

O/155/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2549882
BY NERO & BIANCO LIMITED
TO REGISTER THE TRADE MARK**

NERO & BIANCO

IN CLASS 30

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 100874 BY
ELAH DUFOUR S.P.A.**

BACKGROUND

1) On 9 June 2010 Nero & Bianco Limited (hereinafter the applicant), applied to register the following trade mark:

NERO&BIANCO

2) In respect of the following goods in Class 30: “Chocolate bars & Cocoa based confectionery.”

3) The application was examined and accepted, and subsequently published for opposition purposes on 2 July 2010 in Trade Marks Journal No.6842.

4) On 25 August 2010, Elah Dufour S.p.A., (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark and is opposing the mark in suit under Section 5(2)(b):

Number	Mark	Filing and Registration Date	Class	Specification relied upon
CTM 4969961	NERO NERO	13.03.2006 16.04.2007	30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; chocolate, chocolate-based goods, pastries, ice-cream and confectionery.
			35	retailing and wholesaling of chocolate, chocolate-based goods, pastries, ice-cream and confectionery.

5) On 8 November 2010, the applicant filed a counterstatement which denied the opponent’s claims. The applicant states that the term “nero” for chocolate is “unremarkable” and states that the earlier mark’s distinctiveness resides in its whole and that the repetition is an important and striking feature. The applicant did not put the opponent to proof of use.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 8 March 2012. At the hearing, the opponent was represented by Mr Gill of Messrs W P Thompson & Co.; the applicant was represented by Mr Malynicz of Counsel instructed by Messrs Fry Heath & Spence LLP.

OPPONENT'S EVIDENCE

7) On 17 January 2011 the opponent's trade mark attorney filed written submissions. I will not detail these here but deal with them, as and when required, in my decision.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 14 April 2011, by James Roberts, a director of the applicant. He states that he is aware that the word "nero" is an Italian word which means dark or black and is used within the chocolate industry in Italy to denote dark chocolate. At exhibit JR3 he provides copies of pages from the internet which shows use of the word "nero" on Italian websites being used when referring to dark chocolate and also in reference to the colour of a hair dye product. At exhibit JR3 he provides a witness statement, dated 22 March 2011, by Orietta Marchetti, an account manager of Icam s.p.a., a leading manufacturer of chocolate in Italy. She confirms that the word "nero" is widely used in Italy in relation to chocolate, to describe dark chocolate. She provides exhibits showing use of the word "nero" on chocolate products. At exhibit JR4 he provides photographs of the applicant's products which show use of the mark in suit and also a description of the chocolate, "milk chocolate", "dark chocolate" or "white chocolate".

9) Mr Roberts states:

"5. My company sells organic, Fairtrade chocolate products which contain a minimum of 70% cocoa solids for dark chocolate and a minimum of 35% cocoa solids for milk chocolate. Higher cocoa levels result in higher production costs (and a better taste!). I would say that common high street branded chocolate manufactured by large international companies such as Mars, Inc and Cadbury typically contain no more than 6% cocoa solids. Organic and ethically sourced (e.g. Fairtrade) products are also more expensive to manufacture and so add a premium to the end-consumer price. These facts mean that my company's products are placed at the higher end of the market.

6. Consumers purchasing higher priced chocolate tend to be a little more discerning and careful about the chocolate that they purchase; they do not just "grab and go" in the same way as someone may purchase a Mars bar. They care about the fact that the chocolate is organic or Fairtrade and take note of the cocoa content of the chocolate, which is why my company mentions these facts on its products packaging (see exhibit JR4) and uses the strap line "indulgence with conscience"."

10) At exhibit JR5 Mr Roberts provides a witness statement, dated 15 March 2011, by Christine Moss who is the founder and owner of The Chocolate Truffle Company in Essex. She states that she has been making chocolate products in the UK for twenty five years and as such has an understanding of the UK market. She states that over the last ten years there has been an upsurge of interest in quality chocolate in the UK with a

large number of new companies supplying Fairtrade, organic chocolate. She states her belief that UK consumers are more discerning about the chocolate they purchase and will check labelling for indications of quality (cocoa content and/or organic) and provenance (whether it is ethically sourced). At exhibit JR6 Mr Roberts provides photographs of two chocolate bars that he purchased recently in the UK and also some information from the web site of Caffè Nero, which claims to be the largest independent coffee retailer in the UK. The chocolate bars both have the mark “Caffè Nero” and a description of the chocolate, “milk chocolate” in one instance, “Hazelnut chocolate” in the other. At exhibit JR7 Mr Roberts provides examples of references to the word “nero” on websites aimed at UK consumers. Two are recipes, one which simply gives the Italian and English name of the dish where “squid ink” is translated as “Nero di seppia”, the other is a recipe which includes the ingredient “cavolo nero”. The other internet hits are of cars, mostly of Italian origin, which have either the inside or outside colour described as “nero”, sometimes with the word “black” immediately before or after.

OPPONENT’S EVIDENCE IN REPLY

11) The opponent filed a witness statement, dated 12 September 2011, by Guido Repetto, the CEO of the opponent. He states that he is responsible for the whole European market and so is familiar with market conditions across Europe. He states that this company produces and sells a wide variety of chocolate goods including chocolate bars. Amongst these products is a specific line of chocolate bars called NERO NERO containing high levels of cocoa, ranging from 70 to 99%. At exhibit GP01 he provides an illustration of the product, however, the photocopy is so poor that the mark NERO NERO and other details cannot be seen. He states that all the products of his company are regarded as “high quality” and sell via a variety of shops including supermarkets. He states that his company’s products are sold in Italy and France. He states that the mark has become famous because of their high quality and standards. He states:

“11. Even if the word “nero” could be considered an Italian word which means “black”, the use, the promotion and the notoriety of the Company’s trademark determined a high distinctive character of the mark NERO NERO for the claimed goods.

12. I am not aware of the use of the word Nero, in combination with another word designating common chocolate colour, otherwise than by the Company. The adoption of the “repeated colour reference” is a peculiar concept of the Company and the use of this special combination has acquired notoriety and a distinctive character among the consumers.

13. The traders cited by the Applicant in its statement use the word “nero” not as a trademark but in a descriptive way for their goods; moreover this word is not used in combination with other words or element in order to have distinctive character. I am not aware of traders using the combination of the word “NERO” with another word to designate a colour (for example “NERO” or “BIANCO”) to claim goods in

the market of pastry and confectionery, otherwise than the Company and the Applicant.”

12) Lastly Mr Repetto provides examples of companies offering products in the UK using the term “BIANCO” to describe the colour of the goods. These include a recipe for chicken in white wine “chicken vino bianco”; “pinot bianco” in relation to grapes used in producing wine; “bianco” colour porcelain tiles; a ladies blouse colour bianco/white; the colour chart for Lamborghini cars includes the term “bianco”; as does a site for Dodge cars which are not actually sold in the UK; and an advertisement on Amazon for a colour touch up pen for a Fiat car.

13) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

14) The only ground of opposition is under Section 5(2)(b) of the Act which reads:

“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.”

15) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16) The opponent is relying upon its trade mark CTM 4969961 which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered, 16 April 2007, and the date that the applicant’s mark was published 2 July 2010 the opponent’s mark is not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004.

17) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union

(CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

18) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.


19) In the instant case the opponent has not provided any evidence regarding use of its mark, merely asserting that its mark is well known in Italy and France. It cannot therefore benefit from an enhanced reputation.

20) As the case law in paragraph 17 above indicates I must determine the average consumer for the goods of the parties. I must then determine the manner in which these goods are likely to be selected by the said average consumer. The average consumer would be those members of the general public who consume chocolate. This encompasses almost the whole number of the UK population. The goods which could be included within the specifications of both parties vary considerably in terms of price and specification. Although both parties stress that they produce chocolate with a high proportion of cocoa solids, this is not reflected in the specifications which cover chocolate of all descriptions. As such, some items could be very cheap costing pennies each whilst others could be very expensive. Overall, given that these items are to be consumed by the purchaser or purchased as a present I believe that the vast majority of the goods will not be purchased or selected without a degree of care. If only to ensure that the product does not provoke an allergic reaction which more and more of the population appear to be prone to. They are most likely to be self selected from a shelf and as such the visual comparison is the most important.

21) I shall now consider the goods of the two parties. For ease of reference, I set out the relevant specifications of both parties below:

Applicant's specification	Opponent's specification
Class 30: Chocolate bars & Cocoa based confectionery.	Class 30: cocoa, confectionery, chocolate, chocolate-based goods, pastries, ice-cream and confectionery.

22) Clearly, the goods are identical. I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Opponent's Trade Mark
	NERO NERO

23) The opponent contends that more UK consumers will recognise the word “bianco” as a colour, than would recognise the word “nero”. They conclude that the element “bianco” provides a lesser degree of distinctiveness to the later mark than the prefix “nero”. They contend that the dominant element of the applicant’s mark is the prefix “nero” which is shared with the opponent’s mark and therefore creates a very strong visual and phonetic similarity. In *Petmeds Limited v Petmeds Express, Inc.* (BL O/471/11) Mr Danial Alexander Q.C. acting as the Appointed Person said:

“46. In my view, in general, where a specific assertion is made that marks are not likely to be confused because the common element is descriptive, or otherwise common to the trade, the onus lies on the undertaking asserting that proposition to establish it, with evidence, unless the element in question is so obviously descriptive of the goods or services that judicial notice may properly be taken of it. That is not an unreasonable burden since, if a sign is in common descriptive use, the fact is likely to be easy to prove.”

24) In the instant case both sides have filed instances of the use of the words “nero” and “bianco” on a variety of goods. Both have been instanced in relation to recipes and cars. The opponent also showed use of the word “bianco” upon clothing, tiles and wine, whilst the applicant also showed use of the term “nero” upon hair dye and chocolate. Neither side’s evidence went beyond a few references from the internet at best. Some were single instances of use. Neither side showed evidence of the extent of the use in terms of the sales of any of the products, market share etc.

25) If both words are recognised by the average consumer as meaning black/dark (Nero) and white (bianco) then, to my mind, the opponent’s mark does not have a dominant element as it is descriptive of chocolate. If a bar of chocolate has the term “dark dark” or “black black” upon it then the consumer will, in my opinion, assume that it has a very high level of cocoa solids and so is an intense dark chocolate. It is not quite so clear cut when considering the applicant’s mark. A bar described as “dark and white” or “black and white” would not be seen as readily as descriptive as one usually does not get both types of chocolate in a single bar, although it is possible. The opponent

contended that the repetition of the mark was distinctive and that it would not be viewed as descriptive of the product.

26) It is possible that the average consumer will not recognise either word, or that they will recognise only the word “bianco” as it has been used extensively upon wine. To my mind, whether the words are understood or not, the distinctive character of both parties’ marks lies within their totality rather than their individual elements.

27) Earlier in paragraph 19 I ruled that the opponent could not benefit from enhanced reputation. I must also consider the issue of inherent distinctiveness. In my opinion, the average UK consumer will not be aware that the words “nero” and “bianco” are Italian words which mean “dark/black” and “white” respectively. It is universally accepted that the average UK citizen is not particularly versed in foreign languages. The opponent’s mark therefore enjoys a high degree of inherent distinctiveness.

28) Visually, both marks share the same prefix, however the opponent’s mark repeats the prefix to form its second part and consists of four syllables. The applicant’s mark in contrast has an ampersand and the word “bianco” as its second and third elements, forming a six syllable mark. The applicant’s mark is significantly longer than that of the opponent. Overall the visual differences outweigh the similarities.

29) Aurally, both marks begin with the same word but thereafter are very different. To my mind the aural differences outweigh the similarities.

30) Working on the basis that the average UK consumer will not understand the meanings of the words then neither mark will have any conceptual basis as a result of their literal meanings. However, the opponent’s mark does contain, twice, the name of an infamous Roman Emperor, Nero. Most consumers will be aware of the legend of Nero playing the fiddle whilst Rome burned. Although the word also appears in the mark in suit it is in conjunction with “& Bianco” and so give sthe impression of two different people. There is therefore conceptual dissimilarity.

31) In case I am wrong on whether the average UK consumer will recognise the Italian words, I must consider what the conceptual effect would be were the words to be understood. The opponent’s mark translates to be “black black” or “dark dark”, whilst the mark in suit is “black & white” or “dark & white”. In either case I believe that the conceptual meanings are different.

32) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must consider whether the opponent’s trade mark has a distinctive nature, the average consumer for the goods, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods will not be chosen without a degree of care. In the instant case the opponent’s mark has a high degree of inherent distinctiveness. I accept

that the goods are identical, however, the considerable differences between the marks of the two parties means that there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) fails.

COSTS

33) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£500
Preparing for and attending a hearing	£1200
TOTAL	£2000

34) I order Elah Dufour S.p.a. to pay the Nero & Bianco Limited the sum of £2000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of April 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**