

O-005-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2308375
BY BRITANNIA BISCUITS CO (UK) LTD
TO REGISTER A SERIES OF TRADE MARKS IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION No. 91413
BY CAPITAINE COOK**

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**IN THE MATTER OF Application No. 2308375
by Britannia Biscuits Co (UK) Ltd to register a
series of Trade Marks in Class 30**

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**IN THE MATTER OF Opposition No. 91413
by Capitaine Cook**

Background

1. On 17 August 2002 Britannia Biscuits Co (UK) Ltd (hereafter Britannia) applied to register the following series of four marks:

CAPTAIN COOK' S

Captain Cook' s



2. Britannia specified the following goods “Snack foods; potato and/or wheat based snacks; biscuits; crackers”.

3. The application was published in the Trade Marks Journal with the following clause:

“The applicant claims the colours yellow and blue as an element of the fourth mark in the series”.

4. On 16 January 2003 Capitaine Cook (hereafter CC) filed notice of opposition to this application. CC is the proprietor of UK trade mark registration No. 480497 for the mark CAPITAINE COOK in respect of “Meat, fish, poultry and game; meat extract; preserved,

dried and cooked fruits and vegetables; jellies; jams; fruit puree; eggs; milk and milk products; edible oils and fats”.

5. CC says that it markets and sells a range of food products including fish, shellfish and seafood and food products made from fish, shellfish and seafood products (‘the goods’). It is said that there has been use since at least as early as 1995 (and also before that). As a result CC claims to enjoy substantial rights and reputation in the UK.

6. CC says that the goods applied for are similar to its own goods because Britannia’s products are, for example, complementary to and/or can be used to accompany CC’s own goods and are sold in the same retail outlets. It is further said that the respective trade marks are so similar as to be effectively identical. Despite that reference to near identity, objection has been raised under Section 5(2)(b). Further objection is raised under Section 5(4)(a) having regard to the law of passing off and on the basis of CC’s claimed goodwill in the UK.

7. Britannia filed a counterstatement denying the above grounds and offering submissions in relation to the respective marks and goods. I should also record that Britannia denies that the ‘goods’ referred to in CC’s grounds of objection, other than fish, form part of the specification of No. 480497.

8. Both sides ask for an award of costs in their favour. Only the opponent filed evidence. The parties were reminded of their right to be heard. Neither has elected to exercise that right. No written submissions have been filed beyond those contained in the statement of grounds, counterstatement and evidence. Acting on behalf of the Registrar and after a careful review of the papers I give this decision.

CC’s evidence

9. CC filed a witness statement by Christophe Bontemps who describes himself as General Director of the Plozevet Site of Capitaine Cook. He has held that position from 1 November 2003 and was previously Technical Director from 22 October 2001 to 31 October 2003. He says that he makes his statement from his own knowledge and from consultation with CC’s books and records.

10. The Registry identified a number of defects with Mr Bontemps’ evidence as originally filed. The perceived defects were notified to CC’s UK attorneys, Eric Potter Clarkson, by letter dated 6 April 2004. There followed a number of rounds of correspondence culminating in a letter from the Registry dated 7 July 2004 admitting the witness statement that is now before me along with a single exhibit D. The Registry’s letter contained the following:

“Please note that there are a number of defects in the evidence, which although [they] do not make the evidence inadmissible before the Registry, when the evidence is before the hearing officer he will have to decide how much weight it should be given in light of the defects. Furthermore, I must point out that should the case go to appeal the evidence could be ruled inadmissible. These defects are:

The advertising and promoting figures in Paragraph 7 of Mr Bontemps’ Witness Statement have been omitted. Brackets in the text paragraph are also incomplete.

There is no exhibit B which has been referred to in the witness statement (as acknowledged in your letter dated 24 June 2004)”.

11. These defects appear to stem from the use of a pro-forma document designed to elicit relevant information from the opponent. In addition to the above I note that there is a reference to Exhibit A in the associated text but without the accompanying exhibit that is referred to. It is said to be an extract from CC’s website but as it is dated sometime after the material date its relevance may have proved questionable even if it had been present. There is also a reference in the body of the witness statement to “a large number of trademark registrations in the UK which are protected in Classes 29 and 30. These are exhibited under Exhibit C...”. Again no such exhibit is before me. Despite the fact that two Registry letters (of 7 July 2004 and 2 November 2004) have clearly indicated that only one exhibit (D) has been admitted into the proceedings, CC has made no attempt to suggest that this fails to properly represent the full extent of their evidence. I find this to be an unsatisfactory state of affairs but I can only deal with the material that has been formally admitted and placed before me.

12. Mr Bontemps says that CC first commenced use of the CAPITAINE COOK mark in 1995. The tentative claim in the counterstatement to extensive use prior to that date has not been pursued. The use is said to have been in relation to a range of food products comprising mainly fish, shellfish and sea food and food products made from such items. Approximate sales values and volumes are given as follows:

<u>Year</u>	<u>Annual sales (Euros)</u>	<u>Volume of sales</u>
1995	4226	3264
1996	4263	3264
1997	-	-
1998	-	-
1999	24046	13716
2000	4910	4240

13. CC is said to have supplied various companies in the UK with goods, examples of these include Foodfinders, based in Bury St Edmunds and Jeal Fine Foods in London. The only documentary evidence before me to support these claims consists of 3 invoices dating from 1999/2000 to Foodfinders from which commercially sensitive information has been removed. There are no examples of the products or their packaging though Mr Bontemps does say that they were all branded CAPITAINE COOK. The translation of the invoices indicates that the goods include (to take the first of the invoices):

‘marinated mackerel filets Cook’, ‘marinated mackerel devil filets Cook’, ‘mackerel tomato filets Cook’, ‘appetizers Cook’, ‘white tuna filets olive’, ‘white tuna H. olive Cook’, ‘sardines olive Cook’, ‘sardines olives lemon Cook’, ‘Breton scallop shells’, ‘natural salmon filets’, ‘smoked trouts filets Cook’, ‘mussels with allium sauce’, ‘calmars with american sauce’, ‘salmon butter’ and ‘crab butter’.

14. The other invoices cover the same range of goods. The limited information thus available suggests at best a sporadic trade of modest size and one which appears to have been discontinued or at least not actively pursued since 2000 (the last recorded invoice is dated 18 April 2000), well over two years prior to the material date in these proceedings. No

explanation is given as to the nature of Foodfinders' and Jeal Fine Foods' business and in particular whether they are importers, wholesalers or retailers. If they are merely intermediaries then where and when were the goods placed on the market? I am also unclear as to what is meant by the volume of sales. Does it refer to weights, pack numbers or what? A number of different products are listed on the invoices. I assume they were not all sold in equal quantities but it is not possible to say how the overall sales figures are broken down as between the products concerned.

Decision

15. Section 5(2)(b) 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,

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

16. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. *Canon Kabushiki Kaisha v. Metro-Goldwin-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

17. I can deal fairly shortly with the marks themselves. It is clear from *Sabel v Puma* that the visual, aural and conceptual similarities must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. The applicant has pointed out that ‘CAPITAINE’ is not an English word and is visually and aurally distinguishable from ‘Captain’. Nevertheless the French word is not very different from the English equivalent. When the marks are considered as wholes, this point of difference and the possessive form of the second element of Britannia’s marks are extremely unlikely to serve to distinguish between them. They are similar to a high degree. It is true that the third and fourth marks in the applied for series are presented in slightly stylised form (and in colour in the case of the fourth mark). But these features, taken individually or collectively, do not in my view make a material difference (consistent with the claim that they are a series). I am also of the view that the marks are highly distinctive and memorable in relation to the goods at issue.

18. The real issue in this case is whether the goods are similar. CC submits that the parties’ goods are complementary and that Britannia’s goods could be used in conjunction with CC’s own products. Mr Bontemps says that:

“The nature of the goods, namely foodstuffs are identical and their purpose namely to satisfy ones hunger is also identical. The trade channels through which the respective products can be bought and sold, namely supermarkets, convenience stores, grocery

stores are also identical and I believe that the distribution (at wholesale level) would also pass through the same channels.

Brand extension specifically relating to foods is very common now and most companies who have a successful brand in relation to a specific foodstuff will give serious consideration to extending that range to cover complimentary or related foodstuffs. For this reason, I believe that registration to Application No. 2308375 would prevent my company from extending its brand into complimentary and related foodstuffs and/or in the alternative, my company is being prevented from being able to exploit its brand (for related products beyond the current product range) by, for example, the appointment of licensees or authorised companies who would be allowed to use the CAPITAINE COOK trademark (with my company's permission)."

19. Britannia for its part submits (per the counterstatement) that the goods are not similar since the physical nature of the products would be different, the location of the products would be different in normal retail environments and they do not compete with one another.

20. The principles to be applied in considering the similarity of goods are to be found in the *Canon* case where the ECJ stated at paragraph 23:

"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 end users and their method of use and whether they are in competition with each other or are complementary."

21. In *British Sugar Plc v James Robertson & Sons* (TREAT) [1996] RPC 281 it was considered that channels of trade should also be brought into the reckoning.

22. In approaching the issues before me I take the average consumer for the goods at issue to be the public at large. That consumer is deemed to have the qualities identified in the *Lloyd Schuhfabrik* case. Most of the items in the respective specifications are likely to be moderate to low-priced items that may be purchased on either a regular or occasional basis. By and large consumers will not be overly attentive when making such purchases.

23. Although the parties have offered submissions on issues of similarities/differences between the goods neither has identified the specific goods within the specifications which lead them to their particular views. CC's goods are, I think, reasonably clear from the terms used in the specification as are the biscuits and crackers in Britannia's specification. I am less certain what the terms 'Snack foods; potato and/or wheat based snacks' (part of Britannia's specification) should be taken to cover. The term snack foods is an imprecise one but, without some appreciation of what the notional coverage of the term might be, the process of applying the normal principles of comparison cannot begin.

24. It was established in *Altecnic's Trade Mark Application* [2002] RPC 34 that the Registrar is entitled to treat the Class number as relevant to the scope of an application. Thus, Britannia's snack foods can only be those that are appropriate to Class 30.

25. The term 'snack' is defined in Collins English Dictionary as "a light quick meal eaten between or in place of main meals". It seems to me that most people would readily accept

that items such as extruded puffed wheat/corn/rice products, sausage rolls and such like would readily fall within the term snack foods. But I see no reason to unduly limit the scope of the term and would take it to cover confectionery products (cereal and chocolate bars for instance) as well as savoury products. The aforementioned items would all be appropriate to Class 30 but snack foods can also be found in Class 29 (examples would be items such as spicy meat sausages, snack foods of vegetable or fruit, potato crisps, edible seeds, nuts, raisins).

26. How far beyond this one should go seems to me to be open to debate. Trade evidence may have helped in showing how consumer perception of the term snack foods has been fashioned. To take an example, a pizza would normally be regarded as a main meal but it is by no means uncommon to see pizza slices being offered for sale. Does that make a pizza slice a snack food product?

27. There is a further dimension to the problem in that the market for such foods is a developing one as manufacturers see opportunities for new product offerings to meet or create consumer demand. Consumer perception of what is or may be a snack food can, therefore, vary over time. Consumers are also unlikely to concern themselves with the intricacies of classification of such goods. But that is not to say that all products which might be regarded as snack foods must automatically be considered similar.

28. Making the best I can of the matter, I think I must take the broad term snack foods in Class 30 to include not just the more obvious sweet and savoury 'nibbles' mentioned above but also items such as pies, pasties, vol-au-vents, sandwiches etc. Britannia's specification, therefore, notionally includes such items.

29. CC's Class 29 specification includes, inter alia, meat, fish, poultry and game and preserved, dried and cooked fruits and vegetables. I do not consider that such items would ordinarily be considered snack foods (and the other items do not appear to improve CC's case). CC has argued its case on the basis of brand extension and complementarity. I do not regard the brand extension point as being self-evident. Rather, it would require evidence to illustrate practices in the trade and, more importantly, the effect such practices have had on consumer expectation. Moreover, whilst a party's inability to extend the scope of its brand may be a consequence of confusion, it does not form a basis of objection in its own right. On the other hand, if there is a likelihood of confusion, that is enough for an opponent to succeed. It does not matter what adverse consequence is likely to result.

30. The submission that there is complementarity in the sense that the parties' goods may act as accompaniments to one another might appear to be a rather more plausible basis for a finding of similarity. But I am left to speculate on which of CC's goods are meant to be complementary. The statement of case (paragraphs 1 and 4) refers to the goods not in terms of CC's registered specification but fish, shellfish and seafood and food products made from fish, shellfish and seafood products. Of these items only fish is included in the registered specification (on my reading of the latter). No case seems to be argued in this respect in relation to the other items in the specification. In the absence of evidence or argument on the point the case for complementarity between fish and Britannia's goods seems to me to be a weak one.

31. Nevertheless, it seems to me that there is a degree of similarity between snack foods and certain of the items in CC's specification in as much as one would be an ingredient in, or

alternative purchase to, the other. I have already indicated that I regard snack foods as being a wide enough term to encompass pies and such like goods in Class 30. Clearly items in the first half of CC's specification can be key ingredients in certain snack foods. Examples of the relationship between the Class 29 and Class 30 goods would be sausage meat/sausage rolls, meat/meat pies, cooked fruits or vegetables/fruit or vegetable pies. Applying the *Canon/Treat* test the nature of the goods is different (they are food items in each case but more likely to be at different stages of processing); the users would be the same; they are in competition to the extent that the consumer might encounter the marks in use on products that would be alternatives to one another (the choice, say, between buying a ready to eat pie or the filling to make the same thing oneself); they would probably not appear in close proximity in a retail environment and I have been given no information on the position at earlier stages in the production/distribution process. That all seems to suggest a low but not negligible degree of similarity.

32. Britannia's specification also includes biscuits and crackers. With these items I can see no real similarity with the opponent's goods. If there is similarity it really required rather more explanation or evidence than has been supplied.

33. Likelihood of confusion is a matter of global appreciation taking all relevant factors into account (*Sabel v Puma*). A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon v MGM*). I have found that there is a high degree of similarity between the marks; that the marks have a high degree of inherent distinctiveness; and that there is a low but not negligible degree of similarity between snack foods and certain items in CC's specification. I have not found this an easy matter to decide but have concluded that the opposition succeeds under Section 5(2)(b) in relation to snack foods and potato and/or wheat based snacks but fails in relation to biscuits and crackers.

34. There is a further ground under Section 5(4)(a) based on the law of passing off. The evidence that would go to support a claim to goodwill is weak and poorly substantiated. In my view CC's case under this head would not get off the ground. In any case it would scarcely lead to any greater success than the opponent has already achieved.

35. The application will be allowed to proceed if, within 28 days of the expiry of the appeal period, the applicant files a Form TM21 restricting its specification to "Biscuits; crackers". If no Form TM21 is filed within the period set the application will be refused in its entirety.

Costs

36. As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 7th day of January 2005

M REYNOLDS
For the Registrar
the Comptroller-General