

O-299-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2654894  
BY PROVENANCE BRANDS LIMITED TO REGISTER THE  
TRADE MARK**

**PROVENANCE BRANDS**

**IN CLASSES 3, 5, 21, 25, 29, 30, 31, 32, 33, 35, 43 & 44**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 400549  
BY PROVENANCE INNS LIMITED**

## Background and pleadings

1) Provenance Brands Limited (“the applicant”) applied to register the mark PROVENANCE BRANDS in the UK on 5 March 2013. It was accepted and published in the Trade Marks Journal on 12 April 2013 in respect of numerous goods and services. In respect of these proceedings, only the following of the applicant’s list of goods and services is relevant:

**Class 29:** *Meat; fish; poultry; game; sea food; meat extracts; preserved, dried, frozen and cooked fruits and vegetables; salads; nuts; jellies; jams; eggs; egg products; milk; milk products; butter; cheese; cream; yoghurts; edible oils and fats; prepared meals; soups; crisps.*

**Class 30:** *Coffee; tea; cocoa; sugar; rice; pasta; flour; preparations made from cereals; breakfast cereals; bread; bread products; sandwiches; pizza; pastries; pastry products; pies; cakes; bakery goods; bakery desserts; puddings; biscuits; confectionary; sweets; chocolate; ices; ice cream; honey; yeast; salt; sauces; condiments; relishes; pepper; dressings; flavourings; seasonings; spices; prepared meals.*

**Class 31:** *Fresh fruit; fresh vegetables; herbs; natural plants; natural flowers.*

**Class 32:** *Beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; syrups for making beverages; smoothies; non-alcoholic beers and wines.*

**Class 33:** *Alcoholic beverages excluding whisky, spirits and liquors, but including wine; alcopops; cocktails; bitters; cider; perry; port; sherry.*

**Class 35:** *...; retail services connected with the sale of ..., food and beverages, alcoholic and non-alcoholic beverages, including such services provided online from a computer database or via the Internet.*

**Class 43:** *Provision of and services for providing food and drink; restaurant, bar, catering, canteen, cafeteria, café, coffee shop, bakery, take-away food and snack bar services; preparation of food and drinks.*

2) Provenance Inns Limited (“the opponent”) partially opposes the mark (in respect of the goods and services listed above) on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK mark 2554152. The relevant details of this earlier mark are:

PROVENANCE

Filing date: 26 February 2013

Date of entry in register: 14 June 2013

**Class 43:** *Restaurant services; accomodation services; hotel, motel, bar, cafe, inn, public house and pub services; banqueting and catering services; provision of facilities for the consumption of alcoholic and non-alcoholic*

*beverages; provision of facilities for meetings, seminars, conferences and baquets, and for exhibitions; hotel accomodation reservation services.*

3) The opponent argues that the respective marks are “in effect identical”. In respect of the goods and services, it argues that they are identical or similar because all of the applicant’s goods may be provided through the services of the opponent.

4) The applicant filed a counterstatement denying the claims made. It provides detailed submissions that I will not summarise here, but will keep in mind and refer to, as necessary, later in my decision.

5) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

## **Opponent’s Evidence**

6) Mr Michael Robert Harrison, a registered Trade Mark Attorney with the opponent’s representatives, Harrison IP, has provided a witness statement. He states that it is the intention of the opponent to sell food and drink through retail establishments and over the Internet. He further states that this development of the opponent’s activities is a natural progression of a business involving the purveying of food and drink. In support of this he refers to *Carluccio’s*, *Ottolenghi* and *Harrods* as examples of third parties who provide both restaurant services and retail of food and drink.

## **Applicant’s Evidence**

7) Dr Mark Sullivan, director of the applicant, filled a witness statement. He identifies a number of public houses that the opponent operates in Yorkshire. He states that

- the applicant has no intention of promoting its goods in Yorkshire and only wishes to use its mark to promote goods of West Country provenance;
- the core business of the applicant is food production and processing. In addition he provides details of a bakery business owned by the applicant that sells its goods through its retail outlets;
- the businesses owned by the applicant will provide their goods under existing marks (different to the applied for mark) and it is these marks that the consumer will be exposed;
- the applicant’s activities and use of its mark involves the retail of food and drink via various channels, including stores, online and cafes, but not pubs, inns, hotels or motels;
- there has been no known instances of confusion.

## **Opponent’s Evidence in reply**

8) This takes the form of a witness statement by Mr Christopher James Blundell, chairman of the opponent. He states that from the outset, his intention was to

develop the opponent's business from the initial operating of public houses and inns to other related activities. Mr Blundell notes that Dr Sullivan stated that development of the applicant's logo has been put on hold suggesting that its mark is not currently being used and explains why there is no evidence of confusion.

## DECISION

9) Section 5(2)(b) reads:

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

(a) ...

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

10) In reaching my decision under this ground I bear in mind that the Court of Justice of the European Union (“the CJEU”) has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

## ***Comparison of goods and services***

11) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.'

12) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

13) 'Complementary' in the sense referred to in *Canon* was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

14) For ease of reference, the respective goods and services to be compared are:

Opponent's services	Applicant's goods
<p><b>Class 43:</b> <i>Restaurant services; accomodation services; hotel, motel, bar, cafe, inn, public house and pub services; banqueting and catering services; provision of facilities for the consumption of alcoholic and non-alcoholic beverages; provision of facilities for meetings, seminars, conferences and baquets, and for exhibitions; hotel accomodation reservation services.</i></p>	<p><b>Class 29:</b> <i>Meat; fish; poultry; game; sea food; meat extracts; preserved, dried, frozen and cooked fruits and vegetables; salads; nuts; jellies; jams; eggs; egg products; milk; milk products; butter; cheese; cream; yoghurts; edible oils and fats; prepared meals; soups; crisps.</i></p> <p><b>Class 30:</b> <i>Coffee; tea; cocoa; sugar; rice; pasta; flour; preparations made from cereals; breakfast cereals; bread; bread products; sandwiches; pizza; pastries; pastry products; pies; cakes; bakery goods; bakery desserts; puddings; biscuits; confectionary; sweets; chocolate; ices; ice cream; honey; yeast; salt; sauces; condiments; relishes; pepper; dressings; flavourings; seasonings; spices; prepared meals.</i></p> <p><b>Class 31:</b> <i>Fresh fruit; fresh vegetables; herbs; natural plants; natural flowers.</i></p> <p><b>Class 32:</b> <i>Beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; syrups for making beverages; smoothies; non-alcoholic beers and wines.</i></p> <p><b>Class 33:</b> <i>Alcoholic beverages excluding whisky, spirits and liquers, but including wine; alcopops; cocktails; bitters; cider; perry; port; sherry.</i></p> <p><b>Class 35:</b> <i>...; retail services connected with the sale of ..., food and beverages, alcoholic and non-alcoholic beverages, including such services provided online from a computer database or via the Internet.</i></p> <p><b>Class 43:</b> <i>Provision of and services for providing food and drink; restaurant, bar, catering, canteen, cafeteria, café, coffee shop, bakery, take-away food and snack bar services; preparation of food and drinks.</i></p>

**Class 29, Class 30 and Class 31**

15) The opponent refers to the Registry decision *Flaming Grill* O-198-12, where the hearing officer made a distinction between food products that were in competition with restaurant services and those that were not. This appears to me to be the correct approach. Applying this same approach to the current case, there is similarity between the opponent's *restaurant services, cafe, inn, banqueting and catering services* and the following of the applicant's goods:

**Class 29:** *prepared meals; salads; soups, ..*

**Class 30:** *sandwiches; pizza; pastries; pastry products, pies; cakes; bakery goods; bakery desserts; puddings;...ices, ice cream; prepared meals.*

16) The reason for this is that all these food products that may be ready to eat and may be chosen by the consumer as an alternative to visiting a restaurant or cafe. Consequently, they are in competition with each other. Further, they may share trade channels where, for example, an eating establishment may also prepare food such as sandwiches, pasties, cakes etc. for consumption off the premises.

17) In respect of the applicant's remaining goods in Class 29, Class 30 and Class 31, these are all in the nature of ingredients or constituents of meals, or they are goods to which other food goods are added; none of the listed goods are in the nature of prepared meals and so are not in competition to restaurant services etc. And as the hearing officer observed in *Flaming Grill* :

“ ...it [is] unlikely that there is a complementary relationship in such a way that consumers may think that the same undertaking is responsible for both supplying the unfinished ‘raw’ food goods (e.g. milk, eggs, meat) and the service. There is no shared nature, purpose or channel of trade, nor meaningful level of complementary or competitive relationship with the goods listed in this paragraph. There is no similarity between these goods and the opponent's services.”

18) I concur with the hearing officer in that case and find that there is no similarity between the opponent's services and the applicant's goods in Class 29, Class 30 and Class 31, other than those identified in paragraph 15, above.

### **Class 32**

19) In respect of the applicant's *beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; ...; smoothies; non-alcoholic beers and wines*, these are all similar to the opponent's *bar, café* [including licensed cafes], *inn, public house and pub services*. All these services involve the supply of alcoholic and non-alcoholic beverages, often as the primary purpose. In respect of both the goods and the services, the average consumer is likely to be the same. The purpose of both alcoholic and non-alcoholic beverages and the establishments providing the opponent's services are both to quench thirst and/or, in the case of alcoholic beverages, to seek the intoxication effect of alcohol. Consumers can chose to drink at home or on the premises of an establishment and consequently there is an element of competition between beverages and *bar, café, inn, public house and pub services*. As these establishments require beverages to ply their trade, the respective goods and services are also complementary.

20) The applicant's *syrups for making beverages* are ingredients for beverages and are therefore one step further removed from the opponent's services. In the same way as I have found that food ingredients are not similar to the opponent's services, I also find that that neither are the applicant's *syrups for making beverages*.

### **Class 33**

21) In respect of the applicant's *alcoholic beverages excluding whisky, spirits and liquors, but including wine; alcopops; cocktails; bitters; cider; perry; port; sherry*, these are all similar to the opponent's *bar, [licensed] café, inn, public house and pub services*. All these services involve the supply of alcoholic beverages, often as the primary purpose. In respect of both the goods and the services, the average consumer is likely to be the same. The purpose of both alcoholic beverages and the establishments providing the opponent's services are both to quench thirst and/or to seek the intoxication effect of alcohol. Consumers can chose to drink at home or in licensed premises and consequently there is an element of competition between alcoholic beverages and *bar, café (if licensed), inn, public house and pub services*. As these establishments require alcoholic beverages to ply their trade, the respective goods and services are also complementary.

### **Class 35**

22) The applicant's *retail services connected with the sale of ..., food..., including such services provided online from a computer database or via the Internet* includes the retail of food in the form of prepared meals or other foods consumed without further preparation, and consequently may be in competition with the opponent's restaurant and cafe services because the consumer may make an active choice between eating in one of these establishments or to purchase a prepared meal or other food to take home to eat. Whilst the nature and method of use of the respective services are different, they do have overlap in intended purpose because the intention is for both to provide prepared meals or other food to the consumer. Therefore, I conclude there is similarity between these respective services.

23) Similar considerations apply when considering the applicant's *retail services connected with the sale of ..., beverages, alcoholic and non-alcoholic beverages, including such services provided online from a computer database or via the Internet* and the opponent's *bar, cafe, inn, public house and pub services*. Here too, the consumer has the choice whether to access beverages in a pub or cafe or to purchase them from a retail outlet for consumption off the premises. Consequently, there is an element of competition. The nature and method of use of the respective services are different but they do overlap in respect of their intended purpose because the intention is for both services is to provide beverages to the consumer. I conclude there is similarity between these respective services.

### **Class 43**

24) In respect of the applicant's *provision of and services for providing food and drink; restaurant, bar, catering, canteen, cafeteria, café, coffee shop,... snack bar services, preparation of food and drinks*, these are all covered by the identical or broader terms included in the opponent's specification, namely *restaurant services; ..., bar, cafe, inn, public house and pub services; banqueting and catering services and provision of facilities for the consumption of alcoholic and non-alcoholic beverages*. I find that these respective services are identical.



25) The applicant's *take-away food services* are not identical to any of the opponent's services but there is a good deal of similarity with its restaurant and cafe services. This is because they are in competition with consumers having the choice to obtain food from a take away establishment or to eat in at a restaurant or cafe. Further, it is common for restaurants and cafes to also offer a take-away service for its food and consequently there can be overlap in trade channels. Further the intended purpose is also the same, namely to provide food to consumers in a prepared form and often hot.

26) Finally, in respect of the applicant's *bakery services*, this is the preparation of bakery products such as bread, cakes etc. The opponent's *cafe services* may also prepare its own bakery products, especially cakes. Consequently, these respective services may be in competition and share the same intended purpose. Taking this into account, I conclude there is a similarity between these services.

## Average consumer and the purchasing act

27) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

28) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods and services. In the current case this will depend on the nature of the food and drink establishment, the type of food sold and the prices charged, the attention of the consumer will vary. For example, a quick stop in a cafe will not result in the same level of attention being paid as when choosing to dine at an expensive restaurant. In the main, the purchaser will pay a reasonable amount but not the highest amount of attention. The purchasing process will be primarily visual, but oral use of the mark may also play a part.

## Comparison of marks

29) The respective marks are shown below:

Opponent's mark	Applicant's mark
PROVENANCE	PROVENANCE BRANDS

30) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details . 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; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

31) There cannot be an artificial dissection of the marks, although it is necessary 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 the them and is deemed to be reasonably well informed and reasonably circumspect and observant . The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

32) The applicant’s mark is not readily divided into separate components and its distinctiveness lying in its entirety. The opponent’s mark, on the other hand, does readily divide into the two words PROVENANCE and BRANDS. The second word will be perceived as being descriptive with the dominant and distinctive element being the word PROVENANCE. I keep this in mind.

33) Visually and aurally, both marks share the word PROVENANCE being the totality of the opponent's mark and the largest part of the applicant's mark. The word consists of three syllables with the applicant's mark also including a further sound BRANDS. Having regard for these observations, I conclude that the respective marks share a good deal of visual and aural similarity.

34) The word PROVENANCE means “the place of origin or earliest known history of something”<sup>1</sup>. With the presence of this word in both marks, the concept created by this word is identical in both. There is an additional concept present in the applicant’s mark, namely the word BRANDS, being the plural of the word “brand” meaning “a type of product manufactured by a particular company under a particular name”<sup>2</sup>. The applicant submits that the two words present in its mark are of equal importance because the word “brands” has the purpose of associating its various existing brands under one group. I agree that it may be perceived as indicating brands under a single banner of PROVENANCE, but this meaning is achieved because the average consumer will readily understand the descriptive meaning of the word “brands”. Whilst this word is absent in the opponent’s mark, the average consumer will, nonetheless, perceive both marks as being an indication of the product of a particular company that is identified by the name PROVENANCE.

35) The applicant also submits that the word PROVENANCE is a generic word commonly used in the food and drink industry. There is no evidence before me that

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<sup>1</sup> "provenance." Oxford Dictionary of English. Ed. Stevenson, Angus. : Oxford University Press, 2010. Oxford Reference. 2010. Date Accessed 16 Jun. 2014

<[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0668890](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0668890)>.

<sup>2</sup> "brand." Oxford Dictionary of English. Ed. Stevenson, Angus. : Oxford University Press, 2010. Oxford Reference. 2010. Date Accessed 16 Jun. 2014

<[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0099010](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0099010)>.

goes to this point. However, as I have observed above, the word PROVENANCE does have a meaning and this is likely to be understood by the consumer.

36) Taking all of this into account, I conclude that there is also a good deal of conceptual similarity.

### **Distinctive character of the earlier trade mark**

37) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

38) The opponent's evidence is unspecific regarding the scale of its food and drink purveying business other than that it operates six inns (as of April 2014) and there is no evidence of how the mark is used. In the absence of further information, I am unable to conclude that the opponent's mark benefits from any enhanced level of distinctive character arising from the use made of it. Therefore, I only have the inherent level of distinctive character to consider. The word PROVENANCE is an ordinary English word. The applicant submits that as a result of this (and its unsubstantiated claim that it is generic in the food and drinks industry) the opponent's mark does not have a highly distinctive character. It concludes that the opponent's mark is non-distinct. I do not agree with this conclusion. Whilst the word PROVENANCE may have a meaning understood by the consumer, it will serve to indicate trade origin for all goods and services including those covered by the opponent's mark. Further, when considering the issue, I keep Section 72 of the Act in mind. Accordingly, I must consider its registration as *prima facie* evidence of its validity and, hence, its distinctiveness (see also guidance to this effect in *Formula One Licensing BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-196/11P, paragraph 47). Of course, such distinctiveness may be the minimum required for registration, but I do not believe this is the case here. The word is not directly descriptive of the goods and services concerned, even if it were a word commonly used in the industry. It is no more than allusive. Taking all of this into account, I conclude that the opponent's mark is endowed with a reasonable level of distinctive character.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

39) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

40) The applicant cites a number of other PROVENANCE marks in Class 29, 30, 31 or 33, in the name of third parties, as support for its submission that the word PROVENANCE is common place and that these marks are only qualified by a second word present in each of the marks. I do not accept that the existence of three other marks incorporating the word PROVENACE is evidence of this. In reaching this conclusion, I am mindful of the following guidance of the General Court (“the GC”) in *Zero Industry Srl v OHIM* – T-400/06 (GC):

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

41) The opponent operates a number of pubs in Yorkshire and the applicant operates in the South West of England trading in bakery products and sea salt. The applicant submits that whilst it does have seating in some of its establishments, it does not currently operate restaurants and submits that its operations are not in competition with those of the opponent. I note this, but I am required to undertake my analysis of the parties’ marks based upon a notional and fair use analysis of the goods and services as claimed in the respective lists of goods and services. The current market situation with the two companies may change over time and therefore has little bearing on my considerations. In this respect (see, for example, the comments of the GC in *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-99/06).

42) Consequently, I dismiss the applicant’s claims based upon the current respective markets of the parties.

43) In his witness statement, Dr Sullivan claims that there have been no actual instances of confusion. In response, Mr Blundell comments that it appears that the applicant has yet to start using the applied for mark and therefore, it is not surprising there are no instances of confusion. This may be so, but regardless, it is well established that the relevance of an absence of confusion in the market place rarely has an influence on the outcome of cases based upon Section 5(2) of the Act (see *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 (HC), paragraph 22; *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] RPC 30 (HC), paragraph 99 and *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 (COA)).

44) The applicant also submits that the word PROVENANCE is not distinctive and only becomes so when another word is added to the mark, as is the case with its mark. I have already concluded that the word is distinctive. Rather, it is the word BRANDS that lacks distinctive character, providing no information to the consumer as to trade origin. When comparing the marks as a whole, the same distinctive element is present in both marks, being the only element of the opponent's mark and the dominant and distinctive element of the applicant's mark. I have also found a number of the respective goods and services are identical and similar and that the respective consumers of these goods and services will be the same or overlap and the purchasing process will involve a reasonable level (but not the highest amount) of attention and the purchasing process is primarily visual.

45) When taking all of the above into account, I conclude that where the respective goods and services are identical or similar there is a likelihood of direct confusion. This is where the consumer will confuse one mark for the other. Even where the consumer is aware of the addition of the word BRANDS in the applicant's mark, there is a likelihood of indirect confusion where the consumer will assume that the goods and services, provided under the respective marks, are provided by the same or linked undertaking.

46) In summary, I find that the opposition is successful in respect of the following list of the applicant's goods and services:

**Class 29:** *prepared meals; salads; soups, ..*

**Class 30:** *sandwiches; pizza; pastries; pastry products, pies; cakes; bakery goods; bakery desserts; puddings;..ices, ice creams; prepared meals.*

**Class 32:** *Beers; ales; mineral and aerated waters; non-alcoholic drinks; fruit drinks; fruit juice; ...; smoothies; non-alcoholic beers and wines.*

**Class 33:** *alcoholic beverages excluding whisky, spirits and liquors, but including wine; alcopops; cocktails; bitters; cider; perry; port; sherry.*

**Class 35:** *retail services connected with the sale of ..., food and beverages, alcoholic and non-alcoholic beverages, including such services provided online from a computer database or via the Internet.*

**Class 43:** *provision of and services for providing food and drink; restaurant, bar, catering, canteen, cafeteria, café, coffee shop, bakery, take-away food and snack bar services, preparation of food and drinks.*

47) The opposition fails in respect of the remainder of the applicant's goods and services subject to the opposition, namely:

**Class 29:** *Meat; fish; poultry; game; sea food; meat extracts; preserved, dried, frozen and cooked fruits and vegetables; ...; nuts; jellies; jams; eggs; egg products; milk; milk products; butter; cheese; cream; yoghurts; edible oils and fats; ...; crisps.*

**Class 30:** *Coffee; tea; cocoa; sugar; rice; pasta; flour; preparations made from cereals; breakfast cereals; bread; bread products; ...; biscuits; confectionary; sweets; chocolate; ...; honey; yeast; salt; sauces; condiments; relishes; pepper; dressings; flavourings; seasonings; spices; ....*

**Class 31:** *Fresh fruit; fresh vegetables; herbs; natural plants; natural flowers.*

**Class 32:** *...; syrups for making beverages; ...*

## **COSTS**

48) In his witness statement, Mr Sullivan submits that he has been “deeply frustrated” by the conduct of opponent in these proceedings, stating that he has not been contacted by the opponent at any stage, despite making it clear in open correspondence that he would be prepared to amend the current application to a limited extent, but that he has been frustrated by lack of engagement and long delays. He also identifies that the opposition was filed “at the 11<sup>th</sup> hour” and it only acted when deadlines spurred it into action. I have reviewed the file for these proceedings and I have found nothing unusual regarding the prosecution of the case or the time frames involved. When a party abides by the deadlines set, this must be taken as acceptable behaviour. The applicant may have wished for a more speedy response, but the opponent was under no obligation to do so. It filed its Form TM7 within the statutory opposition period, it filed its evidence within the deadline set by the Registry. It is not obvious to me that the applicant was any the more timely in the filing of its counterstatement or its evidence. Consequently, I do not consider it is appropriate to make an adjustment to the award of costs for alleged poor conduct by the opponent.

49) Turning to the level of the costs award, I keep in mind the comments of Ms Amanda Michaels, sitting as the Appointed Person in *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited*, BL O-197-11, where she stated the following in a case where one party was largely, but not wholly, successful:

“22. The starting point for the exercise of the discretion, as set out in CPR 44.3 and reflected in Johnsey, is that costs should follow the event. As CPR 44.3(2)(a) puts it “the general rule is that the unsuccessful party will be ordered to pay the costs of the successful party”. Nevertheless, as CPR 44.3(4) indicates, the judge “must have regard to all the circumstances” which may include “whether a party has succeeded on part of his case, even if he is not be wholly successful.” The court may therefore make different orders for the costs incurred in relation to discrete issues and should consider doing so where a party has been successful on one issue but unsuccessful on another.

...

Approaching the matter in accordance with CPR 44.3, it seems to me that NISA ought be considered the successful party and to have its costs, subject to a deduction of an amount to reflect the fact that it was not wholly successful in the invalidation application or in respect of the opposition based on subsection 5(2)(b). NISA was only unsuccessful in both the invalidation and

opposition proceedings in relation to a fairly narrow range of goods, yet in my judgment some credit should be given to Morrisons to reflect the result. Without a breakdown of the parties' costs by reference to the issues, a process which it would be disproportionate to ask the parties to undertake at this stage, making such a reduction is necessarily a rough and ready process. Doing the best I can, in my judgment it would be appropriate to reduce the costs awarded to NISA by 20% to reflect its partial level of success (save as stated in sub-paragraph 27(d) below)."

50) Accordingly, since the opponent has had some but not complete success, it is entitled to a contribution to its costs, offset by the partial failure of its opposition. The opponent has been successful in relation to various goods and services in Class 29, Class 30, Class 32, Class 33, Class 35 and Class 43. Its success rate, as a rough and ready measure, has been about 75%. Applying the scale of costs, I assess the costs contribution as follows:

Notice of Opposition and statement considering statement of case in reply (including official fee)	£500
Preparing and filing evidence & considering other side's evidence	£400
Filing written submissions	£400
Discount for partial success (25%)	(£325)
<b>TOTAL</b>	<b>£975</b>

51) I, therefore, order Provenance Brands Limited to pay Provenance Inns Limited the sum of £975. The above sum should 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 9th day of July 2014**

**Mark Bryant  
For the Registrar,  
The Comptroller-General**