

O-067-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2583110  
BY  
NDINOS PERI PERI LIMITED  
TO REGISTER THE TRADE MARK



IN CLASS 30

AND

THE OPPOSITION THERETO  
UNDER NO 102486  
BY  
NANDO'S INTERNATIONAL HOLDINGS LIMITED

## BACKGROUND

1. On 1 June 2011, Ndinos Peri Peri Limited (the applicant) applied to register the above trade mark in class 30 of the Nice Classification system, as follows:<sup>1</sup>

Peri peri sauces, condiments, marinades, salad dressings


2. Following publication of the application on 8 July 2011, Nando's International Holdings Limited (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed at all of the applicant's goods in class 30. The opponent relies upon the three marks shown below in respect of the opposition under section 5(2)(b).

<b>MARK DETAILS AND RELEVANT DATES</b>	<b>GOODS AND SERVICES</b>
<p><b>TM:</b> 2502465</p> <p><b>MARK:</b> NANDINO'S</p> <p><b>Filing date:</b> 13 November 2008</p> <p><b>Registration date:</b> 24 April 2009</p>	<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits, vegetables and meat; salads including vegetable salads; jellies, jams, eggs, milk, milk products and other dairy products; edible oils and fats; preserves, pickles; pre-prepared uncooked, semi-cooked and cooked foods, snacks of all kinds included in class 29 including those prepared from/made of meat, fish, poultry, game, fruits and vegetables and combinations and products thereof; hamburgers, pies and hotdogs having meat, fish, poultry or vegetable fillings.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, pepper, vinegar, sauces of all kinds (except salad dressings); spices; mayonnaise.</p> <p>Class 43: Restaurants, snack bars, cafeterias, road-houses, canteens, take-away or fast-food outlets; catering, food and beverage serving, restaurants chains, central kitchen (food preparation) services.</p>

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

<p><b>TM:</b> 2502462</p> <p><b>MARK:</b></p>  <p><b>Filing date:</b> 13 November 2008</p> <p><b>Registration date:</b> 24 April 2009</p>	<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits, vegetables and meat; salads including vegetable salads; jellies, jams, eggs, milk, milk products and other dairy products; edible oils and fats; preserves, pickles; pre-prepared uncooked, semi-cooked and cooked foods, snacks of all kinds included in class 29 including those prepared from/made of meat, fish, poultry, game, fruits and vegetables and combinations and products thereof; hamburgers, pies and hotdogs having meat, fish, poultry or vegetable fillings.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, pepper, vinegar, sauces of all kinds (except salad dressings); spices; mayonnaise.</p> <p>Class 43: Restaurants, snack bars, cafeterias, road-houses, canteens, take-away or fast-food outlets; catering, food and beverage serving, restaurants chains, central kitchen (food preparation) services.</p>
<p><b>TM:</b> 1467109</p> <p><b>MARK:</b> NANDO'S</p> <p><b>Filing date:</b> 10 June 1991</p> <p><b>Registration date:</b> 24 September 1993</p>	<p>Class 29: Meat, fish, poultry and game; preserved, dried and cooked fruits and vegetables; salads; mayonnaise and salad dressings; pickles and preserves; milk and milk products; prepared meals and snacks; all included in Class 29.</p> <p>Class 30: Coffee, tea, cocoa, sugar; non-medicated confectionery; bread, cakes, pastries, pies and biscuits; ices; ice-cream; salt, mustard, pepper, vinegar, sauces and spices; prepared meals and snacks; all included in Class 30.</p> <p>Class 43: Catering services; restaurant, cafe, cafeteria, bar and snack bar services; consultancy and advisory services, all relating to catering and to the planning of parties.</p>

5. In its statement of grounds the opponent states that the applicant's mark is phonetically and visually similar to its three earlier marks. It also submits:

*"21. ...the goods of the Opposed Mark and the goods and services of the Earlier Trade Marks are identical and/or highly similar."*

6. In relation to section 5(3) the opponent relies on the second and third marks listed above, which it terms „the Nando’s marks’. It states in its notice of opposition:

*“25. The Opponent’s UK trade marks numbers 1467109 and 2502462 enjoy an extensive reputation in the UK in respect of all the goods and services for which they are used and registered, including restaurants, sauces and spices. The Opponent has been using the NANDO’S Marks in the UK since 1992 and currently has over 200 restaurants located across the UK offering a wide menu of food and drinks and in particular its speciality dish, flame grilled chicken with medium, hot or extra hot Peri-Peri sauce. In addition a variety of sauces (e.g. Nando’s Medium Peri-Peri sauce), marinades and spice rubs are sold under the NANDO’S Marks in a number of supermarkets (including Sainsbury’s and Tesco’s) and are available from the Opponent’s online shop.”*

7. Under the heading „Unfair advantage taken of the distinctive character of the repute of that mark’, it states:

*“29. The Opponent submits that the Applicant will obtain unfair advantage by its registration and use of the Opposed Mark because the registration and use of that mark creates a link in the mind of the average consumer between the Opponent’s goods and services and the Applicant’s goods.*

...

*31. The advantage gained by the Applicant is unfair as it is parasitic on the well established reputation and goodwill enjoyed by the Opponent’s goods and services, including restaurants, sauces and spices under the NANDO’S marks.”*

8. Under the heading „Detriment to the distinctive character of the earlier mark’ the opponent submits that a link would be formed in the mind of the public between the opposed mark and the NANDO’S marks and that:

*“33. This would affect the economic behaviour of the average consumer of the goods and services for which the NANDO’S marks are used and registered, as the number of customers visiting its restaurants and buying its goods such as sauces from supermarkets and its online shop will be reduced as a result of the erosion of the distinctive character. This will affect the Opponent’s revenue and profits.”*

9. Under the heading „Detriment to repute of that mark’ the opponent states:

*“34. Public recognition of the Nando’s brand in the UK is very substantial. The Opponent has over 200 Nando’s restaurants in the UK and its goods are available for sale from a variety of retailers including supermarkets and the Opponent’s own online shop. The sale of products made to a different quality standard under a mark which the public associate with the Opponent is detrimental to the repute of the NANDO’S marks.”*

10. Under 5(4)(a) of the Act the opponent relies on the plain word mark NANDO’S and states:

*“38. ...the Opponent’s NANDO’S Marks were first used in the UK in 1992. Since then the NANDO’S mark has been extensively used in respect of a wide variety of goods and services for amongst other things restaurants, sauces and spices, marinades, spice rubs and mayonnaise. There has been consistent use of the*

*NANDO'S mark in a red thick-styled font, as per UK trade mark registration number 2502462."*

11. The opponent concludes that since the applicant mark is identical in colour and filed in respect of identical goods, namely peri-peri sauces, confusion will occur. This in turn will lead to considerable damage to its goodwill associated with the NANDO'S mark.

12. On 12 December 2011, the applicant filed a counter statement in which it denies the grounds upon which the opposition is based. Mr Criticos (the director of the applicant company) submits that the application is his own name and as such should be registered.

13. The opponent's marks 2502462 and 2502465 are earlier marks which are not subject to proof of use because, at the date of publication of the application, none of them had been registered for five years.<sup>2</sup> The opponent's mark 1467109 is subject to proof of use, having completed its registration on 24 September 1993.

14. A hearing took place on 13 December 2012 at which the applicant was represented by Mr Criticos and the opponent was represented by Allan Poulter of Bird & Bird LLP.

## **EVIDENCE**

### **The opponent's evidence**

15. The opponent's evidence consists of witness statements from Andrew Colin Rayner, dated 21 February 2012, accompanied by 9 exhibits and Georg Friedrich Gruber, dated 17 February 2012, accompanied by 15 exhibits.

### Mr Rayner's witness statement

16. Mr Rayner is the Marketing Director of Nando's Chickenland Limited and states:

*"I am authorised by Nando's International Holdings Limited to make this witness statement on its behalf."*

17. Mr Rayner explains at paragraph 4 of his statement that the opponent company holds all of the intellectual property rights used in all Nando's restaurants worldwide. Nando's Chickenland Ltd is the UK franchise.

18. In respect of Nando's products Mr Rayner states:

*"6. Nando's also manufactures, distributes and sells a range of proprietary sauces, marinades and condiments which are sold in Nando's restaurants, through the online shop on Nando's UK website, and in supermarkets nationwide."*

19. At paragraph 7 Mr Rayner lists the products referred to. These include, inter alia, peri-peri sauces, peri-peri marinades, peri-peri table sauces, lemon & herb peri-peri seasoning rub, BBQ peri-peri seasoning rub, Hot peri-peri seasoning rub and peri-peri chip sprinkle.

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

20. At paragraph 8 Mr Rayner states that turnover from Nando's UK business was £317,356,000 for the year ending 27 February 2011.

21. Exhibit AR1, dated 15 February 2012, is a print of these products taken from Nando's website at [www.nandos.co.uk](http://www.nandos.co.uk). Each product is listed with a small picture to the left, the title of the product and the price. The prints include the sauces listed in Mr Rayner's witness statement, inter alia, medium peri-peri sauce, garlic peri-peri sauce, sun dried tomato and basil peri-peri sauce. The images of the sauces bottles are too small to see the mark clearly though it looks to be the red „Nando's' mark, namely:

The image shows the Nando's logo, which consists of the word "Nando's" in a stylized, red, cursive font with a white outline and a slight shadow effect.

22. Exhibit AR2 consists of the annual accounts for the 52 week period ending 27 February 2011.

23. Exhibit AR3 consists of prints of Nando's products available from Sainsbury's, Tesco's and Asda websites, dated 26 January 2012, and prints from Waitrose website, dated 2 February 2012. Each of the products is listed with a small picture and description of the product followed by the price. The products shown include the types of sauces described by Mr Rayner, inter alia, peri-peri sauces in various strengths, salsa, marinades, chip sprinkle. The images of the sauces bottles are too small to see the mark clearly though it looks to be the red „Nando's' mark reproduced at paragraph 21, above.

24. Exhibit AR4 is an article taken from the Observer on Sunday 16 May 2010, titled *„How Nando's conquered Britain - David Beckham eats there. So does Tinchy Strider. The peri-peri chicken chain is now the restaurant of choice for a new breed of confident multi-cultural Britons'.*

25. Mr Rayner states, at paragraph 15, that since 1999 Nando's has spent over £10 million on advertising and marketing. Its goods and services have been promoted on posters and through press, radio, television and internet advertising. Exhibited at AR5 are a selection of these posters and press cuttings. Eight pages show examples of flyers. These are not dated and it is not clear where they were made available. Cuttings are provided of articles printed in the *Daily Mail*, *Independent*, *Sun* and *Financial Times* newspapers and *Heat* magazine, dated 17 May, 18 May, 21 June, 1 July 2010 and 27 Feb- 5 Mar 2010.

26. Exhibit AR6 is a disc of radio and internet adverts.

27. At paragraph 16 Mr Rayner states that Nando's operates within the social networking world. It has a facebook page which is regularly updated. It currently has 750,000 people who „like' it. Nando's also operates a Twitter page which has over 200,000 followers and launched a smart phone application (app) in January 2012. Exhibit AR7 is a print, dated 26 January 2012, from its website, announcing the launch.

28. Exhibit AR8 is a print of Nando's Food Standards Agency commitments which relates to 2008.

29. Exhibit AR9 is a copy of the current Nando's menu. The section of the menu for under 10s is headed „Nandinos'.

## Mr Gruber's witness statement

30. Mr Gruber is the Chief Executive Officer of the Nando's Grocery Division of Nando's Chickenland Limited. He states:

*"3. As CEO of Nando's Grocery my role includes the responsibility of the Nando's Grocery UK business. Nando's Grocery Limited is responsible for licensing the Nando's Grocery Offering to All About Food Ltd., a UK registered company, which is authorised to sell the Offering to UK grocery retailers. The Offering comprises a portfolio of Nando's products, together with the use of the Nando's brand as a whole."*

31. Exhibit GG1 is a copy of the opponent's marks taken from the UK Trade Marks Register.

32. Exhibit GG2 are prints of a selection of peri-peri sauces, condiments etc. which include pictures of chillies on their respective labels. These include sauces by Cambridge Chilli Farm, Cajohn's, Hot-Headz!, Wellington's and the Chilli Foundry. Mr Gruber states that the use of a chilli pepper in the opposed mark does not distinguish it from the earlier marks.

33. Exhibit GG3 is a screen shot which Mr Gruber states shows a search for 'Nandinos Peri-Peri' which returns Nando's website as the first hit and various Nando's products as suggestions. This print is not dated.

34. Exhibit GG4 is an article from the *London Evening Standard*, dated 13 December 2011. It is an interview with Mr Criticos, the applicant in these proceedings. Mr Gruber notes the following quotation from the article:

*"While the two brands [Nando's and Nandinos] may look 'confusingly similar' on the outside, they taste anything but."*

35. Exhibit GG5 is an article from the IPKat blog concerning these proceedings, dated 2 February 2012. Mr Gruber provides the following quotation:

*"The IPKat can't help but feel some sympathy for Nando's in this instance: he had to do a double-take when first reading about the dispute to assure himself that that 'Nandinos' was not, in fact, a typo."*

36. Mr Gruber concludes that these extracts show that third parties regard the marks as confusingly similar.

37. Exhibit GG6 is an extract from Nando's website, dated 15 February 2012. It shows the children's menu, which is headed 'Nandinos'. Mr Gruber also refers to the article from the *Observer* exhibited by Mr Rayner at AR4. The bottom of page 2 refers to customers of Nandos's as 'Nandinos'. Mr Gruber states that 'Nandinos' is a term widely used to refer to Nando's customers.

38. Exhibit GG7 is a photograph taken from the applicant's *facebook* page, posted on 4 August 2011, which Mr Gruber says, "appears to show the Applicant's goods and Nando's goods next to each other on the same shop shelf."

39. At exhibits GG8 and GG9 Mr Gruber provides prints from the applicant's facebook and twitter pages showing a link he has posted to the *London Evening Standard* article. These prints are dated 2 February 2012. Mr Gruber states that by using the opposition proceedings to gain publicity for his brand, the applicant is creating a link between his own goods and those of Nando's.

40. Exhibit GG10 shows bottles of Nando's sauces presented above Ndinosaurs sauces on the page. This appears to be a created page showing images of the parties' goods cut and pasted from elsewhere. The page is undated.

41. Exhibit GG11 consists of prints from *dooyoo* and *amazon* UK, dated 2 February 2012. These are online marketplaces on which Nando's goods are sold. Mr Gruber draws attention to the fact that Nando's Peri-Peri sauces have a five star customer rating on *amazon*.

42. Exhibit GG12 is a print from the applicant's website, dated 16 February 2012. It describes the origins of the applicant's sauce as a family recipe.

43. Exhibit GG13 is a print from the applicant company's facebook page, dated 15 February 2012, which Mr Gruber suggests shows that Mr Criticos (the director of the applicant company) is known to his friends as „Dino’.

44. Exhibit GG14 is a print of Mr Criticos's personal facebook page showing his name to be Dino Criticos. The print is dated 2 February 2012.

45. Exhibit GG15 is undated. It consists of two pages of pictures of two Nando's restaurants, a selection of sauce bottles, two packets (I cannot be sure what they contain), three containers of the sort used to package herbs and spices which are labeled „peri-peri' grind, a seasoning rub, a jar of peri-naise and a jar of peri-salsa and a cooking sauce. These products all show the Nando's red stylised word on the labels.

### **The applicant's evidence**

46. The applicant's evidence consists of a witness statement by Ndinosaurs Criticos, dated 15 August 2012, accompanied by 8 exhibits and six „stand alone' witness statements.

### Mr Criticos's witness statement

47. Ndinosaurs Criticos is the founder and director of Ndinosaurs Peri-Peri Ltd.

48. Mr Criticos states:

*“3. As director of Ndinosaurs Peri Peri Ltd my role includes the day to day running of the company and all the marketing, manufacturing and distribution of my products.”*

49. Exhibit NCI-01 consists of prints from the UK Register of the three marks relied upon by the opponent in these proceedings.

50. Exhibit NCI-02 is a page with the opponent's earlier mark, 2502462, the stylised „Nando's' mark, presented above the applicant's mark. Mr Criticos says:



*“Differences are easily spotted between the marks, in their details and as whole marks.”*

51. Exhibit NCI-03 is a print taken from Google. Mr Criticos states that this is the same search carried out by the opponent and submitted with their evidence above. He states that the search for „Ndinos Peri Peri’ returned his own company’s website and not „Nando’s sites or products’.

52. Exhibit NCI-04 is a witness statement by Liana Conradie, dated 15 August 2012. Ms Conradie is the designer of the applicant’s mark and states:

*“As a designer of various brands, and someone who believes in creating unique and timeless designs, I can confirm that Ndinos Peri Peri brand is not a threat to Nando’s.”*

53. Exhibit NCI-05 is a copy of Mr Criticos’s birth certificate, which shows his name to be NDINOS CRITICOS.

54. Exhibit NCI-06 consists of some prints taken from Nando’s website. These are not dated.

55. Mr Criticos states that the prints show Nando’s use a black cockerel/chicken on their products, buildings and advertising, not a chilli.

56. Exhibit NCI-07 is a print taken from ndinosperiperi.co.uk of the homepage.

57. Exhibit NCI-08 is a picture of a bottle of Ndinos peri peri sauce next to a bottle of Nando’s peri peri sauce. Mr Criticos points out that the bottles and lids of his company’s goods are of different sizes and materials to those of the opponent’s goods.

58. The applicant has also filed stand alone witness statements by some of the stockists of its products. Each of the five witnesses state that they are not aware of any confusion between the applicant’s and opponent’s products. Only two of them sell both parties’ goods. The sixth statement is by Charlie Westcar, Office Manager at the Guild of Fine Foods. He also states he is not aware of any confusion between the products.

### **The opponent’s best case**

59. The opponent relies on three marks for the purposes of this opposition. At the hearing Mr Poulter stated that the plain work mark NANDINO’S is the closest to the applicant’s mark, as the whole of the applicant’s mark is contained within it. I agree. It is on this basis that I will continue. As I have stated above at paragraph 13, NANDINO’S is not subject to proof of use.

## DECISION

60. First I will deal with the opposition based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

(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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

### Section 5(2)(b) case law

61. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### The CJEU cases

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing act**

62. The earlier mark covers services as well as goods. For the purposes of the comparison based on 5(2) I will consider the goods only. If the opponent cannot win based on the goods, they are in no better position in respect of the services.

63. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

64. The average consumer of the goods at issue will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf. These are relatively low value, fairly frequent purchases though, in my view, the average consumer will pay a reasonable degree of attention, to the extent that they will consider, inter alia, ingredients, nutritional value, flavour and in the case of these particular goods, the strength of flavour.

## Comparison of goods and services

65. The goods and services to be compared are as follows:

Opponent's goods and services	Applicant's goods
<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits, vegetables and meat; salads including vegetable salads; jellies, jams, eggs, milk, milk products and other dairy products; edible oils and fats; preserves, pickles; pre-prepared uncooked, semi-cooked and cooked foods, snacks of all kinds included in class 29 including those prepared from/made of meat, fish, poultry, game, fruits and vegetables and combinations and products thereof; hamburgers, pies and hotdogs having meat, fish, poultry or vegetable fillings.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, pepper, vinegar, sauces of all kinds (except salad dressings); spices; mayonnaise.</p> <p>Class 43: Restaurants, snack bars, cafeterias, road-houses, canteens, take-away or fast-food outlets; catering, food and beverage serving, restaurants chains, central kitchen (food preparation) services.</p>	<p>Class 30: Peri peri sauces, condiments, marinades, salad dressings</p>

66. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

67. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated, at paragraph 23 of its judgment:

“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.”

68. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

69. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:


“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

70. „Peri peri sauces’ and „marinades’ in the application clearly fall within the broad category „sauces of all kinds...’ contained in class 30 of the opponent’s specification. In accordance with *Meric* these goods are identical. „Salt’, ‘pepper’, „mustard’ and „vinegar’ in the opponent’s specification in class 30 are included within the broad term „condiments’, in the application. On the *Meric* principle these are also identical goods

71. The application also includes salad dressings, the opponent’s specification specifically excludes salad dressings but includes mayonnaise in class 30. The users of both parties’ goods are members of the general public. Such products will be used as an accompaniment for food. The goods may be liquid or of a thicker consistency and are normally made available in bottles or soft plastic packaging. The goods are available in supermarkets, from websites and from smaller stores. Evidence filed by both parties shows the products presented side by side on the same shelves. The goods are not complementary in the sense that one is indispensable for the use of the other. They are in competition, one could use mayonnaise in place of salad dressing and vice versa. Taking these factors into account I find these goods to be highly similar.

## Comparison of marks

72. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
NANDINO'S	

73. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>3</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind.

### Dominant and distinctive components

74. The applicant's mark consists of six characters, which Mr Criticos stated at the hearing and in his witness statement; represent his own first name, NDINOS. There is some degree of stylisation to the letters which are presented in upper case in red. The third character in the mark consists of a chilli shaped device in place of the letter 'I' which Mr Criticos has stated, in his witness statement and at the hearing; he believes to be distinctive for his company's goods. The background has a few small red marks which the applicant describes as „vibration marks'. These are unlikely to be noticed by the average consumer, but even if they are they are unlikely to be afforded any trade mark significance.

75. At exhibit GG2 Mr Gruber has submitted images of a range of chilli based products which include pictures of chillies on their labels. It can come as no surprise to anyone that the device of a chilli is likely to be used by a wide range of those trading in the field of chilli based sauces and foodstuffs. While I think I would have been prepared to accept as much without evidence, the opponent's evidence puts the matter beyond doubt. In those circumstances, while the device of a chilli in place of the letter 'I' in the applicant's mark is a dominant element, if it has any distinctive character at all, it can only be at a very low level. More likely, it will be seen by the average consumer as an indication of the type of goods to which the trade mark will be applied i.e. goods containing chillies. The chilli device does not prevent the word from being read as NDINOS. Consequently, it is the word which is the dominant element of the mark.

76. The opponent's mark, 'NANDINO'S', does not split into separate distinctive and dominant components. It will be viewed as the word 'NANDINO'S' which is its only constituent part. I will now approach the visual, aural and conceptual comparison with the above conclusions in mind.

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<sup>3</sup> *Sabel v Puma AG*, para. 23.

## Visual similarities

77. In his witness statement Mr Criticos highlights several points of difference between the marks:

*“Ndinos is in Taco salad font which has been altered to make it unique - very different to the Nando’s font.*

*They are two different words (spelt differently)*

*NDINOS is in two tone black/red...Nando’s is a different single tone colour red.*

*NDINOS is written in a font going from small to large and back to small as it is sticking out more in the centre.*

*Nando’s is in all uniform size letters bar the Capital “N”*

*Nando’s has an apostrophe “s” at the end NDINOS does not.*

*NDINOS has a Dominant CHILLI featured in it serving as part of the mark, Nando’s doesn’t have a dominant distinctive feature in it [sic] registered mark.*

*NDINOS has red vibration marks symbolising movement - Nando’s has Nothing”*

78. In its skeleton argument filed on 11 December 2012, the opponent stated:

*“The first letter and the last 5 letters of UK trade mark number 2502465 for NANDINO’S are the same as for the Opposed Mark. Visually, the only difference between NANDINO’S and the dominant part of the Opposed Mark is the additional two letters („an’) after the first letter (and the absence of an apostrophe in the Opposed Mark, but which is implied). It is well-established that a word mark covers the word in a wide range of typefaces because the distinctive character of the mark resides in the word itself.”*

79. The opponent concludes that the marks are visually highly similar.

80. The applicant refers to the colouring of its mark as one of the elements which distinguishes it from the opponent’s mark. This does not have a bearing on the issue of similarity as the applicant’s mark is not limited to any particular colour. The matter must be assessed on the similarity between the respective words without regard to colour.<sup>4</sup>

81. The respective words are six characters and eight characters in length. They both begin with the letter „N’. The opponent’s mark ends with the five letters „DINOS’, the applicant’s with five characters, which Mr Criticos states represent the letters „DINOS’. Taking all of these factors into account I find the marks share a reasonably high degree of visual similarity.

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<sup>4</sup> *Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2) [2011] FSR 1, Mann, J.*

## **Aural similarities**

82. Mr Criticos identifies the following differences between his company's mark and that of the opponent:

*"6.9 Nandino's Pronounced "Nan-Dee-Nose" (three syllables)  
Ndinos Pronounced "N-DEE-NOS" (three syllables)..."*

*6.10 "Ndinos" is a Greek name and in the Greek language "OS" at the end of a word is masculine and pronounce [sic] in the same way as you would pronounce the name of the Greek island of KOS. In the Greek language they do not pronounced [sic] my name a N-dee-nose. It is incorrect."*

83. The opponent states:

*"20. The Opposed Mark is pronounced "N-dee-nose". NANDINO'S is pronounced "Nan-dee-nose". Thus, both NANDINO'S and the Opposed Mark consist of three syllables: the first syllables of both marks start with the letter "N"; both marks have the same "dee" syllable in the middle; and the last syllables are also the same ("nose")."*

84. The opponent concludes that there is a high degree of aural similarity between the marks.

85. I must assess the marks before me with reference to the average consumer for the goods in question. The average consumer in this case is the average UK consumer, who is unlikely, in my view, to be familiar with the finer points of grammar within the Greek language. Consequently, the average consumer will pronounce the opponent's mark in the way that both parties describe, NAN-DEE-NOSE and will, more likely pronounce the applicant's mark N-DEE-NOSE. Taking these factors into account I find there to be a high degree of aural similarity between the marks.

## **Conceptual similarities**

86. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>5</sup>

87. The applicant's mark, which Mr Criticos states is his first name, NDINOS is not a dictionary word and will be seen by the average consumer as an invented word. The opponent's mark NANDINO'S may also be seen as a made up word, in which case the parties' marks are neither conceptually similar nor conceptually different. However, the addition of the apostrophe means that the opponent's mark may be seen as relating to a person called NANDINO, in which case the marks are conceptually distinct. Which of these is more likely, I cannot be certain.

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

88. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as

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<sup>5</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.



coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

89. The opponent's mark consists of the word 'NANDINO'S'. It does not serve to describe the goods at issue, nor is it non-distinctive in that context. Consequently, the mark in its totality possesses a high level of inherent distinctive character. In evidence filed by the opponent there are two examples of use of the NANDINO'S mark, namely, on the menu to refer to the children's section and in a newspaper article which describes *Nando's* customers as „NANDINOS'. The totality of the use shown is not sufficient to enhance the distinctive character beyond the already high level of inherent distinctive character I have identified above.

### **Likelihood of confusion**

90. Throughout the hearing and in his submissions Mr Criticos was keen to point out that the word which is the subject of his application, NDINOS, is his own name and that he is therefore able to rely on Section 11(2)(a) of the Act. NDINOS is in fact his first name, the full name on the birth certificate in evidence being NDINOS CRITICOS. It is not clear from the evidence provided what name Mr Criticos uses generally, though his facebook page would indicate 'DINO'. What is self evident is that the chilli pepper element in the applicant's mark is not part of Mr Criticos's name and has been designed as part of the trade mark.

91. Section 11(2)(a) was designed to stop the proprietors of trade mark registrations from preventing a person or persons from using their own name and address to identify themselves, providing such use was in accordance with honest practices. It cannot be used as a defence in opposition proceedings, the relevant provisions for which I have outlined above.

92. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>6</sup> I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

93. I have found that the marks share a reasonably high degree of visual and a high degree of aural similarity and are conceptually neutral or distinct. I have found a high level of inherent distinctive character in the earlier mark and have found the applicant's goods to be identical to those of the opponent, other than „salad dressings', which I have found to be highly similar. I have identified the average consumer, namely a member of the general public and have concluded that a reasonable degree of attention will be paid to the purchase of such goods (which will be primarily visual), to the extent that the purchaser will consider, inter alia, ingredients, flavour, nutritional information, etc.

94. Taking all of these factors into account the similarity of the marks are such that in the context of identical and highly similar goods, purchased, for the most part, visually, there will, in my view, be direct confusion (where one mark is mistaken for the other). At the very

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

least there will be indirect confusion (where the average consumer believes the respective goods and services originate from the same or a linked undertaking).

### **Conclusion**

95. The opposition having succeeded under 5(2)(b) it is not necessary for me to make an assessment under sections 5(3) and 5(4)(a) of the Act, neither of which put the opponent in any better position.

### **Costs**

96. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering the other side's evidence:	£500
Preparation for and attendance at a hearing	£500
Official fee:	£200
<b>Total</b>	<b>£1500</b>

97. I order Ndinós Peri Peri Limited to pay Nando's International Holdings Limited the sum of £1500. 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 13th day of February 2013**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**