

O-326-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2295498
BY THE BURY BLACK PUDDING CO LTD
TO REGISTER THE TRADE MARK:**



IN

CLASS 29

AND

**THE OPPOSITION THERETO
UNDER No 90795**

**BY
CHADWICK'S ORIGINAL BURY BLACK PUDDING LTD**

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BACKGROUND

1) On 15 March 2002 The Bury Black Pudding Co Ltd, which I will refer to as BBP, applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the "Trade Marks Journal" on 8 May 2002 with the following specification:

black puddings.

The above goods are in class 29 of the International Classification of Goods and Services. BBP claims the colours black and gold as an element of the trade mark.

2) On 8 July 2002 Chadwick's Original Bury Black Pudding Ltd, which I will refer to as Chadwick, filed a notice of opposition to this application.

3) Chadwick states that it is a private limited company which carries on the manufacture, retail and wholesale sale of black puddings, white puddings, tripe and other meat products. It states that it retails these goods from its market stall in Bury, Greater Manchester, and also sells goods wholesale to customers in Rawtenstall, Heywood, Padiham, Haslingden, Bacup, Chipping and Buxton and other locations. Chadwick states that it has traded under the trade name CHADWICK'S ORIGINAL BURY BLACK PUDDINGS since 1972 and has an annual turnover of £100,000.

4) Chadwick states that due to the well-known nature of its trade name within Bury and its surrounding areas, little expenditure is made in promoting the trade mark. However, its trade mark has been promoted in various magazine and newspaper articles and reviews, television programmes and Internet reviews. Chadwick states that whilst its activities are concentrated within Bury and the surrounding areas, it also has regular customers located outside of the region.

5) Chadwick states that it has acquired a considerable reputation and goodwill in relation to its

business so that members of the public associate the trade name CHADWICK'S ORIGINAL BURY BLACK PUDDINGS with it. BBP's use of the trade mark amounts to a misrepresentation which leads members of the public to perceive a connection in the course of trade between it and Chadwick. Chadwick states that it is aware of numerous instances of confusion on the part of the public between its business and BBP's activities under the trade mark. As a result of such misrepresentation, Chadwick is likely to suffer loss.

6) Chadwick states that the trade mark should be refused under section 5(4)(a) of the Trade Marks Act 1994 (the Act), in that use of it is liable to be prevented by virtue of the law of passing-off.

7) Chadwick states that the trade mark is devoid of distinctive character in that it consists exclusively of an indication which serves in trade to designate the nature and geographical origin of the goods. The trade mark merely indicates that BBP supplies black puddings originating from Bury. BBP has not filed evidence that the trade mark has acquired a distinctive character through use. The trade mark should be refused under sections 3(1)(b) and (c) of the Act.

8) Chadwick states that it understands that the products upon which BBP uses the trade mark are manufactured in Farnworth, rather than in Bury. The trade mark should, therefore, be refused under section 3(3)(b) of the Act on the basis that that trade mark is of such a nature to deceive the public as to the geographic origin of the goods.

9) Chadwick states that it has contacted BBP to request that it voluntarily withdraws its application. BBP has refused to do so.

10) Chadwick requests that the application be refused in its entirety and seeks an award of costs.

11) BBP filed a counterstatement. It admits that Chadwick is a private limited company which retails black puddings, white puddings, tripe and other meat products. BBP puts to proof that Chadwick carries on the manufacture and wholesale sale of black puddings, white puddings, tripe and other meat products. BBP admits that Chadwick sells black puddings and other meat products from its market stall in Bury. Chadwick is put to proof that it sells its products wholesale in Rawtenstall, Heywood, Padiham, Haslingden, Bacup, Chipping and Buxton and other locations. BBP puts Chadwick to proof that it has traded under the name of Chadwick's Original Bury Black Puddings Limited since 1972 and that it enjoys an annual turnover of £100,000.

12) BBP admits that Chadwick has spent little in advertising the name CHADWICK'S ORIGINAL BURY BLACK PUDDINGS. Chadwick is put to proof that the name CHADWICK'S ORIGINAL BURY BLACK PUDDINGS is well-known in Bury and its surrounding areas. Chadwick is put to proof that the trade mark CHADWICK'S ORIGINAL BURY BLACK PUDDINGS has been promoted in various magazine and newspaper articles and reviews, television programmes and Internet reviews and that it has regular customers located outside of Bury and its environs.

13) BBP puts Chadwick to proof that it has made extensive use of the trade mark CHADWICK'S ORIGINAL BURY BLACK PUDDINGS and that it has acquired a considerable reputation and goodwill in this trade mark. Chadwick is put to proof that

members of the public associate the trade name CHADWICK'S ORIGINAL BURY BLACK PUDDINGS with its business. BBP denies that its use of the trade mark amounts to a misrepresentation leading members of the public to perceive a connection between it and Chadwick. Chadwick it put to proof that there have been numerous instances of confusion on the part of the public between its business and BBP's activities under the trade mark. It is denied that use of the trade mark has caused, or is likely to cause, Chadwick loss.

14) BBP denies that the application should be refused under section 5(4)(a) of the Act and that use of the trade mark is liable to be prevented by virtue of the law of passing-off.

15) BBP denies that the trade mark is devoid of distinctive character and that it should be refused under sections 3(1)(b) and (c) of the Act.

16) BBP denies that the nature of the trade mark is such as to deceive the public as to the geographical origin of the goods sold under it. It denies that the application should be refused under section 3(3)(b) of the Act.

17) BBP admits that Chadwick contacted it, requesting the withdrawal of the application. BBP admits that it has refused to withdraw the application.

18) BBP requests that the application proceeds to registration and seeks an award of costs.

19) Both sides filed evidence.

20) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Marks & Clerk, the representatives for Chadwick, and Appleyard Lees, the representatives of BBP, both filed written submissions. In reaching my decision I have taken into account both the evidence before me and the submissions of the two sides.

EVIDENCE

Evidence of Chadwick

21) This consists of a witness statement by Mary Sinacola. Ms Sinacola is the director of Chadwick, a position she has held since 1982.

22) Ms Sinacola states that Chadwick carries on the manufacture, retail sale and wholesale sale of black puddings, white puddings, tripe and other meat products. She states that Chadwick has traded since its incorporation in 1982 but that the business carried out by it dates even further back. In 1954 her father, Edwin Chadwick, started a butchers business, as part of this business he made his own sausages, cooked meats and black puddings. Over the next twenty years he acquired a considerable reputation in the black puddings that he sold. In 1972 Mr Chadwick was approached by Kenneth Young, the owner of Thompson's Original Bury Puddings, who offered to sell the business to him. Thompson's Original Bury Puddings had been founded in 1865 and sold Original Bury Puddings from its market stall in the old Bury market. Mr Young was a direct descendant of the founder of the business. Mr Chadwick agreed to buy the Thompson business and decided to combine the name of his existing business with that of the Thompson business, hence Chadwick's Original Bury Black

Puddings. Ms Sinacola states that she is unaware of any other trader referring to black puddings as Bury black puddings before then; the products were referred to as either black puddings or Bury puddings. Mr Chadwick's business was incorporated as a private limited company in 1982.

23) Ms Sinacola states that Chadwick has used the trade name Chadwick's Original Bury Black Puddings since 1972 in relation to the retail business carried on from its market stall in Bury Market, and also in relation to the manufacture of the meat products in question and the wholesale distribution of such meat products. Ms Sinacola exhibits three photographs of Chadwick's market stall. Copies of these photographs are reproduced in the annex to this decision.

24) Ms Sinacola states that Chadwick not only sells its products from its market stall in Bury market but also to wholesale customers around the county; including customers in Rawtenstall, Heywood, Padiham, Haslingden, Bacup, Chipping and Buxton. She exhibits eight copy invoices dated between 6 September 2002 to 14 December 2002. They are addressed to Barbeque Barn of Bury Market, Castle Hotel of Buxton, Derby Arms of Chipping, R Moore of Bacup, DT Law of Haslingden, Bradshaws Quality Foods of Padiham, Beg Sausages of Heywood and J Monks of Rawtenstall Market. All of the invoices are for black pudding, two are also for tripe. The invoices are all stamped with Chadwick's Original Bury Black Puddings Ltd, 247 Burnley Road East, Waterfoot, Rossendale, Lancs. The quantities of goods supplied varies but includes, for instance 50 kilograms of black puddings for Derby Arms and 30 x 2.5 kilogram black puddings for Beg Sausages.

25) Ms Sinacola states that Chadwick's turnover for the last five years has been as follows:

1997	£105,283
1998	£103,974
1999	£114,723
2000	£110,126
2001	£119,167.

These figures do not include VAT.

26) Ms Sinacola states that Chadwick does not spend a lot in promoting its business. However, it has been the subject of a number of press articles and television programmes which have served to promote and advertise the business to the public. She exhibits various materials in relation to this:

- Part of a publication entitled "Musings of a Black Pudding Man" by Gordon Lomax. The publication was published in 2002 by Gordon Lomax. He refers to "Bury Black Pudding" and Thompson's. He writes:

"Now that Thompson's are no more, my granddad, had he been alive today, would have relished the glory of Bury's food from heaven resting on the shoulders of Chadwick's Black Pudding Company."

- Part of a publication entitled "How it all began in Lancashire" by Maurice Baren. The publication was published by Dalesman Publishing Company Limited in 1999. Reproduced is a section headed "Chadwick's". This gives the history of Chadwick

and refers to two other black pudding makers in Bury. (It refers to the butchers premises of Mr Chadwick at 247 Burnley Road East, the address on the invoices.) There is photograph reproduced which is similar to the first one shown in the annex.

- Part of a publication entitled “Lancashire Lives” by Benita Moore. It was published in December 1991 by Carnegie Publishing Ltd. The extract is an interview with Mary Chadwick, now Ms Sinacola. It deals with her taking over the business from her father and the making of the puddings in Burnley Road East, Waterfoot. The author comments that Chadwick’s black puddings are very well known in North East Lancashire. In the extract Ms Sinacola is quoted as saying that she supplies a lot of shops and retailers.
- An article from the “Bury Times” of 10 November 1998. This article deals with the history of black puddings in Bury. Part of it deals with the Chadwick business. On several occasions the writer refers to Bury pudding and not black pudding. One part of the article states the following:

“His daughter, Mrs Betty Kenyon, said: “He always insisted it was Bury puddings – not black puddings. I’d never divulge the recipe.”

- Part of a publication called “Freetime” from October/November 2002. The extract promotes Bury market. There is a picture of Chadwick’s stall. The signage bears the word Chadwick’s in large letters and beneath it, in considerably smaller type, “Original Bury Black Pudding Ltd”.
- A copy of “Lancashire Life” for June 2002. An article deals with the history of black puddings in Bury. Chadwick’s stall and Ms Sinacola are referred to in the article, with pictures of the stall. Mrs Betty Kenyon is again interviewed. However, on this occasion she is reported as saying:

“My father never called them black puddings, just puddings.”

The article refers to the World Black Pudding Throwing Championship, which is held in Bury; in which black puddings are thrown at Yorkshire puddings. Black puddings are described as “the Bury delicacy”. The article also states:

“Chadwicks have been making the distinctive horseshoe shaped pudding for about 50 years, but, as Mary points out, not every pudding with such a shape is from Bury.”

The article also refers to the Mayor of Bury taking black puddings to the headquarters of the Fusiliers in London.

- A copy of “Lancashire Life” for March 2002. In the magazine there is an article about Bury. Included in this article is the following:

“Advertisements for Bury Market always bear the tag ‘world famous’ and it is no idle boast. Hundreds of thousands of shoppers visit the market – and the adjoining indoor market – every week. A fair number of them come for just one thing – black puddings. The market is renowned for the delicacy but

requests for the 'secret ingredient' that give Bury black puddings their special taste are always met with polite refusals."

- A page downloaded from the Internet on 12 December 2002 from deliaonline.com. On the page is a short piece about Chadwick's Original Bury Black Puddings and its stall.
- Pages downloaded from mysite.treeserve.com on 29 November 2002. This appears to be the personal website of Maurice Clegg. Two of the pages show pictures of Chadwick's stall. A sign that can be seen has underneath Chadwick's the words: "Manufacturers & Purveyors of the original Bury Black Pudding".
- An article downloaded from the "Middleton Guardian" website on 12 December 2002. The article is about Lancashire Day. Included in the piece is a paragraph about "Chadwick's puddings".

27) Ms Sinicola states that Chadwick has a number of regular customers in Bury and the surrounding area who consistently return to its market stall. She estimates that seventy per cent of Chadwick's customers visit the stall at least once a week.

28) Ms Sinicola states that she is not aware of any other trader in Bury and its environs who deals with products similar to those of Chadwick and trades under a name similar to that used by Chadwick. She states that following BBP's use of the trade mark she has become aware of numerous instances of confusion on the part of the public between Chadwick and BBP. She states that she has received complaints from both existing customers and individuals who have not previously purchased goods from Chadwick; those complaining believe that BBP's products are those of Chadwick or that Chadwick is responsible for some of BBP's products. Ms Sinicola exhibits seven letters in relation to this.

29) The first letter is from Stephen Darcy of Preston and is dated 5 December 2002. It is addressed to "to whom it may concern". Mr Darcy writes:

"I was travelling to work on the M61 when I spotted a huge sign advertising "The Bury Black Pudding Company" on the world wide webb. I visited the webb site and thought everything was perfect until a friend informed me that they were not the Bury Black Puddings sold on Bury Market.

When I next visited the market, I asked the staff on Chadwick's stall where I usually go and was informed of the ongoing Court action.

From the advert and the website, I was never informed of where there black puddings came from and so was under the impression (wrongly it seems) that they were made and were being sold by Chadwicks Original Bury Black Puddings."

The next letter is from Mathew Skinner of Kirkham and is dated 25 November 2002. It is simply addressed "Dear Sir". Mr Skinner writes:

"I was shopping on Bury Market and bought a so called hot Bury Black pudding. I asked the lady if I was at the right place and she told me there was two Black pudding stalls now. I was so disgusted with the taste and had to throw my hot pudding away.

Later at Chadwicks I was informed that they had nothing to do with the other stall, a point the lady didn't care to tell me about and in my opinion misled me. I had a proper hot Bury Black pudding at Chadwicks and after being told of the facts agreed to write my concerns down in the hope it may help and hopefully get something done to avert any more misunderstandings."

The third letter is from Mrs M Fox of Heywood and is dated 13 December 2002. It is simply addressed "Dear Sir(s)". Mrs Fox writes:

"I became aware of another Black Pudding manufacturer selling Bury Black Puddings when I read an issue of The Bury Times August 16th 2002. In it I read you could order Bury Black Puddings on the internet and have them sent anywhere in the country.

In a later edition I read a letter by Mrs. M. Sinacola in which she stated that she did not supply this company and in fact these puddings were bought and not manufactured by them.

As my parents live on the South Coast and I always have to take some Bury Black Puddings made by Chadwicks, who they used to buy from when they lived in Bury.

Because of all this confusion I decided to check out a few things for myself. In the first editorial it was claimed that the Bury Black Pudding Company was based in Bury. After making enquiries with Bury Environmental Services I was informed that "The Bury Black Pudding Company has an administrative officer in the Borough of Bury but in fact, the manufacturing premises are within the borough of Bolton." Dismayed but still unaware of the claim Bury Black Puddings being true or not I tried Bolton Environmental Services. The reply received from Bolton was quite ambiguous in which it stated the product was indeed Morris's Gold Medal Black Puddings and was then wrapped and packaged next door by the Bury Black Pudding Company.

This had left me bewildered to say the least that a company and product that goes back years can be usurped by somebody trying to trade off their name and subsequently try to and indeed manage to confuse customers such as myself.

In my opinion this should never been allowed to happen in the first instance."

The next letter, dated 1 December 2002, is from Mr F Rowe of Blackpool. It is simply addressed "Dear Sir". Mr Rowe writes:

"As a frequent visitor to Bury and a great lover of Bury Black Puddings purchased from Chadwicks.

I was absolutely delighted to find them being sold in Asda at Fulwood. I rushed home to put the pudding in a pan and was absolutely disgusted with the taste.

Later that week I confronted the staff at Chadwicks to tell them of my disappointment. I was informed of the current situation with the Bury Black Pudding Company. It wasn't until this was pointed out to me that I realised my confusion.

I do hope this statement helps in some way.”

The fifth letter, dated 8 December 2002, is from Antony Hayden of Trowbridge in Wiltshire. The letter is addressed to Chadwick at Burnley Road East. Mr Hayden writes:

“I have lived in Wiltshire for many years now although I am originally from Lancashire. One of the things that I miss the most is ‘Bury Black Puddings’ which I have always bought from ‘Chadwick’s Original Bury Black Puddings Ltd’. Whenever friends and family visit I always insist they bring me some down.

I was browsing the Internet when I saw ‘The Bury Black Pudding Company’, I assumed they would be selling ‘Chadwick’s Original Bury Black Puddings’ and I would therefore not have to depend on friends and family to obtain them on my behalf.

It was not until I was having a telephone conversation with a relative who still lives in Lancashire when I brought up the subject of Black Puddings. I was informed that they had read in the ‘Bury Times’ of another company setting up with a similar name and that they did not sell ‘Chadwick’s Original Bury Black Puddings’. I was very confused but after discussing with my relative and that they had tried ‘The Bury Black Pudding Company’s’ product that is sold on Bury market, they expressed that they were extremely disappointed so I have decided to continue having them brought to me every visit.

I felt that it was necessary to indicate the similarity between the two company names that may cause confusion when purchasing the products. Hopefully this letter will encourage you to make clear that these two company names, are very similar but as in the opinion of my relative your product is by far superior.”

The next letter is from Caroline Booth of Shipley and is dated 4 December 2002. This is addressed “Dear Sir(s)”. Mrs Booth writes:

“As an infrequent visitor to Bury Market I look forward greatly to spending time looking on all the stalls and at the end of the day I like nothing better than a hot Bury Black Pudding.

On a previous visit in the summer I made the mistake of going to a stall for a hot Black Pudding that at first I did not recognise. The lady behind the counter told me the stall had been there for years and they did sell Bury Black Puddings.

When I tasted this black pudding I was shocked and disgusted and vowed never to have another black pudding. It was not until my next visit some weeks later that I found Chadwicks Original Bury Black Puddings and was informed of the mistake. This misunderstanding was made worse when I realised I had parked my car next to a white van advertising “The Bury Black Pudding Company”. I have since found that this company doesn’t even sell Bury Black Puddings and realise I had eaten one on my previous visit.

When I complained to the staff at Chadwicks I was told of the situation and agreed to write this letter in the hope that other people will not be confused as I was.”

The final letter is from Anthony Sinacola and is dated 10 December 2002. Mr Sinacola is writing from Chadwick as its company secretary. The letter is addressed "Dear Sir(s)". Mr Sinacola writes:

"As I am already aware of the current dispute between ourselves and "The Bury Black Pudding Company". I feel I must inform you of one particular situation where confusion arose on more than one occasion.

Firstly on Wednesday 10th July at 3.45 pm, a refrigeration engineer forced his way into our stall, claiming he was trying to fix the lights on the new fridges. When challenged he said "He was looking for the Bury Black Pudding stall". When challenged further he said "He was looking for the Bury Black Pudding Company".

Again on Friday 12th July at 3.00 pm, the same engineer appeared at our stall and this time asked for Ms. Debbie Pierce and again re-iterated that fact he was looking for "The Bury Black Pudding Company". He stated "He wanted to fix the fridges on the market purchased by the said company while still under warranty".

It surprised me that the same engineer came to our stall on two occasions and was sent packing, politely of course. It would appear he was looking for the Bury Black Pudding Stall, one which we have had on Bury Market for over thirty years. One can only wonder what information this engineer was told, but on both occasions he came to our stall."

30) Ms Sinacola states that she understands that the goods of BBP are manufactured by J Morris, outside of Bury. The rest of Ms Sinacola's statement is submission rather than evidence of fact and I will say no more about it.

Evidence of BBP

31) This consists of a witness statement by Deborah Pierce. Ms Pierce is a director of BBP, a position which she has held since its inception in February 2002. Ms Pierce states that she is also the owner and manageress of the James Wallace Farm Produce (JWFP) stall in Bury Market. She has worked on the stall for over fifteen years, managed it for over two years and has owned it since April 2003.

32) Ms Pierce states that the JWFP stall in Bury market sells Bury black puddings. These products have been manufactured by Morris's Black Puddings and Wholesale Foods for over thirty years and have been sold on the market stall as "Bury black puddings" for at least twenty years. The Bury black puddings supplied to the JWFP stall are supplied directly from Morris's and not through BBP. Ms Pierce states that she personally collects and delivers the black puddings supplied by Morris's to the JWFP stall. She exhibits a photograph showing a photograph of Bury black puddings upon the JWFP stall. Over twenty of the puddings can be seen on a tray. Upon them is a label, at the top of this in large letters are the words James Wallace. Underneath in different coloured lettering is written:

TRADITIONAL
BURY BLACK PUDDINGS
£2.60 per kg

Ms Pierce states that the Bury black puddings sold on the James Wallace stall are labelled without any indication of origin and have been labelled in this manner for at least twenty years.

33) Ms Pierce states that BBP has not supplied Bury black puddings to the JWFP stall. BBP has not affixed any of its own trade marks or its trade name to any products, labels or leaflets supplied to or sold on the JWFP stall, nor has it affixed its trade name or any of its trade marks to any structural element or advertising hoardings on the stall. Ms Pierce states that BBP has never advertised its products on a market stall in Bury market. BBP has never affixed the trade mark nor its company name to any products, labels or leaflets which have been sold or distributed in Bury market, not to any structural element or advertising hoardings displayed in Bury market. Ms Pierce states that she transports products for the JWFP stall in a van bearing the company name of BBP. She states that the van is only used to transport goods of third party suppliers to the stall.

34) Ms Pierce states that BBP is primarily a mail order and Internet order company which also supplies Asda plc and farm produce stores in the Lake District with Bury black puddings. She states that the goods sold under the trade mark can only be purchased through Asda, a farm produce stall in the Lake District or by contacting BBP's office by means of telephone, post or the Internet.

35) Ms Pierce states that Bury black puddings are not exclusively manufactured in Bury. She exhibits a list of six manufacturers from outside of Bury. It would appear that this is a list that Ms Pierce has drawn up. She states that these manufacturers have been making Bury black puddings for at least several years before the date of BBP's application.

36) Ms Pierce states that the term Bury black pudding refers to the shape of the goods. She exhibits pages downloaded, on 31 March 2003, from the website of RS Ireland. RS Ireland is a black pudding manufacturer based in the Rossendale Valley in Lancashire. In the exhibit it is twice mentioned that the puddings are tied into "the traditional "Bury Black Pudding" shape". Ms Pierce exhibits a handwritten "letter" from a Mrs Greenhalgh who Ms Pierce describes as the manageress of Redman's market stall in Bury market. This "letter" is not addressed to anyone and states:

"I consider that the bury black Puddings to be a horseshoe shape and to contain the bury recipe. On our stall the bury Puddings are made in Liverpool."

Ms Pierce also exhibits the article from "Lancashire Life" of June 2002 which I have dealt with in paragraph 26 above. She exhibits a menu from the "Swan and Cemetery" public house in Bury. One of the starters on the menu is "Bury Black Pudding with apples, onions & grain mustard or garlic butter". Ms Pierce states that the Bury black puddings on the menu are manufactured by R S Ireland Limited.

37) Ms Pierce states that JWFP and Chadwick are not the only stalls selling Bury black puddings on or around Bury market. She exhibits photographs of black puddings on display of the premises of Redman's and Bennett's. Ms Pierce states that Redman's is in Bury market and that Bennett's backs onto and faces Bury market. She states that both Redman's and Bennett's have been selling Bury black puddings since at least 1985. Ms Pierce exhibits a further "letter" from Mrs Greenhalgh. This is dated 2 April 2003 and is not addressed to anyone. It states:

“I have worked on Redman’s for 4 years & have always sold ‘Bury black puddings’ under that name.”

The photograph of the Redman’s display shows black puddings in sealed plastic. Upon them is a display card which is headed Redmans, underneath is written “Black Pudding Bury”. On the exhibit, but not in the photograph itself, it is indicated that the goods emanate from Lockwood’s of Liverpool. The photograph of the Bennett’s display shows black puddings. A display card is behind them. It is headed “Bennett’s Quality Meats”. Beneath this are the words “award winners”, beneath this are the words “Bury Black Pudding” (presented vertically). On the exhibit, but not in the photograph itself, it is indicated that the goods are manufactured by Morris’s of Bolton.

38) Ms Pierce exhibits a letter from Marks & Clerk, Chadwick’s trade mark attorneys, dated 16 May 2002. Ms Pierce highlights the following paragraph from the letter:

“Indeed, our client is aware of several instances of confusion between its business and your activities under the trade name THE BURY BLACK PUDDING COMPANY, in that our client is aware of a number of instances of customers returning its puddings purchased from you, indicating that said products were of inferior quality.”

Ms Pierce states that at the date that the letter was written BBP had supplied only a single order of Bury black pudding by mail order to a customer in Penzance and a single order to a farm produce shop in the Lake District. She states that the mail order was sent on 15 May 2003 and, therefore, would have arrived on 16 May 2002 at the earliest. She states that no other products had been supplied by BBP before 15 May 2002.

39) Ms Pierce states that BBP’s website makes no claim as to the manufacturing origin of the Bury black puddings that it sells. She exhibits what she describes as the advertising material applied to Bury black puddings sold by Asda and as supplied by BBP and a picture of signage from Chadwick’s stall. The former is an elongated version of the trade mark. The latter has the word “Chadwick’s” prominently at the top, underneath in small lettering is written “ORIGINAL BURY BLACK PUDDINGS LTD”. The background is mainly in light green. A pink rectangle runs along most of the sign upon which “Chadwick’s” is written.

40) Ms Pierce states that the advertising board and website referred to by Mr Hayden make no reference to Bury market. She exhibits a letter from Richard Morris of Morris’s Black Puddings & Wholesale Foods in Bolton. The letter is dated 24 March 2003 and is addressed “Dear Sirs” and is headed “Opposition against UK Trade Mark Application No: 2295498”. Mr Morris writes that Morris’s has been making bury (sic) black puddings for over thirty years. He writes that it now manufactures around five tonnes of bury black pudding each week. Mr Morris continues by saying that a network of agents distribute Morris’s product throughout the United Kingdom. He writes that currently no one makes black pudding in the district of Bury. He says that a large number of manufacturers produce the traditional horseshoe shaped puddings and all refer to them as “bury black pudding” and always have done so. He finishes with the following:

“I do think that Chadwick’s are being extremely naïve and rather arrogant assuming that members of the public automatically connect their brand alone with a bury black pudding. In fact this opinion is shared by other manufacturers especially when you

consider that Chadwick's are probably the smallest of the bury black pudding manufacturers. Both Andy Holt of RS Irelands and myself manufacture significantly greater quantities of bury black puddings.

I think that it is fair and accurate to say that Chadwick's are most certainly synonymous with Bury Market, but most definitely **not** with bury black puddings exclusively."

41) Ms Pierce finishes by stating that she is not aware of any confusion on the part of the public between goods and services provided under the trade mark and the goods and services provided by Chadwick.

Evidence in reply of Chadwick

42) This is made by way of a further declaration from Ms Sinacola. Parts of this witness statement can best be characterised as being submission and/or a critique of the evidence of BBP rather than evidence of fact. I will only summarise those parts of the statement which I consider can be characterised as representing evidence of fact.

43) Ms Sinacola states that JWFP has sold black puddings for many years, although these are not the principal product it sells. She states that up until 2003 no mention was made on the JWFP stall as to from where the puddings came from nor by whom they were made. Ms Sinacola states that it was only recently that the puddings upon the stall were referred to as "Bury black puddings".

44) Ms Sinacola exhibits a copy from an article from the "Manchester Evening News" of 3 July 2002 about Ms Pierce and BBP. Ms Sinacola highlights the following parts of the article:

"black puddings from Bury have taken over at Wimbledon.... The website is run from home and Debbie also has a stall on Bury Market.... to help him source authentic, award winning puddings from Bury."

45) Ms Sinacola states that she is aware of a van which is parked in a "prominent" position at Bury market every day and which bears the trade mark.

46) Ms Sinacola states that the term "Bury black pudding" does not refer to the shape of the puddings. She states that black puddings, whether made in Bury or not, take a variety of shapes; including a horseshoe shape. Ms Sinacola states that the essential feature of a Bury black pudding is the recipe, which was originally intended to specifically appeal to customers in Bury and Lancashire. She exhibits an article from the "Bolton Evening News" from 1979. Included in the article is the following:

"The legendary Bury pud fell flat, though according to its maker it has far from had its chips.

"The Bury pudding suits the palate of Lancashire folk and they'd do crackers if I changed the recipe," said master pud producer Edwin Chadwick from Rossendale, who sells 5,000 puds a week at Bury market.

"It's all about taste and what suits Bournemouth folk wouldn't suit local pudding eaters," added Mr Chadwick, who was born in Bury and uses a recipe passed down through the ages."

47) Ms Sinacola comments upon the letter from Mr Morris. She states that previously Mr Morris has referred to his goods simply as “black puddings” and even as “Farnworth puddings”. She exhibits an article from the “Manchester Evening News” of 20 January 1996. (Unfortunately, the photocopying has cropped the left hand column of the article.) There is no reference to Bury in any shape or form in the article. There are various references to black puddings. Ms Sinacola has highlighted a reference to Farnworth puddings and the following:

“They come in various shapes and sizes, from a small 4oz pudding to the larger horseshoes and stick puddings, for slicing like a salami.”

DECISION

48) My summary of the evidence has been somewhat exhaustive. I consider this necessary owing to the disputation of basis issues such as whether Bury black pudding is a particular type of black pudding and if so what type of pudding. Is Bury pudding a term of the art whilst Bury black pudding is not?. A good deal of the evidence also casts light upon the issues tangentially and obliquely rather than directly. It has also been necessary to take this approach owing to the nature of certain of the evidence. In its submissions BBP wishes the letters furnished by Chadwick to be disregarded as it believes that the information should have been adduced via statutory declaration or affidavit. I presume on this basis that BBP also considers that the evidence which it has furnished in this form should be disregarded.

49) Rule 55 of the Trade Marks Rules 2000 (the Rules) states:

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a

witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

This rule is clear. There is a stipulated method of adducing evidence. In this case both sides have put in what they call “letters” and have adduced them into the proceedings as exhibits to witness statements. In the case of BBP there are the two letters of Mrs Greenhalgh and the letter from Mr Morris. Letters are addressed to someone, these are not. They were born of the proceedings and clearly solicited for the proceedings. If BBP wished Mrs Greenhalgh and Mr Morris to make statements it should have got them to complete witness statements, in which they would have made declarations of truth. It elected not to. These letters represent evidence that should have been adduced as per rule 55. To take cognisance of these letters would be to countenance the circumvention of rule 55. Consequently, I will take no cognisance of the letters of Mrs Greenhalgh and Mr Morris.

50) Chadwick also supplied letters. One of these letters, from Mr Sinacola, can only be described as bizarre: the company secretary of Chadwick sending a letter addressed to no one other than “Dear Sir(s)”. If the company secretary wishes to make a statement, he should do so in the prescribed form. The other letters also give rise to problems. It is necessary to consider whether these letters existed or would have existed independently of the proceedings. If so there is nothing that would stop them being adduced by way of exhibit. However, if they were born of the proceedings, or even solicited, the contents should have been adduced into the proceedings by way of statutory declaration or witness statements.

51) The letter from Mr Darcy is addressed “to whom it may concern”, ie it is addressed to no one in particular. From this element and the reference to talking to the staff on Chadwick’s stall this is a letter that is born of the proceedings. Mr Skinner in his letter states that he agreed to write the letter after talking to Chadwick’s staff, another letter born of the proceedings. The content of the letter from Mrs Fox clearly indicated that she was inspired to write it having read a letter from Ms Sinacola some time after 16 August 2002, another letter born of the proceedings. Mr Rowe actually describes the content of his letter as a statement and that it was given rise to after talking to Chadwick’s staff. Mrs Booth states that she agreed to write her letter following talking to Chadwick’s staff. The letter from Mr Hayden was born of discussing the conflict between the two sides with a relative. It was not something that would have existed without knowledge of this conflict.

52) I do not consider that any of the letters adduced by Chadwick have an independent existence. They were all born of the conflict between the two sides. To describe them even as letters in any conventional sense would be difficult. They are statements that have been put into the form of letters. The views/opinions/comments of the writers would not have been made without the current dispute. Certain of the letters were clearly solicited. I consider that the evidence which Chadwick is trying to get in by this means should have been adduced by way of witness statement or statutory declaration. To allow these letters into the proceedings would also be to countenance the circumvention of rule 55. The form of evidence is important, as well as the content. That form is prescribed by rule 55 and a key part of that form is that the evidence is made under oath or include a statement of truth. The “letters” are not subject to this fundamental and essential requirement. I do not intend to take the contents of the letters into account due to this fundamental failing.

Findings of fact

53) There are three main issues of fact in contention:

1. The goodwill of Chadwick and the sign associated with it.
2. Whether Bury black pudding is a description of a certain type of black pudding.
3. Whether the public would consider that black puddings which use the word Bury in their description are produced in Bury.

54) Chadwick has produced various published material (see paragraph 26) about its business. Certain of this material is not specifically dated or is dated after the filing of the application and so in so far as it disseminates the name of Chadwick cannot be relied upon. (However, it can still be considered in relation to the reputation as it invariably refers to the longevity of the business.) The material which falls under this stricture is from “Musings of a Black Pudding Man”, “Freetime”, the two copies of “Lancashire Life”, the page from deliaonline, the pages from the website of Maurice Clagg and the article downloaded from the “Middleton Guardian”. It is also to be noted that all the copy invoices that have been produced are from after the filing of the application. I have no doubt from the warp and weave of all the material exhibited, which shows a long and successful trade, that Chadwick enjoys a goodwill in relation to the sale of black puddings in the Bury area. In the context of this case it is not necessary to consider whether that goodwill extends to other meat products. From the evidence before me it is difficult to know how far out that goodwill radiated at the date of the filing of the application. The appearance of Chadwick in what appear to be limited local publications, “Lancashire Lives” and “How it all began in Lancashire”, and which cover various other subjects tells me little. The stall in Bury market has an attractive force. The market will be visited by people from around Bury but from how far is difficult to gauge. “Freetime” refers to people flocking to Bury market “from all over the UK, with regular coach visits from places as far afield as Birmingham, Carlisle, Durham and North Yorkshire”. However, “Freetime” is promoting Bury market, so how much of this is reality and how much wishful thinking or puff is impossible to say. Casual visitors to the market will also not necessarily be aware of one particular stall selling black puddings and the name it trades under. The piece in Lancashire Life for March 2002 supports the case for people visiting from further afield than the environs of Bury. This piece also states that some of the visitors only come to the market for the black puddings. In the end, in this case, I do not consider that anything will turn on the exact perimeters of the radiation of the goodwill. It is enough that Chadwick has a protectable goodwill within Bury and its environs.

55) Having decided that Chadwick has a goodwill in its black pudding business I need to consider what sign is associated with the business. In a lot of the material the business is referred to as Chadwick’s, with or without the apostrophe. This is likely to be how the business is referred to on a day to day basis and remembered. It is unlikely that in the ordinary course of events that customers will refer to CHADWICK’S ORIGINAL BURY BLACK PUDDINGS, it would be rather a mouthful. In the extract from “Musings of a Black Pudding Man” the author refers to Chadwick’s Black Pudding Company. In the extract from “Lancashire Lives” the writer refers to Chadwick’s Bury Black Puddings, however, there is a photograph of the stall and a partly obscured sign showing Chadwick’s Original Bury Black can be seen; the pages from the Internet were downloaded in November and December 2002 and so tell me nothing about the position at the date of the filing of the application. The stamp on the invoices bears the wording Chadwick’s Original Bury Black Puddings Ltd but, of course, all the invoices emanate from after the date of application. The current signage for

the stall, as seen in "Freetime" is Chadwick's Original Bury Black Pudding Ltd, the last five words being below the first word and in much smaller typeface. However, this tells me what the position was in October/November 2002, again after the date of application. So on exhibited evidence Chadwick's claim that the goodwill of its business is associated with the sign CHADWICK'S ORIGINAL BURY BLACK PUDDINGS rests upon the undated photographs that are shown in the annex. However, although undated the first photograph bears a striking resemblance to that shown in "How It All Began In Lancashire" which was published in 1999. However, the photograph could have been taken a good many years before the date of application and before 1999 and so any association with the sign could have withered away and been forgotten. The onus lies upon Chadwick to justify its claim that its goodwill is associated with the sign CHADWICK'S ORIGINAL BURY BLACK PUDDINGS as it has claimed. There is the statement of Ms Sinicola and a few undated photographs to support the claim. It is scant evidence. Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

There is an absence of evidence from the trade and the public, indeed there is a dearth of evidence to support the claim. On the basis of the evidence before me I cannot find that Chadwick has established that the goodwill in its black pudding business is associated with the sign CHADWICK'S ORIGINAL BURY BLACK PUDDINGS.

56) BBP argues that Bury black pudding is a specific type of black pudding ie that it is a generic term. Chadwick seems to dispute this. Although it is not clear from the evidence if Chadwick disputes if there is a particular type of Bury black pudding per se or whether it simply disputes if a Bury black pudding is defined by its ingredients rather than its shape; or alternatively whether it is arguing that the normal descriptor is Bury pudding rather than Bury black pudding and if this is the case if this descriptor relates to a black pudding in a particular shape or having a particular taste. The evidence is clear in that Bury has a long history of selling black puddings, some of them made within the town, others coming in from outside. From all the articles that have been produced there can be little doubt that the town has a reputation amongst the aficionados of black pudding. Articles dealing generally with Lancashire life deal with the black puddings of Bury. The fame will possibly have spread as a result of the black pudding throwing competition. In an article in "Lancashire Life" the author writes: "Why black puddings have become synonymous with Bury, nobody seems to know". This fame for black pudding is clearly different from the issue as to whether there is a specific type of Bury black pudding and if there is what it is. The simplest way in which BBP could have proved its point was by furnishing a definition from a reference source such as the "International Dictionary of Food and Cooking" or "Larousse Gastronomique". It has not

done so, whether because there is no such reference, I know not. The evidence shows that there are black pudding competitions. It should have been easier enough, I believe, to have got expert evidence as to the generic nature of the term or otherwise from those who judge such competitions. Neither side has opted to go down this avenue. I am left to make the best fist of the matter from the references in the evidence before me.

57) In “Musings of a Black Pudding Man” the author writes:

“I learned that the celebrated Bury Black Pudding had to be plump and not resemble an emaciated pepperoni salami. I was warned that a BBP was not a “banger”.”

In “Lancashire Lives” the writer refers to “the famous Chadwicks’ Bury Black Puddings”. In the article from the “Bury Times” reference is made to “Bury Puddings” four times. The article in “Lancashire Life” of June 2002 refers to “Bury black puddings”. In this article there is a reference to “Bury black pudding” being upon the menu of a hotel in the Lake District; it also notes that “the famous Bury black puddings” of Chadwick “are actually made in Waterfoot, Rossendale”. In this article there is also the comment that “Chadwicks have been making the distinctive horseshoe shaped puddings for about 50 years, but, as Mary points out, not every pudding with such a shape is from Bury”. The Mary referred to is Ms Sinacola. In the article from “Lancashire Life” for March 2002 the following is written:

“A fair number of them come for just one thing – black puddings. The market is renowned for the delicacy but requests for the ‘secret ingredient’ that give Bury black puddings their special tastes are always met with polite refusals.”

The article of 3 July 2002 from the “Manchester Evening News” refers to “Bury Black Puddings” in title case in describing BBP. However, it also refers to “award winning Bury black puddings” when quoting Ms Pierce. In the article from the “Bolton Evening News” from 1979 the following comments appear: “the legendary Bury pud”, “The Bury pudding suits the palate of Lancashire folk.” In the article from the “Manchester Evening News” of 20 January 1996, which deals with the Morris black pudding business, it is stated that their puddings come in various shapes and sizes, “from a small 4oz to the larger horseshoes and stick puddings”. I have so far only been considering the evidence of Chadwick. I now turn to the evidence of BBP. The list of Bury black pudding manufacturers does not aid BBP’s cause. This is a list produced by it with no substantiating documentation. There are the photographs of black pudding being described as Bury black pudding on the stalls of Redman’s and Bennett’s Butchers. There is also the photograph of black pudding thus described on the JWFP stall. I give little weight to this last photograph. Ms Pierce owns the stall upon which the goods are displayed. The use of the description could have arisen from the conflict between BBP and Chadwick. Chadwick queries the photographs of the other stalls. They are undated. It is most likely that they were taken after the dispute had arisen. It would seem unlikely that BBP were taking pictures of other stalls unless there was a need. However, these stalls have described their black puddings as Bury black puddings. It can be presumed that they expect their customers to know what it meant by the term. It seems most unlikely that the use of the term as a descriptor by them began arbitrarily after the date of application. The menu from “The Swan & Cemetery” uses the term “Bury Black Pudding”. Finally there are the pages downloaded from the RS Ireland website which refer to “the traditional “Bury Black Pudding” shape”. The pages were downloaded on 31 March 2003, well after the relevant date. However, why should this undertaking use this form of words if it were not the case that there is what it considers a traditional Bury black pudding shape?”

58) I consider that the pictures reproduced in the annex are also of some significance. The usage of the words “original Bury black pudding” is very much subsidiary to Chadwick’s. It appears to describe what is sold on the stall; not just black puddings but Bury black puddings.

The use of the word “original” reinforces that this is a specific type of product following the original recipe and or shape, being traditional Bury black puddings.

59) As part of the consideration of the issue of the generic nature or otherwise of Bury black pudding I need also to take into account the importance or otherwise of the use of Bury as an indicator of the geographic origin of the product. Is the name of the product generic because of where it is produced rather than because of its ingredients and/or shape? BBP claims that there are no manufacturers of black pudding in Bury itself. This has neither been denied nor challenged by Chadwick. Chadwick itself does not produce its goods in Bury even though it uses the words original Bury black puddings to describe its goods. Although the usage of Chadwick is in itself not at issue the nature of that usage can be helpful in considering the geographical significance or otherwise in relation to Bury and black puddings. From the evidence I have no doubt that various persons are describing their products as Bury puddings or Bury black puddings. At the same time as this is going on there is no one producing the products in Bury. There is no indication that any of the purchasers of the product consider that it is necessary for goods described as Bury black puddings to be from Bury; they would be sadly disappointed if they had this expectation. They might conclude that they were from Bury but it cannot be considered that the purchasing decision would be based on from where they came. The fact or otherwise of the goods being made in Bury would not add to their value.

60) So if the use of Bury has any significance in the purchasing decision it will be in relation to the nature of the goods. The evidence before me leads me, if somewhat obliquely, to the conclusion that Bury for black puddings does describe something about them other than their geographical origin. There is the physical appearance: the horseshoe shape; that every black pudding that is in a horseshoe shape is not a Bury black pudding, does not mean that every Bury black pudding is not in a horseshoe shape. There is also an issue as to the recipe and the contents. There is no evidence giving a specific recipe. This is not damning. There are many types of sausage with different recipes, this does not mean that sausage is not a generic term. In the context of this case, black puddings are thrown at Yorkshire puddings. There is no one recipe for Yorkshire pudding, although they will have the same basic ingredients. Taking into account all the evidence before me I find that the term Bury black pudding describes a specific (generic) type of black pudding. I am unable to conclude from the evidence if that description is related solely to the taste (and so the ingredients) or the taste and the shape. However, I do not consider that this matters greatly. The main issue is as to whether Bury black pudding is a generic term.

Passing-off – section 5(4) of the Act

61) Section 5(4)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented 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. In this case the rule of law relied upon by Chadwick is the law of passing-off.

62) To succeed in a claim to passing-off Chadwick has to establish that it has goodwill, that there would be deception or misrepresentation and that there would be damage. Deception or misrepresentation do not have to be wilful. I have decided above that Chadwick has a goodwill in relation to its black pudding business. Based upon my findings above this goodwill is associated with Chadwick (with or without an apostrophe s) or Chadwicks. The

evidence does not substantiate the claim that the goodwill is associated with CHADWICK'S ORIGINAL BURY BLACK PUDDINGS. There can be no issue as to the similarity of Chadwick or Chadwicks and BBP's trade mark. There is no similarity. In the absence of any similarity there can be no deception or misrepresentation and so no consequential damage. To succeed in the claim to passing-off Chadwick must satisfy all three criteria of the classic trinity. **It fails on two of them and so the claim to passing-off must fail.**

Deception – section 3(3)(b) of the Act

63) Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is——

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

Chadwick claims that use of the trade mark would deceive the public as to the geographical origin of the goods. In its submissions Chadwick states:

“Customers who purchase Bury black puddings do so on the assumption that the black pudding will possess a particular taste common to black puddings manufactured in Bury.”

and

“It is submitted that the trade mark applied for gives rise to an expectation that the goods on which the mark is used will have been manufactured in or around Bury”.

The first quotation seems to accept that there is such a thing as a Bury black pudding. At first Chadwick demands that the pudding is made in Bury. However, later in its submission it dilutes this to in or around Bury, a vague geographical description. Of course its first argument gives rise to problems as there are no black puddings manufactured in Bury according to the evidence. I have already decided that a Bury black pudding is a specific type of pudding. There is nothing in the evidence that suggests that the public would make its purchasing decision upon the basis of the geographical indication within the name. Rather the purchasing decision would be made upon the nature of the goods. There is a dearth of case law in relation to this part of the law. Chadwick refers to “Kerly's Law of Trade Marks and Trade Names” (thirteen edition):

“Section 3(3)(b) of the 1994 Act prevents the registration of deceptive marks, a notion familiar from section 11 of the 1938 Act. The paragraph itself cites some non-exhaustive examples: trade marks which are of such a nature as to deceive the public as to nature, quality or geographical origin of the goods or services. In general, if a mark gives rise to an expectation which will not be fulfilled, then registration will be refused. The expectation (and hence the objection) must be a real one, as opposed to something obscure or fanciful, arising from the mark itself.

There are two features of this provision to note. First, it is an absolute and not a relative ground for refusal. It is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. [Relying on *Ardex* [1946] R.P.C. 63, an opponent tried to use s.3(3)(b) against GALAXY for "Preparations for killing weeds and destroying vermin", citing public

policy in the risk to children accustomed to eating the chocolate so named. This ground failed, because the mark in itself would not deceive the public. The opposition succeeded under s.5(3): GALAXY, May 19, 2000, Regy.] The latter type of objection arises under the relative grounds in section 5. Likewise, an objection that use of a mark would result in passing off arises under section 5(4)(a) and not under section 3(3)(b).”

Secondly, the paragraph refers expressly to deception caused by the nature of the mark itself. This does not mean that the mark has to be considered in a vacuum. It must be considered against the goods or services applied for and in the general context of the relevant trade.

The expectation that the public will have, I believe, is that the black pudding is a Bury black pudding not that it is the produce of Bury, even if Bury is considered a geographic descriptor. If Chadwick had pleaded under section 3(3)(b) that the public would be deceived if the black puddings were not Bury black puddings, in the generic sense, then it might have had a case. However, this is not what has been pleaded. It is the geographical deception that has been pleaded and that is all I can deal with.

64) I do not consider that the public would be deceived as to the geographical origin of the goods and so dismiss the objection under section 3(3)(b) of the Act.

Distinctiveness – sections 3(1)(b) and 3(1)(c) of the Act

65) Sections 3(1)(b) and (c) of the Act read as follows:

“The following shall not be registered—

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.”

The proviso to this part of the Act reads as follows:

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

As no use of the trade mark has been shown prior to the date of the filing of the application BBP cannot seek assistance from the proviso.

66) Chadwick states in its submissions:

“The essential element of the trade mark applied for is the wording “THE BURY BLACK PUDDING COMPANY”. It is submitted that such wording is devoid of distinctive character in relation to black puddings manufactured in Bury, being wholly descriptive of a company trading in such goods.

The trade mark applied for also contains a form of stylisation, in that the words BURY BLACK PUDDING are printed in a block filled typeface, the words BLACK PUDDING being printed in a smaller typeface than that of BURY, with the word COMPANY being placed immediately beneath the words BLACK PUDDING. Finally, the whole of the mark is underlined, such underline bearing a simplistic curlicue at each end.

It is submitted that such stylisation is not sufficient to lend the mark a sufficient degree of distinctiveness to justify registration. The mark, when taken as a whole, clearly comprises the descriptive name THE BURY BLACK PUDDING COMPANY. The stylisation included within the mark is of a non-distinctive nature – such stylisation is commonly found in signage, and will not be perceived by members of the public as serving to identify the origin of the Applicant’s goods. The stylisation does not affect the identity of the mark in any way, and does not render the trade mark applied for distinctive.”

BBP in its turn submits:

“In the Statement of Grounds filed by the Opponent dated 5 July 2003, the Opponent asserts that the trade mark applied for is devoid of distinctive character in that it consists exclusively of an indication which services in trade to designate the nature and geographic origin of the goods applied for. Contrary to this assertion the trade mark applied for comprises the term “The Bury Black Pudding Company” in a stylised format surrounded by a logo border, and comprising the colours black and gold. Therefore the mark is not devoid of distinctive character, and nor does it consist exclusively of an indication which serves in trade to designate the nature and geographic origin of the goods applied for. The issue has already been considered by an experienced Trade Mark Examiner. As stated previously, the Applicant makes no claim to the exclusive rights in the term “Bury black pudding”.”

67) I will make two initial comments about BBP’s submissions. Firstly, what a trade mark examiner decided does not concern me and has no influence on my decision whatsoever. This is an inter partes matter and has to be considered by me upon the basis of the evidence before me and my application of the law to that evidence. Secondly, I am not aware of where BBP has previously stated that it claims no exclusive rights in the words “Bury black pudding”. No disclaimer has been entered or applied for as far as I am aware. Even if there were a disclaimer, I do not see that this would affect the fundamental issues as to whether registration of the trade mark would be contrary to sections 3(1)(b) and/or (c) of the Act. A disclaimer will not affect the public’s perception of the trade mark, the public will not be aware of it. A disclaimer would only affect the infringement rights of BBP. Anyway, the rights that BBP would gain with a registration would be rights in the trade mark as a whole; they would not gain separate rights in “Bury black pudding”.

68) I intend to consider the section 3(1)(b) objection first. In *Rewe Zentral* the Court of First Instance stated:

“The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it

proves to be negative, on the occasion of a subsequent acquisition.”

In *Cycling Is...TM* [2002] RPC 729, Mr Hobbs QC, sitting as the appointed person, describes trade marks as being origin neutral and origin specific ie those which act as an indicator of origin and those which do not. The purpose of a trade mark is to indicate origin. In *Sykes Enterprises, Incorp v OHIM (Real People Real Solutions)* T-130/01 the Court of First Instance stated:

“Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.”

So part of the process in assessing whether a trade mark is devoid of distinctive character is how the relevant consumer will perceive the trade mark. It is whether the black pudding consumer would view BBP's trade mark as an indicator of origin. It is not expected that he will dissect and analyse the sign to reach a conclusion.

69) BBP makes no bones about “Bury Black Pudding” being a generic term. Even if this was not the case it would make little odds owing to the renown of Bury amongst black pudding aficionados. However, many trade marks will contain generic or descriptive terms. It is necessary to consider the trade mark as a whole, to decide if it will indicate the products of one particular undertaking. There is an element of stylisation to the trade mark and a colour claim. In itself this stylisation and colour claim will do little for BBP. All trade marks which are predominantly word marks have to be in some sort of font and will be in one colour or another. The public are well used to seeing all types of matter in different fonts and colours. In this case there is nothing particularly unusual about the font. However, the stylisation and colour claim could have an effect in forming an overall trade mark character. BBP consider that the elements which are additional to the words “Bury black pudding” make its trade mark distinctive of it and no other.

70) That “Bury black pudding” is a generic term and that Bury is famous for black pudding will have an influence on the perception on the consumer. This is very much the other end of the spectrum from North Pole bananas. In my experience it is a common promotional puff of undertakings to describe themselves as “the” something or other eg the movers, the bakers. In this case BBP is describing itself as “The” Bury black pudding company. From the evidence, much of it from BBP, it is clear that there are various black pudding companies supplying Bury and making Bury black puddings. Would the average consumer see BBP's trade mark as indicating a specific company or just a Bury black pudding company? As Bury is famous for its black puddings, it is very feasible that the consumer would simply see the trade mark as not indicating origin but being a puff; this is “The” Bury Black Pudding Company, the definite article indicating the main, the best, the original. In the context of the trade mark and how the definite article is used in trade for promotional purposes the simple definite article becomes a great deal more than it might in another context. Applying the *Rewe Zentral* and *Sykes* criteria to the trade mark I do not consider that by its nature the trade mark of BBP will do its job as acting as indicator of origin. The average consumer will, even if particularly attentive (which *Sykes* says he or she will not be), not see BBP's as being distinctive of the goods of one undertaking. It is far more likely that he or she will see the trade mark as being descriptive of what the company does rather than who the company is and wonder where the trade mark is

and who is responsible for the goods.

71) I find that the trade mark is devoid of any distinctive character and the application is to be refused as per section 3(1)(b) of the Act.

72) Jacobs AG in his opinion in *Procter & Gamble v. Office for Harmonization In the Internal Market* [2001] ETMR 75 stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

As the application is to be refused under section 3(1)(b) of the Act I see no need to consider the objection under section 3(1)(c) of the Act.

Costs

73) Chadwick’s Original Bury Black Pudding Ltd having been successful is entitled to a contribution towards its costs. I order The Bury Black Pudding Co Ltd to pay Chadwick’s Original Bury Black Pudding Ltd the sum of £1,550. 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 28th day of October 2003

**David Landau
For the Registrar
the Comptroller-General**



