

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 9704
BY ROBERT WISEMAN DAIRIES PLC
FOR A DECLARATION OF INVALIDITY AND/OR RECTIFICATION OF THE REGISTER

IN RESPECT OF TRADE MARK No 2114332
STANDING IN THE NAME OF
FERRERO S.P.A.

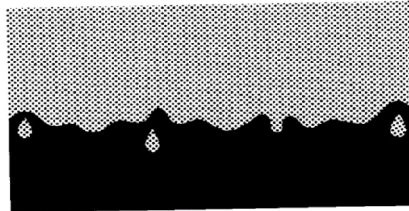
DECISION

1) Trade mark registration No 2114332 is registered with the following specification of goods:

Class 29: “Whipped cream and milk shakes..”

Class 30: “Ice creams and soft ice, chocolate, chocolate products, chocolate eggs, pastry and confectionery, ice, cold pastry products, bakery products, sponge cakes, products made from cereals, snacks.”

2) The registration with effect from 30 October 1996, is in the name of Ferrero S.p.A.. The mark itself is as follows in the register of trade marks:



The applicant claims the colours cream and red as an element of the mark.

3) By an application dated 7 August 1997 Robert Wiseman Dairies Plc applied for invalidation and/or rectification of the register. The terms, which have been amended, are in summary:

i) Robert Wiseman and Sons Limited is a wholly owned subsidiary of Robert Wiseman Dairies Plc. The former is the proprietor of a number of registered UK trade marks listed at annex A.

ii) The representation of the Trade Mark number 2114332, as published at page number 2675 of Trade Marks Journal number 6166, and as entered on the Register, is not the same as the mark applied for on the form of application lodged with the Patent Office on 30 October 1996. The amendment is contrary to the provisions of Section 39 of the Trade Marks Act 1994. The Registrar is,

accordingly, requested to rectify the register, in accordance with Section 64, so that the representation of the mark is as it was applied for on the form of application.

iii) The applicant is the proprietor of the earlier registered trade marks set out in annex A. Therefore registration of the mark in suit would be contrary to the provisions of Section 5(2)(b) and 5(3) and should be declared invalid under Section 47(2)(a) of the Act.

4) The registered proprietor filed a counterstatement defending the registration and denying the applicants claims. Both sides ask for an award of costs.

5) Both sides filed evidence in these proceedings and the matter came to be heard on 12 February 2002 when the applicant was represented by Dr Vitoria of Queens Counsel instructed by Messrs Fitzpatricks. The Registered Proprietor was represented by Mr Edenborough of Counsel instructed by Messrs Taylor Joynson Garrett.

APPLICANTS' EVIDENCE

6) The applicant filed two declarations. The first, dated 26 June 2000, is by Alasdair Hume the applicant's Trade Mark Attorney. In his declaration, Mr Hume provides at exhibits AH1 and AH2 copies of correspondence from the file relating to registration number 2114332 in the name of Ferrero S.p.A and also a copy of the trade mark from the Registry Journal. Mr Hume claims that the mark shown in the journal differs from that in the application. He states:

"I am aware that, from time to time, the Trade Marks Registry asks applicants to lodge professionally prepared artwork which is known as camera ready copy. This is sometimes presented in half- tones or what is known as heraldic shading. I note that there is no reference in the journal advertisement for application number 2114332 that the mark was being depicted in heraldic shading. I note that the applicant (Ferrero S.p.A.) Claims the colours cream and red as an element of the mark. The mark is not, however, limited to those colours."

7) Mr Hume then refers to Section 39 of the Trade Marks Act and claims that the mark as published is not the same mark as applied for by the applicant, that the amendment to the mark is contrary to Section 39(2) and asks the Registry to rectify the Register entry. Mr Hume does not elaborate any further on the differences between the mark as applied for and as published in the Trade Mark Journal. He also claims that the mark, as published, is confusingly similar to a number of the proprietor's marks and that the specifications are similar. Further, Mr Hume claims that whilst certain aspects of the goods in the specification of Trade Mark 2114332 are not similar to those goods for which the trade marks of Robert Wiseman Ltd are registered, the dissimilar goods (chocolate, bakery products and snacks) are sold in the same outlets as Wiseman products. He therefore seeks to have application 2114332 declared invalid having regard to Section 5(2), 5(3) and Section 47(2)(a) of the Act.

8) The second declaration, dated 26 June 2000 is by William G Keane the Secretary and Finance Director of Robert Wiseman Dairies Plc. He states that Robert Wiseman & Sons Limited is a

wholly owned subsidiary of Robert Wiseman Dairies Plc. Mr Keane provides details of trade marks and their specifications which are owned by Robert Wiseman & Sons Ltd. These are detailed at Annex A. At exhibit WK2 he provides labels and samples of packaging which he claims shows use of these trade marks. All the use shown reveals the applicant's mark to be used as get-up on packaging for the goods.

9) Mr Keane supplies turnover figures as follows, although what marks and goods these figures refer to is not specified:

Year	Turnover £
1992	39,000,000
1993	46,036,000
1994	59,743,000
1995	107,935,000
1996	148,274,000
1997	192,904,000

10) Mr Keane states that the applicant's transport services are provided by vehicles which carry the distinctive black and white livery. He claims that this "Friesian cow" marking has become well known and has featured in the press. At exhibit WK3 he provides a copy of a promotional brochure which shows pictures of cartons of milk with the trade mark, and also a copy of the applicant's Annual Report for 1996.

11) Mr Keane also states that it is his view that the mark applied for by Ferrero S.p.A is not the same as that advertised in the Trade Marks Journal and that if the mark advertised were used in black and white (or even in very dark and light contrasting colours) it would be confused for one of his company's marks. He also claims that the products in the specifications of both parties are similar.

REGISTERED PROPRIETOR'S EVIDENCE

12) The proprietor filed a witness statement, dated 15 November 2000, by David Corbet Connal the General Affairs Manager of Ferrero UK Limited. a member company of the Ferrero Group of which Ferrero SpA and Soremartec SA are also members. He provides at exhibit DCC1 two statutory declarations (dated 30 April 1997 and 5 November 1997) given by Vivienne Wooll in a related opposition action. Mr Connal states that he has read these statements and confirms the contents to be correct.

13) In her first declaration, dated 30 April 1997, Ms Wooll states that she is the Manager of External Affairs of Ferrero UK Limited. She states that the registered proprietor utilises a logo which is featured in the five registrations shown at Annex B. The logo is shown at exhibit VW1 and is reproduced below for ease of reference.



14) Ms Wooll states that there have been substantial sales in the UK of products bearing the logo since 1967. At exhibit VW3 she provides figures for sales bearing the logo as follows:

Year	Kinder Surprise Net Revenue £	Kinder Chocolate Net Revenue £	Kinder Maxi Net Revenue £	Kinder Bueno Net Revenue £
1991 / 92	5,437,866	180,736	80,356	964,261
1992 / 93	17,431,869	285,457	183,654	833,688
1993 / 94	11,176,706	244,685	1,625	643,858
1994 / 95	12,384,175	94,743	0	247,829

15) Ms Wooll states that the products have been promoted in the UK via advertisements in newspapers and magazines such as *The Grocer*, *Super Marketing* and *Independent Grocer* and also by television advertisements. Figures for promotion on KINDER CHOCOLATE goods in the UK are provided as follows. Her later declaration confirms that these figures relate to expenditure in UK£.

Year	Expenditure £
1991 / 92	52,101
1992 / 93	-
1993 / 94	9,333
1994 / 95	128,750

16) Ms Wooll states that “goods bearing the logo the subject of the application have been advertised and sold throughout Great Britain and Northern Ireland”. She lists principal towns and cities covering the whole of the UK. She also states that:

“I verily believe that the logo the subject of the above application is recognised throughout the trade as indicating the goods of the opponent”

17) In her second declaration, dated 5 November 1997, Ms Wooll provides at exhibit VW4 sample invoices showing sales of products which she claims bear the logo referred to at exhibit VW1 in her earlier declaration. These invoices show at least one sale of the various products in a number of years as shown below:

Product Name	Years
Kinder Surprise	1991 - 1997 incl.
Kinder Chocolate	1991 - 1997 incl.
Kinder Bueno	1991 - 1997 incl.
Kinder Maxi Bars	1991- 1993 incl. and 1997.

18) Ms Wooll reiterates her claim that the logo has been used on products labelled *Kinder Surprise*, *Kinder Chocolate*, *Kinder Bueno*, and *Kinder Maxi*. At exhibit VW5 she provides two copies of advertisements for *Kinder Bueno* although she does not state how, when or where they appeared. Ms Wool refers to other advertising material but this is not supplied as part of the declaration or its exhibits. Ms Wooll provides advertising figures for Kinder Surprise and Kinder Bueno as follows:

Year	Kinder Surprise £	Kinder Bueno £
1984 / 85	469,000	-
1985 / 86	388,000	-
1986 / 87	407,000	-
1987 / 88	376,000	-
1988 / 89	635,000	-
1989 / 90	421,000	-
1990 / 91	665,000	-
1991 / 92	584,000	-
1992 / 93	1,800,000	162,000
1993 / 94	2,700,000	0
1994 / 95	3,400,000	35,807
1995 / 96	2,900,000	38,348
1996 / 97	2,700,000	28,158

19) Ms Wooll makes a number of comments regarding a declaration by Mr Keane dated 22 July 1997. This declaration was filed as evidence in the other action, however it has been filed as an exhibit by the proprietor (Ferrero S.p.A.) in this case. Ms Wooll points out that in his evidence there is no reference to when trade mark 2038519 was first used. On the turnover figures provided by Mr Keane she notes that there is no evidence to substantiate them nor show that they relate to goods sold or products provided under the trade mark 2038519.

20) Ms Wooll also claims that there is no evidence of extensive use of the trade mark 2038519; that the livery is recognised or that the livery features the trade mark in the said application.

21) That concludes my review of the evidence. I now turn to the decision.

DECISION

22) I find it convenient to consider first the request for rectification based upon Sections 39 and 64 which read as follows:

“39. - (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting -

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.”

And:

“64 .- (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the registrar or to the court, except that -

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the registrar or the court directs otherwise, the effect of rectification

of the register is that the error or omission in question shall be deemed never to have been made.

(4) the registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The registrar may remove from the register matter appearing to him to have ceased to have effect.”

23) Dr Vitoria, for the applicant, contended that the representation of the mark as advertised in the Trade Mark Journal did not depict the essential features of the mark applied for and was not a proper representation of the mark which was sought to be registered. The registration was therefore procedurally irregular, but rectification of such issues is not allowed under Section 64 and the proper course of action is for the registered proprietor to withdraw the trade mark and to make a fresh application.

24) In relation to the question regarding the representation of the mark, I was referred to the CREOLA trade mark [1997] RPC 507 where Laddie J. stated:

“The purpose of advertisement is to allow interested third parties (and, in particular, third parties who may be adversely affected by registration) to learn that a potentially important statutory monopoly is being applied for, so that they can, if they so wish, oppose within the time set by the Act. If that is so, says Mr Arnold, the representation filed in the Registry must be sufficiently clear and distinct as to allow all the significant features of the mark to be readily discerned. Absolute clarity in the case of complicated graphical marks make it impossible and, in particular, in accordance with current practice the Registry only places monochrome advertisements, and some lack of definition will inevitably be caused by this.”

25) Reference was also made to *Andreas Stihl's* application [2001] RPC 215 where Mr Hobbs as the Appointed Person stated:

“19. Sections 38 to 40 impose important administrative requirements upon the Registrar. Taken together, they envisage that there will be no significant differences between (i) an application for registration as accepted; (ii) the application advertised for opposition purposes; and (iii) the application as ultimately granted. They equally clearly envisage that an application will not be allowed to proceed to registration: (1) until it has survived exposure to opposition; or (2) at a time when acceptance has been suspended or withdrawn under the power reserved to the registrar in the closing words of section 40(1). In my view, the act of registering a trade mark is liable to be regarded as procedurally irregular if these requirements are overlooked or ignored.

20. In the present case there was no request for amendment of the application as accepted and no opposition to the application as advertised. However, the application as granted differs from the application as accepted. The difference consisting of the reference “*hard* operated hedge clippers” instead of “*hand* operated hedge clippers” is sufficiently

insignificant to be rectifiable under section 64. On the other hand, the difference consisting of the omission of the words “*high pressure and vacuum cleaners for industrial use*” is sufficiently significant to be incapable of rectification within the narrow confines of that section. I was told that goods of the kind identified by these words are commercially important to the applicant in terms of its business interests under the relevant trade mark.

26) Dr Vitoria set out her contention as follows:

“My submission is that the reasonable reader, seeing that, would somehow apply the colours cream and red to the representation. Red is clearly shown as the dark block. Above the dark block is shown a stippled effect and so what is being depicted in the advertisement is a stippled sky over a red ground, if I may just use those terms, whereas in fact the mark applied for is a clear, unstippled, cream sky over a red ground. My objection is that the impact of the mark visually is different from that which was applied for.”

27) For the registered proprietor Mr Edenborough pointed out that, in the absence of colour printing, his client had been requested to provide a camera ready copy of the mark to the Registry and had chosen to use half tones rather than heraldic shading, both being acceptable to the Registry.

28) As Dr Vitoria accepts that the registration, even if it is irregular, cannot be rectified under Section 64, there is strictly nothing for me to determine with regard to the request for rectification of the Register.

29) In any event I do not accept Dr Vitoria’s contention that the reasonable reader would view the mark as advertised as having a stippled or polka dot. In my opinion the advertisement depicted the essential features of the mark applied for and would be seen by a reasonable reader as being a two colour mark, the upper part being cream and the dark lower part being red with three cream droplets. To my mind the mark as advertised was clear and distinct enough for the significant features of the mark to be discerned, and was therefore a proper representation of the mark applied for.

30) It follows that the mark entered in the register, which is identical to the mark advertised, similarly depicts the essential features of the mark when taken together with the colour claim. Anyone inspecting the register who wishes to see the marks as originally filed in colour may do so on request, or they can request a coloured copy of the mark. Advances in technology mean that electronic trade mark registers can now record colour. Accordingly, all new coloured trade marks are being registered in colour and an exercise is underway to record all existing colour marks (including this one) on the register in the colours filed.

31) The grounds for rectification, therefore fail.

32) I now move onto consider the grounds for invalidity. The applicant’s request for the declaration of invalidity is made under the provisions under Section 47(1) & (2) of the Act. This states:

“47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier mark or other earlier right has consented to the registration.”

33) I shall deal first of all with the ground of the application for the declaration of invalidity based upon Section 5(2)(b) of the Act. This reads:

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

(a)...

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

34) An earlier right is defined in Section 6, the relevant parts of which state:

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

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

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (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.”

35) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

36) At the hearing Dr Vitoria identified trade mark registration number 2038519 as providing the

strongest case for the applicant, with trade mark registration number 1369454 mentioned as the “next closest one”. It was common ground at the hearing that the Class 29 specifications of both the applicant’s trade marks were either identical or very similar to the class 29 specification of the registered proprietor’s mark.

37) I move now to compare the applicant’s goods in Class 29 of its marks to the registered proprietor’s class 30 specification. In order to assess the similarity of the goods, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

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

38) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

39) Dr Vitoria separated the registered proprietor’s class 30 specification into three parts:

- a) ice creams and soft ice;
- b) chocolate, chocolate products, chocolate eggs, pastry and confectionery, cold pastry products, bakery products, sponge cakes, products made from cereals, snacks;
- c) ice.

40) In carrying out the comparison I shall refer to these groupings. The applicant’s mark 2038519 is registered for the following goods in Class 29 “Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter”. There are minor differences in the specification of the applicant’s mark 1369454 but as nothing turns on these very slight differences I shall treat the specifications of the applicant’s two marks as identical for the purposes of the comparison test.

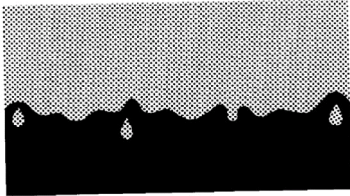
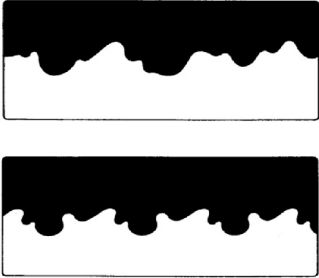

41) Within the applicant’s specification the terms “milk products, dairy products and edible fats” in Class 29 do not cover “ice cream” and “soft ice” in Class 30 of the registered proprietor’s specification. This is clear from the ordinary meanings of the words and the fact that they are classified differently.

42) Clearly the users of the respective goods are the same in that they are the general public. In the broadest terms the uses are similar in that they are foods. Yoghurt and cream are used as deserts as are the goods at paragraph 39(a), however yoghurt and cream are also used in general cooking whereas the goods at 39(a) are not. The physical nature of the goods was claimed by Dr Vitoria to be similar in that her client's products and those at 39(a) were sold in tubs or containers and clearly the goods of the applicant are used in the manufacture of the registered proprietor's goods. It was also claimed that the applicant's goods and those at 39(a) would be found in chill cabinets. However, in my experience they are not normally to be found in the same cabinet due to the different temperature requirements. No evidence was provided as to how the goods are classified by the trade.

43) In my view there is some similarity between the applicant's goods in class 29 and the goods at 39(a). I consider the goods at 39(b) and 39(c) to be dissimilar to the applicant's class 29 specification.

44) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

45) For ease of reference the marks of both parties are reproduced below:

Registered Proprietor	Applicant for Invalidity
<p data-bbox="135 1102 252 1133">2114332</p>  <p data-bbox="135 1693 719 1749">The applicant claims the colours cream and red as an element of the mark</p>	<p data-bbox="812 1102 928 1133">2038519</p>  <p data-bbox="812 1608 928 1639">1369454</p> 

46) All these marks have been registered as pictorial marks without any indication that they are part of a pattern on the packaging of the food products covered by their specifications. Consequently, they must be considered to be figurative marks which will be used in the form registered. In the absence of any formal challenge to the validity of either party's marks on distinctiveness grounds, I must treat them as validly registered on absolute grounds.

47) The registered proprietor's mark has been registered in the colours cream and red. The applicant's marks although used solely in black and white could also be used in any colour combination. (See *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] FSR 205 at 215).

48) I must therefore consider fair and notional use of the marks in addition to actual use. As Dr Vitoria asserted, her client may chose to use their mark in the colours cream and red on a strawberry drink product, or to use different colours to distinguish types of milk. The latter is common practice with red being used on fully skimmed milk, green on semi-skimmed milk, and blue on full fat milk.

49) Whilst the applicant has several marks which were referred to collectively as "Friesian" marks I have to consider each of the marks individually for the purposes of this comparison. The applicant's strongest case is under trade mark 2038519. This mark consists of two bands of colour, light above dark, with an irregular or wavy line at the joining point. Mr Edenborough likened this to "a sort of band across the tummy of a Friesian cow". He also pointed out that there is no interdigitation of one colour into the other colour in the applicant's mark, merely blocks of colour with strong fingers spreading out. He contrasted this with his client's mark which clearly has drops of one colour in the other colour.

50) In my opinion unless the average consumer was aware of the existence of the applicant's other marks or had been educated as to the allusion to the hide of a Friesian cow, the applicant's mark 2038519 would be seen simply as two bands of colour, light above dark, joined by a wavy line. Equally the registered proprietor's mark would be viewed in the same manner. In a side by side comparison the average consumer may take note of the interdigitation mentioned by Mr Edenborough but such comparisons are not always possible and the concept of imperfect recollection must be taken into account.

51) The applicant claims that its reputation is such that it enhances the distinctive character of its mark and widens the penumbra of protection afforded to it. The applicant has supplied turnover figures for five years prior to the relevant date. These show that the applicant enjoyed an average turnover of approximately £80 million per annum. The applicant also supplied evidence of use of its marks and promotional literature. However, the applicant has a number of trade marks registered for a variety of goods and services. I also note that the applicant supplies goods to multiple retail outlets such as Safeway and Tesco, which usually sell products such as milk under their own labels. At the hearing Dr Vitoria had to concede that some of the examples of use related to trade marks other than those shown at annex B. She acknowledged that "in some case what has happened is that the advertising men have moved ahead of the trade mark registration".

52) To achieve the greater protection offered to trade marks with an enhanced reputation the applicant needs to be able to show that it enjoys a reputation in a given mark in relation to

particular goods or services. In the instant case the applicant has failed to show that it has an enhanced reputation in any particular mark or for any particular goods or services. The evidence relates to all goods and services provided under a plethora of registered and unregistered marks. All of the use shown in the applicant's evidence is use as patterns on packaging or on delivery lorries rather than as the figurative marks in the form registered. All the use will have been secondary to word marks. Further, all the use shown has been of black and white marks whereas the applicant's best case under 5(2)(b) is on the footing that its mark may be used in colours the same as or similar to red and cream, the registered proprietor's colours. Therefore, in the instant case the applicant cannot be said to enjoy an enhanced distinctive character relevant to the likelihood of confusion.

53) In making my global assessment I must take into account all the relevant factors. I accept that the applicant's mark could be used in similar colours to those of the registered proprietor's mark. To my mind, neither of the marks has a highly distinctive character per se, and the scope of protection of relatively weak marks is bound to be limited. I therefore come to the conclusion that:

a) in relation to the identical goods in Class 29 the degree of similarity between the mark in suit and the applicant's trade mark 2038519 is such that there was, at the relevant date, a likelihood of confusion on the part of the public.

b) in relation to the goods in Class 30 of the registered proprietor's specification the similarity of the goods when combined with the degree of similarity between the applicant's trade mark 2038519 is such that there was no likelihood of confusion on the part of the public at the relevant date.

54) When comparing the applicant's trade mark 1369454 with the mark in suit the applicant's position is not improved.

55) I next turn to the ground of invalidity under Section 5(3) which reads:

"5. (3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

56) The purpose and scope of this section have been considered in a number of cases including *General Motors Corp v Yplon SA* [1999] ETMR 122 and [2000] RPC 572 (*Chevy*), *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767 (*Typhoon*), *C.A. Sheimer (M) Sdn Bhd's TM Application* [2000] RPC 484 (*Visa*) and *Valucci Designs Ltd v IPC Magazines O/455/00 (Loaded)*.

57) Sitting as the Appointed Person, Simon Thorley QC, in the *Loaded* case observed that in an attack under Section 5(3) the tribunal would need to have regard to a number of considerations. I intend to approach the matter on the basis of the heads he identified.

(i) Whether the trade mark under attack is identical with or similar to the earlier trade mark(s).

58) I have found earlier in this decision that there is a degree of similarity between the marks.

(ii) Whether the trade mark under attack is registered in respect of goods or services which are not similar to those for which the earlier trade mark is protected.

59) Earlier in this decision I found that the following goods in the registered proprietor's specification under Class 30 "*chocolate, chocolate products, chocolate eggs, pastry and confectionery, cold pastry products, bakery products, sponge cakes, products made from cereals, snacks, ice*" were dissimilar to the goods of the applicant.

(iii) Whether, and to what extent, the earlier trade mark(s) has a reputation in the UK.

60) The goods being opposed by the applicant fall within Class 30 and are clearly sold to ordinary members of the public. The relevant public in the instant case is the general public. The applicant needs to establish that it has a reputation under its mark with the general public.

61) The applicant has two distinct strands to its business. A service side which collects and delivers goods and a processing side which produces and sells milk based products. The collection and delivery of goods is a service provided to multiple retailers and farmers. The company in its annual report dated 1996 (exhibit WK3) describes itself as "the leading UK based liquid milk processing and distribution company". Later in the same exhibit it states "... the company is uniquely placed to offer distribution coverage throughout the Midlands, Northern England and Scotland".

62) Then there are the milk based products which are sold to multiple retailers such as Tesco under own branding arrangements and also through other outlets under the various "Friesian" trade marks. Examples of products on sale to the general public under the "Friesian" marks have been provided in the proprietor's evidence. The applicant is therefore dealing with clients of a disparate nature and its reputation would be spread across the differing groups.

63) The applicant has provided turnover figures relating to its entire business. I accept that the business has achieved an average turnover of £80 million per annum over the five years prior to the relevant date and that turnover was rising year on year. However, it has not provided any breakdown of these figures. They have offered no independent testimony to the extent of their reputation in any of the fields in which they operate. Nor have they filed any survey evidence from the relevant public. Their position is also weakened due to the number of differing trade marks used. Although it could be said that they are all part of the "Friesian" family of marks.

64) The hurdle set in relation to reputation under section 5(3) is high. This is not surprising given

that the party is seeking to extend his rights into non-similar goods. In consequence of the above I find that the applicant has not established a reputation amongst the relevant public as at 30 October 1996. Absent reputation the applicant cannot succeed under section 5(3). However, in the event that I am wrong on this finding I go on to consider the other heads identified.

(iv) Whether the use of the later trade mark is “without due cause”.

65) This point only arises as a possible defence if I find one or more of the adverse consequences envisaged by the Section is otherwise made out. The registered proprietor has not provided any explanation of how the mark came to be adopted. In these circumstances I have no hesitation in reaching the conclusion that, if Robert Wiseman Dairies Plc can otherwise succeed in its claim under 5(3) Ferrero S.P.A can obtain no assistance from the words “without due cause” in that section.

(v) Whether the use of the later trade mark

(a) takes unfair advantage

(b) is detrimental to

the distinctive character or the repute of the earlier mark.

66) Dr Vitoria asserted that use by the registered proprietor of the mark in suit on milk chocolate products would give rise to an association as people will assume that the applicant’s milk is used as an ingredient. This, she claimed, would be detrimental to the character and repute of the applicant’s marks as the applicant would have no control over the use made, and would take unfair advantage of the goodwill the applicant has built up in their marks.

67) In Oasis Stores Ltd’s Trade Mark Application [1998] RPC 631 the Hearing Officer said:

“I do not consider that simply being reminded of a similar trade mark with a reputation for dissimilar goods necessarily amounts to taking unfair advantage of the repute of that mark. The opponents chances of success may have been better if they were able to point to some specific aspect of their reputation for batteries etc sold under their mark which was likely , through (non-origin) association, to benefit the applicants’ mark to some significant extent. However, in my judgement, the opponents have not established any such conceptual connection between their reputation for batteries etc, and the goods in respect of which the applicants’ mark is to be used.”

68) Referring to the Oasis Stores case and others Neuberger J said in Premier Brands UK Ltd v Typhoon Europe Ltd [2000] FSR 767:

“.....Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same, or similar to, a registered trade mark with a reputation; nor is Section 10(3) intended to enable the proprietor of a well known registered mark to be able to object as a matter of course to the use of a sign which may remind people of his mark”.

69) Section 10 deals with infringement of a registered trade mark but is in equivalent terms to Section 5(3).

70) Whilst the “chocolate products” within the registered proprietor’s specification may have as a raw ingredient a considerable amount of milk I do not consider that this is sufficient to find that the relevant public would form a connection between the marks of the two parties. The applicant has not put forward any evidence that members of the general public would assume an association between the supplier of a raw material and the supplier of a manufactured product. In my view the applicant has not shown how the use of the registered proprietor’s mark would take unfair advantage or be detrimental to the distinctive character or repute of the applicant’s mark. I find that the opposition under Section 5(3) fails.

71) The applicant’s request for a declaration of invalidity in relation to the registered proprietor’s mark in relation to the whole of the Class 29 specification under Section 5(2)(b) has been successful, whilst the invalidity request in relation to the goods in Class 30 has failed. The registration is therefore invalid with regard to the following items.

Class 29: “Whipped cream and milk shakes.”

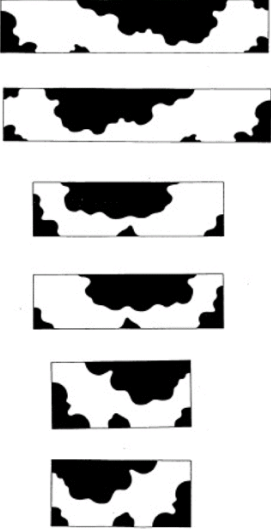
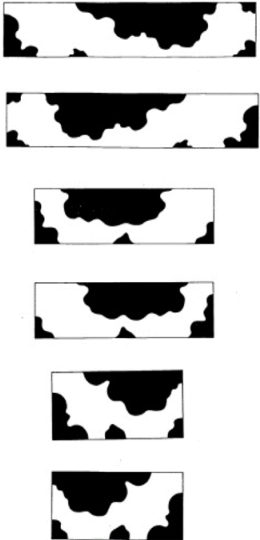
72) The registration will be cancelled to this extent pursuant to Section 47 of the Act.


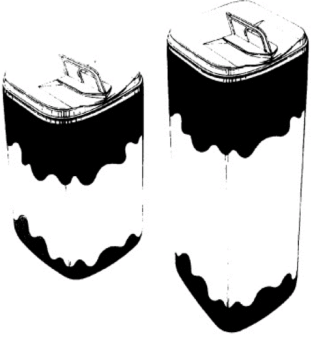
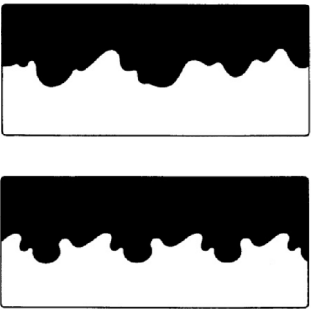
73) The request for invalidity having succeeded the applicant is entitled to a contribution towards its costs. At the hearing both sides sought leave to file submissions on costs following the issuing of the decision. The parties therefore have one month from the date of this decision to file submissions regarding costs. This does not affect the appeal period which is 28 days from the date of issue of the decision.

Dated this 18 day of June 2002

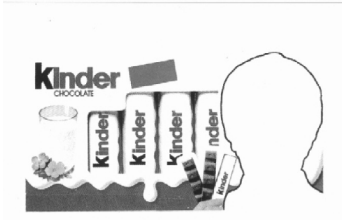

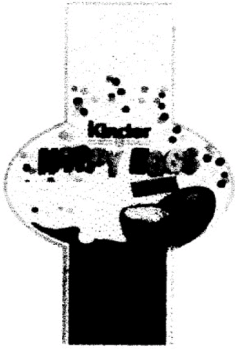
George W Salthouse
For the Registrar
The Comptroller General

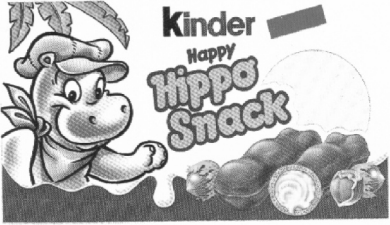

Annex A

Mark	Number	Effective Date	Class	Specification
	1511963	3.9.92	39	The delivery of goods and transport of goods by road; all included in Class 39
	1511962	3.9.92	29	Milk, milk beverages and milk products; all included in Class 29.

	B1369454	6.1.89	29	Milk and milk products; cream; semi skimmed milk; dairy products; butter; butter cream; edible oils and fats, margarine; milk beverages; yoghurt; all included in Class 29.
 <p data-bbox="193 1021 528 1039">The mark consists of the pattern on the packaging.</p>	2044276	10.11.95	29	Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter.
			39	Collection and delivery services; transport services.
	2038519	27.9.95	29	Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter.
			39	Collection and delivery of goods, milk, milk beverages and milk products.

Annex B

Mark	Number	Effective Date	Class	Specification
	1525450	1.2.93	30	Chocolate and chocolate products; all included in Class 30.
	1529878	16.3.93	30	Cold pastry products with filling comprising milk, cocoa and/or other ingredients enrobed with chocolate or chocolate flavoured with or without granulated covering; all included in Class 30.
	1561631	8.2.94	30	Chocolate, chocolate products and confectionery; all being shaped in an egg form and all with a creamy filling; all included in Class 30.

	1569173	19.4.94	30	Products consisting of hazelnut milky filling surrounded by wafer and coated with chocolate.
	1390446	5.7.89	30	Milk chocolate bars; all included in Class 30.