

O-288-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2408467
BY THOMAS PLANT (BIRMINGHAM) LIMITED
TO REGISTER THE TRADE MARKS (A SERIES OF FOUR):**



IN CLASSES 7, 8, 21 AND 25

AND

**THE OPPOSITION THERETO
UNDER NO 94381**

**BY
ROUSSELON FRERES ET CIE**

Trade Marks Act 1994

**In the matter of application no 2408467
by Thomas Plant (Birmingham) Limited
to register the trade marks (series of four):**



**in classes 7, 8, 21 and 25
and the opposition thereto
under no 94381
by Rousselon Freres et Cie**

Introduction

1) On 7 December 2005 Thomas Plant (Birmingham) Limited, which I will refer to as Plant, applied to register the above trade marks. The application was published for opposition purposes in the *Trade Marks Journal* on 3 March 2006 with the following specification:

machines for domestic and/or kitchen use; food processors, presses for foodstuffs; can-openers (electric); potato peelers; coffee grinders; electric knife sharpeners and machines; mandolins and food slicing machines; parts, fittings and replacement blades for the aforesaid;

hand tools and implements (hand operated); cutlery; can-openers (non-electric); peelers, corers, tongs for food, skewers, knife holders; knives, kitchen knives, forks, cutlery, spoons, cake slicers, spatulas, pasta cutters; scissors, scissor-sharpening apparatus, knife sharpening apparatus; mandolins;

household or kitchen utensils and containers (not of precious metal or coated therewith); cookware; stainless steel, aluminium, tri-ply, copper, hard anodized aluminium, cast-iron and cast aluminium cookware; frying pans, roasting pans, steamers, casseroles, poachers, stockpots, roasting dishes, saucepans and woks; bakeware; steelwool; food

graters, shredders, cutters, pressers, chippers, slicers; chopping boards, buckets, cast-iron cookware, fruit squeezers; mincers (non-electric); mills for domestic purposes, salt and pepper mills; hand-operated food processors; juice pressers, corkscrews; bottle-openers; food mashers; garlic presses; corn-on-the-cob holders; skewers, orange and lemon zesters; food scoops;

chefs' and kitchen clothing and headgear; aprons.

The above goods are in classes 7, 8, 21 and 25 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 2 June 2006 Rousselon Freres et Cie, which I will refer to as Rousselon, filed a notice of opposition to the application. Rousselon is the owner of the United Kingdom trade mark registration no 940831 for the trade mark **SABATIER**. It is registered for the following goods:

kitchen knives, cooks' knives, butchers' knives; forks for cooking, carving and roasting; and sharpening steels (not being machines).

The above goods are in class 8 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The trade mark was applied for on 8 April 1969 and registered in 1975. Rousselon claims that in the five years prior to the publication of the application it had used its trade mark in respect of all of the goods of its registration.

3) Rousselon claims that the respective trade marks are similar and that all of the respective goods are similar. Consequently, there is a likelihood of confusion and registration of Plant's trade marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Rousselon claims that its trade mark has a reputation in respect of all of the goods of the specification. Rousselon claims:

“The opponent has built up a reputation in the mark SABATIER for more than 30 years in the UK. If the applicant's goods are sold under its mark which incorporates the word SABATIER, the marks will be associated with one another by the public, believing the applicant's goods to be an extension of the opponent's existing range of kitchen goods. Such action would lead to the dilution of the opponent's rights in the mark SABATIER. The applicant has no reason to use the name SABATIER in its mark other than to take advantage of the reputation of the earlier mark.”

Consequently, registration of Plant's trade marks would be contrary to section 5(3) of the Act.

5) Plant filed a counterstatement. It requires proof of use of Rousselon's trade mark in the period of five years before the date of publication of its trade mark. Plant denies that Rousselon's trade mark has been used as a trade mark in the form in which it is registered in the previous five years in relation to any of the goods of the registration. Plant denies that the respective trade marks and goods are sufficiently similar for there to be a likelihood of confusion. Plant denies that Rousselon has a sufficient reputation in its trade mark for the grounds under section 5(3) of the Act to succeed. It denies that use of its trade mark would take unfair advantage of or be detrimental to any distinctive character or repute of Rousselon's trade mark. Plant denies that the earlier trade mark has any distinctive character or repute in relation to the goods for which it is registered.

6) Plant requests the dismissal of the opposition and its full costs.

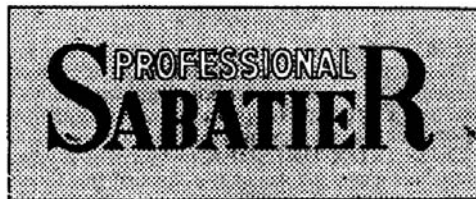
7) Only Rousselon filed evidence.

8) A hearing was held on 20 September 2007. Plant was represented by Mr Thomas Mitcheson of counsel, instructed by Forrester Ketley & Co. Rousselon was represented by Mr Mark Vanhegan of counsel, instructed by Saunders & Dolleymore.

Evidence of Rousselon

9) This consists of a witness statement by Philippa Dianna Eke, a trade mark attorney in the employ of Saunders & Dolleymore.

10) Ms Eke exhibits at PDE1 a declaration dated 7 November 2005 made by Pascale Bruchon, who is president of the board and general manager of Rousselon. The declaration was filed in respect of application nos 82212 and 82213 (consolidated) for the invalidation of United Kingdom trade mark registration nos 2225281 and 2225287. The applications for invalidation were filed by Rousselon and are based on three United Kingdom registrations; nos 940831, 759851 and 1514055. Registration no 759851 is for the trade mark:



Registration no 1514055 is for the trade mark:



11) In her declaration Ms Bruchon gives the history of the trade mark SABATIER. At the beginning of the nineteenth century the Sabatier family of Thiers in France began to manufacture knives. Subsequent generations and different branches of the Sabatier family continued to use the trade mark for knives. Family names were not protectable as trade marks in France unless they were accompanied by a word or image until 1964. Prior to 1964 different branches of the Sabatier family registered the trade mark SABATIER with accompanying words or images in respect of knives. In 1979 the registered proprietors of French trade marks including the trade mark SABATIER, being the descendants of or successors to the Sabatier family, formed an association to protect the name SABATIER in the field of cutlery. A purpose of the association is to conserve the distinctive character of the name SABATIER and the high quality image recognised by consumers. A copy of the agreement establishing the association is exhibited, and an English translation. Article 2 of the agreement identifies the purpose of the association:

- “1) protecting the name SABATIER considered as constituting or forming part of a manufacturing or trade mark in the field of cutlery;
- 2) for this purpose, bringing together the proprietors of the SABATIER marks presently in use and registered in France prior to the year 1974 (accompanying list of proprietors, either individuals or the representatives of bodies corporate, together with their respective SABATIER marks);
- 3) taking legal action whenever deemed necessary in order to enforce the rights in trade marks incorporating the word SABATIER and belonging to members of the Association; and
- 4) devoting itself to conserving the distinctive character of the name SABATIER and the high quality image recognized therein by its clientele.”

The ten proprietors who joined in 1979 were: Maxime Girard, Sabatier Aine et Perrier, Goutteborge SA, Cazeau Chapelat – Monsieur Chazeau, Fontenille Ytournal, Sabatier Jeune, Deglon, Thiers Issard, France-Exportation and Victoria-Nogent.

12) Rousselon is the successor to the rights of Maxime Girard. Sabatier Aine et Perrier owns the trade mark K SABATIER. Adiamas SA is the successor to the rights of Goutteborge, it owns the trade mark SABATIER DIAMENT and diamond device.

Richardson Sheffield Limited is the successor to the rights of Monsieur Chazeau, it owns the trade marks R SABATIER and V SABATIER FRANCE. Therias et L'Econome SA is the successor to the rights of Fontenille Ytournal. It owns the trade marks MEXEUR & CIE SABATIER and L'UNIQUE SABATIER 1 ERE QUALITIE. Bargoin Societe Par Actions Simplifiee is the successor to the rights of Sabatier Jeune. It owns the trade mark SABATIER JEUNE FRANCE. Deglon owns the trade mark SABATIER DEG. Thiers Issard owns the trade mark SABATIER with the device of four stars and an elephant.

13) Knives including the name SABATIER are traditionally manufactured in the Thiers region. SABATIER is used in relation to professional knives used by butchers, cooks and chefs. The trade mark SABATIER is also applied to other cutlery products which are sold to the general public.

14) Rousselon sells knives and accessories in three product ranges: 32 DUMAS AINE, LION SABATIER and 2 LIONS SABATIER INTERNATIONAL. A copy of the current catalogue for the first two brands is shown at exhibit 3, it was published in June 2002. It is in English and French, it is distributed to Rousselon's clients in the United Kingdom. The LION SABATIER trade mark appears in the catalogue primarily in the following manner:



On the blades of knives the trade mark appears in a similar fashion, but with the device to the left of the word LION and the word SABATIER not underlined. Reference in the catalogue is also made to SABATIER LION. All of the goods of the specification of the Rousselon trade mark registration appear in the catalogue by reference to LION SABATIER. Page 41 of the catalogue shows various knives which bear the name SABATIER within an oval on the handle of the knife.

15) A copy of material relating to 2 LIONS SABATIER INTERNATIONAL is shown at exhibit 4. On the blade of the knives the trade mark is used as shown below:



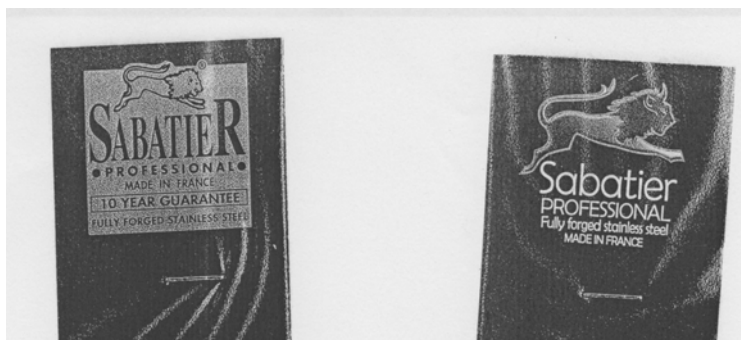
In the material the trade mark is used in a slightly different format with INTERNATIONAL appearing below SABATIER. The material was published in June 2004. It is distributed to Rousselon's clients in the United Kingdom.

16) Ms Bruchon states that Rousselon sells its products to clients in the United Kingdom and has done so for many years. She states that Rousselon provides bespoke packaging and marking for some clients whilst other clients package the goods themselves. She gives the following approximate sales figures (at wholesale prices) for products purchased by United Kingdom clients:

2000	€65,000
2001	€21,00
2002	€1,166,000
2003	€73,000
2004	€18,000
2005	€31,000

17) Rousselon's products reach their end users via the following clients: The John Lewis Partnership, Lockhart Catering Equipment Ltd, Paul Swolf Ltd, Divertimenti Retail Ltd, Steamer Trading Ltd, Le Creuset UK Ltd and Harrison Fisher & Co Ltd.

18) Rousselon has been selling its products to John Lewis for more than fifteen years. They are sold throughout the United Kingdom and are displayed in the Cookshop area. A copy of current and previous packaging is exhibited, as shown below (the old form to the left):



The reverse of the old form of the packaging shows the trade mark:



To the right of this SABATIER appears. The new form of the packaging shows a lion device:



To this side of this SABATIER is written.

19) Lockhart is a large distributor of catering equipment in the United Kingdom. It sells to the trade across many market sectors, including hotels, restaurants and pubs. Sales are made from Lockhart's catalogue, its website and its showroom in East London. At exhibit 6 copies of pages from Lockhart's 2003 and 2005 catalogues can be found. On pages 142 and 162 of the catalogues SABATIER products are displayed. The headings are 'SABATIER' KNIVES and CHEF'S 17 PIECE 'SABATIER' KNIFE & GADGET SET. On page 162, under the first heading the rubric explains that the goods are 2 LIONS SABATIER INTERNATIONAL products. Various knives and a carving fork can be seen.

20) Paul Swolf imports and exports cutlery. It sells cutlery to wholesalers who generally sell to the restaurant trade. Rousselon has been selling its products to Paul Swolf for twenty five years. Shown in exhibit 7 is a picture of products sold by Paul Swolf. SABATIER LION and device appear on the blades of the knives, SABATIER in an oval appears upon the handles of the products, which include a butchers' knife, chefs' knives, steels and cooks' knives. (From the evidence given by Stephen Lloyd (see below) it can be deduced that this material emanates from prior to 28 October 2005 – when his witness statement was signed.)

21) Rousselon's products are sold in Divertimenti's two stores, one in South Kensington/Knightsbridge, the other in the West End. Pages from Divertimenti's website, downloaded on 24 October 2005, are exhibited at exhibit 8. On the pages there are references, inter alia, to: "Grand Sabatier knives and knife set", "Sabatier carving knives", "Sabatier knife block set", "Sabatier knife set", "Sabatier meat fork, bread and salmon knives, steels and cleaver Range". A leaflet is also exhibited, this shows a "SABATIER 'SYDNEY' KNIFE SET & BLOCK", which includes a cooks' knife, carving knife, bread knife, paring knife and carving fork. The leaflet refers to a prize draw the closing date of which is 31 January 2006, opening hours for the period 5 December to 23 December are also given, so it appears to emanate from the end of 2005.

22) Steamer has six stores in East Sussex, two in Surrey and one in Kent; they sell kitchenware items. An extract from its website, downloaded on 24 October 2005, is exhibited at exhibit 9. The extract is headed "Sabatier", a description of the SABATIER

brand is given; SABATIER is used on several occasions; a picture of a LION SABATIER and device knife is shown; SABATIER appearing on the handle in an oval.

23) Rousselon has been supplying LION SABATIER knives to Le Creuset for at least fifteen years. Le Creuset products are available in a variety of outlets. At exhibit 10 a brochure and leaflets distributed by Le Creuset are exhibited. The device of a lion, the word LION and the word SABATIER can be seen upon the blades of knives, SABATIER in an oval can be seen upon the handles of the knives. The word SABATIER in an oval can also be seen on steels and carving forks. A leaflet shown use of SABATIER knives (the leaflet is for an offer which has a closing date of 31 January 1991.) There are two leaflets for Maxime Girard SABATIER, Maxime Girard was a predecessor in title to Rousselon. At exhibit 11 there is a copy of packaging for a cooks' knife.

24) Harrison Fisher trades under the name Taylor's Eye Witness. It packages Rousselon's products itself. Harrison Fisher sells 2 LIONS SABATIER INTERNATIONAL and VERITABLE SABATIER products. At exhibit 12 there is a picture of a knife bearing VERITABLE SABATIER and a coat of arms device upon the blade. The coat of arms includes an intertwined M and G. A copy of packaging for VERITABLE SABATIER is shown at exhibit 13.

25) At exhibits 14 and 15 six invoices are shown:

17 February 2004	to Le Creuset
15 November 2004	to Paul Swolf
18 February 2004	to Paul Swolf
28 February 2005	to Harrison Fisher
5 October 2004	to Divertimenti
23 March 2005	to John Lewis

The serial numbers on the invoices can be cross referenced to catalogues. The Le Creuset invoice, the Paul Swolf invoices of and the Harrison Fisher invoice relate to products bearing LION SABATIER and device. The Divertimenti invoice relates to blocks and poultry shears, which are not in the specification of Rousselon's registration. Ms Bruchon states that the blades of the knives of the Harrison Fisher invoice have VERITABLE SABATIER stamped upon them. The goods supplied to John Lewis are from the NEPTUNE range and bear the trade mark reproduced below upon them:



26) At exhibit PDE3 is a picture of knives, in their packaging, supplied to John Lewis; the use is as per paragraph 18.

27) Exhibited at PDE4 are pictures of a knife, a steel and a carving fork in their packaging as supplied to Le Creuset. The trade mark on the front of the packaging is virtually the same as that shown in the left hand example in paragraph 18. On the handles of all the products SABATIER in an oval appears.

28) Exhibit PDE5 consists of a witness statement by Stephen Lloyd. Mr Lloyd is the general manager of Paul Swolf. Mr Lloyd states that Paul Swolf imports knives bearing the trade mark SABATIER from Rousselon, it has been buying these knives for twenty five years. A promotional leaflet is attached to his statement, it does not have a date but Ms Bruchon writes in the present tense that Paul Swolf sells goods that bear the trade mark SABATIER on the handle and she is writing within the material period for proof of use. The promotional leaflet is the same as one exhibited by Ms Bruchon; SABATIER in an oval appears on the handles of most of the products, which include knives, chefs' forks, butchers' knives and steels. Mr Lloyd states that annual turnover figures for goods sold under the SABATIER trade mark for 2003 and 2004 were £6935.16 and £7993.94 respectively. Mr Lloyd ends his statement by stating that there are several users of the trade mark SABATIER.

29) Exhibit PDE6 consists of a witness statement by Alastair Fisher. Mr Fisher has spent thirty years working for Harrison Fisher; Taylor's Eye Witness is a trading name of the company. Harrison Fisher imports knives and steels from Rousselon to sell as part of the Taylor's Eye Witness brand, as of 2005 this had been happening for three years. Two ranges of knives and steels are sold: VERITABLE SABATIER and SABATIER INTERNATIONAL. Promotional material from 2005 is exhibited, this shows use of VERITABLE SABATIER in relation to knives and steels and SABATIER INTERNATIONAL in relation to knives. The blades of the former knives bear the words VERITABLE SABATIER and a coat of arms which includes an intertwined M and G. The blades of the latter knives bear the trade mark:



The promotional material describes Taylor's eye witness as a knife maker. The material states that the knives are made in France, no reference to Rousselon can be seen. The annual turnover for goods bearing these trade marks was £30,028 and £6,825 in 2004 and 2003 respectively. Mr Fisher ends his statement by stating that the trade mark SABATIER is used on knives which are supplied by members of what he calls the 'Sabatier Guild'.

30) Exhibit PDE7 consists of a witness statement by Kate Carrick. Ms Carrick is the central buyer, Cookshop, for John Lewis. Ms Carrick states that she buys knives from Rousselon to sell in its department stores to sell to the general public. She states that these goods are sold under the trade mark SABATIER together with a picture of a leaping

lion or a picture of two lions' heads. John Lewis has been buying these knives for thirteen years. She states that she is aware that Rousselon also sells knives bearing the trade mark SABATIER and the lion devices to Le Creuset and Taylor's Eye Witness. She completes her statement by stating that knives bearing the trade mark SABATIER originate from Thiers.

31) Exhibit PDE8 consists of a witness statement by Michael Schneideman who was previously a director of Divertimenti, which had recently been acquired by Aga Foodservice Group. Mr Schneideman states that for the previous two years Divertimenti had been selling knives and block sets that bear the trade mark SABATIER (his statement was made on 31 October 2005). These have been bought from Rousselon. He states that he has attached a copy of the Christmas 2004 catalogue which includes a promotional offer in relation to SABATIER products. This has not been attached. Annual turnover for knives and knife blocks bearing the SABATIER trade mark were £6299.85 and £5750.00 for 2005 and 2004 respectively.

32) Exhibit PDE9 consists of a witness statement by Alison Thorne. Ms Thorne is international marketing manager for Le Creuset. She states that she has worked with LION SABATIER knives since joining Le Creuset in 1989. She states that Le Creuset products are available at most leading department stores and independent cook shops. Ms Thorne states that Le Creuset sells knives bought from Rousselon. The knives have the trade mark SABATIER etched onto the blade, accompanied by the word LION and a picture of a lion. The handle also has the trade mark SABATIER stamped upon it. Le Creuset has been selling this brand of goods since 1987. Ms Thorne finishes by stating:

“Having worked in the kitchenware/housewares industry for almost 17 years I believe that the Sabatier brand is perceived by the consumer as standing for high quality, tradition, excellent performance and longevity. I also believe that the consumer feels there is only “one Sabatier” and the product will be of good quality if it carries the Sabatier name. The Sabatier name is a very important factor in the consumer's decision-making process when purchasing kitchen knives as it implies quality. From my experience the Lion Sabatier range/brand, made in the original and traditional way, is by far the best Sabatier range available in the UK. It is important to be able to make the link back to the origins of the brand, which dates from the 1800s and was started by the Sabatier family in Thiers, France. There is a confirmed link between the Lion Sabatier brand/Rousselon Freres at cie and the original family business.”

33) Exhibited at PDE10 is another witness statement by Ms Eke. On 17 October 2005 a search was made of trade mark applications and registrations having effect in the United Kingdom. It was conducted in respect of all marks that included the word SABATIER in class 8. There are three refused applications. Two are owned by Richardson Sheffield Limited. Two, in the name of Horwood Homewares Limited, are the subject of invalidation proceedings by Rousselon. An application in the name of Horwood Homewares Limited has been opposed by Rousselon. One is owned by Ets Therias et L'Econome. Six are owned by Rousselon. One is owned by Etablissements Bargoin

Societe Par Actions. One is owned by Ivo Cutelarias, Lda, which had not been published for opposition purposes. Two are owned by Adiamas. One is owned by Ets Jean Deglon. An exhibit to Ms Eke's statement consists of copies of two photographs taken at the John Lewis department store in Watford on 7 November 2005. The copies are not of a good quality, they show knives, forks and steels. Where trade marks can be seen on the packaging they conform to the two types of trade mark shown in exhibit PDE3.

34) Exhibit PDE11 consists of a copy of a letter dated 26 May 2006 from the trade attorneys for Rousselon to the trade mark attorneys for Plant. Ms Eke states that enclosed with the letter were copies of exhibits PDE1 and PDE5 – PDE8. Exhibited at PDE12 and PDE14 are copies of preliminary indications given in other cases involving Rousselon and the use of SABATIER in trade marks. Taking into account the comments of Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch)ⁱ I will say no more about the preliminary indications.

35) Ms Eke exhibits copies of pages from Dexam International Limited's 2005 catalogue. I do not understand why these pages have been exhibited, nor was Mr Vanhegan able to enlighten me in relation to this matter at the hearing.

36) Exhibits PDE5 – PDE10 (inclusive) were originally filed in respect of application nos 82212 and 82213 for invalidation.

Proof of genuine use

37) It must first be established if Rousselon has established that there was genuine use of its trade mark for the goods for which it is registered in the five years prior to the date of the publication of Plant's application; as per section 6A of the Actⁱⁱ. Genuine use "of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". Under Section 100 of the Act the onus is upon the owner of the trade mark to prove that there has been genuine useⁱⁱⁱ. It is Mr Mitcheson's contention that Rousselon has not established that there has been genuine use of the trade mark.

38) There has been use of SABATIER in an oval on the handles of the goods of the specification. Ms Thorne in her witness statement states that the products that Le Creuset sells have this form of the use of SABATIER. Le Creuset's products are available at department stores, independent cookshops, cookshops under the Elizabeth David name and at Le Creuset factory outlet shops. Most of the products sold by Paul Swolf have SABATIER in an oval upon the handles, as shown by the leaflet that has been exhibited; no date has been given as to from when the leaflet emanates but Ms Bruchon writes in the present tense that Paul Swolf sells goods that bear the trade mark SABATIER on the handle and she is writing within the material period for proof of use. On one of the pages downloaded from the Steamer website the same use of SABATIER upon the handle of a knife can be seen. Examples are given of the packaging of Rousselon's goods for John Lewis and Le Creuset are shown. In the examples for Le Creuset SABATIER in an oval can be seen on the handle of a knife, a carving fork and a steel. SABATIER with a lion

above it appears prominently on the front and reverse of the packaging. The front of the packaging for John Lewis shows:



The reverse of the old form of the packaging shows the trade mark:



To the right of this SABATIER appears. The new form of the packaging shows a lion device:



To the side of this SABATIER is written.

39) An exhibit to Ms Eke's exhibited statement consists of copies of two photographs taken at the John Lewis department store in Watford on 7 November 2005 ie within the material period for proof of use. In the second photograph both forms of the packaging can be seen, products in the packaging included a variety of knives, cooks' forks and steels. There are examples of undertakings using SABATIER on its own eg Divertimenti's use. Mr Vanhegan argued that use by other undertakings was use with the consent of Rousselon. There is no evidence that the use was with the consent of Rousselon. Use of SABATIER on its own in catalogues and publicity material does not indicate that Rousselon gave consent for such use. It might not have been unaware of the use at the time or if aware of the use might just not have been bothered to comment upon it, effectively acquiesced in the use. Possible acquiescence and consent are not one and the same, from the evidence I do not consider that consent can be inferred^{iv}. Consequently, I will not take into account the third party use in catalogues and publicity material. The use by Paul Swolf can be taken into account as SABATIER has been put in an oval on the handles by Rousselon.

40) Mr Vanhegan argued that use of SABATIER in composite trade marks was use of SABATIER within the terms of section 6A of the Act. So use of SABATIER within the trade marks:



and



was use of SABATIER. The basis of Mr Vanhegan's argument was that the average consumer would see the goods as being SABATIER goods. The issue under section 6A of the Act is whether the use is in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, not how the average consumer would identify the goods. So I consider that Mr Vanhegan's argument is fatally flawed. To decide this matter I need to identify the differences between the trade mark as used and then decide if these differences alter the distinctive character of the trade mark, this should be done from the perspective of the average consumer^v. I cannot see that adding the device of the heads of two lions, the number 2, the word Lions, in the upper trade mark, can be considered to be anything other than altering the distinctive character of the trade mark. In fact, I do not consider that it is merely altering the distinctive character of the trade mark in question but use of another trade mark; the same applies in relation to the lower trade mark.

41) Mr Vanhegan considered that the judgment of the ECJ in *Société des produits Nestlé SA v Mars UK Ltd* Case C-353/03 [2005] ETMR 96^{vi} supported his case; if a trade mark could acquire distinctiveness through use in conjunction with another registered trade mark then such use could be considered genuine use in relation to a non-use action. The issue before me is whether the use is use in a form that satisfies the requirements of section 6A of the Act, not whether the use would allow for one non-distinctive element of a registered trade mark to be separately registered owing to the use that had been made of it. It is a matter of looking at the trade mark as registered and the ways in which the trade mark has been used; Mr Vanhegan is posing a different question about different issues. I do not consider that the type of use as shown in the two examples above is use within the context of section 6A of the Act.

42) Mr Mitcheson argued that use of a trade mark in a form that could be independently registered could not be use in a form that satisfies the requirements of section 6A of the Act. That the trade mark as used could be the subject of a separate registration does not exclude the use from being use as permitted under section 6A of the Act. Mr Mitcheson is inventing a test which is neither in the Act nor in the Directive. It is most certainly not

something that was proposed by Lord Walker in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25. Mr Mitcheson sought support for his position from the judgment of the European Court of Justice (ECJ) in *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-234/06 P. In that judgment the ECJ stated:

“86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

The ECJ was commenting upon extrapolating of evidence of use in relation to one registered trade mark to another registered trade mark where no evidence has been furnished in relation to the latter trade mark. The judgment relates to the “means of proof of use”. If evidence was furnished in relation to the latter trade mark it would have been necessary to consider that evidence and whether that evidence established genuine use in a slightly different form to the one in which the trade mark was registered. The ECJ has not stated that if the trade mark as used could be the subject of a separate registration then it could not be acceptable use; to have done so would have effectively nullified the provision that allows for a trade mark registration to be maintained where the use has been in “a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”.

43) The use I have specifically identified in paragraphs 38 and 39 divides into two. The use on the handles of the products and the use of SABATIER in proximity with other material. Is the use on the handle use of the trade mark in a form differing in elements which does not alter the distinctive character of the mark in the form in which it was registered? To decide this I need to identify the differences between the trade mark as used and then decide if these differences alter the distinctive character of the trade mark, this should be done from the perspective of the average consumer^{vii}. SABATIER appears in a normal type face, the letters increase and lessen as demanded by the oval in which they appear. The oval shape acts as no more than a label into which the word is placed. I am of the view that this use is use that does not alter the distinctive character of the trade mark.

44) There is no requirement for a proprietor to use a trade mark on its own in order to prove genuine use^{viii}. It is common for undertakings to use more than one trade mark in relation to their products; there will often be use of a house mark, a brand and even a sub-brand, a mixture possibly of word marks, device marks and composite trade marks. The public is used to seeing this use of multiple trade marks whether it be on an item of confectionery, a motor car or an item of clothing. The John Lewis use, on the reverse of the packaging, puts SABATIER on its own at some distance from the trade mark to its left. I am of the view that the average consumer will see this as use of two separate trade

marks. On the front of the old packaging there is an ® symbol after the device of a lion; this is my view acts as a divider between the device and the word SABATIER beneath it. A similar position arises in relation to the front of the packaging for Le Creuset; SABATIER in an oval appears on the handles of the goods, emphasising that this is a separate trade mark.

45) I consider that the John Lewis, Le Creuset and Paul Swolf use establishes use of Rousselon's trade mark in respect of the goods of the specification. There has been use for a lengthy period of time; there is no indication that the use has been solely for the purpose of maintaining the registration of the trade mark. The scale of actual use is not disclosed by way of turnover figures in relation to the first two undertakings, however, the length of use is. One can also see from the photographs of the John Lewis store in Watford that there were a large number of products on display. Mr Lloyd gives turnover figures of close to £8,000 and £7,000 for the years 2003 and 2004 respectively, these are not enormous sums but they indicate a real trade.

46) Mr Mitcheson submitted that if there had been use it fell into the category of de minimis use. There is a quantitative threshold but it only exists in so far as in relation to the relevant market the use is such that it demonstrates that it maintains or creates a market share for the goods or services; that is the test, not an a priori scale of use, and minimal use can be sufficient to establish genuine use^{ix}. There has been a long term relationship with Le Creuset, John Lewis and Paul Swolf; the invoice of 17 February 2004 shows sales to Le Creuset, within the relevant period. The photograph of the John Lewis store in Watford shows the products out. I have no doubt that the use shown is of a scale and a nature sufficient to maintain or create a market share for the goods of the registration.

47) In normal circumstances the automatic sequitur would be to find that Rousselon has established genuine use of its trade mark for the goods of the registration. However, these are not normal circumstances. Genuine use of a trade mark requires that it is used in accordance with its essential function, which is to guarantee the origin of the goods for which it is registered; this is in order to create or preserve an outlet for the goods^x. If a sign does not perform this function then it cannot maintain or create a market share for the goods in relation to which it is used. There may be use but it is not trade mark use and the judgment of the ECJ requires trade mark use. The two elements of the requirement defined by the ECJ are part and parcel of the same concept. This essential function demands that the sign guarantees "that all of the goods or services bearing it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality^{xi}".

48) Rousselon's own evidence shows that there are various other undertakings using the SABATIER trade mark for the same goods. Mr Lloyd states that "there are several users of the mark for knives". Mr Fisher states that:

"The mark SABATIER used on knives which are supplied by a member of, what I call, the 'Sabatier Guild'."

Ms Thorne states:

“Having worked in the kitchenware/housewares industry for almost 17 years I believe that the Sabatier brand is perceived by the consumer as standing for high quality, tradition, excellent performance and longevity. I also believe that the consumer feels there is only “one Sabatier” and the product will be of good quality if it carries the Sabatier name. The Sabatier name is a very important factor in the consumer’s decision-making process when purchasing kitchen knives as it implies quality. From my experience the Lion Sabatier range/brand, made in the original and traditional way, is by far the best Sabatier range available in the UK. It is important to be able to make the link back to the origins of the brand, which dates from the 1800s and was started by the Sabatier family in Thiers, France. There is a confirmed link between the Lion Sabatier brand/Rousselon Freres at cie and the original family business.”

Mr Vanhegan suggested that Ms Thorne was referring to a number of SABATIER trade marks owned by Rousselon. Taking into the other evidence of this case I do not find this the most likely interpretation of her words; it is out of kilter with the evidence of Ms Bruchon. Be that as it may, the other evidence goes to the effect that there are a number of SABATIER trade marks in the ownership of different undertakings being used in the United Kingdom for knives. Mr Mitcheson submitted that the way that the average consumer distinguishes between the goods and identifies the trade mark is through other trade mark matter eg through the use of LION SABATIER, it is the LION element that identifies the particular undertaking that is responsible for the goods sold under it, SABATIER does not tell anyone anything about the provenance of the goods. Ms Bruchon states that Rousselon sells three product ranges, 32 DUMAS AINE, LION SABATIER and 2 LIONS SABATIER INTERNATIONAL.

49) The evidence certainly suggests that those who sell knives are likely to know that SABATIER does not identify a particular undertaking, that it is some other matter used in relation to SABATIER that acts as the indicator of origin. However, there is nothing to suggest that the purchaser of the goods from the supplier is likely to be aware of this. Certainly, if I was purchasing a knife I would view the SABATIER name as the indicator of origin. Of course, now, from the evidence in this case, I know that SABATIER would not be fulfilling the essential purpose of a trade mark, of offering a guarantee that all the goods bearing it have been produced under the control of a single undertaking which is responsible for their quality^{xii}. Rousselon is using SABATIER but it is not using it to distinguish its goods from those of other undertakings, some other sign or signs are doing this.

50) Mr Vanhegan did not consider that use by others of SABATIER was relevant to the question of establishing genuine use. He sought support for his position from the judgment of Laddie J in *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51. He particularly directed me to paragraphs 50 -55 of the judgment. These paragraphs relate to whether the trade mark was invalid as per sections 3(1)(b), (c) and (d) of the Act and so I do not see that they can assist Rousselon. The use of ‘mail’ in relation to other

newspapers was raised as a defence eg *Birmingham Evening Mail* and the *Sunday Mail* in question. However, it was not held that the trade marks used by Associated Newspapers Ltd would not perform the essential function of a trade mark, the primary argument was that it could not have a monopoly of the word 'mail'. I cannot see that there is a parallel with the position in this case where there are various users of SABATIER which quite simply means that the sign SABATIER is not performing the essential function of a trade mark.

51) So one is left with the position that SABATIER is being used by Rousselon, the average consumer is likely to see SABATIER as being the trade mark, but he or she is deceived in this belief, it is something else that distinguishes, at least to those in the know, various SABATIER signs. That the average consumer is likely to believe that SABATIER is acting as the indicator of origin, does not in the end, in my view, change the position in relation to the genuine use question; SABATIER is not identifying the origin of the goods for which it is registered in order to create or preserve an outlet for them, as submitted by Mr Mitcheson, it is something else that does this. **Consequently, I do not consider that Rousselon has established that if the five years prior to the publication of Plant's application it has made genuine use of the trade mark SABATIER in relation to the goods of the registration.** I am not indicating or stating that SABATIER is generic, that it identifies a particular type of knife or steel of fork, I am simply taking into account that there are a variety of users of the sign and so the use of SABATIER by Rousselon does not fulfil the essential function of a trade mark and so, in my view, the use cannot satisfy the requirements set out by the ECJ in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85. Objection may be raised to my finding, owing to the effect that this might have in relation to trade marks that were registered on the basis of consent or under the 1938 Act on the basis of honest concurrent use; I have to consider the issues before me in this case and apply the law as I understand it, I cannot investigate hypothetical situations in relation to other trade marks in other situations.

52) As Rousselon has failed to establish genuine use of the sole trade mark upon which it relies its opposition must fail. However, in the event that I am wrong in my finding in relation to genuine use, I will consider the grounds of opposition under sections 5(2)(b) and 5(3) of the Act on the basis of the full specification of the earlier trade mark; use of the sign was established in relation to all of the goods of the registration; it is just not, in my view, trade mark use.

Earlier trade mark

53) Sections 5(2)(b) and 5(3) of the Act require the opponent to be relying upon an earlier trade mark. Registration no 940831 is an earlier trade mark as per section 6(1)(a) of the Act^{xiii}.

Average consumer and the purchasing process

54) The goods of the earlier registration could be bought by professionals but equally they could be bought by the public at large. There will be few households that do not have knives for cooking, although there are likely to be fewer households that have forks for cooking, carving and roasting and sharpening steels. One group of average consumers must, therefore, be the public at large; who are likely to have a less knowledge in relation to the goods than some professional users of the goods. The class 7, 8 and 21 goods of the application and aprons will also have these two types of average consumer. The public at large, therefore, will represent the group where the factors for confusion are most likely to arise and so I will take into account the perspective of this group in my deliberations in relation to the class 7, 8, 21 goods and aprons. The other class 25 goods of the application are aimed at the professional user, even if some non-professional might use them, and so I consider that the average consumer for these goods will be persons in the catering trade. All of the goods are the subject of intermittent purchases, it is likely, therefore, that some consideration will be given in the purchase. The degree of this consideration is likely to vary; the class 7 goods of the application are machines that are unlikely to be of insignificant cost; such things as the potato peelers in this class will be electrically powered peelers not hand held ones. I consider that the purchasing process of the class 7 goods will be more careful and considered than that for the other goods of the application. The varying degrees of care that are likely to be taken in the purchasing of the goods will be offset, at least to some extent, by the intermittent nature of the purchases which means that imperfect recollection is likely to have a greater effect.

Section 5(3) of the Act

55) For Rousselon to succeed under section 5(3) of the Act it must establish that its trade mark is known by a significant part of the public concerned by the products. Ways of establishing this include showing the market share held by the trade mark, how intensive, geographically widespread and long-standing the use of the trade mark has been, the amount invested by the undertaking in promoting the trade mark^{xiv}. There is no indication of the market share that Rousselon enjoys in relation to its goods, no figures are given in relation to the promotion of the goods; the evidence suggests that there has not been a great deal of promotion. The evidence shows that there has been use of the trade mark, if I am wrong in my findings in relation to genuine use, in many areas of the United Kingdom for a good number of years but longevity of itself is not the equivalent to reputation. (Potentially issues could arise from the use of the trade mark SABATIER by others, as to whether this could assist Rousselon or ham string it. However, on the basis of the evidence before me this is not a matter that taxes me.)

56) On the basis of the evidence before me, Rousselon has not established a reputation that satisfies the requirements set out by the ECJ in *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 and so the grounds of opposition under section 5(3) of the Act must be dismissed.

Likelihood of confusion – section 5(2)(b) of the Act

57) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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

58) *Kitchen knives* appear in both specifications and so these goods are identical. *Knives, forks, knife sharpening apparatus* and *scissor-sharpening apparatus* of the application will include the goods of the earlier trade mark. “Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^{xv}”. **Consequently, knives, forks, knife sharpening apparatus and scissor-sharpening apparatus of the application are identical to the goods of the earlier registration.**

59) In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose^{xvi}, their method of use and whether they are in competition with each other or are complementary^{xvii}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective 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 in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) 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.”

In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{xviii}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{xix}. The class of the goods in which they are placed is relevant in determining the nature of the goods^{xx}. Consideration should be given as to how the average consumer would view the goods^{xxi}. In considering the similarity of the goods I have to consider the individual goods specified, unless the same ground of refusal

is given for a category or group of goods, then I can use a general reasoning for all of the goods or services concerned^{xxii}.

60) A number of the goods of the application can be categorised as being manual cutting, slicing products or have an analogous food preparation functions. *Hand tools and implements (hand operated)* includes goods for culinary use, the latter category of goods includes potato peelers and so these latter goods fall into the category defined in the first sentence of this paragraph. *Household or kitchen utensils* include such goods as peelers and grinders and so fall within the category defined in the first sentence. The other goods that I consider fall into this category are: *peelers, corers, cake slicers, scissors* (which include scissors for culinary purposes), *mandolins, pasta cutters, food graters, shredders, cutters, pressers, chippers, slicers, mincers (non-electric); mills for domestic purposes, hand-operated food processors, food mashers, garlic presses, orange and lemon zesters*. All of these goods share the following with the goods of the earlier registration: they are all manually operated, they all cut, slice, mince, mash or have some analogous function. All of the goods could be primarily of metal; with the exception of the food mashers and garlic presses they are all bladed or could be bladed. All of the goods are used manually. They have the same basic use, to change the nature of food whether by cutting, peeling or crushing. Mr Vanhegan argued that these goods, indeed, all of the goods, have the same channel of trade as they all appear in the Lockhart catalogue. As a distributor of equipment to the catering industry it is not surprising that Lockhart supplies all manner of goods, this ranges from furniture to ashtrays to clocks. All of the goods of the application and the earlier trade mark could well appear in a kitchen supply shop and so there is to some extent a common channel of trade. One might use a knife to peel or core fruit; a knife to make chips or to crush garlic etc. However, that knives could be used for the same purpose does not mean automatically that such goods are in competition with one another; that the purchase of the products of Plant would be an alternative to the purchase of the products of Rousselon. In my view the goods of the application under consideration here have specialist functions and will be bought for these functions; knives will be bought for more general purposes. Consequently, I do not consider that the goods are in competition with one another. I cannot see that the goods under consideration have a dependent or symbiotic relationship with one another and so do not consider that they are complementary. (Owing to the nature of the goods I do not consider that the issue of the goods being aesthetically complementary comes into play.) **Although there are some areas of divergence, I find that *hand implements (hand operated), household and kitchen utensils, peelers, corers, cake slicers, scissors, mandolins, pasta cutters, food graters, shredders, cutters, pressers, chippers, slicers, mincers (non-electric); mills for domestic purposes, hand-operated food processors, food mashers, garlic presses, orange and lemon zesters* are similar to the goods of the earlier registration.**

61) *Electric knife sharpeners and machines* serve the same purpose as *sharpening steels*, ie to sharpen knives. A machine and a steel has a different nature. One can choose to purchase a steel or a machine to achieve the same purpose, consequently, the respective goods are in competition with one another. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. The goods do not share a dependent or symbiotic relationship, so I do not consider that they

are complementary to each other. **Owing to the respective goods having the same use and being in competition with one another, I consider that they are similar.**

62) *Cookware; stainless steel, aluminium, tri-ply, copper, hard anodized aluminium, cast-iron and cast aluminium cookware; frying pans, roasting pans, steamers, casseroles, poachers, stockpots, roasting dishes, saucepans and woks; bakeware and cast-iron cookware* are all goods within which food is cooked. These goods, therefore, do not have the same purpose as the goods of the earlier registration. These goods cannot be substituted for the goods of the earlier trade mark, they are not in competition. I cannot see that the goods under consideration have a dependent or symbiotic relationship with one another and so do not consider that they are complementary. (Owing to the nature of the goods I do not consider that the issue of the goods being aesthetically complementary comes into play.) I cannot see any similarities in the methods of use of the goods or their nature. Mr Vanhegan considered that it was significant that saucepans could be seen on a stand adjacent to Rousselon's knives in John Lewis in Watford. I would note that one example cannot be taken as a trend and that this might have more to do with a lack of space than a conscious categorisation. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. **The only area of similarity lies with the fact that all of the goods are used in the process of cooking food. Although the goods of the earlier trade mark are used in the preparation of food and the goods of the application in the cooking of the food, so any similarity is extremely limited.**

63) I cannot see where there is any area of meaningful coincidence between the goods of the earlier registration and *household or kitchen containers (not of precious metal or coated therewith), steelwool and buckets*. (The containers will not include containers specifically designed for knives as these are in class 8.) Mr Vanhegan argued that one area of similarity was that all of the goods could be found in the kitchen. Washing machines are often found in the kitchen, I do not see that this gives rise to any meaningful similarity. If there is any element of similarity between the goods in question it is so slight that it cannot be conflated with the goods being similar. **I find that *household or kitchen containers (not of precious metal or coated therewith), steelwool and buckets* are not similar to the goods of the earlier registration.**

64) *Knife holders* serve no purpose without knives, they are complementary to a high degree to the goods of the earlier registration. In my experience, and as shown in the evidence, it is not uncommon for *knives* to be sold as a set with *knife holders*, in such circumstances there will be an identity of channels of trade. The users of the respective goods will of necessity be the same. **I find that *knife holders* are highly similar to the goods of the earlier registration.**

65) *Skewers* in classes 8 and 21 are used for cooking. *Skewers* in class 8 will be of metal, as are goods of the earlier registration primarily. These goods cannot be substituted for the goods of the earlier trade mark, they are not in competition. I cannot see that the

goods under consideration have a dependent or symbiotic relationship with one another and so do not consider that they are complementary. (Owing to the nature of the goods I do not consider that the issue of the goods being aesthetically complementary comes into play.) I cannot see any similarities in the methods of use of the goods. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. **The only area of similarity lies with the fact that all of the goods are used in the process of cooking food. Although the goods of the earlier trade mark are used in the preparation of food and skewers in the cooking of the food, any similarity is very limited.**

66) *Tongs for food, spatulas, spoons and food scoops* are all products that are used for serving food. Consequently, there is a common intended purpose with *forks for carving*. There is nothing to suggest a complementary or competitive relationship with the goods of the earlier registration; there is no dependency, symbiotic relationship or natural substitution of products. All of the respective goods could be of metal. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. All of the respective goods are used in relation to food. **I consider that there is a degree of similarity between *tongs for food, spatulas, spoons and food scoops* and *forks for carving*.**

67) *Juice pressers, fruit squeezers* in class 21 are products that are manually operated to extract juice. Their intended purpose is, therefore, not the same as the products of the earlier registration. They are goods that could be made of metal, like the goods of the earlier registration. The respective goods do not share a common method of use. One set of goods is not an alternative for the other, they are not in competition. There is no dependent or symbiotic relationship, they are not complementary. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. All of the respective goods are used in the preparation of food. **I consider that there is an extremely limited degree of similarity between *juice pressers and fruit squeezers* and the goods of the earlier registration.**

68) *Corkscrews, bottle openers, can-openers (non-electric), can-openers (electric)* are all used for opening containers of food or drink. They do not share a common purpose with the goods of the earlier registration. The first three are all hand operated and could be of metal, and so have this similarity with the goods of the earlier registration. Some can-openers (non-electric) use a blade that is forced into the tin (an example of this type of tin opener can be seen on page 35 of the catalogue (exhibit 3)). One set of goods is not an alternative for the other, they are not in competition. There is no dependent or symbiotic relationship, they are not complementary. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a

department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. All of the respective goods are used in the preparation of food. These goods are not used directly in the preparation of food, they are the means of getting to a food or beverage. **Owing to the quantity and extent of the differences between *can-openers (electric)* and the goods of the earlier registration, I do not consider the respective goods to be similar. There is a low degree of similarity between *can-openers (non-electric)* and the goods of the earlier registration and a yet lower degree of similarity between *corkscrews* and *bottle openers* and the goods of the earlier registration.**

69) *Cutlery* will include knives and forks but, taking into account the normal interpretation of the term, they will not be interchangeable with the knives and forks of the earlier registration. It could be a very perilous eating experience that uses a kitchen knife and a carving fork for instance. I do not consider that the goods are in competition with one another. There is no dependent relationship between the respective goods. It is possible that in relation to a carving fork, that could be used at the table, that the goods could be aesthetically complementary; the fork being of the same design and style as the cutlery^{xxiii}. (In my experience it is not uncommon for people to desire a common design or style in relation to table settings and all that is set upon the table.) All of the goods are quite likely to be of metal; all of the knives are for cutting, all of the forks for holding food. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. However, it is quite possible in a department store that *cutlery* will be in proximity to crockery and table linen rather than cooking utensils. **Taking into account the similarities, whilst balancing the dissimilarities, I consider that *cutlery* is similar to the goods of the earlier registration.**

70) Without knives *chopping boards* would have no purpose, they have a dependent, if not mutually dependent, relationship with knives and, so, are complementary. *Chopping boards* are not a substitute for the goods of the earlier registration, they are not in competition. In my experience *chopping boards* are made of wood, marble, glass or plastic; so they are not made of the same material as the goods of the earlier registration. The purpose of the board is to effect the cutting of food, the same purpose as the knives of the earlier registration; this identity of purpose means that the user of the goods is likely to be the same. **I consider that there is a high degree of similarity between *chopping boards* and the goods of the earlier registration.**

71) *Salt and pepper mills* are discrete items with very specific functions. They do not have the same purpose as the goods of the earlier registration. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. They could be of metal, as the goods of the registration are. One set of goods is not an alternative for the other, they are not in competition. There is no dependent or symbiotic relationship, they are not complementary. All of the respective goods are used in the

preparation of food. They can be used in the preparation of foods but will not have direct contact with the food, unlike the goods of the earlier registration. **I consider that the similarities that exist between the goods are very limited and there are marked dissimilarities, if the similarities can lead to the respective goods being considered similar it is at the very lowest level.**

72) *Corn-on-the cob holders* are used to facilitate the eating of corn on the cob. They and the goods of the earlier registration could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. Their purpose is to allow for the eating of a particular food product, so they do not have a common purpose with the goods of the earlier registration. One set of goods is not an alternative for the other, they are not in competition. There is no dependent or symbiotic relationship, they are not complementary. *Corn-on-the cob holders* are quite likely to be of metal and so of the same material as the goods of the earlier registration. **I consider that the similarities that exist between the goods are very limited and there are marked dissimilarities, if the similarities can lead to the respective goods being considered similar it is at the very lowest level.**

73) *Replacement blades* for the class 7 goods of the application will be for cutting, as the knives of the earlier registration are; so they have the same purpose. This identity of purpose means that the user is likely to be the same. They will be of metal, like the goods of the earlier registration. A blade for a machine cannot be substituted for a knife, I do not consider that they are in competition. There is no dependent or symbiotic relationship between *replacement blades* and the goods of the earlier registration, they are complementary goods. Such blades are likely to be found in the area of a shop selling kitchen machines, not with the knives. **There are various differences between the respective goods, however, taking into account the identity of purpose, the identity of material and the identity of the user, I consider that there is a high degree of similarity between *replacement blades* and the knives of the earlier registration.**

74) The Registry's classification data base shows that *hand tools* in class 8 include such goods as butchers' saws, hand tools for culinary use and potato mashers. Taking the first item, these goods have the same purpose, they will be made of the same material, they have the same users, they could be used with each other in the carving up of carcasses (and so are complementary to a certain degree). The principle identified in paragraph 58 (goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application) must logically equally apply to similar goods. **Consequently, taking all the above factors into account I consider that *hand tools* are highly similar to the goods of the earlier registration.**

75) *Food processors; potato peelers; mandolins and food slicing machines*, being in class 7, are all powered machines. They are all goods for the preparation of food. Like the knives of the earlier registration they can all be used for cutting or peeling food.

Consequently, these goods have the same purpose as the knives of the earlier registration. This identity of purpose means that they will have the same users. These goods differ from the goods of the earlier registration by being powered, and by being machines; they are not of the same nature. There is no dependent or symbiotic relationship, they are not complementary. In the kitchen one might choose between using a knife to chop up or peel foods or use one of the machines under consideration here. Although there is this alternative in the kitchen, I cannot see that the purchasing of one of the machines under consideration would be an alternative to purchasing one of the knives of the earlier registration. I cannot imagine, for instance, that a potential customer would consider that a knife was a reasonable alternative to a *potato peeler*, being a machine. Consequently, although in the kitchen the goods might be alternatives, they are not alternatives in the purchasing process and so, in my view, are not in competition. *Food processors; potato peelers; mandolins and food slicing machines* are likely to be found in the area of a shop specifically selling powered kitchen machines, an area discrete to that selling the goods of the earlier registration. **Taking into account the points of confluence and difference I consider that there is a degree of similarity between *food processors; potato peelers; mandolins and food slicing machines* and the knives of the earlier registration. As machines for domestic and/or kitchen use will include *food processors; potato peelers; mandolins and food slicing machines*, the former goods must be considered to have the same level of similarity (see paragraph 74 re this issue).**

76) *Presses for foodstuffs* will include such things as presses for making hamburgers and pizzas. Like the goods of the earlier registration they are goods for the preparation of food. They are not for cutting. There is a similarity of purpose but it is at a very general level. These goods differ from the goods of the earlier registration by being powered, and by being machines; they are not of the same nature. There is no dependent or symbiotic relationship, they are not complementary. The respective goods are not alternatives for each other, they are not in competition. *Presses for foodstuffs* are likely to be found in the area of a shop specifically selling powered kitchen machines, an area discrete to that selling the goods of the earlier registration. **I consider that the similarities that exist between the goods are very limited and there are marked dissimilarities, if the similarities can lead to the respective goods being considered similar it is at the very lowest level.**

77) *Coffee grinders* have a purpose that is not fulfilled by the goods of the earlier registration. Like the goods of the earlier registration they are goods for the preparation of food. They are not for cutting. There is a similarity of purpose but it is at the most general and abstract of levels. These goods differ from the goods of the earlier registration by being powered, and by being machines; they are not of the same nature. There is no dependent or symbiotic relationship, they are not complementary. The respective goods are not alternatives for each other, they are not in competition. *Coffee grinders* are likely to be found in the area of a shop specifically selling coffee making equipment, an area discrete to that selling the goods of the earlier registration. **Taking into account the marked dissimilarities between the goods and the one exceptionally general area where there is a similarity, I consider that *coffee grinders* are not**

similar to the goods of the earlier registration. (Having a similarity cannot be conflated into being similar^{xxiv}.)

78) This leaves the class 25 goods of the application. They do not have the same purpose as the goods of the earlier registration. The goods could be sold in the same kitchen goods supplier but it seems unlikely that they will be in the same area of the store. In a department store they may be in greater proximity as there is likely to be a limited space for cooking related products, and a limited range of such products. The goods are of different materials. They are of a very different nature. One set of goods is not an alternative for the other, they are not in competition. There is no dependent or symbiotic relationship, they are not complementary. Mr Vanhegan considered that Rousselon's case was at its weakest in relation to the class 25 goods. I consider that someone cooking would wear the class 25 goods does not represent a basis for considering that these goods are similar to the goods of the earlier registration. In my view these are clearly dissimilar goods that would need to be caught by section 5(3) of the Act rather than section 5(2) of the Act. **I consider that the class 25 goods of the application are dissimilar to the goods of the earlier registration.**

79) The Rousselon catalogue shows the sale of such goods as jar openers, graters, stoners, tin openers, corkscrews, egg cups and skewers but the fact that Rousselon sells such goods does not establish a similarity within the parameters of the case law applying to the assessment of similarity. The catalogue also shows the sale of toothpicks. All that the catalogue establishes is that Rousselon sells such goods.

Comparison of trade marks

80) The trade marks to be compared are:

Rousselon's trade mark:

SABATIER

Plant's trade marks:



81) I did not understand counsel to argue that there was anything in the series of trade marks that required them to be dealt with separately. I have to consider the trade mark as registered, not the nature of the use provided in the proof of use claim^{xxv}.

82) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xxvi}. 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^{xxvii}. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xxviii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xxix}.

83) The trade marks coincide in relation to the word SABATIER. This has to be the distinctive and dominant element of Rousselon's trade mark as it is the only element of it. One of the premises of Mr Mitcheson's argument in relation to similarity was that SABATIER, owing to the use by others, was not a distinctive and dominant element of Plant's trade mark. The issue of similarity has to be seen through the eyes of the average consumer. The educated consumer knows that SABATIER does not indicate one undertaking for the goods of the earlier registration. However, there is nothing to suggest that the average consumer will be aware of this. I consider that the average consumer, the man or woman on the street, will see SABATIER as an indicator of origin. He or she will be mistaken in his or her belief but that will be his or her belief. I consider that Plant's trade marks fall into three parts: MASTERCLASS, the device of a mortar board and SABATIER. In relation to the goods of the application, I consider that each of these elements is distinctive; owing to its size and position I consider that MASTERCLASS is the most dominant element of the trade marks but it certainly does not swamp the SABATIER element. I cannot see that MASTERCLASS or the device of a mortar board is in any way descriptive or even clearly allusive to the goods. These elements evoke, in my view, an idea of goods of high quality, the sort of goods that would be used by an excellent cook. This evocation does not translate into anything that undermines the distinctiveness of these elements; one of the purposes of trade marks is to try and evoke positive feelings in the potential purchaser. The MASTERCLASS and mortar board elements are completely alien to the earlier trade mark. However, the presence of SABATIER does give rise to similarities both visually and phonetically. I am of the view that SABATIER is a relevant element of Plant's trade marks and so the trade marks must be considered to be similar^{xxx}. (I bear in mind that I must take into account all elements of the trade marks together when considering similarity^{xxxi}.)

Conclusion

84) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between services, and vice versa^{xxxii}. In this case some of the goods are identical, in relation to other goods there are varying degrees of similarity. Some of the goods are not similar and so there cannot be a likelihood of confusion in relation to these goods^{xxxiii}. It is necessary to

consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion^{xxxiv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xxxv}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods 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^{xxxvi}. As my analysis of the evidence in relation section 5(3) indicates, Rousselon cannot look to reputation to increase the distinctiveness of its trade mark; nor to help in relation to goods that are only distantly similar. The leitmotif of this case returns; the use of SABATIER by others and its effect on the analysis of the issues before me. There is no evidence to suggest the SABATIER describes a particular type of knife, despite the submissions of Mr Mitcheson to this effect. It is a sign that is used by various undertakings in relation to knives; does this mean that it does not have a capacity to distinguish the goods of Rousselon from those of other undertakings, and so has limited distinctiveness? Again I go back to the man or woman on the street as the average consumer. For him or her, there is nothing to suggest that SABATIER has any meaning, or that it is used by a number of undertakings. SABATIER is a French surname, an alien word in the United Kingdom; so without knowledge of the other users of the sign, it will be highly distinctive to him or her. He or she will be likely to confuse various SABATIER trade marks, but it is not a defence for Plant to say that there is already confusion in the marketplace so the addition of its trade mark should be allowed. The question under section 5(2)(b) is one as to whether there will be confusion; in this case, whether the man or woman on the street knowing Rousselon's trade mark and seeing Plant's trade mark in relation to the goods of the application would believe that the goods emanate from the same undertaking or an economically linked undertaking.

85) In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* Case C-120/04 the ECJ held that in order "to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark"^{xxxvii}. In this case I consider that the use of SABATIER in the trade marks of Plant still has this independent, distinctive rôle; the impression that is created by the trade marks is that the goods are SABATIER goods. I consider that this independent, distinctive rôle makes an impression on the trade marks and the effect of the trade marks, how they will be perceived by the man or woman on the street. This independent, distinctive rôle will, in my view, give rise to confusion in instances where there is a limited degree of similarity of goods. However, where the respective goods are on the boundaries of what can be considered to be similar, I do not consider that there is a likelihood of confusion. (In these cases it is a moot point as to whether the point or points of similarity is sufficient to give rise to the respective goods being similar. One has to be careful not to conflate having a similarity or similarities with being similar.)

86) Taking all the above into account, I find that, if I am wrong in relation to the proof of use issue, that the application should be refused, under section 5(2)(b), for the following goods:

machines for domestic and/or kitchen use; food processors, potato peelers; coffee grinders; electric knife sharpeners and machines; mandolins and food slicing machines; replacement blades;

hand tools and implements (hand operated); cutlery; can-openers (non-electric); peelers, corers, tongs for food, skewers, knife holders; knives, kitchen knives, forks, cutlery, spoons, cake slicers, spatulas, pasta cutters; scissors, scissor-sharpening apparatus, knife sharpening apparatus; mandolins;

household or kitchen utensils (not of precious metal or coated therewith); food graters, shredders, cutters, pressers, chippers, slicers; chopping boards; mincers (non-electric); mills for domestic purposes; hand-operated food processors; food mashers; garlic presses; skewers, orange and lemon zesters; food scoops.

COSTS

87) Owing to my decision re the proof of use, the opposition is rejected in its entirety. Consequently, Plant is entitled to a contribution towards its costs. I award costs on the following basis:

Considering notice of opposition	£200
Counterstatement	£300
Considering evidence of Inc	£750
Preparation and attendance at hearing	£1,000
Total	£2,250

88) I order Rousselon Freres et Cie to pay Thomas Plant (Birmingham) Limited the sum of £2,250. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of September 2007

David Landau
For the Registrar
the Comptroller-General

ⁱ “17. As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. The Registrar's view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar's preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

ⁱⁱ Section 6A of the Act reads:

“(1) This section applies where –

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

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

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

ⁱⁱⁱ “If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

^{iv} In relation to consent and exhaustion of right Jacob LJ in *Mastercigars Direct Ltd and another v Corporacion Habanos SA* [2007] RPC 24 said:

“23. I do not think these cases advance the argument one whit. They are decisions that the facts in those cases (which differ markedly from those here) did not establish that consent must be inferred. The plain fact is that in *Davidoff* the ECJ rejected the French Government's submission that consent must always be express and has said there may be cases where one can conclude from the facts that consent was given. The real question is whether that is made out on the facts and circumstances of this case.”

This related to consent in relation to exhaustion of right rather than use in a non-use case, however, the basic principle seems to hold good in relation to the latter type of case where there has been no express consent.

^v *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25, Lord Walker:

“40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal:“... use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.”(This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

^{vi} “30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

32 In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

^{vii} *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25.

^{viii} *Casellblanch, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-29/04:

“33 In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company, as is the case particularly in the context of the automobile and wine industries.

34 That approach must be followed. The situation is not that the intervener’s mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice.”

^{ix} *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-416/04 P:

“71 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (see, to that effect, order in *La Mer Technology*, paragraph 22).

72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

^x *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services

directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

^{xi} *Björnekulla Fruktindustrier AB v Procordia Food AB* Case C-371/02:

“20 The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, inter alia, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality (*Canon*, paragraph 28).”

^{xii} *Björnekulla Fruktindustrier AB v Procordia Food AB* Case C-371/02.

^{xiii} Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”.

^{xiv} Section 5(3) of the Act reads:

“ A trade mark which is identical with or similar to an earlier trade mark, 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.”

In *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 (*Chevy*) ECJ set out the requirements for reputation under section 5(3) of the Act:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

^{xv} *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05. This was also the position of Professor Annand, sitting as the appointed person in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04.

^{xvi} The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

^{xvii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xviii} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{xix} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{xx} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xxi} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{xxii} *BVBA Management, Training en Consultancy v Benelux-Merkenbureau C- 239/05.*

^{xxiii} The Court of First Instance (CFI) in *El Corte Inglés SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 443/05* held that goods may be considered complementary if they “have a common aesthetic function by jointly contributing to the external image (‘look’) of the consumer concerned”. (Also see *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 150/04*. A common aesthetic function can clearly arise in relation to other goods which are often co-ordinated for aesthetic purpose, table settings for instance.

^{xxiv} See for instance the judgment of the CFI in *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-105/05:*

“34 Lastly, it should be stated that there is a degree of complementarity between some articles of glassware, in particular wine glasses, carafes and decanters, on the one hand, and wine, on the other, in so far as the first group of products is intended to be used for drinking wine. However, in so far as wine may be drunk from other vessels and the articles of glassware mentioned above can be used for other purposes, that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods in question are similar within the terms of Article 8(1)(b) of Regulation No 40/94.”

^{xxv} *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03:*

“65 Before examining the visual, phonetic and conceptual comparison of the signs carried out by the Board of Appeal, it is necessary to reject the applicant’s argument that the Board of Appeal ought to have examined the earlier national mark not as it was registered but as it was used, by the sign reproduced in paragraph 10 above.

66 It is important to note that, under the provisions of Regulation No 40/94 governing examination of opposition to registration of a Community trade mark, the purpose of demonstrating genuine use of an earlier national mark is to provide a means for its proprietor, at the express request of the Community trade mark applicant, to furnish proof that during the period of five years preceding the date of publication of the Community trade mark application its mark has been put to actual and genuine use on the market. In accordance with Article 15(2)(a) and Article 43(2) and (3) of Regulation No 40/94, that proof also applies where the sign used differs from the earlier mark as it was registered in elements which do not alter the distinctive character of the mark. In the absence of such demonstration, in particular if the elements used alter the distinctive character of the earlier mark, or in the absence of demonstration of justifiable grounds for lack of use, the opposition must be dismissed. Accordingly, demonstration of genuine use of an earlier mark in connection with opposition proceedings has neither the aim nor the effect of granting its proprietor protection for a sign or elements of a sign which have not been registered. Accepting the opposite argument would lead to unlawful extension of the protection enjoyed by the proprietor of an earlier mark which is the basis of an opposition to registration of a Community trade mark.

67 In this case, since the applicant registered only the earlier mark as reproduced in paragraph 5 above, which is the basis of the opposition on which the Board of Appeal was asked to rule in the contested decision, only that mark enjoys the protection accorded to earlier registered trade marks. It is therefore also

that mark which, for the purposes of examination of the opposition, had to be compared with the mark applied for, as the Opposition Division and the Board of Appeal legitimately did, in respect of the goods for which the proof of genuine use had been furnished by the applicant, in this case ‘watches and watch bands or straps’ in Class 14.”

^{xxvi} *Sabel BV v Puma AG* [1998] RPC 199.

^{xxvii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xxviii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^{xxix} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xxx} “*Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-363/04:

“98 It must also be recalled that, according to case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30, and Case T-168/04 *L & D v OHIM – Sämann (Aire Limpio)* [2006] ECR II-0000, paragraph 91).”

^{xxxi} See the judgment of the ECJ in *Société des Produits Nestlé SA c Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case C-193/06 re the need to take all elements into account when considering visual similarity:

“35 En particulier, la Cour a jugé à cet égard que, dans le cadre de l’examen de l’existence d’un risque de confusion, l’appréciation de la similitude entre deux marques ne peut se limiter à prendre en considération uniquement un composant d’une marque complexe et à le comparer avec une autre marque. Il y a lieu, au contraire, d’opérer la comparaison en examinant les marques en cause considérées chacune dans son ensemble (voir, en ce sens, ordonnance *Matratzen Concord/OHMI*, précitée, point 32, ainsi que arrêts précités *Medion*, point 29, et *OHMI/Shaker*, point 41).

41 Certes, au point 50 de l’arrêt attaqué, le Tribunal a examiné l’importance de l’élément figuratif propre à la marque demandée par rapport à son élément verbal. Toutefois, ayant constaté que cet élément figuratif n’est pas dominant par rapport à l’élément verbal, en ce sens que son intensité est égale ou inférieure à l’élément verbal et que ce dernier ne saurait donc être considéré comme subsidiaire ou négligeable, il a estimé pouvoir conclure à l’existence d’une similitude visuelle entre les signes en cause sur le seul fondement de la similitude des éléments verbaux, sans examiner, à ce stade ultime de son appréciation sur ce point, l’impression d’ensemble résultant, pour la marque demandée, de la combinaison d’un élément verbal et d’un élément figuratif.

42 Il est vrai que, selon la jurisprudence, l’impression d’ensemble produite dans la mémoire du public pertinent par une marque complexe peut, dans certaines circonstances, être dominée par un ou plusieurs de ses composants (voir, en ce sens, ordonnance *Matratzen Concord/OHMI*, précitée, point 32, et arrêts précités *Medion*, point 29, ainsi que *OHMI/Shaker*, point 41).

43 Toutefois, ainsi que la Cour l’a déjà jugé, ce n’est que si tous les autres composants de la marque sont négligeables que l’appréciation de la similitude pourra se faire sur la seule base de l’élément dominant (arrêt *OHMI/Shaker*, précité, point 42). Tel pourrait notamment être le cas, ainsi que le Tribunal l’a relevé au point 47 de l’arrêt attaqué, lorsqu’un composant d’une marque complexe est susceptible de dominer à lui seul l’image de cette marque que le public pertinent garde en mémoire, de telle sorte que le ou les autres composants de cette marque est ou sont négligeables dans l’impression d’ensemble produite par celle-ci.

46 Il en résulte que l'appréciation opérée par le Tribunal repose, aux points 48 à 50 de l'arrêt attaqué, sur la présomption selon laquelle, lorsqu'une marque complexe est composée à la fois d'un élément verbal et d'un élément figuratif, et que ce dernier est d'une intensité égale ou inférieure au premier, l'appréciation de la similitude visuelle des signes en cause peut être établie sur la seule base de la similitude des éléments verbaux, de sorte que, à intensité égale, ce sont uniquement ces derniers qui déterminent la similitude visuelle desdits signes.

47 Il s'ensuit que le Tribunal, en n'ayant pas apprécié la similitude visuelle des signes en cause sur la base de l'impression d'ensemble produite par ceux-ci, a méconnu l'article 8, paragraphe 1, sous b), du règlement n° 40/94 et que, partant, les points 48 à 50 de l'arrêt attaqué sont, à cet égard, entachés d'une erreur de droit."

^{xxxii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xxxiii} See for instance *Eurodrive Services and Distribution NV c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Case T- 31/04* and *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-202/03*.

^{xxxiv} *Sabel BV v Puma AG* [1998] RPC 199.

^{xxxv} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xxxvi} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

^{xxxvii} "29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”