

O-404-03

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 609129
AND A REQUEST BY INTERNATIONAL FOOD & GOURMET PRODUCTS BV
TO PROTECT A TRADE MARK IN CLASSES 29, 30 AND 31**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70690
BY LA MEXICANA QUALITY FOODS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF International Registration
No. 609129 and a request by International Food & Gourmet Products BV
to protect a Trade Mark in Classes 29, 30 and 31**

and

**IN THE MATTER OF Opposition thereto under
No. 70690 by La Mexicana Quality Foods Limited**

BACKGROUND

1. On 24 November 1999 International Food & Gourmet Products B.V., on the basis of a Benelux registration, requested protection in the United Kingdom for the following mark:



2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10 including the following clause:

“The applicant claims the colours green, different shades of orange, brown, yellow and black as an element of the mark.”

3. The application covers the following specification of goods in Classes 29, 30 and 31 respectively:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour and preparations made from cereals, bread, pastry and confectionery, edible ice; honey, molasses; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; cooling ice.

Agricultural, horticultural and forestry products and grains, not included in other classes; live animals; fresh fruit and vegetables; natural seeds, plants and flowers; animal feed, malt.

4. On 18 October 2001 La Mexicana Quality Foods Limited filed notice of opposition to the conferring of protection on this international registration. They are the proprietors of the following registrations:

No.	Mark	Class	Specification
1477556		30	Milled corn, corn flour, corn meal; milled maize, maize flour, maize meal; flour for foods; milling products for flour; cereal preparations, farinaceous foods, farinaceous food pastes; tortilla chips and tortilla, whether of maize or wheat flour, fried or unfried, for use instead of bread or as a wrapper or container for fillings; wheat flour; pancakes, biscuits, cake, bread; prepared meals or individual dishes; pastries, pastry; tarts; pizzas; pies; meat pies; pasties; patties; dumplings; puddings; fudge; caramels; syrups; condiments; sauces; seasoning; peppers for seasoning; milk based gruel; ice cream, edible ices; sherbets; vanilla; all included in Class 30, and all originating from Mexico or made to Mexican recipes or being in Mexican style.
1578949		29	Cooked, dried, preserved, chilled and frozen fruit and vegetables; fruit pulp; fruit salads; vegetable salads; tomato puree; soup preparations; bouillon and bouillon concentrates; fish and meat; poultry; dairy products; prepared nuts; edible fats and oils; eggs; all originating from Mexico or made to Mexican recipes or being in Mexican style; all included in Class 29.
2125798	LA MEXICANA	29	Cooked, dried, preserved, chilled and frozen fruit and vegetables; fruit pulp; fruit salads; vegetable salads; tomato puree; soup preparations; bouillon and bouillon concentrates; fish and meat;

		<p>30</p> <p>poultry; dairy products; prepared nuts; edible fats and oils; eggs; all originating from Mexico or made to Mexican recipes or being in Mexican style.</p> <p>Milled corn, corn flour, corn meal; milled maize, maize flour, maize meal; flour for foods; milling products for flour; cereal preparations, farinaceous foods, farinaceous food pastes; tortilla chips and tortilla, whether of maize or wheat flour, fried or unfried, for use instead of bread or as a wrapper or container for fillings; wheat flour; pancakes, biscuits, cake, bread; prepared meals or individual dishes; pastries, pastry; tarts; pizzas; pies; meat pies; pasties; patties; dumplings; puddings; fudge; caramels; syrups; condiments; sauces; seasoning; peppers for seasoning; milk based gruel; ice cream, edible ices; sherbets; vanilla; all originating from Mexico or made to Mexican recipes or being in Mexican style.</p>
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5. The opponents say that the words LA MEXICANA feature prominently in their marks and that the applied for mark, which incorporates the word MEXICANA, is similar. They also suggest that the applicants' goods are, in large measure at least, either identical or similar to those of the above registrations. They conclude that there is a likelihood of confusion and the applied for mark would offend the provisions of Section 5(2)(b) of the Act.

6. In the event that any of the goods are considered dissimilar ("agricultural, horticultural and forestry products and grains; live animals; natural seeds, plants and flowers; animal feed, malt" in Class 31 are mentioned) then it is said that the request for protection should be refused under Section 5(3) of the Act having regard to the reputation enjoyed by the opponents' marks.

7. Finally, there is a claim under Section 5(4)(a) having regard to the reputation and use claimed by the opponents since 1992 in respect of foodstuffs.

8. The applicants filed a counterstatement denying the above grounds and putting the opponents to proof of their claims.

9. Both sides ask for an award of costs in their favour.

10. Both sides filed evidence. In accordance with current practice the case papers were reviewed by a Hearing Officer at the conclusion of the evidence rounds. He wrote to the parties on 7 October 2003 expressing the view that the objection based on Section 5(2)(b) was likely to be determinative of these proceedings and indicating that in his view the matter could be decided on the basis of the statutory provisions and the relevant jurisprudence without the need for oral submissions. The parties were nevertheless reminded of their right to be heard or to offer written submissions. In the event, neither side has asked to be heard but written submissions have been received from Forrester Ketley on behalf of the opponents (their letter of 5 December 2003). I note too that this letter appears to accept the Hearing Officer's preliminary view that the Section 5(2) ground is likely to be determinative of the outcome of the case. Acting on behalf of the Registrar and with the above material in mind I give this decision.

DECISION

11. I believe the Hearing Officer who reviewed this case was right to suggest that the Section 5(2) ground is likely to be determinative of the matter. The relevant Section of the Act reads:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

Sub paragraph (b) applies here.

12. I have been referred to and accept that I must take into account the guidance provided by the European Court of Justice via *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

13. The registrations relied on by the opponents are all earlier trade marks within the meaning of Section 6(1)(a) of the Act. In principle I must compare each of the marks and associated goods with the mark and goods applied for. Nos. 1477556 and 1578949 show the words LA MEXICANA set within an oval device which is itself part of what is probably a label with a bold background pattern. Visually the words form a relatively small part of the whole. In contrast No. 2125798 is for the words LA MEXICANA on their own. As it is the words (or more particularly the word MEXICANA) on which the opponents rely I consider the latter registration to offer them their best chance of success. I should also add that No. 2125798 is a multi-class registration which reproduces and consolidates the specifications of the other two registrations.

Comparison of goods

14. The parties' submissions have concentrated in large measure on a consideration of the respective marks. There is little in the way of detailed analysis of the goods. That is not altogether surprising in the circumstances of this case. A cursory review of the Class 29 and 30 specifications will reveal that identical goods are involved. The applicants concede that this is the case (witness statement of Robert James Hawley, paragraph 18). The opponents, for their part, anticipate that certain of the applicants' goods in Class 31 may not be similar to the goods of their own earlier trade marks. Between these extremes there are likely to be a number of items which are susceptible to argument as to whether they are similar in the context of the established criteria set down in the *Canon* case. I do not find it necessary to resolve this middle ground at this point.

Distinctive character of the respective marks

15. The distinctive character of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). Furthermore there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it (*Sabel v Puma*, paragraph 24).

16. The distinctiveness of a mark must also be assessed in the context of the goods for which it is applied for or registered and by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). The opponents' mark is LA MEXICANA. It is recorded that "the mark consists of South American Spanish words meaning "The Mexican Woman"". The opponents' goods are qualified as being "all originating from Mexico or made to Mexican recipes or being in Mexican style". Clearly the mark will be taken to allude to the Mexican theme of the goods. But the mark is not MEXICAN. If it was it would have been wholly descriptive. The presence of LA and the final A takes the mark beyond a purely descriptive word. What is not clear is how the average consumer would see the mark. Would the average consumer understand that the mark means 'The Mexican Woman'? There is no evidence to suggest that there would be any significant level of awareness of such a meaning amongst potential purchasers of the goods even though some may identify LA as the definite article. In these circumstances I am of the view that for most people the mark will be taken to allude to the nature of the underlying goods but with the precise meaning of the mark remaining somewhat obscure. On that basis the mark can be said to enjoy a moderate degree of distinctive character but I would put it no higher than that.

17. The opponents have filed evidence of use which I assume is intended in part to support a claim to an enhanced distinctive character for their mark. The primary evidence comes from John Brennan, a Director of La Mexicana Quality Foods Ltd. The main points to emerge from his witness statement are that:

- the company has been selling a range of Mexican foodstuffs since 1986;
- turnover in the last five years has been in the region of £2-£2.5 million per annum;

- advertising has taken place in e.g. supermarket magazines;
- the goods have been promoted at various UK and European food exhibitions;
- advertising expenditure has been in the £25-£50,000 range over the past few years;
- the goods are sold to leading supermarket chains, food service companies and the industrial sector.

18. Exhibits JB2 to 5 have been supplied in support of the above – these being a selection of packaging, recipe cards, price lists, photographs of an exhibition stand and a Tesco magazine advertisement.

19. The evidence has been heavily criticised in a witness statement filed by Robert James Hawley, the applicants’ trade mark adviser. Mr Hawley’s main points are that much of the material is undated; that the use of LA MEXICANA is in a label logo (but not the form of the registered marks) and is in essence the opponents’ company name; that there are few instances of use of the mark in relation to goods; that the turnover figures are not said to relate to the UK only; and that the exhibition photographs may not represent UK use (in fact I understand they were taken at an exhibition in Germany albeit that it is said to attract visitors from the UK).

20. There is force to some of these criticisms. Much of the evidence is not dated and shows use on a limited range of goods (mainly tortillas and wraps though I accept that the product list at JB2 refers to a somewhat wider range of goods). No breakdown of the turnover figure is given which might help to cast light on whether an enhanced reputation might exist in relation to specific products. The mark LA MEXICANA is used either on its own or as part of a simple label device with or without the addition of the words ‘Quality Foods’. I take the view that the applicants’ criticism (that it is in effect use of the company name) is misplaced in this regard. The overall impression is that there is an established business of moderate size but that there is simply insufficient substantiating detail to reach an informed view as to the nature and extent of the opponents’ reputation. In *DUONEBS Trade Mark* BL O/048/01 Mr S Thorley QC, sitting as the Appointed Person, in dealing with the question of the reputation attaching to a mark said:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

21. I do not consider that I can come to the conclusion that the opponents’ mark enjoys an enhanced reputation as a result of the use made of it and certainly not in relation to the full range of goods for which it is registered. If the opponents wished to make a claim for such a reputation

in relation to a narrower range of products then it was incumbent on them to supply disaggregated and specific evidence addressing that claim.

22. Turning to the applied for mark, it is a complex mark consisting of the words CANTINA MEXICANA with the first word in arching dark orange lettering set against a sun device and MEXICANA in white lettering on a black banner. To either side of the sun device are a device of a cactus and a sitting figure wearing a sombrero. These latter are fairly commonplace images associated with Mexico or things Mexican and contribute in a modest way only to the overall distinctive character of the mark. The mark is also subject to the colour claim referred to above. Consumer perception and recognition is likely to focus on the words CANTINA MEXICANA and the overall get-up of the mark. I regard the totality as being possessed of a reasonably high degree of distinctiveness.

23. There is, additionally, a witness statement from Mr W.A.P. F. L. de Wit, Director/President of the applicant company. He gives evidence of use in the UK since 1996 but the turnover figures are extremely small and no supporting exhibits have been supplied. This evidence does not take matters any further forward.

Comparison of marks

24. The visual, aural and conceptual similarities of the marks are to be assessed by reference to the overall impressions created by those marks, bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23).

25. The opponents in their written submissions suggest that, whilst the applicants' mark contains a number of details, it clearly shows MEXICANA as a central and prominent feature. They say that it is possible that the average consumer will retain the word MEXICANA as an essential feature of the mark and that the different meanings between the marks claimed by the applicants (see below) would not necessarily be recognised in the UK. I note too that it is suggested the sun device appearing in the applied for mark is not dissimilar in shape to the oval device forming part of the opponents' marks as registered under Nos. 1477550 and 1578949. However, I can see little merit in such a claim.

26. The applicants' submissions (contained in Mr Hawley's evidence) point to the composite nature of their mark and the fact that the words CANTINA MEXICANA will be understood by the relevant public as referring to either a restaurant or bar-restaurant specialising in Mexican cuisine (the point is not expressly explained but I assume it rests on CANTINA being perceived as being akin to 'canteen'). On that basis, it is said that mark has a conceptual significance of its own which is different from LA MEXICANA meaning the Mexican woman.

27. Clearly the element MEXICANA is a feature of both marks. It is the dominant element in the mark LA MEXICANA and a visually prominent element in the applied for mark. It is equally clear that overall there are significant visual differences between the respective marks that is to say both the opponents' LA MEXICANA and device marks and the word only form. Much therefore, depends on consumer perception of the significance of, and importance attaching to, the presence of the common element.

28. The applicants' submissions focus on what they consider to be the different ideas conveyed by the marks. The issue is perhaps better approached from the standpoint of consumer perceptions. I have already indicated I am not persuaded that consumers would understand LA MEXICANA to mean the Mexican woman. They may understand LA to be the definite article in which case MEXICANA would (subconsciously at least) be understood to be a noun but the precise meaning might be elusive.

29. By contrast the word MEXICANA appearing in conjunction with CANTINA is more likely in my view to be seen as subordinate, adjectival (and descriptive) usage. There are sufficient visual and phonetic similarities between CANTINA and the English word canteen that the allusion to an eating establishment will not be lost on consumers. Alternatively, if that is overstating the position, CANTINA would be treated as a meaningless word (but one which would thereby have an even stronger claim to be a distinctive component within the mark). Either way MEXICANA would in my view be seen as qualifying element.

30. In *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 32 Mr G Hobbs QC, sitting as the Appointed Person, in a case involving the *Polo Lauren Company* as opponents said:

“The word POLO functions adjectivally in the context of the applicant's mark whereas the opponent's earlier trade mark registrations envisage use of the word POLO in a manner that would, most likely, be perceived as a noun. Adjectival use of a word is distinguishable from use of the same word as a noun and the resulting differences of perception may be sufficient to preclude a likelihood of confusion of *The European Ltd v. The Economist Newspaper Ltd* [1998] F.S.R. 283, CA, at page 293 per Hobhouse L.J. I think that is the case here. In my view the semantic content of the marks in issue is (and was at the relevant date) insufficiently similar or analogous to give rise to the mistaken belief that POLO brand toiletries and ROYAL BERKSHIRE POLO CLUB toiletries come from the same undertaking or economically-linked undertakings.”

31. Some care is needed with analogies of this kind particularly where foreign language words are involved. But I think it is entirely likely that, in the context of Mexican foodstuffs, the word MEXICANA will be seen as descriptive adjectival use in the CANTINA MEXICANA mark. For somewhat different reasons to the applicants I find that this points to a low degree of conceptual similarity between the marks (save in so far as both may be said to allude to the nature of the underlying goods).

32. Finally, I should briefly comment on aural similarity. The graphical elements of the applicants' mark are unlikely to play a part in oral/aural use. The comparison is, therefore, likely to be between LA MEXICANA and CANTINA MEXICANA. The presence of the common element results in some similarity but there is no basis for thinking that the other elements of, and differences between, the marks will go unnoticed.

33. There is one further piece of evidence that I have not so far mentioned. This is a witness statement by Barry Margolis, the Chairman of Apple Pan Ltd. He gives evidence to the effect

that he is familiar with the range of products sold under the trade marks LA MEXICANA or LA MEXICANA and device (he does not identify the device he means). He comments as follows:

“I would not be happy to see products sold under the Trade Mark CANTINA MEXICANA because I consider this to be too close to LA MEXICANA or LA MEXICANA & Device.”

34. There is no explanation as to what prompted Mr Margolis’ statement and what, if any, his relationship is with the opponents. More importantly he does not say that he would be confused (only that the marks are in his view ‘too close’) or why he is of this view. The question of whether marks are similar is a matter for the tribunal. I do not find this evidence to be of assistance.

Likelihood of confusion

35. This is a matter of global appreciation (*Sabel v Puma*, paragraph 22). The *Canon* case also sets out the principle of interdependency such that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon v MGM*, paragraph 17). I bear in mind that identical and/or similar goods are involved and that the applied for mark reproduces the dominant element of the opponents’ LA MEXICANA mark. MEXICANA is not a word in the English language but any distinctiveness that it attracts on that account must be tempered by the fact that it is strongly allusive in nature when used in relation to Mexican foodstuffs. In the final analysis I must have regard to the marks as wholes. My conclusion is that there is no likelihood of consumers being confused into thinking that the applicants’ goods were those of the opponents or someone associated with or licensed by the opponents. The opposition fails under Section 5(2)(b).

36. There are, additionally, the grounds under Section 5(3) and 5(4)(a). However, in the light of my views on the marks it would not be possible for the opponents to succeed under these heads having failed under Section 5(2).

37. The opposition has failed. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of December 2003

**M REYNOLDS
For the Registrar
the Comptroller-General**