauces; prepared, pre-prepared or pre-packaged meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; foodstuffs prepared in the form of meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; nutritionally balanced low-calorie prepared meals consisting principally of pastry, pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; prepared stir fry meals, made from or predominantly made from pasta, rice or noodles pasta, rice or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; preparations made from cereals for food for human consumption; rice based snack foods; pasta based snack foods; noodle based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of pastry, pasta, rice or noodles but also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal*. They are similar to a medium degree.

Comparison of marks

40) 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.”

41) 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.

42) The respective trade marks are shown below:

The applicant's mark	The opponent's marks
	LO-DOUGH LO DOUGH

43) The applicant's mark is a composite mark made up of a combination of words and a device which are all presented on a roundel device. The words are "NO DOUGH PIZZA CO". The word PIZZA and the device thereof are descriptive of the applicant's pizza goods and are therefore not distinctive. For non-pizza goods, the word and device are distinctive. In terms of overall impression the devices do play a role but the mark is marginally more dominated by the words.

44) The opponent's earlier marks are, LO-DOUGH and LO DOUGH. The only difference between the two marks being the presence of a hyphen in the first mark and its absence in the second. In terms of the overall impression, the distinctiveness of the mark rests in the whole. There is no material difference between the two marks and I therefore intend to refer to them in the singular, LO DOUGH.

45) Visually, the opponent argues that: "The words LO DOUGH and NO DOUGH are identical but for the first letter. The curvature of the words NO DOUGH in the device and the font can be ignored..." and "Comparing the marks as a whole...there is a medium to high degree of visual similarity between the marks".⁵ The applicant emphasises that its mark is not just NO DOUGH. It argues that it is a combination of a device of a pizza and words placed within the roundel device. Whilst the figurative elements of the mark are not particularly stylised, they do form part of the mark and it would be wrong for me to artificially dissect the application by focussing solely the words NO DOUGH. Accordingly, I find that the marks are similar to a degree above low but not medium.

46) Aurally, the opponent argues that the earlier LO DOUGH mark is virtually identical to the rhyming words NO DOUGH in the application. Ms Reid also argues that since consumers are well known to use shortened spoken form of marks, they are aurally similar to a medium degree. In my view the applied for mark is likely to be pronounced as NO DOUGH PIZZA CO (CO being the well-known abbreviation for "company"). The opponent's mark will be pronounced as LOW-DOUGH. Therefore, even if I accept that the first three syllables rhyme, there are still four words in the

⁵ Paragraph 19 of the skeleton argument

applicant's mark and two in the earlier mark and so there are more dissimilarities than similarities. I find there to be a low degree of aural similarity.

47) In order for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer⁶. Ms Reid argues that whilst its earlier mark has no immediate concept, "it does allude to products, and services associated with such products, which have ingredients at low levels". Therefore, Ms Reid argues that at its broadest level there is an overlap in concepts. I generally agree with this assessment. The earlier mark consists of LO DOUGH and I am of the view that LO will be viewed as being a misspelling or shortening for the word LOW, so that the mark signifies goods which are low in dough content. The application includes the words NO DOUGH followed by PIZZA CO which would simply be viewed as PIZZA that does not contain DOUGH. The device and roundel do not alter this concept. Accordingly, for goods which may contain dough, the respective marks share the same concept. For "non-dough" goods the concept is more striking since it would not be descriptive and therefore they are also conceptually similar.

Average consumer and the purchasing act

48) 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*.

49) 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

⁶ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

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.”

50) Mr Hovanessian, on behalf of the applicant, argues that the products offered by the respective parties are likely to appeal to different consumers and therefore they will not be in competition with one another. This is based on the goods that the applicant and opponent respectively sell. My assessment is confined to the goods/services of the respective parties as applied for and as registered. In other words, it is an abstract determination of which goods/services are similar as set out at paragraphs 26 to 39 and not what use has been made.

51) The goods in question are various foodstuffs. The average consumer of such goods will be a member of the general public. They will be purchased following a visual self-selection process, though aural considerations are not discounted. The level of attention paid upon purchasing the goods is medium.

Distinctive character of the earlier trade mark

52) 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).”

53) The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. Distinctiveness can also be enhanced through use of the mark. The opponent has not claimed to have an enhanced degree of distinctive character by virtue of the use made of it. Even if it had made such a claim this is not supported by the evidence and what has been filed would not have supported such a finding, not least because its use in the UK began only 9 months prior to the relevant date.

54) I now consider the inherent distinctive character of the earlier mark. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that:

"41.....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the

mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)."

55) The distinctive character must be determined in relation to the goods. In the present case some of the goods contain or relate to dough. I shall deal with each set separately. For goods which may contain dough, the distinctive character resides in LO being an invented word. This is despite it being an obvious misspelling or shortening of the word LOW. In view of the guidance set out in the *Formula One* case above, the earlier mark is registered and so must be afforded distinctive character which I consider to be very low. With regard to the earlier mark which contains a hyphen, I do not consider this to add any distinctive character and so this earlier mark is also inherently distinctive to a very low degree.

56) For the goods in relation to which the word dough does not indicate an ingredient, it is neither allusive/suggestive of the goods themselves nor descriptive. However, I bear in mind that they are nevertheless foodstuffs and use of the earlier marks (LO DOUGH) which do not include or have any suggestive/allusive connection to dough would be unexpected and unusual. Accordingly, for non-dough products I consider the earlier mark to have an above low but not as high as medium degree of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

57) Similarity between the goods is a prerequisite for a finding of likelihood of confusion. Therefore, since I have not found any similarity to the following applied for goods, the section 5(2)(b) ground fails in relation to:

Class 29: game, fish, seafood; eggs; preparations for making soup; dairy products

58) I shall now turn to the remaining goods to determine if there is a likelihood of confusion. 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, goods and services down to the responsible undertakings being the same or related).

59) 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.

60) The common element between the marks is the word DOUGH and, the opponent argues, the combination of the rhyming words NO and LO. For some goods the word DOUGH is descriptive of an ingredient or element of the goods themselves and is therefore descriptive. On this basis, it is sensible to group the remaining goods into dough and non-dough items. I shall begin with the “dough” goods, which are defined as “A thick, malleable mixture of flour and liquid used for baking into bread or pastry”⁷, which are as follows:

Class 30: Pasta and pasta products; prepared, pre-prepared or pre-packaged pasta meals; prepared, pre-prepared or pre-pack pizzas; prepared, pre-prepared or pre-packaged pizza meals; prepared, pre-prepared or pre-packaged meals made from pastry, pasta or noodles; prepared, pre-prepared or pre-packaged meals containing principally of pastry, pasta or noodles; prepared, pre-prepared or pre-packaged meals consisting principally of

⁷ Definition obtained from the online Oxford dictionary which can be found at www.lexico.com

pastry, pasta or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; foodstuffs prepared in the form of meals consisting principally of pastry, pasta, or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; nutritionally balanced low-calorie prepared meals consisting principally of pastry, pasta or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; prepared stir fry meals, made from or predominantly made from pasta, or noodles pasta, or noodles, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; bread; pastries; cereal based snack foods; pasta based snack foods; noodle based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of pastry, pasta or noodles but also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal.

61) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

62) In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

63) Further, in *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch) Arnold J. stated that:

“.....if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

64) Firstly, I remind myself of the various findings that I have made. I have found the respective marks to be visually similar to an above low but not medium degree, aurally similar to a low degree and conceptually similar. I have found that the goods will predominantly be purchased following a visual inspection of the goods with a medium degree of care taken. With these findings in mind, I consider the guidance set out in *Kurt Geiger* and *Whyte & Mackay* to be particularly relevant to the circumstances of this case. This set of goods either contain dough, or have some form of connection to dough. Therefore, the word DOUGH solus has no distinctive character. I have already found that LO will be viewed as either being an abbreviation or misspelling of the word LOW but must accept that it is afforded a minimal degree of distinctive character. Combining LO and DOUGH does not add any additional distinctive character and, for the avoidance of doubt, nor does the hyphen. Accordingly, it is LO that has the distinctive character rather than DOUGH or the combination of the two. Whilst I note the opponent’s argument that LO and NO sound and look alike and that they precede DOUGH, but for the reasons given there is no likelihood of confusion, either directly or indirectly. This is even when the respective goods are found to be identical.

65) At this point it is prudent to deal with the opponent's argument that actual confusion arose. I note from the evidence that the goods which led to the alleged instance of confusion is pizza which, of course, include dough. During the hearing Mr Hall referred me to the decision of his Honour Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited*,⁸ whereby he considered the applicability of the *Office Cleaning Services* case to the law of registered trade marks. He stated at paragraph 40 that:

“...The court will be careful to discount confusion which...has arisen solely because of the purely descriptive elements common to both the claimant's and the defendant's marks – for instances, where some people have muddled the identity of two companies just because they both have ‘office cleaning’ in their names. This is not a matter of policy; it is simply that such confusion is irrelevant to the claimant's case.”

66) I also note the words of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*:⁹

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

67) As can be seen from the above, the courts have frequently stated that traders that choose marks which are low, or non-distinctive of the goods or services in question, will have to tolerate use by third parties which they believe to be confusing. That is the case here, particularly for goods which may include dough (in this instance, pizza). Therefore, I dismiss this argument.

⁸ [2018] EWHC 35 (IPEC)

⁹ [1946] 63 RPC 39. *Office Cleaning* was a passing off case, but is applicable in a 5(2)(b) case – see Mr Daniel Alexander QC (sitting as the Appointed Person) in Case BL O/255/13 (Sandra Amalia Mary Elliott) at paragraphs [56] and [57].

68) I now turn to the non-dough goods, which are:

Pasta sauces; pizza sauces; prepared, pre-prepared or pre-packaged meals made from rice; prepared, pre-prepared or pre-packaged meals containing principally of rice; prepared foodstuffs in the form of sauces; prepared, pre-prepared or pre-packaged meals consisting principally of rice, and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; foodstuffs prepared in the form of meals consisting principally of rice, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; nutritionally balanced low-calorie prepared meals consisting principally of rice, and also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, eggs or dairy products; prepared stir fry meals, made from or predominantly made from rice and also including meat, meat substitutes, poultry, game, fish, seafood, or vegetables; preparations made from cereals for food for human consumption; rice based snack foods; pre-prepared meals or dishes made from any of the aforesaid goods and preparations for making the aforesaid meals; food products made from any combination of the aforesaid goods; pre-prepared meals, pre-packaged in kit form, comprising pre-prepared ingredients consisting primarily of rice but also including meat, meat substitutes, poultry, game, fish, seafood, vegetables, fruits, eggs or dairy products, together with pre-prepared sauces, seasonings and spices, from which to make and cook a meal; non-medicated confectionery products.

69) These goods do not include or have any obvious link to dough and so the word is not descriptive or allusive/suggestive thereof. For ease of reference I repeat my findings which must be taken into account when determining whether a likelihood of confusion exists. These are: 1) some of the respective goods are identical, and the rest similar to varying degrees, 2) the respective marks are visually similar to an above low but not medium degree, aurally similar to a low degree and conceptually similar, 3) the goods will predominantly be purchased following a visual inspection of the goods with a medium degree of care taken, and 4) the earlier mark has an above low but not as high as medium degree of inherent distinctive character. Taking all of

these factors into account, given the overall differences between the marks there cannot be a likelihood of direct confusion.

70) With regard to indirect confusion I am mindful of the comments made by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*¹⁰

“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 recognised 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

¹⁰ BL O/375/10

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).”

71) I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹¹ I also bear in mind the guidance of Mr James Mellor QC, sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*:¹²

“81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

72) As I have already stated, I still consider the earlier marks to be an above low degree of distinctive character for foodstuffs. Whilst I fully take into account the interdependency principle that some of the goods are identical, I do not consider this outweighs what I consider to be low levels of overall similarity between the marks. A finding of indirect confusion based on them sharing the common element DOUGH preceded by NO and LO respectively is not sufficient to find a likelihood of indirect confusion when there are additional elements in the application. Whilst the average consumer may notice the similarity, it would lead to nothing more than mere association. I certainly do not consider the average consumer would not consider there to be an economic link between them. There is no likelihood of indirect confusion.

¹¹ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

¹² BL O/547/17

Section 5(2)(b) conclusion

73) The opposition under section 5(2)(b) of the Act fails.

SECTION 5(4)(a)

74) I now turn to the section 5(4)(a) claim. The claim is based on the opponent's alleged earlier rights in a business operating under the signs LO DOUGH and LO-DOUGH which it claims to have been using for various foodstuffs since December 2015.

75) Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

Case law

76) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341,

HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

77) Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant date

78) Since the applicant has not filed any evidence to support that it has used its mark, the date at which I must assess the section 5(4)(a) claim is the date of the UK application,¹³ i.e. 21 February 2018.

Goodwill

79) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 the House of Lords defined goodwill as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of

¹³ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person

a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

80) I begin by reminding myself that the opponent’s section 5(4)(a) of the Act claim is based on its alleged earlier rights in the signs LO-DOUGH and LO DOUGH. It claims to have been selling the following foodstuffs since December 2015:

Slimming bread and bread products for medical purposes; Dietetic foodstuffs for medical purposes; Bread products for diabetics; Vitamin enriched bread for therapeutic purposes; Pharmaceutical preparations and dietetic preparations, all for use in slimming.

Crisps; light crisp style bite snacks.

Snack foods consisting principally of bread; Bread; Breadsticks; Breadcrumbs; Bread biscuits; Pitta bread; Naan bread; Bread mixes; Ginger bread; Malt bread; Bread buns; Fresh bread; Stuffed bread; Rolls (Bread -); Bread doughs; Bread sticks; Garlic bread; Flat bread; Currant bread; Multigrain bread; Bread pudding; Crisp breads; Fruit breads; Pre-baked bread; Soft rolls [bread]; Bread and buns; Filled bread rolls; Semi-baked bread; Low-salt bread; Gluten-free bread; Dairy-free bread; Vegetarian bread; Sandwich wraps [bread]; Bread flavoured with spices; Bread-based stuffing mixes; Unleavened bread in thin sheets; Burgers contained in bread rolls; Mixes for the preparation of bread; Hot sausage in bread rolls; Dough; Doughnuts; Dough mix; Pizza dough; Frozen dough; Ready-to-bake dough products; Fried dough twists; Foodstuffs made from dough; doughs, batters, and mixes therefor; Sandwiches; Open sandwiches; Filled sandwiches; Croissants; Pastries; Pizza; Pizza bases; Fresh pizza; Uncooked pizzas; Chilled pizzas; Preserved pizzas; Frozen pizzas; Pre-baked pizzas crusts; Prepared meals in the form of pizzas; Pizza mixes; Preparations for making pizza bases; Pizza flour; poppadoms; Bakery goods; Crumpets; Crusty rolls; Pikelets; Scones; Fruited scones; Crackers; crispbread snacks; crispbread; Salt crackers; Crackers flavoured with fruit; Crackers flavoured with meat; Crackers flavoured with spices; Crackers flavoured with herbs; Crackers flavoured with cheese; Crackers filled with cheese; Crackers flavoured with vegetables; Cereal snacks; Cereal bars and energy bars; Cereal cakes for human consumption; Cereals; Processed cereals; Breakfast cereals, porridge and grits; Cereals prepared for consumption by humans; Chocolate-based ready-to-eat food bars.

81) There is very little evidence which is prior to the relevant date. There are no turnover figures or advertising/marketing spend. The only article dated prior to the relevant date is The Guardian Diabetes Magazine dated November 2017. This in itself is not evidence of goodwill having been acquired. Ms Reid seeks to rely upon Mr Wales’ statement that the number of customers¹⁴ is over 80,000 and 22% of the revenue to date was achieved prior to the relevant period. However, Mr Wales states

¹⁴ Paragraph 3 of the witness statement

himself that the “signs were first made available to the public in the UK in May 2017, following the official marketing launch of the brand.” Whilst I acknowledge that the opponent has filed an unchallenged statement claiming to own goodwill, and make various statements regarding use, there is insufficient corroborating evidence. The opponent has been filed to demonstrate that even if it had launched the brand, goodwill was established at the relevant date.

82) In view of the above, the evidence does not support a claim to the opponent having the requisite goodwill and so the claim falls at the first hurdle. However, if I am wrong about this finding then I shall go onto considering misrepresentation based on the opponent having goodwill for all of the goods it claims.

Misrepresentation

83) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

84) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

85) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

86) I am not satisfied that “a substantial number” of the opponent’s customers or potential customers will be deceived. In other words, I do not consider the opponent to be in any better same position to successfully argue that there would be

misrepresentation (or likelihood thereof) as there was as arguing there was a likelihood of confusion. The legal tests differ, but the outcome is the same. Therefore, the section 5(4)(a) ground of opposition fails.

OVERALL CONCLUSION

87) The opposition has failed. Subject to appeal, the application shall proceed to registration for all the goods applied for.

COSTS

88) The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the opponent's statement of claim and preparing a counterstatement	£350
Preparing evidence and considering the other side's evidence	£800
Preparing for and attending a hearing	£700
TOTAL	£1850

89) I therefore order LO-DOUGH LIMITED to pay Scratch Meals Limited the sum of £1850. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of November 2019

MARK KING

For the Registrar,

The Comptroller-General

Annex A

UK 3145093

Class 5: Slimming bread and bread products for medical purposes; Dietetic foodstuffs for medical purposes; Bread products for diabetics; Vitamin enriched bread for therapeutic purposes; Pharmaceutical preparations and dietetic preparations, all for use in slimming.

Class 16: Cardboard packaging; Packaging materials; Plastic foil for packaging; Plastic film for packaging; Cartons of cardboard for packaging; Cartons of card for packaging; Packaging materials made of cardboard; Paperboard trays for packaging food; Foils of plastic for packaging; Cling film plastics for packaging; Polythene films for wrapping or packaging; Packaging materials made of recycled paper; Packaging materials of plastic for sandwiches; Cardboard packaging boxes in collapsible form; Bags [envelopes, pouches] of paper or plastics, for packaging; Plastic materials for packaging (not included in other classes); Films for wrapping foodstuffs; Plastic foil for wrapping; Plastic film for wrapping; Pouches of plastic for wrapping; Printed matter; Printed publications, leaflets, pamphlets, material; Printed matter for advertising; Teaching and instructional materials.

Class 29: Crisps; Light crisp style bite snacks.

Class 30: Snack foods consisting principally of bread; Bread; Breadsticks; Breadcrumbs; Bread biscuits; Pitta bread; Naan bread; Bread mixes; Ginger bread; Malt bread; Bread buns; Fresh bread; Stuffed bread; Rolls (Bread -); Bread doughs; Bread sticks; Garlic bread; Flat bread; Currant bread; Multigrain bread; Bread pudding; Crisp breads; Fruit breads; Pre-baked bread; Soft rolls [bread]; Bread and buns; Filled bread rolls; Semi-baked bread; Low-salt bread; Gluten-free bread; Dairy-free bread; Vegetarian bread; Sandwich wraps [bread]; Bread flavoured with spices; Bread-based stuffing mixes; Unleavened bread in thin sheets; Burgers contained in bread rolls; Mixes for the preparation of bread; Hot sausage in bread rolls; Dough; Doughnuts; Dough mix; Pizza dough; Frozen dough; Ready-to-bake dough products; Fried dough twists; Foodstuffs made from dough; doughs, batters, and mixes

therefor; Sandwiches; Open sandwiches; Filled sandwiches; Croissants; Pastries; Pizza; Pizza bases; Fresh pizza; Uncooked pizzas; Chilled pizzas; Preserved pizzas; Frozen pizzas; Pre-baked pizzas crusts; Prepared meals in the form of pizzas; Pizza mixes; Preparations for making pizza bases; Pizza flour; poppadoms; Bakery goods; Crumpets; Crusty rolls; Pikelets; Scones; Fruited scones; Crackers; crispbread snacks; crispbread; Salt crackers; Crackers flavoured with fruit; Crackers flavoured with meat; Crackers flavoured with spices; Crackers flavoured with herbs; Crackers flavoured with cheese; Crackers filled with cheese; Crackers flavoured with vegetables; Cereal snacks; Cereal bars and energy bars; Cereal cakes for human consumption; Cereals; Processed cereals; Breakfast cereals, porridge and grits; Cereals prepared for consumption by humans; Chocolate-based ready-to-eat food bars.

Class 42: Research of foodstuffs; Professional advisory services relating to food technology; Technical consultancy in relation to the technical research in the field of food and beverages; Technical consultancy in relation to research services relating to foods and dietary supplements.

Class 43: Preparation of food and drink; Provision of information relating to the preparation of food and drinks; Services for the preparation of food and drink; Preparation and provision of food and drink for immediate consumption; Catering services; Restaurants; Restaurant services; Take-out restaurant services; Self-service restaurants; Mobile restaurant services.

ANNEX B – EUTM 16050007

Class 5: Slimming bread and bread products for medical purposes; Dietetic foodstuffs for medical purposes; Bread products for diabetics; Vitamin enriched bread for therapeutic purposes; Pharmaceutical preparations and dietetic preparations, all for use in slimming.

Class 30: Snack foods consisting principally of bread; Bread; Breadsticks; Breadcrumbs; Bread biscuits; Pitta bread; Naan bread; Bread mixes; Ginger bread; Malt bread; Bread buns; Fresh bread; Stuffed bread; Rolls (Bread -); Bread doughs; Bread sticks; Garlic bread; Flat bread; Currant bread; Multigrain bread; Bread pudding; Crisp breads; Fruit breads; Pre-baked bread; Soft rolls [bread]; Bread and buns; Filled bread rolls; Semi-baked bread; Low-salt bread; Gluten-free bread; Dairy-free bread; Vegetarian bread; Sandwich wraps [bread]; Bread flavoured with spices; Bread-based stuffing mixes; Unleavened bread in thin sheets; Burgers contained in bread rolls; Mixes for the preparation of bread; Hot sausage in bread rolls; Dough; Doughnuts; Dough mix; Pizza dough; Frozen dough; Ready-to-bake dough products; Fried dough twists; Foodstuffs made from dough; doughs, batters, and mixes therefor; Sandwiches; Open sandwiches; Filled sandwiches; Croissants; Pastries; Pizza; Pizza bases; Fresh pizza; Uncooked pizzas; Chilled pizzas; Preserved pizzas; Frozen pizzas; Pre-baked pizzas crusts; Prepared meals in the form of pizzas; Pizza mixes; Preparations for making pizza bases; Pizza flour; poppadoms; Bakery goods; Crumpets; Crusty rolls; Pikelets; Scones; Fruited scones; Crackers; crispbread snacks; crispbread; Salt crackers; Crackers flavoured with fruit; Crackers flavoured with meat; Crackers flavoured with spices; Crackers flavoured with herbs; Crackers flavoured with cheese; Crackers filled with cheese; Crackers flavoured with vegetables; Cereal snacks; Cereal bars and energy bars; Cereal cakes for human consumption; Cereals; Processed cereals; Breakfast cereals, porridge and grits; Cereals prepared for consumption by humans; Chocolate-based ready-to-eat food bars.