

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2004307 BY
SUDMILCH AG TO REGISTER THE MARK
DELICE IN CLASS 29**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 45493
BY COMPAGNIE LAITIERE BESNIER**

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DECISION

On 8 December 1994 Sudmilch AG applied to register the mark DELICE in respect of a specification of goods which, after amendments, reads:

“Cream with fruit, desserts made from curd with fruit, desserts made from yoghurt with fruit, desserts in the form of puddings with a milk base, prepared desserts in the form of puddings with a milk base; milk and dairy products, all being in the nature of desserts and not including ice cream.”

The application is numbered 2004307.

On 25 September 1996 Compagnie Laitiere Besnier filed notice of opposition to this application. The opponents say they are the proprietors of the UK registration number 1584567 for the mark BRIDELICE and have used the mark in respect of milk, dairy products, butter, cheese, cream and yoghurt. As a result their grounds of opposition are in summary:

- (i) under Section 1 in that the mark at issue is not capable of distinguishing the goods of the applicants
- (ii) under Section 3(3)(b) in that “by virtue of the opponents’ use and reputation” the mark is of a nature to deceive the public
- (iii) under Section 3(6) in that the application was made in bad faith as the applicants should have been aware of the opponents’ earlier use. Furthermore it is said that the applicants did not have a bona fide intention to use the mark in relation to all or any of the goods.
- (iv) under Section 5(2)(b) in that the mark applied for is similar to the opponents’ earlier trade mark and is to be registered for identical or similar goods
- (v) under Section 5(4) having regard to the use made of the opponents’ mark

Details of the registration referred to above are as follows:

No.	Mark	Class	Journal	Specification
5 1584567	BRIDELICE	29	6094/7759	Milk; dairy products; butter, cheese, cream, yoghurt

10 The opponents also ask for the application to be refused in the exercise of the Registrar's discretion. As there is no power to refuse an application which otherwise meets the requirements of the Act I need say no more about this aspect of the opponents' case.

The applicants filed a counterstatement denying the above grounds and asking for an award of costs in their favour.

15 Both sides filed evidence in these proceedings. No hearing has been requested. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

20 The opponents filed a statutory declaration dated 8 October 1997 by Urion Marcel, the General Manager of Compagnie Laitiere Besnier.

25 Mr Marcel says that Compagnie Laitiere Besnier is an affiliate of the Besnier group which is one of the largest and best known names in the French milk and dairy products area. Besnier started as a small operation in 1933 and has grown into an international trading group with plants throughout France, and in US and Spain. Besnier has a large export business which includes exporting to the UK on a substantial scale. Besnier has a UK trading partner, David Brough Gourmet Foods, of London, who are committed to increasing Besnier's presence in the UK, and Besnier has been selling directly in the UK since 1990. In 1988, Besnier had 25
30 per cent of total UK sales of Camembert cheese and a third of UK sales of Brie cheese. The market for speciality cheese and dairy products in the UK has grown considerably in the UK and Besnier is said to have succeeded in capturing a large share of that market.

35 Besnier's products are sold throughout the UK through a wide range of outlets including Tesco, Safeway, Asda, Somerfield, Kwik Save, Marks & Spencer, Morrisons, Co-op, CRS, Booker and Waitrose. The products are distributed through a wide range of UK wholesalers, including Dryant, Bradbury, Cheese Press, Clarks, Crowsons, Dairycold, Drayton and Glendower. As a result it is said that Besnier has an extensive reputation in the UK for dairy products and has established a significant amount of valuable goodwill.

40 In support of this Mr Marcel provides

Exhibit I - a company brochure

45 Exhibit II - copy invoices for the UK and Ireland between 1990 and 1997 together with sales figures for the UK and Europe

Exhibit III - articles from 'The Grocer' dated 26 March 1988 and 15 October 1988 relating to Besnier's range of products in the UK.

He goes on to say that

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“Besnier has used the mark BRIDELICE widely in Europe in relation to a full range of dairy products including cream products and butter. Exhibit IV hereto comprises a number of advertisements and articles from France, featuring BRIDELICE products as well as some recent sales figures and advertising figures in Europe for BRIDELICE products. A number of these advertisements incorporate phrases including ‘un delice’ e.g. ‘Une envie, un delice’, ‘Une recette, un delice’. The phrase ‘un delice’ has become, in the minds of the European public, associated with the mark ‘BRIDELICE’, and many British business people and holidaymakers visiting continental Europe, and France in particular, will have seen these. This shows that the ‘DELICE’ part of this mark is important and that the mark is not seen as ‘BRIDEL’ and ‘ICE’. It is Besnier’s intention to launch their BRIDELICE products in the UK.”

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In relation to the applicants’ mark Mr Marcel says

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“The word ‘delice’ is a French word meaning ‘delight’ or ‘extreme pleasure’ and cannot alone in my view be considered distinctive for cream and dairy products. Indeed the applicants’ earlier mark, UK Registration no. 1491617 only proceeded to registration with a disclaimer to the non-distinctive word ‘DELICE’. It cannot be right that the applicants should have a monopoly in the descriptive, or laudatory word ‘DELICE’ in relation to the goods set out above which appeal to the senses.

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The mark DELICE for which the applicants seek registration is so similar to Besnier’s earlier mark BRIDELICE that I believe there exists a likelihood of confusion on the part of the public. The mark ‘BRIDELICE’ is an elision of the words ‘BRIDEL’ and ‘DELICE’. The word ‘DELICE’ is clearly recognisable in the mark . The marks ‘BRIDELICE’ and ‘DELICE’ are clearly both visually and phonetically similar. This may be seen from the use of the phrase ‘un delice’ which has become associated with the mark ‘BRIDELICE’.”

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Finally he exhibits

Exhibit V - showing the opponents’ mark used in relation to creme Anglaise

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Exhibit VI - a copy of a decision of the French Patent Office rejecting the mark DELICE in a corresponding opposition. Proceedings are also said to exist in Switzerland, Germany, Spain and Portugal.

Applicants' evidence

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The applicants filed a statutory declaration by Frank van Amelsvoort, the Marketing Director of the United Kingdom branch of Campina, a European food producer. He says that the company has also been known as Sudmilch and its UK branch as Bailey Milk Products Ltd.

The company is a substantial producer of foodstuffs which it sells through the major multiples in all parts of the United Kingdom. It is particularly concerned with the production and sale of dessert products such as those with a dairy content including yoghurts.

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In 1992 preparations were made for the introduction of a new brand onto the United Kingdom market under the trade mark DELICE. This trade mark was seen as having the appearance of a trade mark, no obvious meaning, and being short and attractive. In September of that year products were first launched onto the United Kingdom market under the trade mark DELICE. Mr Van Amelsvoort says that the trade mark DELICE has proved to be a successful brand and it was used throughout the remainder of 1992, as well as the whole of 1993, 1994, 1995, 1996 and 1997 and it continues to be used today. Food marked with the trade mark DELICE is currently sold through the major multiples including Tesco's, Sainsbury's, Safeways, Asda, Somerfield, Kwik Save, Morrisons, CRS and CWS, whilst products have also been sold through Iceland, Waitrose, William Low, Presto, N&P, NISA, Batley, Collin & Hobson and Huric Foods in the period since 1992. Furthermore, the goods have also been sold through wholesalers such as Makro and Bookers to many smaller retailers.

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Food marked with the trade mark DELICE has been sold throughout the United Kingdom and is likely to have been sold in every significant shopping town. He give examples of these.

Annual turnover is said to be

	<u>No. products sold</u>	<u>Value</u>
25 Sept 1992-end	2,060,000	£350,000
1993	15,500,000	£2,635,000
1994	30,480,000	£5,182,000
1995	50,190,000	£9,040,000
1996	41,200,000	£7,417,000
30 1997	47,350,000	£8,523,000

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The goods are advertised in the trade and by promotional activity. In support of this he exhibits copy invoices, photographs from exhibitions, trade advertisements and samples of product packaging. Mr van Amelsvoort claims that products sold under the trade mark DELICE have acquired a 43 per cent share of the supreme chilled dessert market. He is not aware of any instances of confusion between the parties products and marks.

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A second declaration comes from David John Richards, the applicants' professional representative in these proceedings. He comments extensively on a number of issues. I do not propose to give a full review of his evidence but I take it into account in reaching my decision. In summary Mr Richards

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S suggests that on the basis of the opponents' evidence they could show no use of the mark BRIDELICE in this country at the relevant date

S offers observation on how the mark BRIDELICE might be seen having regard to its component elements

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S notes that the applicants' use predates the opponents' registration and that the applicants also have an earlier registration (no. 1491617) incorporating the element DELICE

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S refers to numerous registrations in the ownership of the opponents incorporating their house mark BRIDEL. It is suggested that this will influence how customers perceive the mark BRIDELICE (that is to say they will not pick out DELICE as an element).

15
S comments on issues to do with distinctiveness. For reasons which I will touch on later in this decision the underlying objection is in my view not well founded and so does not necessitate a review of the applicants' evidence in response.

S denies the relevance of the decision of the French Registry

That concludes my review of the evidence.

I will take the absolute grounds of objection first.

The opponents refer to Section 1 of the Act which so far as is relevant reads:

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“1. - (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

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Section 3(1)(a) is also relevant and reads:

“3. - (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),”

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It seems to me that the objection as framed is misconceived as it is based on the contention that the ground arises “by virtue of the use made of the mark BRIDELICE”. That appears to foreshadow an objection on relative rather than absolute grounds. The matter is further complicated by the observations in Mr Marcel's declaration regarding the meaning and
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significance of the French word ‘delice’ (no objection has been taken under paragraphs (b), (c) or (d) of Section 3(1)). In AD2000 Trade Mark, 1997 RPC 168, Geoffrey Hobbs QC sitting as the Appointed Person said in relation to Section 3(1)(a):-

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“Section 3(1)(a) prohibits the registration of “signs” which do not satisfy the requirements of section 1(1) (because they are incapable of being represented graphically and/or incapable of distinguishing goods or services of one undertaking from those of other undertakings) whereas the prohibitions in sections 3(1)(b), 3(1)(c)

and 3(1)(d) are applicable to “*trade marks*”, i.e. signs which satisfy the requirements of section 1(1). From the provision to section 3(1) it is apparent that sections 3(1)(b), 3(1)(c) and 3(1)(d) prohibit the registration of signs which satisfy the requirements of section 1(1), but nonetheless lack a distinctive character in the absence of appropriate use. This implies that the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of “*signs which cannot constitute a trade mark*” at the time when they are put forward for registration. It is clear that signs which are not objectionable under section 3(1)(a) may nevertheless be objectionable under other provisions of section 3 including sections 3(1)(b), 3(1)(c) and 3(1)(d).”

I have no hesitation whatsoever in coming to the view that DELICE is both a sign and is capable of distinguishing goods within the meaning of the test set out by Mr Hobbs. The opposition fails on this ground.

Section 3(3)(b) reads:

“(3) A trade mark shall not be registered if it is -

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

Again the opponents refer to their own use and reputation as the basis for the objection. The Section is concerned with the inherent characteristics of the mark applied for and not whether it qualifies for registration by reference to a competing right. I see nothing in the mark applied for which suggests that it is in any way disqualified by virtue of Section 3(3)(b).

Section 3(6) reads:

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

Here too the objection appears to be founded on the opponents’ claimed earlier use and raises issues which more properly fall to be decided in relation to the Section 5 grounds. The opponents do not make any direct challenge to the applicants’ claim to ownership. To the extent that any such claim might be implicit in the objection I can see no basis for finding in the opponents’ favour. There is nothing to suggest that the applicants’ mark was other than independently chosen. Additionally under Section 3(6) it is said that there was no bona fide intention to use the mark in relation to all or any of the goods. The range of goods applied for is not overly wide and the use attested to by the applicants since 1992 confirms that their intentions have been put into practice.

Section 5(2)(b) reads:

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

5 (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,

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

15 The correct approach to the interpretation of the expression “a likelihood of confusion on the part of the public” as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport [1998] RPC* 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

20 “Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, 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
25 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
35 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 the 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.”

45 I also note the following observations of Geoffrey Hobbs QC (sitting as the Appointed Person in *BALMORAL Trade Mark* 1999 RPC 297) in relation to the approach to be adopted:

5 “The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

10 It is clear from the respective specifications that the parties are in a similar area of trade which might broadly be categorised as dairy products and desserts made from dairy products. I bear this factor in mind in considering the composite test set out at above though it is clear that my view of the marks will be critical to the outcome.

15 The applicants say that DELICE is an important and recognisable part of their mark and that their mark as a whole was coined by eliding the words BRIDEL and DELICE. They also point to advertising which plays on the origin of the mark by including phrases such as ‘une envie, un delice’, ‘une recette, un delice’ (delice meaning delight). I give very little weight to this latter point as it is an advertising strap line that may well play in the French market but would be less obvious in this country. Not surprisingly there is no evidence that it is actually used here. This line of argument may, of course, have played a part in the proceedings before the French Patent Office (though as no translation of the judgment has been supplied I have not attempted to review the reasoning behind the decision). Mr Richards in his declaration for the applicants speculates on how the marks BRIDELICE and DELICE will be perceived by reference to words such as ‘bride’, ‘bridle’, ‘brie’, ‘lice’ etc. In practice, of course, the public does not approach trade marks in this way and it is for this reason that in cases such as ERECTIKO, 1935 RPC 136, cautionary remarks were made about splitting marks up and comparing individual elements. Although that case was decided under a preceding Act the principle still holds good and finds expression in the Sable v Puma passage referred to above - “the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.” Even so there is one aspect of the applicants’ case that does merit consideration and that is Mr Richards’ comment that

35 “The Registrar is asked to note that those customers who are accustomed to BRIDEL marked products will perceive the mark BRIDELICE as BRIDEL-ICE and are not likely to perceive the element DELICE within it, and confuse the mark as a whole with the applicant’s trade mark.”

40 This was occasioned by the opponents’ own evidence showing that BRIDEL is one of the marks they use in this country. In fact judging by the evidence it is as important, or nearly so, as the house mark BESNIER. I note too that Mr Marcel in his evidence for the opponents foresaw (and denied) the possibility that his company’s mark would be seen as BRIDEL and ICE conjoined. There is some attraction to following Mr Richard’s line of argument. However, without a good deal more information about public recognition of the mark BRIDEL (although seemingly important it is only one of a number of marks used) it would be wrong to place too much reliance on the point.

I must, therefore, reach my own view of the matter based on my impressions of the visual, aural or conceptual similarities between the marks. It is self evident that the whole of the applicants' marks is present in the opponents' mark but that is not in itself fatal to this applicants' case and in my view this factor does not stand out on a comparison of the marks. It is well established (and no less true under the 1994 Act) that the beginnings of words are of particular importance - see for instance the following passage from London Lubricants (1920) Ltd's application (Tripcastroid) (1925) 42 RPC 264 at page 279 lines 36-40:-

"But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction."

The first syllable of the opponents' mark is unlikely to be ignored and in my view is a strong visual element in the mark-up of the mark. I am not persuaded that the average consumer would find the marks visually confusing. For the same reason I cannot see that there will be aural confusion. In assessing conceptual similarity it is said that the mark applied for translates as 'delight' or 'extreme pleasure'. Delice is unlikely to be a commonly understood French word in this country and the average consumer may not even see it as a French word. On the assumption that neither word carries any particular significant to a UK consumer I see no basis for a finding of conceptual similarity. If I am wrong on this latter point or it is said that a proportion of the UK public would recognise, or guess at, its meaning the opponents still face the difficulty of establishing conceptual similarity with the coined word BRIDELICE. In short I find that there is no real likelihood of confusion and the opposition fails under Section 5(2)(b).

The final ground is under Section 5(4) which reads:

"(4) 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."

No reference is made to any particular rule of law. The opponents do, however, refer to their goodwill so it is to be assumed that they rely on the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in WILD CHILD Trade Mark 1998 RPC 455. The necessary elements are said to be as follows:

- (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 goods or services offered by the defendant are goods or services of the plaintiff; and
- 5 (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.

Mr Richards, in his declaration for the applicants criticises the opponents' position in the following terms:

10 "The opposition by Compagnie Laitiere Besnier is based in part upon allegations of extensive and continuous use of its own trade mark BRIDELICE and alleged corresponding passing-off rights in the United Kingdom, but little if any evidence of use in the United Kingdom has been shown. Whilst it may be the case that this trade mark

15 has been used in France in respect of specific milk/dairy products, butter and sauces (but not yoghurts or cheese), M. Marcel states in paragraph 7 of his Declaration that it is his company's "intention" to launch the BRIDELICE product in the United Kingdom, so use would not appear to have commenced in this country and this is supported by Exhibit II to his Declaration in a document headed Etablissement Bridel Europe dated 1

20 July 1997 which sets out the volumes of sales of products in Europe under the trade mark. No turnover figure is stated for the United Kingdom and the only possible United Kingdom use of the trade mark BRIDELICE which I could identify in any of the M. Marcel's evidence is in the company brochure Exhibit I where the mark appears on a sweatshirt next to many other marks. This brochure may have entered the United

25 Kingdom, but judging from the content and spelling, it was intended for the United States market."

The above comments broadly correspond with my own conclusions from reading the evidence. I make no comment on whether the brochure at Exhibit I was intended for the USA market but

30 as it contains 1996 information it is of necessity after the relevant date in these proceedings. I can see no clear evidence of any goodwill under a relevant distinguishing sign as opposed to the opponents' other marks such as 'Bridel', 'Besnier', 'President', 'Lactel' etc. It follows that the opponents cannot hope to succeed under Section 5(4)(a).

35 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 £435.

40 Dated this 10 day of JUNE 1999.

45 M REYNOLDS
For the Registrar
the Comptroller General