

O-155-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 033 203 FOR THE



TRADE MARK **ZAHRA**
CAKES IN THE NAME OF MOHAMMED SHAFIQ NORIN
SHAFIQ IN CLASSES 30 AND 43

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 402 281 BY
FFAUF S.A.

Background and pleadings

1. Mohammed Shafiq Norin Shafiq (the applicant) applied to register the trade



mark **ZAHRA
CAKES** under number 3 033 203 in the UK on 3rd December 2013. It was accepted and published in the Trade Marks Journal on 7th March 2014 in respect of the following goods:

Class 30:

Cakes; Fresh Cream Cakes; Fondant Cakes; Gluten Free Cakes; Chocolate Cakes; Eggless Cakes; Party Cakes; Special Occasion Cakes; Wedding Cakes; Cheesecakes; Pastries; Cold Drinks; Desserts; Sweets; Arabic Sweets; Cake Slices; Almond cake; Almond pastries; Aromatic preparations for pastries; Bakery desserts; Bakery goods; Caffeine-free coffee; Cake decorations made of candy; Cake doughs; Cake flour; Cake frosting; Cake icing; Cake mixes; Cake mixtures; Cake paste; Cake powder; Cake preparations; Cakes; Cakes (flavorings [flavourings], other than essential oils, for-); Cakes (Flavorings [flavourings], other than essential oils, for -); Cakes of sugar-bounded millet or popped rice (okoshi); Cakes (Rice -); Candy; Candy; Candy bars; Candy cake; Candy cake decorations; Candy coated confections; Candy coated popcorn; Candy decorations for cakes; Candy mints; Candy, other than for medical purposes; Candy [sugar]; Candy with caramel; Candy with cocoa; Chai (tea); Chai tea; Cheese puffs; Cheesecake; Cheesecakes; Chilled desserts; Chocolate; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate based beverages; Chocolate beverages; Chocolate beverages containing milk; Chocolate beverages with milk; Chocolate biscuits; Chocolate cake; Chocolate cakes; Chocolate candies; Chocolate candy with fillings; Chocolate pastries; Coffee; Coffee based beverages; Coffee based drinks; Coffee

based fillings;Coffee [roasted, powdered, granulated, or in drinks];Confectionery for decorating Christmas trees;Confectionery ices;Confectionery in frozen form;Confectionery in liquid form;Dairy chocolate;Dairy confectionery;Danish bread;Danish bread rolls;Danish butter cookies;Danish pastries;Dessert puddings;Dessert souffles;Dessert toppings;Desserts;Ice creams;Ice desserts;Ice for refreshment;Ice-cream;Ice-cream cakes;Ice-cream confections;Iced cakes;Iced fruit cakes;Iced sponge cakes;Milk chocolate teacakes;Milk chocolates;Pancakes;Pasties;Pastries;Pastries consisting of vegetables and fish;Pastries consisting of vegetables and meat;Pastries consisting of vegetables and poultry;Pastries containing creams;Pastries containing creams and fruit;Pastries containing fruit;Pastries filled with fruit;Pastries with fruit;Pastry;Pastry cases;Pastry confectionery;Pies;Pies containing fish;Pies containing game;Pies containing meat;Pies containing poultry;Pies containing vegetables;Pies (meat-);Pies (Meat -);Pies [sweet or savoury];Quiche;Quiche [tart];Quiches;Quiches [tarts];Rice;Rice based dishes;Rolls (bread-);Rolls (Bread -);Savory pastries;Savoury biscuits;Scones;Tarts;Tarts [sweet or savoury];Tea;Tea cakes;Tea (iced-);Tea (Iced -);Vanilla;Vanilla [flavoring] [flavouring];Vanilla flavorings;Viennese pastries;Wafers;Waffles.

Class 43:

Arranging of wedding receptions [food and drink];Arranging of wedding receptions [venues];Banqueting services;Bistro services;Brasserie services;Cafe services;Cafés;Cafeteria services;Cafeterias;Canteen services;Canteens;Carvery restaurant services;Catering (Food and drink -);Catering for the provision of food and beverages;Catering of food and drinks;Catering services;Catering services for the provision of food;Catering services for the provision of food and drink;Cocktail lounge services;Coffee shop services;Coffee shops;Consultancy services relating to baking techniques;Consultancy services relating to food;Consultancy services relating to food preparation;Consulting

services in the field of culinary arts;Cookery advice;Cooking apparatus (Rental of -);Corporate hospitality (provision of food and drink);Fast-food restaurants;Food cooking services;Food preparation;Food preparation services;Food service apparatus (rental of -);food takeaway service;Hospitality services [food and drink];Ice cream parlour services;Mobile catering services;Personal chef services;Provision of food and drink;Provision of food and drink in restaurants;Rental of cooking apparatus;Rental of cooking equipment for industrial purposes;Rental of cooking utensils;Rental of crockery;Rental of cutlery;Rental of food service equipment;Restaurant services;Restaurants;Restaurants (self-service-);Restaurants (Self-service -);Self-service cafeteria services;Self-service restaurants;Services for providing food and drink;Snack bar services;Snackbars;Snack-bars;Tea room services;Tea rooms.

2. Ffauf S.A. (the opponent) opposes the trade mark on the basis of Section 5(2)(b) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of the following earlier trade marks:

a) UK Trade Mark Registration No 1 395 135:



In respect of:

Class 30:

Alimentary pasta; breadsticks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

b) UK Designation of International Trade Mark Registration No 834140:

LE DELIZIE ZARA

In respect of:

Class 29:

Olive oil.

Class 30:

Rice, breadsticks, balsamic vinegar, sauces for pasta.

c) European Union Trade Mark No 1 099 4151:



In respect of:

Class 30:

Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice; Vinegar; Beer vinegar; Sea water for cooking; Gluten additives for culinary purposes; Weeds [condiment]; Oat-based food; Farinaceous foods; Starch for food; Aniseed; Star aniseed; Seasonings; Coffee flavorings [flavourings]; Flavorings, other than essential oils; Flavorings, other than essential oils, for beverages; Flavorings, other than

essential oils, for cakes; Oats (Crushed -); Husked oats; High-protein cereal bars; Stick liquorice [confectionery]; Cocoa-based beverages; Coffee-based beverages; Chocolate-based beverages; Tea-based beverages; Baking soda [bicarbonate of soda for cooking purposes]; Cookies; Biscuits; Malt biscuits; Petit-beurre biscuits; Sweetmeats [candy]; Buns; Puddings; Cocoa; Cocoa beverages with milk; Coffee; Coffee beverages with milk; Coffee (Unroasted -); Cinnamon [spice]; Capers; Caramels [candy]; Peppermint sweets; Cheeseburgers [sandwiches]; Cloves [spice]; Chow-chow [condiment]; Chutneys [condiments]; Waffles; Chicory [coffee substitute]; Chocolate; Chocolate beverages with milk; Aromatic preparations for food; Condiments; Confectionery; Peanut confectionery; Almond confectionery; Pralines; Corn flakes; Coulis (Fruit -) [sauces]; Crackers; Cream of tartar for culinary purposes; Cream of tartar for cooking purposes; Custard; Pancakes; Macaroons [pastry]; Turmeric for food; Curry [spice]; Couscous [semolina]; Cakes; Sweeteners (Natural -); Confectionery for decorating Christmas trees; Garden herbs, preserved [seasonings]; Essences for foodstuffs, except etheric essences and essential oils; Malt extract for food; Bean meal; Wheat flour; Corn meal; Barley meal; Potato flour for food; Mustard meal; Soya flour; Tapioca flour for food; Gruel, with a milk base, for food; Hominy; Meal; Ferments for pastes; Oat flakes; Chips [cereal products]; Groats for human food; Pies; Fondants [confectionery]; Ices; Fruit jellies [confectionery]; Ham glaze; Wheat germ for human consumption; Edible ices; Ice, natural or artificial; Ice for refreshment; Frosting [icing] (Cake -); Glucose for culinary purposes; Gluten prepared as foodstuff; Chewing gum; Corn, milled; Corn, roasted; Popcorn; Halvah; Infusions, not medicinal; Spring rolls; Thickening agents for cooking foodstuffs; Ketchup [sauce]; Ice cream (Binding agents for -); Sausage binding materials; Yeast; Baking powder; Leaven; Liquorice [confectionery]; Macaroni; Mayonnaise; Malt for human consumption; Maltose; Marinades; Marzipan; Molasses for food; Mint for confectionery; Honey; Mousses (Chocolate -); Mousses (Dessert -) [confectionery]; Muesli; Allspice; Nutmegs; Barley (Crushed -); Husked barley; Gingerbread; Bread; Rusks; Unleavened bread; Breadcrumbs; Bread rolls; Royal jelly; Almond paste; Soya bean paste [condiment]; Pastry; Pasta; Pasties; Noodle-based prepared meals; Pastries; Lozenges [confectionery]; Petits fours [cakes]; Meat

pies; Pepper; Pesto [sauce]; Pizzas; Cake powder; Powders for ice cream; Cereal preparations; Vegetal preparations for use as coffee substitutes; Flour-milling products; Cocoa products; Meat tenderizers, for household purposes; Stiffening whipped cream (Preparations for -); Bee glue; Quiches; Relish [condiment]; Ravioli; Rice; Sago; Cooking salt; Celery salt; Salt for preserving foodstuffs; Tomato sauce; Soya sauce; Sauces [condiments]; Dressings for salad; Sandwiches; Peppers [seasonings]; Golden syrup; Linseed for human consumption; Oatmeal; Semolina; Hominy grits; Mustard; Cereal-based snack food; Rice-based snack food; Sorbets [ices]; Spaghetti; Spices; Artificial coffee; Meat gravies; Sushi; Tabbouleh; Tacos; Noodles; Tapioca; Tea; Iced tea; Tarts; Rice cakes; Tortillas; Vanilla [flavoring] flavouring; Vanillin [vanilla substitute]; Vermicelli [noodles]; Frozen yogurt [confectionery ices]; Saffron [seasoning]; Ginger [spice]; Sugar; Candy; Fresh, dried, preserved, frozen and ready-to-use pasta.

d) European Union Trade Mark No 9 496 373:

ZARA 

In respect of:

Class 29:

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.

Class 30:

Coffee, tea, rice, tapioca, sago, Flour and preparations made from cereals, bread; cakes and biscuits, both for the breakfast, not made of and not containing liquorice; treacle; Yeast, baking-powder; Salt,

mustard; Vinegar, sauces (condiments); Spices; Fresh, dried, preserved, frozen and ready-to-use pasta.

Class 31:

Agricultural, horticultural and forestry products and grains not included in other classes; Live animals; Fresh fruits and vegetables; Seeds, natural plants and flowers; Foodstuffs for animals, malt.

Class 32:

Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages.

Class 33:

Alcoholic beverages (except beers).

Class 35:

Advertising; Business management; Business administration; Office functions; Bringing together of various goods, namely foodstuffs and beverages (except the transport thereof) for others, enabling customers to conveniently view and purchase those goods.

Class 43:

Restaurant services (food); Temporary accommodation.

e) European Union Trade Mark Registration No 7 016 439:




In respect of:

Class 30:

Fresh, dried, frozen, deep-frozen and ready-to-use pasta.

3. The opponent argues, under Section 5(2)(b) that the respective goods are identical or similar and that the marks are visually, aurally and conceptually similar. Under Section 5(4)(a), the opponent argues that it has acquired a



goodwill in respect of the sign  which has been used in the UK since 1 August 1996 in respect of alimentary pasta; cereal and cereal preparations; prepared meals, snacks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta. Further that it has acquired

goodwill in respect of **LE DELIZIE ZARA** which has been used in the UK since 1 January 2007 in respect of the following: preserves, as tomato puree, tomato juice for cooking; pickles; preserved meat; preserved fish; edible oils; preserved, cooked, frozen vegetables; jellies, jams, marmalades, compotes; fresh, dried, frozen, deep frozen, ready to use (semi-cooked) pasta; cocoa, sugar, rice, tapioca, sago, flour and cereal preparations, bread; pastries and confectionery; salt, mustard, vinegar, sauces (condiments); spices; sauces for pasta; agricultural and horticultural products; fresh fruit and vegetables, malt.

4. The applicant filed a counterstatement denying the claims made. Notably, the applicant considers the respective trade marks to be sufficiently different to avoid confusion. Further, it challenges the opponent's claim to a protectable goodwill.
5. Both sides filed evidence. This will be summarised to the extent that it is considered appropriate.
6. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.


Evidence

Opponent's evidence

7. This is in the form of two witness statements, the latter of which exhibits a further four witness statements. Only the evidence considered to be directly relevant will be summarised.
8. The first witness statement is dated 21st March 2016, from Furio Bragagnolo who is the Chairman of the Board of Directors of the opponent. The following information is contained therein:
 - The opponent is the first Italian exporter of pasta worldwide, with a share of 10% of the total export market of Italy;
 - In respect of the earlier trade mark **LE DELIZIE ZARA**, that it has been used in the UK in respect of the goods claimed above since 2007.

- Use has been in respect of several locations across the UK, including London, Berkshire, Hertfordshire and Warwickshire;
- Total turnover between 2008-2014 is £5,918.52, the peak years being 2008, 2010 and 2012;
- Exhibit FB5 are details of orders placed and Exhibit FB6 are a selection of invoices and delivery notes for the period 2013-2014;
- Exhibit FB7 are examples of promotional activities, the majority being via the opponent's website: www.pastazara.com



- In respect of the earlier trade mark  there is numerous examples of use, including invoices, copies of orders placed, a copy of a purchase agreement with the Supermarket, Aldi's and copies of catalogues displaying numerous goods bearing the trade mark.
 - As regards turnover, it is noted that these are significantly higher totalling £577,698.21 between 2008-2014 ;
 - Details of promotional activities are also provided, including attendance at trade fairs and food exhibitions; sponsorship of sporting events and a social media presence.
9. The remaining witness statements are from Mr Peter McDermott, Director of Food Network Limited (dated 22nd April 2014); Mr Domenico Urso, Director of Il Piccolino's Ltd (dated 8th April 2014); Ms Samantha Mawer, Director of Moore Ingredients Ltd (dated 7th April 2014) and Mr Carlo Diforti of Taste of Sicily (dated 5th April 2014). All confirm that these companies are (or have been) customers of the opponent. There are invoices exhibited to each of these witness statements in support. There are different time periods involved in respect of these companies but all help build a picture in terms of the use of



the earlier trade marks. It is noted that the earlier mark is overwhelmingly displayed throughout the invoices in evidence. I will return to this point further below.

The applicant's evidence

10. This is a witness statement from Ms Amanda China-Rodriguez, a Trade Mark Attorney, representing the applicant in these proceedings. This witness statement contains submissions that shall not be summarised here, but have been taken into account in reaching this decision.

Section 5(2)(b)

11. Sections 5(2)(b) of the Act is as follows:

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

(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”.

Comparison of goods

12. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, 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”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. Following a careful perusal of the earlier trade marks, it is considered that, prima facie, the following earlier trade mark represents the opponent's best

case: **ZARA** 

15. The earlier goods and services are:

Class 29:

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.

Class 30:

Coffee, tea, rice, tapioca, sago, Flour and preparations made from cereals, bread; cakes and biscuits, both for the breakfast, not made of and not containing liquorice; treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Fresh, dried, preserved, frozen and ready-to-use pasta.

Class 31:

Agricultural, horticultural and forestry products and grains not included in other classes; Live animals; Fresh fruits and vegetables; Seeds, natural plants and flowers; Foodstuffs for animals, malt.

Class 32:

Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages.

Class 33:

Alcoholic beverages (except beers).

Class 35:

Advertising; Business management; Business administration; Office functions; Bringing together of various goods, namely foodstuffs and beverages (except the transport thereof) for others, enabling customers to conveniently view and purchase those goods.

Class 43:

Restaurant services (food); Temporary accommodation.

The later goods and services are:

Class 30:

Cakes; Fresh Cream Cakes; Fondant Cakes; Gluten Free Cakes; Chocolate Cakes; Eggless Cakes; Party Cakes; Special Occasion Cakes; Wedding Cakes; Cheesecakes; Pastries; Cold Drinks; Desserts; Sweets; Arabic Sweets; Cake Slices; Almond cake; Almond pastries; Aromatic preparations for pastries; Bakery desserts; Bakery goods; Caffeine-free coffee; Cake decorations made of candy; Cake doughs; Cake flour; Cake frosting; Cake icing; Cake mixes; Cake mixtures; Cake paste; Cake powder; Cake preparations; Cakes; Cakes (flavorings [flavourings], other than essential oils, for-); Cakes (Flavorings [flavourings], other than essential oils, for -); Cakes of sugar-bounded millet or popped rice (okoshi); Cakes (Rice -); Candy; Candy; Candy bars; Candy cake; Candy cake decorations; Candy coated confections; Candy coated popcorn; Candy decorations for cakes; Candy mints; Candy, other than for medical purposes; Candy [sugar]; Candy with caramel; Candy with cocoa; Chai (tea); Chai tea; Cheese puffs; Cheesecake; Cheesecakes; Chilled desserts; Chocolate; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate based beverages; Chocolate beverages; Chocolate beverages containing milk; Chocolate beverages

with milk;Chocolate biscuits;Chocolate cake;Chocolate cakes;Chocolate candies;Chocolate candy with fillings;Chocolate pastries;Coffee;Coffee based beverages;Coffee based drinks;Coffee based fillings;Coffee [roasted, powdered, granulated, or in drinks];Confectionery for decorating Christmas trees;Confectionery ices;Confectionery in frozen form;Confectionery in liquid form;Dairy chocolate;Dairy confectionery;Danish bread;Danish bread rolls;Danish butter cookies;Danish pastries;Dessert puddings;Dessert souffles;Dessert toppings;Desserts;Ice creams;Ice desserts;Ice for refreshment;Ice-cream;Ice-cream cakes;Ice-cream confections;Iced cakes;Iced fruit cakes;Iced sponge cakes;Milk chocolate teacakes;Milk chocolates;Pancakes;Pasties;Pastries;Pastries consisting of vegetables and fish;Pastries consisting of vegetables and meat;Pastries consisting of vegetables and poultry;Pastries containing creams;Pastries containing creams and fruit;Pastries containing fruit;Pastries filled with fruit;Pastries with fruit;Pastry;Pastry cases;Pastry confectionery;Pies;Pies containing fish;Pies containing game;Pies containing meat;Pies containing poultry;Pies containing vegetables;Pies (meat-);Pies (Meat -);Pies [sweet or savoury];Quiche;Quiche [tart];Quiches;Quiches [tarts];Rice;Rice based dishes;Rolls (bread-);Rolls (Bread -);Savory pastries;Savoury biscuits;Scones;Tarts;Tarts [sweet or savoury];Tea;Tea cakes;Tea (iced-);Tea (Iced -);Vanilla;Vanilla [flavoring] [flavouring];Vanilla flavorings;Viennese pastries;Wafers;Waffles.

Class 43:

Arranging of wedding receptions [food and drink];Arranging of wedding receptions [venues];Banqueting services;Bistro services;Brasserie services;Cafe services;Cafés;Cafeteria services;Cafeterias;Canteen services;Canteens;Carvery restaurant services;Catering (Food and drink -);Catering for the provision of food and beverages;Catering of food and drinks;Catering services;Catering services for the provision of food;Catering services for the provision of food and drink; Cocktail

lounge services;Coffee shop services;Coffee shops;Consultancy services relating to baking techniques;Consultancy services relating to food;Consultancy services relating to food preparation;Consulting services in the field of culinary arts;Cookery advice;Cooking apparatus (Rental of -);Corporate hospitality (provision of food and drink);Fast-food restaurants;Food cooking services;Food preparation;Food preparation services;Food service apparatus (rental of -);food takeaway service;Hospitality services [food and drink];Ice cream parlour services;Mobile catering services;Personal chef services;Provision of food and drink;Provision of food and drink in restaurants;Rental of cooking apparatus;Rental of cooking equipment for industrial purposes;Rental of cooking utensils;Rental of crockery;Rental of cutlery;Rental of food service equipment;Restaurant services;Restaurants;Restaurants (self-service-);Restaurants (Self-service -);Self-service cafeteria services;Self-service restaurants;Services for providing food and drink;Snack bar services;Snackbars;Snack-bars;Tea room services;Tea rooms.

Comparison of goods in Class 30

16. It should be noted that the applied for trade mark includes a number of different foodstuffs and beverages. The earlier trade mark includes, in class 35, the following term: *bringing together of various goods, namely foodstuffs and beverages (except the transport thereof) for others, enabling customers to conveniently view and purchase those goods.*

17. This is clearly a retail service which is limited to foodstuffs and beverages.¹ In assessing the similarity of the earlier service to the later goods, I bear in mind the following guidance:

¹ In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison

18. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

19. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

20. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*², and *Assembled Investments (Proprietary) Ltd v. OHIM*³, upheld on

to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁴, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

21. Bearing in mind the guidance outlined above, it is noted that when envisaging the kind of retail service associated with the applied for goods, these could include a bakery or other similar environment, but will also as a matter of course, include a supermarket environment. It is normal for a supermarket to sell own brand foodstuffs and beverages including all those covered by the applicant's trade mark. Indeed such own brand products will only be sold by the particular supermarket. The result being that they are entirely complementary as a consumer would be left in no doubt that they are offered

⁴ Case C-398/07P

by one and the same undertaking. The applied for goods are therefore similar due to their complementary relationship with the earlier services.

22. There is an exception to this finding: in respect of wedding cakes which are more specialist in nature and have a specific purpose: to be served at a wedding. One would not normally expect a bakery in a supermarket retailer to offer for sale such specialist cakes, though it is noted that this it is the norm for such a bakery in respect of other types of occasion cakes (birthdays, anniversaries etc). In any case, it is noted that the earlier trade marks includes cakes (for breakfast). Though the purpose is different, their nature is not; they are all cakes. They also coincide in respect of method of use. They are considered to be similar, to a low to medium degree.

Comparison of services in Class 43:

23. In *Separode Trade Mark* BL O-399-10, the Appointed Person held:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

24. It is noted that the earlier trade mark is registered in respect of restaurant services. This term also appears in the later trade mark and is self evidently identical. Such services can be described as the provision of food and drink items to an end consumer. There are a number of services in the applied for trade mark which in effect perform a similar service namely: ;Bistro services;Brasserie services;Cafe services;Cafés;Cafeteria

⁵ Also: see *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38] (CJEU).

services; Cafeterias; Canteen services; Canteens; Carvery restaurant services;; Coffee shop services; Coffee shops; Fast-food restaurants; food takeaway service; Ice cream parlour services Ice cream parlour services Restaurant services; Restaurants (self-service-); Restaurants (Self-service -); Self-service cafeteria services; Self-service restaurants; Services for providing food and drink; Snack bar services; Snackbars; Snack-bars; Tea room services; Tea rooms. These are all considered to be similar. The degree of similarity will range from low (in respect of, for example, ice cream parlours), to high (in respect of, for example, brasserie services).

25. Of particular note is the contested *cocktail lounge services*. It is considered that there is some coincidence here in that restaurants often offer cocktails to customers as part of its drinks repertoire. The contested services are therefore similar to a low degree.

26. There are services in respect of catering: Arranging of wedding receptions [food and drink]; Arranging of wedding receptions [venues]; Banqueting services; Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Corporate hospitality (provision of food and drink); Hospitality services [food and drink]; Mobile catering services; Personal chef services; Food cooking services; Food preparation; Food preparation services;. These services provide food and/or drink at a business and or social events such as a party or a wedding. There is therefore similarity as to nature and intended purpose (the provision of food). Though they are not usually provided by restaurateurs', there is some similarity, albeit a low degree.

27. There are also a number of consultancy related services in the contested trade mark: Consultancy services relating to baking techniques; Consultancy services relating to food; Consultancy services relating to food preparation;

Consulting services in the field of culinary arts; Cookery advice. One can imagine a restaurant availing itself of such services during its set up stage, when looking to change a menu or to maintain success. They do not provide food and drink per se. These services are therefore different in nature and purpose to the earlier restaurant services. The end user does not coincide, nor do the respective trade channels. They are not similar.

28. There are contested services in respect of the rental of equipment such as: Cooking apparatus (Rental of -); Food service apparatus (rental of -); Rental of cooking apparatus; Rental of cooking equipment for industrial purposes; Rental of cooking utensils; Rental of crockery; Rental of cutlery; Rental of food service equipment. These services seek to make available items used in establishments which provide food and drink. They are different in nature, purpose and method of use. They do not coincide in trade channels of in respect of end user. There is no evidence to suggest they are provided by the same undertakings. They are considered to be not similar.

Comparison of marks


29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

30. 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.

31. The respective trade marks are shown below:



	
Earlier trade marks	Contested trade mark

32. It is noted that each of the trade marks are composite marks combining both graphical and verbal elements. The earlier trade mark is dominated by the distinctive element ZARA, though the pictorial female character carrying ears of corn is also clearly visible. The later trade mark includes a prominent creative circular device encased within which are the interlinked letters “ZC”. This element is also central to the mark and is visually dominant and also distinctive. Underneath, albeit in smaller print, is the distinctive element ZAHRA, which is clearly not negligible and underneath, in even smaller font, is the word CAKES.

33. Visually, the coincidental elements of each of the marks is the letters ZARA, which in the later mark are separated by the letter H. These elements are considered to be highly similar visually. The marks differ in all other respects and so the overall degree of visual similarity is low.

34. Aurally, the matter is somewhat different. It is considered that the additional letter H in the later sign will have a minimal aural impact (if indeed it has any impact at all). It is considered most likely that the later mark will be articulated as ZA RA Cakes rather than ZC or any other combination. In such a scenario, the marks are aurally highly similar, if not identical.

35. Conceptually, it is noted that the earlier trade mark is a female name and it is considered that it is likely to be understood as such, at least by a notable proportion of the population. It is also noted that ZAHRA appears to be a

female name. Indeed the applicant indicates that it is the name of his daughter. It is considered possible that the average consumer would perceive both as being the female name. To that extent, they are conceptually similar, if not identical.

Average consumer and the purchasing act

36. 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, Case C-342/97*.

37. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

38. The goods found to be similar are, generally, consumable products, purchased frequently and are inexpensive. They are usually self selected from a shop shelf or an internet equivalent website, though it can also be requested orally from, for example, a deli or other similar establishment. The degree of attention expected to be displayed will be at the lower end of the spectrum. There are clearly exceptions to this, most notably wedding cakes and the like. For such items (and those that are comparable, such as occasion cakes), it is

considered that a higher degree of attention will be displayed, relying on recommendations, reviews and a more thorough period of research prior to purchase.

39. In respect of the identical and similar services, namely restaurants and the like, such services are normally selected via category of food, word of mouth or following research and reading reviews. As such, it is likely to be, overall, a more considered purchase, though passing trade (and thus a more spontaneous decision making process) is also taken into account.

Distinctive character of the earlier trade mark

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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

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

41. The opponent claims that it has acquired a higher degree of distinctiveness in respect of all of its earlier trade marks relied upon. However, the evidence provided focusses only upon the following: **LE DELIZIE ZARA** and



. In respect of these marks, it is noted that there is no context provided, most notably market share, though it is self evident that the size of the UK market is enormous and in this context, the sales are modest. As such, I am unable to assess the impact of these marks and the perception of them by the relevant public. As such, it is considered that they are not able to benefit from a greater degree of protection as a result of being more distinctive through use. However, in any case it is noted that the marks are comprised of a number of components, which include the female name Zara. This is meaningless in respect of the goods in question and in respect of one of the marks is accompanied by Italian words and in the other is accompanied by a pictorial element. The marks are therefore considered to be distinctive to a medium degree. In respect of the earlier **ZARA**  trade mark (which is the primary focus of this decision), there is no evidence to suggest a higher degree of distinctiveness than that which would be accorded prima facie. This is also the female name, together with a picture of a woman carrying wheat. It is also distinctive to a medium degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

42. 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.

Likelihood of Confusion

43. The marks in question are aurally highly similar. It is accepted that there is a low degree of visual similarity overall and that the purchase at least in respect of the goods, will primarily be visual as a result of the nature of the purchasing act, which will invariably take the form of self-selection. Having said that, the aural point in common, ZARA and ZAHRA is also visually highly similar. Further, these elements are distinctive. It is also taken into account that the marks can be imperfectly recalled. I bear in mind the following guidance from

Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

44. It is noted that the above categories are not exhaustive⁶. However, here there is an earlier trade mark which is of medium distinctiveness, the dominant element of which is visually highly similar in how it appears in the later trade mark. Further, the same element is aurally identical. Though the additional visual differences are not ignored in this assessment, it is considered to be likely that bearing in mind the aural identity, that the misspelling of ZARA/ZAHRA will go unnoticed when taking into account imperfect recollection. This is considered likely to lead to the conclusion that the later trade mark will be viewed as a brand variation of the earlier trade mark.

45. As such, in respect of the goods and services found to be identical or similar, the opposition under Section 5(2)(b) succeeds.

Final Remarks: Section 5(2)(b)

46. The opposition under Section 5(2) is also based on other earlier trade marks. The strength of the opposition in so far as it is based on the other marks is considered to not improve the opponent’s case. The remaining earlier trade marks all contain additional visual and/or verbal elements which have the effect of creating additional differences between them and the later trade mark in dispute. These include additional aural differences. These earlier trade marks do not improve the opponent’s position under Section 5(2)(b).

Section 5(4)(a) – Passing Off

⁶ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at [29]

47. The Opposition in this respect will consider the services found to be not similar under Section 5(2)(b), namely:

Class 43:

Consultancy services relating to baking techniques; Consultancy services relating to food; Consultancy services relating to food preparation; Consulting services in the field of culinary arts; Cookery advice; Cooking apparatus (Rental of -); Food service apparatus (rental of -); Rental of cooking apparatus; Rental of cooking equipment for industrial purposes; Rental of cooking utensils; Rental of crockery; Rental of cutlery; Rental of food service equipment.

Legislation

48. 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.”

49. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt &*

Colman Products Ltd v. Borden Inc. [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

50. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) 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."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have

acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

51. The opponent’s claim under Section 5(4)(a) is advanced on the basis of the



following earlier signs: **LE DELIZIE ZARA** and . The former in respect of preserves, as tomato puree, tomato juice for cooking; pickles; preserved meat; preserved fish; edible oils; preserved, cooked, frozen vegetables; jellies, jams, marmalades, compotes; fresh, dried, frozen, deep frozen, ready to use (semi-cooked) pasta; cocoa, sugar, rice, tapioca, sago, flour and cereal preparations, bread; pastries and confectionery; salt, mustard, vinegar, sauces (condiments); spices; sauces for pasta; agricultural and horticultural products; fresh fruit and vegetables, malt. The latter in respect of alimentary pasta; cereal and cereal preparations; prepared meals, snacks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta.

Goodwill

52. Goodwill has been defined in the following decision: *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

53. It is accepted that the evidence demonstrates that the pleaded signs have been in use for around 5 years prior to the relevant date (the filing date of the application, namely 3rd December 2013) in the United Kingdom. The sales are modest in the context of the industry as a whole and is limited to particular goods, namely, different varieties of pasta and, to a far lesser extent, pasta sauces. Though a protectable goodwill is demonstrated, it is limited to such goods.

54. In respect of a common field of activity, the following is borne in mind: In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

55. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of misrepresentation, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’⁷:

56. In the *Lego* decision *Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

57. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

58. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving misrepresentation and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of

⁷ (*Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J).

resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

59. In the proceedings in question here, it is considered that there is a noticeable gap between, on the one hand, pasta and pasta sauces and the surviving services of the applicant. Though the marks are similar, such a gap, considered together with the modest strength of the goodwill leads to the conclusion that there will not be a misrepresentation. The ground of opposition based upon Section 5(4)(a) therefore fails in its entirety.

60. In summary, the opposition under Section 5(2)(b) therefore succeeds in respect of the following goods and services:

Class 30:

Cakes; Fresh Cream Cakes; Fondant Cakes; Gluten Free Cakes; Chocolate Cakes; Eggless Cakes; Party Cakes; Special Occasion Cakes; Wedding Cakes; Cheesecakes; Pastries; Cold Drinks; Desserts; Sweets; Arabic Sweets; Cake Slices; Almond cake; Almond pastries; Aromatic preparations for pastries; Bakery desserts; Bakery goods; Caffeine-free coffee; Cake decorations made of candy; Cake doughs; Cake flour; Cake frosting; Cake icing; Cake mixes; Cake mixtures; Cake paste; Cake powder; Cake preparations; Cakes; Cakes (flavorings [flavourings], other than essential oils, for-); Cakes (Flavorings [flavourings], other than essential oils, for -); Cakes of sugar-bounded millet or popped rice (okoshi); Cakes (Rice -); Candy; Candy; Candy bars; Candy cake; Candy cake decorations; Candy coated confections; Candy coated popcorn; Candy decorations for cakes; Candy mints; Candy, other than for medical purposes; Candy [sugar]; Candy with caramel; Candy with cocoa; Chai (tea); Chai tea; Cheese puffs; Cheesecake; Cheesecakes; Chilled desserts; Chocolate; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate based beverages; Chocolate beverages; Chocolate beverages containing milk; Chocolate beverages with milk; Chocolate biscuits; Chocolate cake; Chocolate cakes; Chocolate candies; Chocolate candy with fillings; Chocolate pastries; Coffee; Coffee based beverages; Coffee based drinks; Coffee based fillings; Coffee [roasted, powdered, granulated, or in drinks]; Confectionery for decorating Christmas trees; Confectionery ices; Confectionery in frozen form; Confectionery in liquid form; Dairy chocolate; Dairy confectionery; Danish bread; Danish bread rolls; Danish butter cookies; Danish pastries; Dessert puddings; Dessert souffles; Dessert toppings; Desserts; Ice creams; Ice desserts; Ice for refreshment; Ice-cream; Ice-cream cakes; Ice-cream confections; Iced cakes; Iced fruit cakes; Iced sponge cakes; Milk chocolate teacakes; Milk chocolates; Pancakes; Pasties; Pastries; Pastries consisting of vegetables and fish; Pastries consisting of vegetables and meat; Pastries consisting of vegetables and poultry; Pastries containing creams; Pastries containing creams and fruit; Pastries containing

fruit;Pastries filled with fruit;Pastries with fruit;Pastry;Pastry cases;Pastry confectionery;Pies;Pies containing fish;Pies containing game;Pies containing meat;Pies containing poultry;Pies containing vegetables;Pies (meat-);Pies (Meat -);Pies [sweet or savoury];Quiche;Quiche [tart];Quiches;Quiches [tarts];Rice;Rice based dishes;Rolls (bread-);Rolls (Bread -);Savory pastries;Savoury biscuits;Scones;Tarts;Tarts [sweet or savoury];Tea;Tea cakes;Tea (iced-);Tea (Iced -);Vanilla;Vanilla [flavoring] [flavouring];Vanilla flavorings;Viennese pastries;Wafers;Waffles.

Class 43:

Bistro services;Brasserie services;Cafe services;Cafés;Cafeteria services;Cafeterias;Canteen services;Canteens;Carvery restaurant services; Cocktail lounge services;Coffee shop services;Coffee shops; Fast-food restaurants; food takeaway service; Ice cream parlour services;;Provision of food and drink;Provision of food and drink in restaurants;;Restaurant services;Restaurants;Restaurants (self-service-);Restaurants (Self-service -);Self-service cafeteria services;Self-service restaurants;Services for providing food and drink;Snack bar services;Snackbars;Snack-bars;Tea room services;Tea rooms; Arranging of wedding receptions [food and drink];Arranging of wedding receptions [venues];Banqueting services;Catering (Food and drink -);Catering for the provision of food and beverages;Catering of food and drinks;Catering services;Catering services for the provision of food;Catering services for the provision of food and drink;Food cooking services;Food preparation;Food preparation services Hospitality services [food and drink];Mobile catering services;Personal chef services; Corporate hospitality (provision of food and drink).

61. It fails in respect of the following services, which can proceed to registration:

Class 43:

Consultancy services relating to baking techniques; Consultancy services relating to food; Consultancy services relating to food preparation; Consulting services in the field of culinary arts; Cookery advice; Cooking apparatus (Rental of -); Food service apparatus (rental of -); Rental of cooking apparatus; Rental of cooking equipment for industrial purposes; Rental of cooking utensils; Rental of crockery; Rental of cutlery; Rental of food service equipment.

COSTS

62. Both parties have achieved a measure of success, although it is clear that the opponent has been proportionally more successful. This is pitched as being around 85%. As such, it is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing Notice of Opposition and accompanying statement - £ 500

Considering statement of case in reply - £300

Considering evidence and preparing and filing evidence - £500

TOTAL - £1300

63. I therefore order Mohammad Shafiq Norin Shafiq. to pay Ffauf S.A the sum of £1300. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of March 2017

Louise White

For the Registrar,