

**O-413-16**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3094384**

**BY GOLDENFRY BRANDS LTD**

**AND**

**OPPOSITION No. 404817**

**BY McCAIN FOODS (G.B.) LTD**

## Background and pleadings

1. On 13<sup>th</sup> February 2015 (“the relevant date”), Goldenfry Brands Ltd (“the applicant”) applied to register the word **HOME** as a trade mark for a wide range of foodstuffs and food and drink related services in classes 29, 30 and 43.

2. The application was accepted and published for opposition purposes on 1<sup>st</sup> May 2015.

3. On 3<sup>rd</sup> August 2015, McCain Foods (G.B.) Ltd (“the opponent”) filed a notice of opposition. The opposition was based on earlier trade mark 2154598 which includes the words HOME FRIES as one of a series of four marks. The other three marks do not matter for present purposes.

4. The earlier mark is registered for *French fries and potato chips* in class 29.

5. The opponent claims that the contested mark is similar to the earlier mark and is proposed to be registered for goods in class 29 and services in class 43 which are the same or similar to the goods covered by the earlier mark. The opponent claims that there is a likelihood of confusion on the part of the public. Consequently, registration of the contested mark in classes 29 and 43 would be contrary to s.5(1) or s.5(2) of the Trade Marks Act 1994 (“the Act”). This means that the opponent does not oppose the registration of the contested mark in class 30 under s.5(1) or s.5(2).

6. However, the opponent also relies on its common law rights under the words HOME FRIES as a result of its use of those words since at least 1997 to distinguish potato products and products made predominantly from potato. The opponent claims that the words have become distinctive of the goodwill in its business and that use of the contested mark would constitute a misrepresentation to the public. Such a misrepresentation would be liable to damage the opponent’s goodwill. Consequently, use of the contested mark in relation to the goods in classes 29 or 30, or the services in class 43, would amount to passing off. Therefore, registration of the mark in any of these classes would therefore be contrary to s.5(4)(a).

7. The opponent also opposed the registration of the mark on the ground that registration of the contested mark for any of the goods/services covered by the application would be contrary to s.3(1)(c) of the Act. The opponent particularised this ground as follows:

*“ ‘Home’ is prima facie descriptive and non-distinctive for products and services adapted for use in the home..... . It is equally descriptive for the services, for example, catering services in the nature of home delivery services.”*

8. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the earlier mark. The applicant also put the opponent to proof of the existence of the passing off right claimed in the notice of opposition.

### **Case management**

9. The opponent was given until 5<sup>th</sup> January 2016 to file evidence or submissions in support of the opposition. On 4<sup>th</sup> January, the opponent requested an extension of time until 5<sup>th</sup> February 2016 in which to file its evidence. The opponent cited the unavailability of a key person within the opponent’s business and the Christmas holiday period as reasons why more time was required to complete its evidence. The case worker provisionally rejected the requested extension of time.

10. The opponent subsequently filed its evidence on 4<sup>th</sup> February 2016. At the same time it sought an order that the evidence be treated as confidential to the parties and not made available to the public. The justification for this request was that *“much of the evidence....is of a commercially sensitive nature”*.

11. A case management conference (“CMC”) was held on 16<sup>th</sup> February to decide on the opponent’s requests and the related issue of the admissibility of the evidence which the opponent had by then filed. Following the CMC, I issued a number of directions. These included the following:

- i) The opponent's extension of time request was granted and the evidence filed on 4th February was admitted;
- ii) The opponent's request for a direction that the evidence should be treated as confidential, and therefore not open to public inspection, was rejected, except in relation to the columns headed 'unit price' and 'amount' in the invoices making up exhibit GF1;
- iii) A direction under Rule 59(1) would be made in respect of the data identified at (ii) above.

12. I gave my reasons for these decisions as follows:

*"I considered the decision on the extension of time marginal. I had sympathy with the applicant's submission that it had not been shown what action the opponent took within the period allowed for filing evidence, and looking at the evidence the answer was probably none. However, the initial period did include the Xmas period and the extension sought was reasonably short and the evidence was filed within this period. Therefore, on balance, I decided to permit the extension.*

*On confidentiality, I was not satisfied with general assertions that the opponent's evidence was commercially sensitive. The only tenable argument was that the unit cost of the opponent's goods to supermarkets was commercial information that the opponent did not want to be available to its competitors. I agreed to issue a direction covering this data only."*

13. On examination, the opponent's evidence provided no support for the s.3(1)(c) ground of opposition. The applicant's attorney pointed out that Rule 20(3) of the Trade Mark Rules 2008 stated that where no evidence is filed to support an opposition based on s.3, that ground should be deemed withdrawn. After listening to arguments, I further directed that:

- (iv) The opponent had until 22 February to state in writing the

legal basis for continuing with s.3 ground of opposition in circumstances where it has filed no evidence to support that ground and therefore Rule 20(3) appeared to apply.

14. The opponent provided written arguments in support of its position that the opposition under s.3(1)(c) should be allowed to continue. In essence, the opponent submitted that the only fact that it intended to rely on was the dictionary meaning of the word HOME and this was apparent from the notice of opposition. Following a second CMC on 3<sup>rd</sup> March 2016, I directed that the opposition based on s.3(1)(c) should be allowed to continue. I gave my reasons as follows:

*“5. I note that Rule 20(3) is expressed in mandatory terms. If no evidence is filed under Rule 20(2) the opposer “shall be deemed to have withdrawn the opposition”. Consequently, the only question I have to decide is whether [the opponent] has filed evidence in support of [the] opposition.*

*6. The evidence must be such as to permit an evaluation of the relevant ground(s) of opposition. In a case where a ground of opposition is based on a single fact; namely, the ordinary meaning of a well known word, it is possible to evaluate the ground of opposition without further evidence. Consequently, the opponent has provided the only factual material required in this case.*

*7. It is true that the only fact relied on by the opponent in this context was included in the notice of opposition, which preceded the evidence rounds. However, given the nature of the fact in question I am prepared to treat it as having been filed under Rule 20(2). If it were otherwise then oppositions could be deemed withdrawn on the basis that the necessary evidence was filed too soon. Further certain s.3 grounds, such as those based on lack of graphical representation, which may require no more than an assessment of the adequacy of certain words or pictures, and therefore no more evidence than the meaning of the words used, could be impossible to run on the basis of a more literal interpretation of Rule 20.”*

*8. I reserved costs for the CMC to the final decision.”*

## The evidence

15. The opponent's evidence consists of a witness statement by Mr Greg Foster, who is the opponent's Marketing and Communications Manager. Mr Foster's evidence is that HOME FRIES is one of the opponent's most important products. The mark has been used in the five year period ending on 1<sup>st</sup> May 2015 in relation to fries. According to Mr Foster, these goods have been sold on a "massive" scale under the mark through all the major supermarkets in the UK under this mark. HOME FRIES have also been heavily advertised and promoted, including through TV advertising.

15. In support of these claims Mr Foster exhibited invoices dated within the period mentioned above, to UK supermarkets, such as Asda, Sainsbury's, Tesco and Waitrose<sup>1</sup>. These invoices are for substantial volumes of products. Up until September 2011, one of the products is described as HOMEFRIES. Later invoices describe it as HOME CHIPS (or McCain Home Chips).

16. Mr Foster also exhibits an example of the opponent's advertising<sup>2</sup>. This consists of an 'advertorial' from Take a Break magazine dated 27<sup>th</sup> October 2010 which highlights that *McCain Home Fries* launched a competition to celebrate becoming sponsors of ITV's *All Star Family Fortunes* game show.

17. Exhibit GF3 consists of a breakdown of the opponent's advertising spend dated 21<sup>st</sup> June 2010. It is not very clear, but appears to show that the opponent proposed to spend £2.5 to £3m promoting HOME FRIES. Over £1m of this was accounted for by the sponsorship deal mentioned in the previous paragraph.

18. Mr Foster also provides sales figures for HOME FRIES which purport to show that the opponent sold between around 31m and 40m units of these products in each of the years 2011 to 2014<sup>3</sup>.

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<sup>1</sup> See GF1

<sup>2</sup> See GF2

<sup>3</sup> See GF4

19. Finally, Mr Foster provides samples of packaging from the years 2010, 2011 and 2015 showing how the mark has been used. This shows the use of this mark in 2010 and 2011:



And the use of this mark in 2015.



20. The applicant has not challenged the truth of the opponent's evidence. Taking all of the opponent's evidence into account, I find that the opponent made substantial use of HOMEFRIES in 2010 and 2011, and substantial use of HomeChips between 2012 and 2015. The marks were used in relation to potato chips.

21. The applicant's evidence consists of a witness statement by Mr Paul Brandon, who is a trade mark attorney with Appleyard Lees IP LLP, which represents the applicant in these proceedings. Mr Brandon exhibits copies of communications from the examiners who dealt with the application prior to publication<sup>4</sup>. These show that the first examiner challenged the width of the applicant's specifications in classes 29 and 30, but did not object to the application on distinctiveness grounds. The second

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<sup>4</sup> See PLB1 and PLB2

examiner accepted a revision to the applicant's list of goods in classes 29 and 30. The revised list of goods/services is as follows.

#### Class 29

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 29; foodstuffs in Class 29; prepared meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 29; preparations in Class 29 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following; meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats.

#### Class 30

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 30; foodstuffs in Class 30; prepared meals, foods, side dishes, component parts at meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen, meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 30; preparations in Class 30 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following: coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible oils, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, pizzas, pies and pasta dishes, meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats; food mixes for



making batter, cakes, pastry and for making puddings, preparations for making sauces and gravies; flavourings and seasonings; curry mixes, dried culinary herbs, gravies, preparations consisting principally of cereals for use as stuffings for foodstuffs, salt (for food), vinegar, pepper, mustard and breadcrumbs for cooking.

#### Class 43

Services for providing food and drink; bar, hotel, restaurant, cafeteria, banqueting and catering services; restaurants; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

### **The hearing**

22. A hearing was held on 28<sup>th</sup> July 2016 at which the opponent was represented by Mr Mark Armitage of Withers and Rogers LLP. The applicant was not represented at the hearing, but Appleyard Lees filed brief written submissions on the applicant's behalf.

### **Section 3(1)(c) ground**

23. Section 3(1)(c) of the Act (so far as relevant) is as follows:

“3(1) The following shall not be registered –

(a) -

(b) -

(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,

(d) -

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.”

24. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*<sup>5</sup>:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation*

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<sup>5</sup> [2012] EWHC 3074 (Ch)

*in the Internal Market (Trade Marks and Designs) (OHIM) (C-456/01 P)* [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM (C-48/09 P)* , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM (C-80/09 P)*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that

that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

25. The meaning of the word HOME is so well known that there is no need for me to set out the dictionary definitions. The applicant has filed no evidence of any use of the contested mark, therefore I have only the *prima facie* case to consider. The opponent's case is that the word HOME designates "...*goods and services adapted for use in the home*" or in the case of services, "*the subject of home delivery services*". It is, of course, possible to prepare food at home, but I do not understand how this makes HOME a characteristic of food products (as opposed to a description of where they are sometimes prepared and eaten). I am not sure what else is meant by food being *adapted* for use at home. I acknowledge that it is possible to order food for home delivery, but even if these words designate a characteristic of food products delivered to the home, I am doubtful that HOME (by itself) would be understood as a description of a characteristic of such products. Despite its earlier

statement that it intended to rely solely on the dictionary meaning of the word HOME, the opponent's representative at the hearing asked me to take into account that "*it is common practice in the food sector for manufacturers to provide partially prepared meals and products which consumers can then finish with ease at home*". If this is indeed common practice, the opponent could easily have made the submission good with evidence. It did not do so. Further, it does not necessarily follow that the relevant average consumer would understand that HOME (by itself) designates partially prepared meals and products.

26. In this connection, I note that the alleged descriptiveness of the word HOME does not appear to have been such as to prevent the opponent using the mark HOMEFRIES to distinguish its frozen potato chips.

27. I find that this aspect of the opposition under s.3(1)(c) is not made out.

28. I can better understand the argument that HOME describes the place of rendering of services. In particular, it is obvious that the word describes the place of rendering of catering services provided in the home. I therefore find that the mark designates a relevant characteristic of *services for providing food and drink; banqueting and catering services*. The opposition under s.3(1)(c) succeeds to this extent.

29. The opposition under s.3(1)(c) fails in respect of the goods in classes 29 and 30 and the remaining services in class 43, i.e. *Bar, hotel, restaurant, cafeteria services; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class*.

30. The opponent's skeleton argument introduced a further line of argument; namely, that HOME is descriptive of home-style food served in restaurants. This argument is not covered by the opponent's pleaded case. In any event, the difference between the meaning of HOME by itself, and 'home-style' will be immediately perceptible to average consumers of restaurant services. I therefore find that HOME is sufficiently far removed from 'home-style' that the specific descriptive meaning of the latter term is not immediately apparent from the contested mark. Consequently, even if it was

open to the opponent to pursue this argument, on the evidence before me, or more accurately the lack of it, I would have held that whilst HOME is allusive of home-style food products (whether served in restaurants or otherwise) it is not a sign that may serve, in trade, as a designation of such goods.

### **Section 5(1) & (2) grounds**

31. The relevant statutory provisions are as follows.

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

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

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

32. Section 6A of the Act is also relevant in this case. This states that:

““Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.



(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

33. The opponent’s earlier trade mark 2154598 had been registered for more than 5 years at the date of publication of the contested mark. Consequently, the opponent made the required statement of use of the earlier mark. The applicant put the opponent to proof of the truth of this statement. Therefore, in order to be able to rely on the earlier mark, it is necessary for the opponent to show genuine use of the mark during the period 2<sup>nd</sup> May 2010 to 1<sup>st</sup> May 2015.

34. In *Awareness Limited v Plymouth City Council*<sup>6</sup>, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

35. The applicant submits that the opponent’s evidence of use must be assessed to determine whether or not the proof of use is *“sufficient to meet the applicant’s proof*

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<sup>6</sup> Case BL O/230/13

*of use request, in particular in relation to the place, time, nature and extent of any such use*". This appears to be no more than a statement of the obvious. I take it to mean that the applicant does not accept that the opponent has shown genuine use of the earlier mark in the relevant period.

36. The evidence shows that the opponent made substantial use of the mark HOMEFRIES during 2010 and 2011. It is true that the mark was used in combination with the house mark 'McCain'. However, I do not consider that this undermines the evidence that HOMEFRIES was used as a separate trade mark for potato chips<sup>7</sup>.

37. The opponent relies on the registered mark HOME FRIES. However, as the used mark - HOMEFRIES – consists of the words HOME and FRIES run together, and would be perceived as such by consumers, I consider that the used mark has the same distinctive character as the registered mark. Consequently, the use of HOMEFRIES counts as use of the earlier mark under s.6A(4)(a) of the Act. In my view, the extent of the use shown of HOMEFRIES in 2010 and 2011, is sufficient to constitute genuine use of the earlier mark in the relevant period. Consequently, there is no need to consider whether the subsequent use of HOME CHIPS also counts as genuine use of HOME FRIES.

38. The earlier mark has been used in relation to potato chips. 'French fries' are a type of thinly cut potato chips. In my view, average consumers of such goods would regard these terms as alternative descriptions of French fries. It is true that thick cut potato chips that would not usually be described as French fries, and there are probably medium cut chips which some people would regard as French fries and others as just potato chips. I therefore consider that it would be overly picky to distinguish between French fries and potato chips for the purposes of determining the goods for which the earlier mark is entitled to protection<sup>8</sup>. I find that the use shown is sufficient to justify protection of the earlier mark in relation to 'French fries and potato chips'.

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<sup>7</sup> See *Colloseum Holdings AG v Levi Strauss & Co.*, CJEU Case C-12/12

<sup>8</sup> See paragraph 63 to 65 of the judgment of Kitchen L.J. in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, (with whom Underhill L.J. agreed).

## Section 5(1) - identical marks and goods?

39. The application covers:

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 29; foodstuffs in Class 29; prepared meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 29; preparations in Class 29 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following; meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats.

40. In *YouView TV Ltd v Total Ltd*<sup>9</sup>, Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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<sup>9</sup> [2012] EWHC 3158 (Ch)

41. Applying this approach, I find that all the rather general descriptions of goods in class 29 are capable of covering *French fries/potato chips* insofar as they are “*made from or consisting of .. vegetables*”, and therefore potatoes.

42. The general descriptions of goods in class 29 that cover French fries/chips are also capable of describing many other types of goods. However, In *Gérard Meric v OHIM*<sup>10</sup>, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Therefore, I find that to the extent that they cover vegetables (and hence potatoes) the goods shown in paragraph 39 cover identical goods to *French fries and potato chips*.

43. Mr Armitage submitted that the marks should also be regarded as identical because FRIES is just the name of the opponent’s goods. Therefore the opponent’s trade mark is effectively HOME. In support of this submission, he drew my attention to the judgment of Vos J. in *United Airlines Inc. v United Airways Ltd*<sup>11</sup> in which the judge found that UNITED AIRWAYS was identical to UNITED when used in relation to identical (airline) services. The judge applied the test set out by the Court of Justice of the European Union (“CJEU”) in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*<sup>12</sup>, where the court held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

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<sup>10</sup> Case T- 133/05

<sup>11</sup> [2011] EWHC 241 (Ch)

<sup>12</sup> Case C-291/00

viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

44. The judge found support in his view from comments made by Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd*<sup>13</sup> to the effect that PALMOLIVE and PALMOLIVE SOAP could be regarded as identical marks for soaps because consumers would attach no trade mark significance to the word SOAP, even if it written with a capital letter ‘S’. By contrast, the judge (and the court) found that Reed Business Information was not identical to REED because (1) the words ‘Business Information’ were rather non-specific in meaning, and (2) the presentation of those words in capital letters suggested that they were not purely descriptive, but part of a composite word trade mark.

45. In my judgment, the marks at issue are identical when used in relation to *French fries/potato chips*. This is because the word ‘fries’ is such a common shortening of the more formal description *French Fries* that consumers would regard it as just the name of the goods. Consequently, although HOME does not reproduce “..all the elements constituting the trade mark”, the difference between the trade marks HOME and HOME FRIES would go unnoticed by average consumers of *French fries/potato chips*, in the sense that they would most probably regard the omission of the word FRIES from the applicant’s mark as wholly insignificant.

46. It follows that the opposition under s.5(1) of the Act succeeds in relation to the goods specified in paragraph 39 above to the extent that they cover goods made from *vegetables* (and hence potato products).

47. The remaining terms specified in class 29 of the application do not cover *French fries/potato chips*. I will therefore consider whether the opposition under s.5(2) succeeds in relation to these goods, and also the services covered by class 43 of the application which are not caught by the s.3(1)(c) ground of opposition.

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<sup>13</sup> [2004] RPC 767

## Section 5(2) ground - likelihood of confusion

48. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Similarity of goods/services

49. Give the extent of the success of the opposition under the s.3(1)(c) and s.5(1) grounds, I will limit my consideration under s.5(2) to the goods and services which are not caught by the first two grounds of opposition. These are:

#### Class 29

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 29; foodstuffs in Class 29; prepared meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen

meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 29; preparations in Class 29 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following; meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats.

#### Class 43

Bar, hotel, restaurant, cafeteria services; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

50. In the judgment of the CJEU in *Canon*<sup>14</sup>, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

51. At the hearing, the applicant’s attorney argued that products, such as fish or eggs, are often served with chips and there is therefore a degree of similarity between these products and *French fries/potato chips*, either because of a complementary relationship between the goods, or because *French fries/potato chips* can be considered as a prepared meal and/or snack in its own right and therefore in competition with other prepared meals or snack foods “*consisting of one or more of ... meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats*”.

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<sup>14</sup> Case C-39/97



52. In *Kurt Hesse v OHIM*<sup>15</sup>, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. However, in *Boston Scientific Ltd v OHIM*<sup>16</sup>, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

53. I accept that *French fries/potato chips* are often eaten with fish, eggs, meat etc., but they are but one of a number of potential accompaniments and are not therefore *indispensable or important for the use of the other* in such a way that *customers may think that the responsibility for those goods lies with the same undertaking.*” The goods are not therefore complementary.

54. I accept that, in the context of snack foods, consumers may sometimes opt for (say) a burger instead of *French fries/potato chips*. So there is a limited degree of competition and similarity of purpose between, on the one hand, snack foods made from goods other than vegetables (therefore, not potatoes) and, on the other hand, *French fries/potato chips*. However, the nature of the goods is different and, for the most part, the goods are not in competition. In my view, there is a low degree of similarity between snack foods made from products other than vegetables and *French fries/potato chips*.

55. The line between *snacks foods* and *prepared meals* is difficult to define. My finding for snack foods therefore also applies to *prepared meals*.

56. Mr Armitage submitted the applicant’s specification in class 29 covers potato substitutes, such as sweet potato products, or even carrots cut like chips. However, my finding that the s.5(1) ground catches products made from *vegetables* (at large) effectively disposes of this point.

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<sup>15</sup> Case C-50/15 P

<sup>16</sup> Case T-325/06

57. So far as the applicant's services in class 43 are concerned, I see no similarity of any kind between bar and hotel services and *French fries/potato chips*.

58. *Restaurant, cafeteria services and provision of food and drink in restaurants* could all involve serving *French fries/potato chips* to customers, normally as part of a dish or meal. There is therefore a moderate degree of similarity of purpose between the applicant's services and the opponent's goods. The services and goods could occasionally be in competition, but they would not usually be so. The respective services and goods are not complementary in the relevant sense. The nature of the applicant's services is also different to the opponent's goods, and the method of use of the services would also be different to the applicant's goods. Overall, I find that there is only a low degree of similarity between the applicant's services and the opponent's goods.

#### Comparison of the marks

59. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>17</sup>, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

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<sup>17</sup> Case C-591/12P

60. The respective trade marks are shown below:

Applicant's mark HOME	Opponent's mark HOME FRIES
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61. When considering the marks in relation to notionally identical goods I found that they were identical for the purposes of s.5(1). The marks are not literally identical, so this finding depended on the difference between HOME and HOME FRIES being so immaterial as to go unnoticed by average consumers. This was because the absence of the word FRIES from the applicant's mark made no difference to the average consumer's perception of the identity of the marks when both marks were considered in relation to (notionally) *French fries/potato chips*. However, as the judgment of the Court of Appeal in *Reed Executive Plc v Reed Business Information Ltd* shows, there is only limited scope to exclude perceptible visual and aural differences between marks on the basis that the missing or additional elements are purely descriptive. In the context of the applicant's mark being used in relation to goods and services which are not fries, the difference between HOME and HOME FRIES would not go unnoticed. I therefore find that the marks are not identical for the purposes of s.5(2). This means that s.5(2)(a) cannot apply. However, given that FRIES is just a shortened form of the name of the opponent's goods (and the distinctive character of that mark therefore resides overwhelmingly in the word HOME), I find that the marks are almost identical. I will therefore continue to examine the merits of the opposition focusing on s.5(2)(b).

#### Average consumer and the selection process

62. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*<sup>18</sup>.

63. In my view, the average consumer of foodstuffs, restaurant and cafeteria services is the general public. Such consumers are likely to pay an average level of attention when selecting the goods/services. The selection process is likely to be primarily through visual means, such as use of the marks on packaging, advertisements and signage, but oral use, such as word of mouth recommendations (or the opposite) must also be considered.

#### Distinctive character of the earlier trade mark

64. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

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<sup>18</sup> Case C-342/97

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”

65. The opponent’s mark is not an apt description of *French fries/potato chips*, but it is sufficiently similar to descriptive words, such as ‘home-cooking’ and ‘home-made’, that it alludes to such characteristics of the goods. Therefore, I find that HOME FRIES has a low level of inherent distinctiveness for the goods for which it is registered.

66. The opponent made substantial use of HOMEFRIES up until 2011, and since then appears to have made substantial use of HOME CHIPS. However, there is very little information about the promotion of the mark after 2010/11. Further, the fact that the opponent appears to have used the mark in different forms is unlikely to have enhanced the distinctive character of the earlier mark as much as if it had been used in a consistent form. Making the best I can of quite scant evidence, I find that the use of HOMEFRIES/HOME CHIPS will have served to enhance the low level of inherent distinctiveness of the HOME FRIES mark to some extent. However, the inconsistent nature of the use of the earlier mark combined with the lack of specific evidence of recent promotion of HOME FRIES leads to me to the conclusion that the earlier mark had only a moderate level of distinctive character at the relevant date.

#### Likelihood of confusion

67. So far as use of the applicant’s mark in relation to bar and hotel services is concerned, the absence of any similarity between the respective goods/services means that s.5(2) cannot apply<sup>19</sup>.

68. Taking into account the high level of similarity between the marks, the moderate level of distinctiveness of the earlier mark, and the low degree of similarity between *French fries/potato chips* and the remaining goods/services in classes 29 and 43 under consideration, I find that there is no likelihood of confusion amongst the public. Average consumers are unlikely to believe that the marks are used by related

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<sup>19</sup> *Waterford Wedgwood plc v OHIM* – Case C-398/07 P (CJEU)

undertakings. Rather, in the circumstances described above, it is more likely that the use of similar marks for rather different foodstuffs will be regarded as mere coincidence.

69. For the avoidance of doubt, I would have reached the same conclusion even if I had found that the marks were, as a matter of law, identical for the purposes of s.5(2)(a).

#### The applicant's fall-back specification

70. Shortly before the hearing, the applicant proposed a non-binding restriction of the goods in classes 29 and 30. In other words the applicant submitted a fall-back specification for consideration in case I was against the applicant on the basis of the existing specification of goods in these classes. The fall-back specification contained the same words as the existing specification, but with the additional words "*none of the aforesaid containing total potato by weight in the product exceeding 50%, with no individual components of the product exceeding 50% potato by weight*".

71. The amendment to the specification makes no difference to my findings in the opposition based on s.3(1)(c).

72. The amended specification is sufficient to defeat the opposition based on s.5(1). This is because, with the restriction, the applicant's goods could not be *French fries/potato chips*.

73. However, the exclusion does not prevent the application covering goods which are made from 50% potato and 50% other products. I cannot therefore be sure that the revised specification does not cover similar goods to *French fries or potato chips*. For example, the restriction does not exclude sweet potato products. Therefore, although the restriction would be enough to avoid identical goods, it would not be enough to avoid goods with a high level of similarity to *French fries or potato chips*. Consequently, the goods caught by the s.5(1) ground would simply be caught by the s.5(2) ground instead.

74. The applicant chose to describe its goods in general terms and to qualify those general terms with qualifications which are also very wide. In the face of this opposition, the applicant (very) belatedly opted to apply a restriction expressed in negative terms, rather than to set out the specific goods of interest in positive terms. In taking this approach the applicant accepted the inevitable risk that it would not succeed in adequately distancing the goods of interest to it from the opponent's goods. I conclude that the fall-back specification is not sufficient to defeat the opposition under s.5(1) or s.5(2) from succeeding in class 29 to the extent indicated above. The opposition under s.5(2) fails in any event in class 43.

### **The s.5(4)(a) ground of opposition – passing off right**

75. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) 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, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

76. Given that the opposition based on under s.3(1)(c), s.5(1) (or s.5(2)) has succeeded against some of the goods covered by class 29 of the application, and some of the services covered by class 43, I will only consider this ground in relation to the remaining goods/services covered by classes 29 and 43, and the goods covered by class 30. This means:

Class 29

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 29; foodstuffs in Class 29; prepared meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 29; preparations in Class 29 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following; meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats.

#### Class 30

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 30; foodstuffs in Class 30; prepared meals, foods, side dishes, component parts at meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen, meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 30; preparations in Class 30 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following: coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible oils, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, pizzas, pies and pasta dishes, meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats; food mixes for making batter, cakes, pastry and for making puddings, preparations for making sauces and gravies; flavourings and seasonings; curry mixes, dried culinary herbs, gravies, preparations consisting principally of cereals for use



as stuffings for foodstuffs, salt (for food), vinegar, pepper, mustard and breadcrumbs for cooking.

#### Class 43

Bar, hotel, restaurant, cafeteria services; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

77. The necessary requirements to establish a passing off right are well established and are, essentially, (1) goodwill in a business identified by a sign, (2) a misrepresentation by the defendant through the use of a sign similar enough to the claimant's sign to deceive (intentionally or otherwise) a substantial number of the claimant's customers or potential customers, and (3) damage to the claimant's goodwill caused by the defendant's misrepresentation.

#### Goodwill and distinctiveness

78. There is no doubt that the opponent has a business in the UK selling substantial amounts of frozen French fries/potato chips. There was plainly goodwill in that business at the relevant date.

79. There is more room for argument as to whether HOME FRIES was distinctive of that goodwill. This is because, on the evidence, the opponent does not appear to have used HOMEFRIES since 2011, which is over three years prior to the relevant date. However, the opponent appears to have used HOMEFRIES as a trade mark on a significant scale for a number of years prior to 2011. It is well established that a mark can remain distinctive of a business for some time after use ceases<sup>20</sup>. Further, in this case the continuing use since 2011 of HOME CHIPS, again on a significant scale, is likely to have helped to sustain the distinctiveness of HOMEFRIES as a mark of the opponent's business. I therefore find that HOMEFRIES was distinctive of the opponent's business at the relevant date.

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<sup>20</sup> See, for example, *Jules Rimet Cup Limited v The Football Association Limited* [2007] EWHC 2376 (Ch)

## Misrepresentation

80. Halsbury's Laws of England (4th Edition) Vol. 48 provides guidance about the assessment of misrepresentation. This is derived from the case law and sets out the most relevant factors to consider. These are:

### The nature and extent of the reputation relied upon

81. The nature of the reputation of HOMEFRIES is as a product mark for frozen French fries/potato chips. The extent of the reputation under the mark is likely to have been still relatively significant at the relevant date, despite the opponent's apparent switch to HOME CHIPS at the end of 2011. However, the reputation was narrow: HOMEFRIES was a mark for single specific product. And for the reasons given earlier, HOMEFRIES was not a highly distinctive trade mark even for that product.

### The closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business

82. As with the specification in class 29, the descriptions used by the applicant in class 30 are very general and, on the face of things, cover a vast range of foodstuffs. However, as with class 29, the general descriptions used are qualified by the words *included in this class*. In order to understand the significance of this point it is necessary to have in mind the goods that are (and are not) included in class 30.

83. The 'heading' for class 30 is<sup>21</sup>:

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

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<sup>21</sup> From the 10<sup>th</sup> Ed. of the Nice Classification

The accompanying 'Explanatory Note' states that *"Class 30 includes mainly foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavour of food."*

84. By contrast, the 'heading' for class 29 is:

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

The accompanying 'Explanatory Note' states that *"Class 29 includes mainly foodstuffs of animal origin as well as vegetables and other horticultural comestible products which are prepared for consumption or conservation"*.

85. Thus the scope of class 30 does not sit easily with the part of the specification in class 30 which says that the goods are *"made from or consisting of one or more of the following:..... meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats"*. This is because goods of these kinds are proper to class 29 and therefore excluded from the specification in class 30 by the preceding qualifications that the goods are *included in this class*. Consequently, I will treat the underlined words shown above as redundant for present purposes. This means that the applicant's class 30 goods are actually:

#### Class 30

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 30; foodstuffs in Class 30; prepared meals, foods, side dishes, component parts at meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen, meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 30; preparations in Class 30 for

making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following: coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible oils, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, pizzas, pies and pasta dishes, food mixes for making batter, cakes, pastry and for making puddings, preparations for making sauces and gravies; flavourings and seasonings; curry mixes, dried culinary herbs, gravies, preparations consisting principally of cereals for use as stuffings for foodstuffs, salt (for food), vinegar, pepper, mustard and breadcrumbs for cooking.

86. The scope of class 30 is such that the applicant's specification cannot cover vegetable products and therefore any potato products, including potato chips. This means that the applicant's proposed limitation of its specification in class 30 to exclude goods made from more than 50% potato by weight is also redundant.

87. The applicant's case under s.5(4)(a) must be based on the mark it has actually used and on the actual goods sold under it (unlike the position under s.5(1) and s.5(2) where all normal and fair uses of the opponent's registered mark in relation to *French fries and potato chips* had to be considered). Therefore the correct comparison is between frozen French fries/potato chips and normal and fair use of the applicant's mark in relation to any of the goods/services listed above.

88. At the hearing, Mr Armitage identified 'pizza' and 'savory pancakes' as products of particular concern to the opponent because these are often served with chips. I accept that traders in pizzas are in the same broad field of activity as traders in frozen *French fries/potato chips*. Further, all frozen foods are likely to be stocked in the same area of the supermarket or retail store. Having said that, there is no evidence that pizzas are commonly marketed by the same undertakings that market frozen *French fries/potato chips* or under the same trade mark. Further, although frozen foods are stocked in the same area of retail stores, the products are usually separated so that potato chips appear alongside other frozen vegetables rather than with pizzas. It is no doubt true that pizza is commonly eaten with chips, but it is

equally true that chips can be served with most main dishes. One therefore has to be careful about using this to justify the conclusion that undertakings responsible for frozen chips are in the same field of activity as those responsible for products that can be served with chips. For example, steak is often served with chips, but in my experience producers of meat are not really in the same field of activity as producers of frozen chips, except when considered at the highest level of generality, i.e. food producers or frozen food producers. Overall, I find that there is a certain connection between traders in pizzas and savoury pancakes and traders in frozen chips, but not a particularly close connection. This also applies to all the other goods in classes 29 and 30 under consideration.

89. The position is even clearer in class 43: *traders in bar, hotel, restaurant, cafeteria services; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class* are plainly not in the same field of economic activity as traders in frozen chips.

The similarity of the mark, name etc. used by the defendant to that of the plaintiff

90. The mark HOME is plainly very similar to HOMEFRIES, particularly when the latter is used in relation to frozen *French fries/potato chips*.

The manner in which the defendant makes use of the name, mark etc. complained of and collateral factors

91. There is no evidence that the applicant has used the contested mark.

The manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances

92. Frozen chips are usually sold in supermarkets and convenience stores where the trade mark is visible. The goods are sold to the general public.

## Finding

93. Taking all of this into account, I find that the use of HOME in relation to the goods under consideration in classes 29, 30 and 43 will not amount to a misrepresentation to the public. Therefore, there would be no damage to the opponent's goodwill under HOMEFRIES.

## **Overall outcome**

94. The mark should not be registered for goods listed as being in class 30, but which are not proper to that class. Subject to appeal, the contested mark may therefore proceed to registration for:

### Class 29

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 29; foodstuffs in Class 29; prepared meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen meals, foods, side dishes, component parts of meals, and snacks/snack foods for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 29; preparations in Class 29 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following; meat, fish, poultry, game, meat extracts, preserved, frozen, dried and cooked fruits, jellies, jams, compotes, eggs, milk, milk products, edible oils and fats.

### Class 30

Foods and food products, ambient foods and food products, chilled foods and food products, frozen foods and food products, hot foods and food products, all included in Class 30; foodstuffs in Class 30; prepared meals, foods, side dishes, component parts at meals, and snacks/snack foods for human consumption, included in this Class; prepared chilled, hot, ambient or frozen, meals, foods, side dishes, component parts of meals, and snacks/snack foods

for human consumption, included in this Class; preparations for making foods, food products and/or foodstuffs in Class 30; preparations in Class 30 for making foods, food products and/or foodstuffs; all of the aforesaid made from or consisting of one or more of the following: coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, pastry and confectionery, edible oils, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, pies and pasta dishes, food mixes for making batter, cakes, pastry and for making puddings, preparations for making sauces and gravies; flavourings and seasonings; curry mixes, dried culinary herbs, gravies, preparations consisting principally of cereals for use as stuffings for foodstuffs, salt (for food), vinegar, pepper, mustard and breadcrumbs for cooking.

#### Class 43

Bar, hotel, restaurant, cafeteria services; provision of food and drink in restaurants; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this Class.

95. Again subject to appeal, the application will be refused for the remaining goods/services.

## **Costs**

96. Both sides have achieved a measure of success. The applicant has been more successful than the opponent in terms of the goods/services retained as opposed to refused. However, it seems to me that this is partly the result of the applicant choosing such general terms to describe its goods in classes 29 and 30 that the true scope of the application was difficult to discern without a good deal of analysis. It is possible that if the specifications had been clearer the opposition would have been better targeted. In the circumstances, I direct that each side should bear its own costs.

**Dated this 30th day of August 2016**

**Allan James  
For the Registrar**