

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2146338 BY  
THE LONDON TOWN CHOCOLATE COMPANY TO  
REGISTER THE MARK PRIX D'OR IN CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 48410 BY LOUIS MARIE STANISLAS LE DUFF**

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5 **IN THE MATTER OF Application No 2146338**  
**by The London Town Chocolate Company to**  
**register the mark PRIX D'OR in Class 30**

**and**

10 **IN THE MATTER OF Opposition thereto under**  
**No 48410 by Louis Marie Stanislas Le Duff**

15 **DECISION**

On 26 September 1997 The London Town Chocolate Company applied to register the mark  
20 PRIX D'OR in Class 30 for a specification of goods which reads "non-medicated  
confectionery; chocolate; chocolates". The application is numbered 2146338.

On 20 April 1998 Louis Marie Stanislas Le Duff of Rennes, France filed notice of opposition  
to this application on the following grounds:

25 "The Opponents are the registered proprietors of Trade Mark Registration  
No 1338939 ("the Trade Mark") advertised in the Trade Marks Journal No 5771 at  
Page 2221.

30 The Opponents have used the Trade Mark extensively in the United Kingdom in  
relation to the goods for which the mark is registered for many years.

Registration or use of the mark applied for would be contrary to the provision of  
Section 3(6) of the Act in that the application is made in bad faith in view of the  
Opponents use and reputation in the Trade Mark.

35 Registration of the mark applied for would be contrary to the provision of Section 5 of  
the Act in that it is similar to the Trade Mark and is proposed to be registered for  
goods identical and/or similar to the goods for which the Trade Mark is registered and  
has protection. Use of the mark applied for would lead to a likelihood of confusion on  
40 the part of the public including a likelihood of association with the Opponents.

Registration or use of the mark applied for would obstruct or prejudice the legitimate  
conduct of the Opponents business. Registration of the mark applied for should be  
refused as being contrary to the provision of the Act and in accordance with the  
45 exercise of the Registrar's discretion."

Registration No 1338939 referred to above is of the mark BRIDOR and for a specification of goods which reads "flour, preparations made from cereals; bread, pastry, confectionery; ices; yeast, baking powder; all included in Class 30".

5 The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

Both sides filed evidence. Neither party has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

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Opponent's evidence

The opponent filed an affidavit dated 25 August 1998. M. Le Duff says that the trade mark BRIDOR has been used in this country since 1990 in relation to bakery products. A list of products sold under the mark is exhibited (LD/1). Some of these products are said to contain chocolate. The goods are distributed by Speciality Food Services, Hunts Frozen Foods, Morris Keen, Brake Brothers, Henson Foods, NW Levers, Stevgro Inns, and King Brothers and such products are supplied either to bakeries or to hotels for subsequent baking. The baked product will then either be sold through retail bakery outlets or consumed by the residents at the hotels.

The bakery products have been exhibited at the Food and Drink Exhibition (IFEX) in London and at other exhibitions located in Scotland and Northern Ireland through the local distributors of such products. The amount spent annually in such promotions amounts to approximately £20,000.

Turnover is given as follows:

	<u>Year</u>	<u>Amount</u>
30		£
	1993	967,089
	1994	1,318,636
	1995	1,956,427
	1996	2,191,109
35	1997	1,482,907

A leaflet in English relating to products sold under the mark is exhibited at LD/2.

M. Le Duff concludes with some observations on the issue of comparison of the respective marks.

A Statutory Declaration has also been filed by Michael Edward Wade, the Managing Director of Speciality Food Services Ltd, one of the opponent's distributors. He exhibits a copy of his company's current price list (MEW/1) showing products offered under the mark BRIDOR. He says that "confectionery covers sweetmeats and pastries and therefore such term embraces the bakery products sold by my company by reference to the trade mark BRIDOR. To my knowledge the trade mark BRIDOR as applied to bakery products is recognised by my

customers as indicating an exclusive connection in the course of trade with those products distributed by my company for and on behalf of the opponent herein."

5 He concludes by commenting on what he considers to be the close similarity of the respective marks particularly when spoken and expresses the belief that a tangible number of his customers would be confused as to the origin of products marketed under the PRIX D'OR trade mark. I comment in passing that in the absence of direct evidence from these customers I regard this latter claim as being of little evidential value and accordingly give it no weight in reaching my own view of the matter.

10 Applicants' evidence

15 The applicants filed a Statutory Declaration dated 4 September 1998 by Charles Henry Edward Jennings, their professional representative in these proceedings. Briefly he rejects the view of the opponent's declarants in relation to the marks themselves and says that PRIX D'OR has a well known meaning and bears no similarity to the opponent's mark either from a visual or phonetic standpoint. He comments that the opponent gives no indication as to the meaning or origin of the mark BRIDOR.

20 That completes my review of the evidence.

Section 3(6) of the Act reads:

25 "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

30 No evidence has been filed bearing directly on this claim and I can see no obvious basis for such a claim. In the circumstances I do not propose to consider this ground further and the opposition fails in this regard.

35 The opponent refers in the statement of grounds to Section 5 of the Act but has made no further attempt to specify the sub-section relied upon. However, I take it from the wording used in the fourth of the paragraphs quoted above that the claim goes to Section 5(2)(b). This reads as follows:

"5. - (1).....

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

40 (a) .....

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

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

The term "earlier trade mark" is itself defined in Section 6 as follows:

"6- (1) In this Act an "earlier trade mark" means -

- 5 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- 10 (b) a community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) or
- 15 (c) a trade mark which, at the date of application for registration of the trade mark in question of (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

In considering the issue of confusion I also take account of the guidance given by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1998 RPC 199). The relevant sections of the ECJ's decision are set out below-

25 "..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

30 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - 'there exists a likelihood of confusion on the part of the public ....' - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

40 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public."

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As the opponents' registration (no.1338939) covers confectionery it is clear that identical goods are involved. The matter, therefore, turns on the comparison of the marks themselves, that is to say PRIX D'OR and BRIDOR.

5 The Sabel v Puma extract referred to above recognises that a number of factors need to be taken into account in determining the likelihood of confusion. Reference is made particularly to visual, aural and conceptual similarity. The opponents have not suggested that the marks at issue are at all similar visually. It seems to me that quite the opposite is the case. BRIDOR is a single word as opposed to the combination of words in the mark applied for and even the  
10 similarity of the endings is lost in the overall presentation of the marks. Conceptually too I can see no basis for confusion. BRIDOR is, so far as I am aware, an invented word or if it has any particular signification, as a place name say, it would not be obvious to the average member of the public in this country. PRIX D'OR on the other hand would, I think, be recognised as a combination of French words though whether, as the applicants suggest, it has  
15 a well known meaning is less clear. It is reasonable to assume that PRIX would be familiar to many people because of its use in the phrase Grand Prix but it seems to me to matter little whether any particular meaning is ascribed to the words PRIX D'OR. The fact of the matter is that there is no likelihood of association of ideas with BRIDOR.

20 There remains, however, the question of phonetic similarity which is the cornerstone of the opponent's case. I must also consider what part any similarity arising on this account plays in the global appreciation of the likelihood of confusion. Because I take the view that most people will be familiar with the word PRIX if only because of its various uses in sporting contexts it is also reasonable to assume that they will be familiar with the pronunciation of the  
25 word. Whilst the use of the apostrophised D makes some difference to the visual impact of the second element of the applicants' mark I do not think it is likely to have any significant or notable impact on the pronunciation. Because the opponent's mark is to the best of my knowledge an invented word it is more difficult to know how it will be pronounced. I consider that the first syllable could be pronounced either as a short <i>ɪ</i> sound, as in <i>grid</i>, or  
30 either of two different long vowel sounds that can be exemplified by the words <i>crime</i> or <i>fiancé</i>. No evidence has been filed to indicate how the mark is actually pronounced. I find this somewhat surprising in view of the fact that this is central to the opponent's claim. It might be thought that Mr Wade's comments as a UK distributor would have helped to clarify the matter but in my view his evidence falls short of doing so. Also whilst he refers to the possibility of similarity between the respective mark when spoken he does not say that he  
35 himself would be confused and, as indicated earlier, I give no weight to his unsubstantiated views as to what his customers would think. Making the best I can of it I consider that of the possible variant pronunciations referred to above only the third could conceivably result in the sort of phonetic confusion that appears to concern the opponents and even that requires a  
40 number of other assumptions to be made as to the articulation of the words. I have insufficient information before me to say whether this is anything other than a remote and hypothetical risk.

I do not forget that the opponent's mark has been in use for a number of years and that  
45 "recognition of the trade mark on the market" is an issue to be considered in the light of the Sabel v Puma guidance. In fact I note that the mark as shown in LD/2 also contains a device element. Exhibit MEW/1 to Mr Wade's declaration confirms that this is the mark used. The

evidence from M. Le Duff indicates that the mark is used on bakery products and that these are distributed by food wholesalers to bakeries, hotels etc. In the case of Mr Wade's company, Speciality Food Services Ltd, BRIDOR goods are one of a number of selected (and independent) lines offered for sale by way of an attractively illustrated brochure. All this leaves me with the clear impression that the opponent operates through professional food distribution companies and does not rely heavily on word of mouth recommendation to sell the goods. In short there is nothing in circumstances surrounding the recognition of the trade mark on the market that leads me to a different conclusion to the one reached above. The opposition, therefore, fails under Section 5(2)(b).

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I have some difficulty with the final paragraph of the statement of grounds quoted at the start of this decision. It appears to be a request for the exercise of Registrar's discretion. However, as has now been said in many decisions under the Trade Marks Act 1994, the Registrar has no discretion to refuse an application which otherwise meets the requirements of the Act. Bearing in mind also the remarks of Mr Hobbs QC sitting as the Appointed Person in WILD CHILD Trade Mark, 1998 RPC 455, in relation to the need for proper particularisation of pleadings I do not propose to speculate on what other grounds (if any) may have been intended.

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20 As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponent to pay the applicants the sum of **£635**.

**Dated this 18 day of February 1999**

25

30

**M REYNOLDS**  
**For the Registrar**  
35 **The Comptroller General**