

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 216351 and in the matter of an Opposition thereto.

COMPLETE CUISINE LIMITED

Applicant

CUISINE DE FRANCE LIMITED

Opponent

Application for registration

1. On 28 June, 1999, Complete Cuisine Limited, an Irish company, of The Food Centre, Raheen Industrial Estate, Limerick made application (No. 1999/02172) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the series of two marks shown below as a trade mark in respect of a specification of goods in Classes 16, 29 and 30 which was amended in the course of the examination of the application to read as indicated.



Class 16 : *Paper and plastic bags; carrier bags; bags of paper for foodstuffs, bags of plastic for packaging foodstuffs, bags included in Class 16; greaseproof paper, ovenproof paper, bakery papers, metal coated paper; labels; menus, brochures, paper napkins.*

Class 29 : *Meat, fish, poultry, game and bacon and products made from the aforesaid goods; meat extracts; prepared meals; eggs; jelly; jam; fruit sauces; fruit preserves and conserves; preserved, dried and cooked fruits and vegetables; butter; cheese; potato products included in Class 29; potato skins and wedges; black and white puddings; fillings included in Class 29; snack foods included in Class 29 all the aforementioned goods being included in class 29.*

Class 30 : *Non-medicated confectionery, bread, cakes, pies, pastries, biscuits, cereals and preparations made from cereals; bakery products, bread products and filled bakery products; confectionery in frozen forms; flour preparations; bread rolls, baps, bagels, waffles, croissants, sausage rolls, sandwiches; snack foods included in Class 30; spreads for bread; prepared meals; desserts; pizza, pizza bases and pizza toppings; edible ices; ice creams, ice cream confections, ice confections; sauces, dressings, mayonnaise and dips included in Class 30; spices all the aforementioned goods being included in class 30.*

2. The application was accepted for registration and advertised accordingly under No. 216351 in Journal No. 1898 on 6 September, 2000. The advertisement carried a noting to the effect that, in use, the second mark in the series would be in the colours blue and red.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 5 December, 2000 by Cuisine de France Limited of Belgard Square, Tallaght, Dublin 24. The Applicant filed a counter-statement on 9 March, 2001 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a Hearing before me, acting for the Controller, on 9 October, 2006. The parties were notified on 3 November, 2006 that I had decided to dismiss the opposition and to allow the application to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of opposition

5. In its notice of opposition the Opponent says that it is engaged in the manufacture and sale of bread and a variety of other food products and that it has been using its trade mark “Cuisine de France” (and device) for many years in connection with bread and other products, including products containing meat and/or fish. It refers to its proprietorship of Trade Mark Registrations Nos. B152606, B152607 and

214272¹ and then raises objection to the present application under the following Sections of the Act:

- Section 10(2)(b) – *likelihood of confusion on the part of the public,*
- Section 10(4)(a) – *use of mark liable to be prevented on the basis of unregistered prior rights,*
- Section 6(1) – *mark not capable of functioning as a trade mark for food products,*
- Section 8(1)(a) – *mark not a trade mark within the statutory definition,*
- Section 8(1)(b) – *mark devoid of any distinctive character,*
- Section 8(1)(c) – *mark consists exclusively of sign designating characteristics of the goods,*
- Section 8(3)(b) – *mark of such a nature as to deceive,* and
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law.*

Counter-statement

6. In its counter-statement the Applicant denies all of the grounds of opposition and admits only the Opponent's proprietorship of the trade mark registrations cited in the notice of opposition but it points out that the mark that it seeks to register is already registered at the Community Trade Mark Office alongside that of the Opponent.

Evidence²

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits CDF1-CDF3), dated 7 August, 2002, of Karen Coyle, Group Marketing Manager of the Opponent. I would summarise the averments made by Ms. Coyle as follows:

- the trade mark Cuisine de France (and device) was first used in the State in 1989 in connection with bread baked according to a traditional French recipe,

¹ details in Annex I

² review of the evidence confined to matters of fact or alleged fact

- in the period 1995-2001, turnover in bread, confectionery and savoury products sold under the mark exceeded IR£300 million and the amount spent on advertising exceeded IR£25 million,
- goods bearing the mark area available in over 3,000 outlets throughout the country,
- promotion of the mark has included advertisements in national newspapers and periodicals, trade publications, television broadcasts, outdoor hoardings and on the Opponent's fleet of vehicles which travel throughout the country delivering goods,
- prior to the Opponent's adoption of the word "Cuisine" for use in connection with its French bread, the word had never been used in connection with that product,
- the Opponent adopted the colours red, white and blue for use in its trade mark to emphasise the connection with French produce and devised special packaging for its goods bearing those colours together with a ribbon device,
- the Applicant's adoption of the word "Cuisine" as part of its trade mark together with other elements of the Opponent's mark, namely the colours red, white and blue and a ribbon device, suggest that the mark was adopted with the deliberate intention of trading on the Opponent's goodwill and with the deliberate and calculated intention to mislead the public as to the origin of the goods.

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits TH1-TH18) dated 27 August, 2003 of Tom Hanrahan, Managing Director of the Applicant. He refers to the fact that the Applicant has secured registration of its trade mark as a Community Trade Mark³, the

³ No. 1431949 dated 20 December, 1999

application for which was not opposed by the present Opponent. He then explains the history of the development of the trade mark that is the subject of the present application and the reasons for the adoption of the various elements that make up that mark – the words COMPLETE CUISINE and the devices of a ribbon (if it can be so called) and sheaves of wheat, together with the colours blue and red. As to the words, Mr. Hanrahan says (unsurprisingly) that COMPLETE was chosen to represent the large range of products available under the brand and that CUISINE was chosen to denote prepared foods of high quality. The figurative and colour elements of the mark owe their origin to the fact that an associated company of the Applicant previously distributed French bread for a U.K. company under the trade mark LE PAIN CROUSTILLANT in packaging containing those elements, which were then adopted by the Applicant for their symbolic significance in the development of the present mark. There are numerous other marks on the Register containing one or other of these elements. Mr. Hanrahan says that turnover in goods sold under the Applicant's mark has exceeded €10 million. The goods are sold in every city and nearly every large town in the State with over one hundred outlets in Dublin and the Applicant supplies its goods to most of the large retail groups including BWG (Spar/Mace), ADM Londis, Londis Top Shops, Costcutters and Mangans (Mace). The Applicant regularly exhibits at trade shows, including those at which the Opponent has exhibited and also advertises its products by way of road side hoardings and signs at selected outlets. Mr. Hanrahan states that, to his knowledge, no confusion has arisen between the Applicant's and the Opponent's trade marks notwithstanding that both have operated side by side since 1999.

Rule 22

9. Evidence submitted by the Opponent under Rule 22 consisted of a Statutory Declaration dated 3 November, 2004 of Norman MacLachlan, Partner in the firm of MacLachlan & Donaldson, the Opponent's Trade Mark Agents. Referring to the existence of the Applicant's Community Trade Mark, he says that this is not of current concern to the Opponent as it is in respect of the black and white version of the mark and it does not appear that the Applicant has used or intends to use that version. As to the existing registrations of trade marks containing elements that are also to be found in the Opponent's marks, Mr. MacLachlan says that, so

far as is known, only Trade Mark No. 203587, which contains the word CUISINE, is in use in the State and that that registration was restricted to products for sale to the catering trade following an opposition by the present Opponent.

Hearing and issues for decision

10. At the hearing the Opponent was represented by the aforementioned Norman MacLachlan and the Applicant by Jonathan Newman, BL instructed by Tomkins & Co., Trade Mark Agents.

11. Mr. MacLachlan argued the case for the Opponent on three main grounds, namely, (i) that the mark applied for cannot function as a trade mark for foodstuffs as it is devoid of distinctive character in respect of those goods, being simply a collection of descriptive words and images, (ii) that the mark is so similar to the Opponent's marks that there is a likelihood of confusion on the part of the public arising from its proposed use in relation to goods for which the Opponent's marks are known and registered and (iii) that, as of the relevant date⁴, the adoption and use by the Applicant of a mark bearing such an overall similarity to those of the Opponent constituted a calculated misrepresentation as to the origin of the relevant goods which the Opponent could have prevented through an action for passing off. As regards the question of confusing similarity between the respective marks, Mr. MacLachlan placed considerable emphasis on the presence of the word CUISINE in the mark applied for. It would be wrong, he asserted, to regard that word as purely descriptive of the relevant goods simply because it is a dictionary word the meaning of which relates to food; the application of that word to goods of the kind dealt in by both the Opponent and the Applicant is not at all obvious and the word would not be associated with those goods by most people were it not for the Opponent's long and extensive use of its trade mark.

12. In defence of the application for registration, Mr. Newman asserted (i) that the inclusion in the mark applied for of a logo and a high degree of stylisation render it sufficiently distinctive to qualify for registration, (ii) that there was no intention on the part of the Applicant in adopting the mark to appropriate the Opponent's

⁴ the filing date, 28 June, 1999

goodwill and, (iii) that no damage would be (or indeed had been) caused to the Opponent by virtue of the use of the mark by the Applicant. In his submission, the Opponent's charge of *mala fides* in the adoption of the mark was neither consistent nor credible and was not supported by the evidence. Despite many years of trading side by side in the marketplace by the Applicant and the Opponent, no evidence had been given of any actual confusion between the marks, which strongly suggests that there was no likelihood of confusion as of the relevant date, and neither had the Opponent taken any steps to prevent the use by the Applicant of its trade mark notwithstanding its claims that such use constituted deliberate passing-off.

13. Having had the benefit of the insightful submissions made on behalf of the respective parties, I am satisfied that certain of the grounds of opposition raised in the notice of opposition, while not formally abandoned, do not require detailed consideration. That is the case in respect of the objection to registration grounded on Section 8(3)(b) [*mark of such a nature as to deceive*] and Section 8(4)(a) [*use of mark prohibited by law*]. No evidence or argument has been offered in respect of those grounds of opposition and I dismiss them accordingly as unsubstantiated. As to the remaining grounds of opposition, it is convenient to treat those raised under Section 6 and Section 8(1)(a)-(c) together, as the so-called "absolute grounds", and to look at the "relative grounds" under subsections (2) and (4) of Section 10 separately.

Sections 6 and 8 – is the sign applied for a distinctive trade mark?

14. The relevant parts of Sections 6 and 8 of the Act insofar as the present case is concerned read as follows:

6.-(1) In this Act a "trade mark" means any sign which is capable of distinguishing goods of one undertaking from those of other undertakings.

8.-(1) The following shall not be registered as trade marks:

(a) signs which do not satisfy the requirements of section 6(1);

- (b) *trade marks which are devoid of any distinctive character;*
- (c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, ... time of production or other characteristics of goods*

15. The effect of those provisions is, firstly, that a sign may only be considered to be a trade mark for the purposes of the Act if it has the potential to function as such, i.e., to identify a trader's goods and to distinguish those goods from the goods of other traders and, secondly, that any such sign may only be registered as a trade mark if it is distinctive in nature and not simply descriptive of the relevant goods such that it may be required for use by traders generally to designate characteristics of their competing products.

16. As to the first of these, i.e., capacity to distinguish, it is fair to say that almost any complex sign, combining verbal and figurative elements, will have that capacity provided that the elements of which it is composed are not themselves so commonly used to designate the relevant goods that they cannot function to distinguish those of a given undertaking. Even then, I think it would have to be shown also that the elements in question, even if plainly indicative of the relevant goods, are arranged in a manner that is, itself, an obvious, common or bland arrangement, such that it would be unlikely to make any impression on the mind of the average consumer as regards the goods other than an entirely generic one. In my opinion, that could not be said of the sign put forward for registration in this case. Apart from the fact that it incorporates a logo (in the bottom right-hand corner) which is abstract in nature and, presumably, unique to the Applicant, its capacity to distinguish stems from the fact that the words COMPLETE CUISINE do not designate any individual food product within the specification in Classes 29 and 30 (to say nothing of the Class 16 goods) and those words are highly stylised and juxtaposed with stylised figurative elements, creating an overall design that is sufficiently individual and memorable as to easily have the requisite capacity to distinguish the Applicant's goods. The sign would not, in my opinion, be taken as anything other than a trade mark by the average consumer and I could not accept that it is incapable of identifying the Applicant's goods and setting them apart

from the like goods of other traders in that field. It is, therefore, a trade mark within the statutory definition and is not open to objection under Section 6(1) or Section 8(1)(a) of the Act.

17. Whether it is entitled to registration as a trade mark turns on the question of its inherent distinctiveness and, specifically, whether, as the Opponent claims, it is simply a collection of descriptive words and images, however nicely arranged. The difficulty faced by the Opponent's arguments on this question is the wording of the Act itself, which preclude registration only in the case of marks that are devoid of *any* distinctive character or that consist *exclusively* of descriptive content. Even a modicum of distinctiveness is, therefore, apt to overcome an objection to registration on these grounds and, in assessing whether a mark passes the test, one must look at all the elements of it and ask whether any of these is sufficient to imbue it with the requisite individuality. The one caveat that I would add is that, in the case of a composite mark such as the present one, the question must be judged by reference to the overall impression created by it and may not be determined on the basis of particular elements which, while distinctive in themselves, are so peripheral or insignificant in the make-up of the mark as a whole that they are likely to go unnoticed by the average consumer. Having said that, the fact remains that a low level of distinctiveness is still enough to warrant registration as all that is required of a mark is that it be sufficiently distinctive to enable the average consumer, who has once been exposed to goods offered for sale under it, to recognise it on a subsequent occasion of purchase and to associate it with the goods that he has previously seen marketed under that brand.

18. In the present case, the Applicant's mark contains within it the logo previously referred to, which is approximately 1/16th the size of the other elements of the mark but which is positioned at a slight remove from those other elements such that it is not lost or subsumed within them. Because of its size, it forms only a minor part of the trade mark but it would be wrong, in my opinion, to suggest that it is so peripheral to the overall design that it would not even be seen by the average person encountering the mark in use. It must certainly be allowed that the logo is one of the signs of which the mark consists and, because the logo is a distinctive mark in itself, it cannot be said that the mark consists exclusively of

descriptive content. For that reason alone, I think that the logo is enough to carry the mark and to render it sufficiently distinctive to qualify for registration.

19. If I am wrong in this and the logo should be regarded as too small in the context of the mark as a whole to be capable of making the whole distinctive, then I think that the remaining elements are themselves sufficiently distinctive to merit registration, even if the logo is ignored. As I have already found, the words COMPLETE CUISINE do not designate (in the sense of naming) any of the products within the specification of goods covered by the application for registration and nor do they directly describe characteristics of any such products. It is not immediately obvious as to how the cuisine in question is to be understood as being “complete” and, while the verbal element of the mark certainly alludes to the nature of the goods, it does so in an oblique way that could not be said to constitute the common parlance of the average consumer of the goods. There is also the stylisation of the lettering and the use of a stylised device of wheat, which have the effect of creating the appearance of a trade mark as opposed to a simple designation of the goods that might be used to indicate those of any and all undertakings. As I have already said, I believe that the average consumer would instinctively perceive the present sign as a trade mark of a particular undertaking. That instinctive reaction would stem from the overall impression created by the collection together and arrangement of the various elements of which the mark is composed. Taken in its totality, it is sufficiently distinctive to warrant registration. I find, therefore, that the mark is not devoid of any distinctive character and does not consist exclusively of descriptive matter so that the application is not open to objection under Section 8(1)(b) or (c) of the Act.

Section 10(2) – is there a likelihood of confusion on the part of the public?

20. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

“A trade mark shall not be registered if because –

(a)

*(b) it is similar to an earlier trade mark and would be registered for goods
..... 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 of the later trade mark with the earlier trade
mark.”*

Earlier trade marks

21. Each of the Opponent’s Trade Mark Registrations Nos. B152606, B152607 and 214272 constitutes an “earlier trade mark” within the meaning of the Act as against the present application for registration. The first two of those registrations were in force for over eight years prior to the filing of the present application and the third, which consists of the verbal element only of the earlier registered mark, predates this application by two years. Registrations Nos. B152606 and B152607 are subject to disclaimers to the effect that registration gives no right to the exclusive use of the words “Cuisine” and “France”, which would be regarded as indicative, respectively, of the nature and geographic origin of the goods embraced by the registrations such that the registration should not have the effect of conferring on the Opponent a monopoly in the use of those words in relation to such goods. Registration No. 214272 is not subject to any such disclaimer and, in fact, that mark was accepted on the basis that it had acquired a distinctive character by virtue of the use made of it by the Opponent.

22. Disclaimers and other conditions attaching to the registration of marks relied on by an Opponent are not generally regarded as relevant to the determination of an opposition under Section 10(2)⁵, but I mention these facts to illustrate an aspect of this case that is central to it and which was the subject of some discussion at the hearing. That is the fact that the Opponent originally adopted a trade mark which, on an objective assessment, had a relatively low level of distinctiveness given that it has a fairly obvious meaning in the context of the goods in question. As a consequence, the Opponent could not claim to have an exclusive right to the individual words used in its trade mark such that other economic operators in that

⁵ because they do not affect the practical likelihood of confusion on the part of the public arising from the simultaneous use of the opposing marks

field would be prevented from using those words descriptively in relation to their competing products and the Opponent's early registrations reflect that fact. However, as time passed and the Opponent built up an extensive trade under its mark, the words CUISINE DE FRANCE, without any accompanying device, came to be associated with the goods of the Opponent alone to the extent that those words were accepted for registration under No. 214272, which registration was not made subject to any disclaimer, even of the individual words used separately.

23. The acceptance for registration on the basis of acquired distinctiveness of the Opponent's trade mark CUISINE DE FRANCE is not surprising when one looks at the evidence put in by the Opponent in these proceedings. The extent of the trade engaged in by the Opponent under the trade mark CUISINE DE FRANCE and the success of that brand are evident from the Statutory Declaration of Ms. Coyle filed under Rule 20. Here, the figures speak for themselves – sales of over IR£300 million, advertising of over IR£25 million, over 3,000 outlets stocking the goods – and, in the context of the size and nature of the national market in goods of this kind, they tell a story of resounding success. It is against the backdrop of that success that the Opponent says, to paraphrase Mr. MacLachlan, that, although the word CUISINE has a meaning in relation to the goods at issue here, that word has become so associated with the Opponent's goods that its incorporation in another trade mark for use on the same or similar goods will be taken by the average person as indicating a connection with the Opponent. For his part, Mr. Newman did not dispute the Opponent's claim to have an established reputation under the trade mark CUISINE DE FRANCE but he asserted that that reputation attached to the mark in its totality and not to the word CUISINE alone, which word remains descriptive of the relevant goods and, therefore, not of such a nature as to create confusion as to commercial origin. To a great extent, the case turns on that issue and I will return to it in the context of the assessment of the likelihood of confusion.

Identical or similar goods

24. The goods of the present application are set out in paragraph 1 above and those in respect of which the Opponent's earlier trade marks are protected are listed in

Appendix 1. As regards the goods in Classes 29 and 30, there are several items that are common to both the Applicant's and the Opponent's specifications, including *meat, fish, meat extracts, prepared meals, preserved fruits and vegetables, bakery products, bread, biscuits, cakes and confectionery*, so that the criterion of identity of goods is satisfied as regards those items. Many of the other food products within the Applicant's specification are clearly similar to those in respect of which the Opponent's marks are protected and I would include here *poultry, game, bacon, jelly, jam, fruit sauces, fruit preserves and conserves, dried and cooked fruits and vegetables, black and white puddings, cereals, flour preparations, bagels, waffles, pizza, etc.*. As to the goods in Class 16 of the application for registration, these are not similar in nature to food products but it is clear both from the wording of the specification and from the Applicant's evidence as to its trade that most of the paper, plastic and foil products listed are for the purpose of wrapping or packaging such food products. In practice, I have no doubt but that the Applicant's declared intention to use the mark propounded for registration in relation to paper and other packaging goods in Class 16 is for the purpose of branding the contents and not the packaging.

25. In any event, the fact that the parties engage in the same field of trade is not in dispute and no point was taken at the hearing by Mr. Newman as to the inclusion within the Applicant's specification of goods of items in Class 16 that could be said to be dissimilar to the goods of the Opponent's registrations and, therefore, outside of the scope of Section 10(2). For practical purposes, I think it is sensible to accept that certain of the goods in respect of which the Applicant seeks registration of its mark are identical with those in respect of which the Opponent's marks are protected and to assess the likelihood of confusion in relation to those goods first. If no such likelihood is identified, then there cannot be any such likelihood in the case of the goods that are merely similar and consideration of the matter in the context of those goods becomes unnecessary.

Similar marks

26. The Opponent offers three main reasons for its assertion that the mark which the Applicant seeks to register is similar to its trade mark, namely,

- (i) the use of the word CUISINE and the presentation of that word in a different typeface from that used for the word COMPLETE such that CUISINE is separated and highlighted,
- (ii) the use of the colours red and blue against a white background, and
- (iii) the use of devices of wheat and a ribbon.

The effect of these three similarities in combination results, it says, in an overall similarity between the respective marks that is sufficient to create an association between them in the mind of the average person. The Applicant denies this, asserting that any similarities between the marks are in respect of particular elements only, which elements are descriptive or allusive of characteristics of the goods in question, but that the overall impressions created by the respective marks are different. As noted earlier, much attention was paid at the hearing to item (i) above, the inclusion of the word CUISINE in the Applicant's mark although it appeared from the evidence filed by the Opponent that its main difficulty lay with the use of a colour scheme similar to its own.

27. In considering the extent to which the marks at issue here may be regarded as similar or different, I have kept in mind the statement of the European Court of Justice (ECJ) in *Sabel BV v Puma AG and Rudolf Dassler Sport*⁶ to the effect that a global appreciation of the visual, aural and conceptual similarity between trade marks must be based on the overall impression created by the marks, bearing in mind, in particular, their distinctive and dominant components. In the case of a composite mark such as that put forward for registration by the Applicant, it is particularly important to consider, firstly, what is the dominant feature that determines the overall impression created by the mark because consumers normally perceive a mark as a whole rather than analysing its various elements separately. It is the case therefore that, although specific points of similarity or even identity may be identified between opposing marks, the overall impressions created by them may still differ if the particular elements that correspond are not significant in the make-up of each mark's unique identity. So, for example, in *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market*

⁶ Case C-251/95, paragraph 23 of judgement dated 11 November, 1997

*(Trade Marks and Designs) and Hukla Germany SA*⁷ the Court of First Instance of the European Communities stated that *a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark.*

28. In the present case, I take the view that the dominant component of each of the respective marks is its verbal element, CUISINE DE FRANCE in the one case and COMPLETE CUISINE in the other. I say this primarily because, in general, words speak louder than devices in composite trade marks as the words give the product its name and provide the consumer with his first reference point of distinction between the product and its rivals. Of course, a particularly unusual or striking device may function from day one as an effective trade mark and even a rather plain device may become well known as a trade mark for particular goods through prolonged use, but neither scenario is in play here. In this case, the device elements of the respective marks are, in my opinion, subsidiary in nature and quite subordinate to the verbal elements in terms of creating the overall identity of each mark. In the Opponent's mark registered under Nos. B152606 and B152607, the device element is a rather unremarkable stylisation of entwined ears of wheat, which is positioned underneath the words CUISINE DE FRANCE and serves as much as anything to simply underline and, therefore, emphasise those words. In the Applicant's mark, the logo device is very much smaller than the remaining elements (as I have already noted) while the slightly stylised representation of wheat is rather faint and somewhat lost behind the extravagant swirl of the extended C in COMPLETE. In terms of the immediate and, I suggest, lasting impression that each mark makes, the respective names CUISINE DE FRANCE and COMPLETE CUISINE are dominant.

29. I do not intend by this analysis to suggest that the device elements of the respective marks may simply be ignored in the comparison of them from the point of view of confusing similarity. Those elements go towards the overall make-up of the respective marks and may, to the extent that they correspond, add to the

⁷ Case T-6/01, paragraph 33 of judgement dated 23 October, 2002

likelihood of confusion between them. However, they are not themselves the primary determinant of whether a likelihood of confusion exists. As regards that question, I am satisfied that the issue turns mainly on the similarity of the respective verbal parts.

30. Turning then to a comparison of the terms CUISINE DE FRANCE and COMPLETE CUISINE, I note firstly that each consists of a reference to the word and concept CUISINE. Of course, the word CUISINE has an obvious meaning and significance in terms of food products and it is a word that I think the average consumer would perceive as being used to convey a sense of quality and excellence about the products so marked. For that reason, it seems to me that the distinctiveness of the marks at issue here must emanate from the way in which each qualifies the concept of cuisine as that word and concept alone is not apt to distinguish goods in a trade mark sense. To that extent, its simultaneous use in the trade marks of two different undertakings in the food business is unlikely to be perceived by the average person as signifying a connection between those undertakings. On the contrary, the average person would be more likely to assume that the brands in question each featured the word simply for its value as a way of communicating a positive message about the products. To identify the distinctive conceptual message of the respective marks, one has therefore to look to the other words within them and to ask whether the concept of cuisine is similarly or differently qualified in each case.

31. Looked at in that way, I think the respective messages of the marks are rather different. In one mark, the concept of cuisine is qualified as being specifically French cuisine⁸ and, in the other, it is characterised as being “complete”, which I think would probably suggest to the average consumer the meaning that Mr. Hanrahan said the Applicant had in mind when choosing that word, i.e., complete in the sense of a comprehensive range of products. So, while the Opponent’s trade mark conveys a message that is specifically related to France and all that goes with French cooking, the Applicant’s mark has no such connotation. In the Applicant’s mark, the use of the word “cuisine” appears to be use of that word as

⁸ there is no evidence on the point but I have assumed that the translation would be obvious to the average consumer

one that has become commonly used in English speech meaning a style or quality of cooking and, despite its French origin, the word no longer conveys a sense of connection with France when used in combination with the ordinary English word “complete”.

32. In summary, I would say that the respective marks are dominated by the words within them, that those words name the respective products and are the primary means by which those products would be identified and remembered and that, in the context of those words, the respective messages conveyed by the marks differ in their distinctive aspects. In essence, the overall impressions created by the names CUISINE DE FRANCE and COMPLETE CUISINE are not similar and, judged on their verbal content only, I would say that the respective marks are more different than similar.

33. I return now to the figurative elements of the marks and consider whether these are so similar as to significantly influence the overall degree of similarity between the marks. In this regard, the Opponent has asserted that the use of the colours red and blue in the Applicant’s mark reinforce the notion of a French connection that is suggested by the use of the word “cuisine” such that the overall idea of the Applicant’s mark mimics that of its mark. I reject that argument for two reasons. Firstly, there is no evidence that the colours red and blue in a trade mark, even one containing a French word, necessarily suggest a connection with France to the average consumer. These are two of the three primary colours which may be used in combination simply for their aesthetic appeal and with no intention whatsoever of evoking the idea of France. Secondly, since the average consumer does not analyse the individual components of a composite trade mark in such a way as to discern and interpret hidden meanings within them, I find it implausible that a message delivered so subliminally as is suggested here would penetrate his consciousness sufficiently to create a link between the respective trade marks that he would not otherwise perceive. Nor do I think the Opponent’s case is helped by the occurrence in each of the marks of devices of wheat. The respective devices are quite different in appearance and are positioned differently within the respective marks so that they do not add to the degree of similarity of the marks, perceived as wholes.

34. On an overall assessment, I would say that the marks at issue here display only a low level of similarity. While they each contain the word CUISINE and share a number of other similar elements, the overall impressions created by them are quite different. Because of their shared verbal and figurative components, they may be said to fall within the scope of Section 10(2) as “similar marks” but they are only mildly so and I propose to treat them accordingly in the assessment of the likelihood of confusion.

Likelihood of confusion

35. The assessment of the likelihood of confusion between trade marks is a practical business and must be approached from the perspective of the average consumer of the goods in question and on the assumption of a normal and fair use of the marks in question as trade marks for those goods. For the purpose of that assessment, the average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect but only rarely has a chance to make a direct comparison between the marks and must rely on the imperfect picture of them that he has kept in his mind⁹. It is also the case that the more distinctive a trade mark is, whether inherently or because of the use that has been made of it, the greater the likelihood of confusion arising from the use of a similar mark in relation to similar goods¹⁰.

36. In the present case, the goods dealt in by both the Applicant and the Opponent fall within what may be called convenience foods, which are frequently consumed “on the run” having being purchased at roadside service stations that cater to our commuter society. At the hearing, Mr. MacLachlan referred to the goods as “fast food” and, although I do not think they fall within the traditional meaning of that term, it is fair to say that they are not likely to be the subject of detailed consideration prior to purchase and consumption by the average consumer. It was also not disputed that the parties are direct opponents in the marketplace and I understand that their products are not to be found side by side within the same retail outlet – a given store will carry one or other of the brands (or neither, of

⁹ ECJ in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* (Case C-342/97)

¹⁰ ECJ in *Sabel BV v Puma AG and Rudolf Dassler Sport*

course) but not both. The brands cannot, therefore, be directly compared in the instance of selection and purchase and the possibility of confusion through imperfect recollection is increased accordingly. Having said that, it must be recalled that the goods in question are food items and it is fair to assume that the average consumer will take some care to purchase a brand that appeals to his taste and to avoid other products.

37. As to the distinctiveness of the Opponent's trade mark, I have already noted that it is not inherently distinctive but that it has acquired a high level of recognition through extensive use so that the Opponent can fairly claim that it is associated in the minds of the purchasing public with its goods alone. The Opponent goes further and says that it has become so well known for CUISINE DE FRANCE products that the use of the word CUISINE in the Applicant's mark will cause confusion by creating an association in the mind of the relevant consumer between the goods sold under that mark and its CUISINE DE FRANCE goods. Such an association would constitute confusion within the meaning of Section 10(2) of the Act.

38. I do not accept that proposition for the reason that there is no evidence to suggest that the undoubted success of the CUISINE DE FRANCE mark has resulted in the Opponent being identified in the minds of consumers with the word CUISINE alone. The term CUISINE DE FRANCE expresses a single and specific concept and it is not a term that is apt to be broken up into its constituent parts. The words CUISINE and FRANCE appear in the same font size and style within the Opponent's mark and the evidence shows that the mark has been used as registered, i.e., with those words having equal prominence. In the absence of any evidence or convincing argument to suggest that the average consumer is likely to take particular notice of the word CUISINE within the Opponent's mark, I am satisfied that the factual distinctiveness attaching to that mark by virtue of the use that has been made of it must be regarded as attributable to the mark in its entirety and not to the word CUISINE alone.

39. Having regard to all of the foregoing, I have come to the conclusion that, notwithstanding the existence of the Opponent's earlier trade marks, there is not a

likelihood of confusion in the minds of the public such as would warrant refusal of the present application for registration. Given the low level of similarity between the marks, I think the likelihood of direct confusion between them whereby the Applicant's goods are taken to be those of the Opponent is negligible. It seems to me that the average person must be assumed to have the capacity to easily differentiate and distinguish between the terms CUISINE DE FRANCE and COMPLETE CUISINE and that the passing similarity between the other, subsidiary elements of the marks is not likely to impair that capacity in any way. Even allowing for a relatively low level of attention being paid to a hurried selection and purchase of a convenience food product, nevertheless, the marks are not susceptible of direct confusion by a reasonably circumspect consumer. Nor do I believe it likely that there will be confusion by association of the CUISINE DE FRANCE brand with the Applicant's goods. The trade mark COMPLETE CUISINE (and device) does not create the impression of a sub-brand, associated brand or brand extension of the CUISINE DE FRANCE product. If anything, I think the average consumer who was caused to recall the Opponent's mark on encountering goods bearing the Applicant's mark would immediately and instinctively understand that the goods in question constituted an alternative and competing product to that of the Opponent. To say that the use of the word CUISINE would be sufficient to cause confusion by association is entirely too simplistic and ignores the factors that I have outlined as to the conceptual significance and overall impressions created by the respective marks. Those factors are sufficient, in my opinion, to obviate the likelihood of confusion including confusion by association and I have decided, therefore, to dismiss the opposition to registration based on Section 10(2) of the Act.

Section 10(4) – is the use of the mark by the Applicant liable to be prevented by virtue of the law of passing off?

40. The relevant part of Section 10(4) of the Act, as far as the present opposition is concerned, reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

41. My finding under Section 10(2) to the effect that there is not a likelihood of confusion on the part of the public effectively determines the opposition under this section also as there could be no passing off if the consumer is not likely to take the Applicant's goods as being in any way connected with the Opponent. I include separate mention of this ground of opposition solely for the purpose of referring to the other aspect of the passing off claim, namely a deliberate misrepresentation on the part of the Applicant that its goods are those of the Opponent. That charge was particularised in the Applicant's evidence wherein it was claimed that the Applicant adopted elements of the Opponent's trade mark *with the deliberate intention of trading on Opponent's goodwill and of benefiting from the overall concept developed by the Opponent*¹¹. Mr. Hanrahan answered the charge by setting out in detail the circumstances leading to the adoption and refinement of the mark now propounded for registration and his account of that process is perfectly credible and above board in my view. So, for the sake of completeness, I record that I am satisfied that the Opponent's allegation of a deliberate attempt on the part of the Applicant in the adoption of the present mark to siphon off its goodwill is not supported by the evidence and, to the extent that its objection to registration under section 10(4) is grounded on that allegation, I would dismiss it accordingly.

Conclusion

42. The opposition has failed on every ground and the mark may proceed to registration.




Tim Cleary

Acting for the Controller

27 November, 2006

¹¹ paragraph 12 of Statutory declaration of Karen Coyle filed under Rule 20

**Opponent's Trade Mark Registrations
referred to in Notice of Opposition**

No.	Mark	Date	Class/Goods
B152606		04/01/1991	<p>Class 29</p> <p>Chilled and frozen food products; meat and meat products; fish and fish products; dairy products; preserved fruits and vegetables; partially and fully prepared meals and constituents of meals included in Class 29; products included in Class 29 suitable for baking.</p>
B152607		04/01/1991	<p>Class 30</p> <p>Partially and fully prepared bakery products, prepared meals and constituents of meals included in Class 30; croissants, baguettes, bread, biscuits, cakes and confectionery; semi-prepared and prepared meals included in Class 30; food products included in Class 30 suitable for baking.</p>
214272		27/05/1997	<p>Class 29</p> <p>(as for B152606)</p> <p>Class 30</p> <p>(as for B152607)</p>