

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 222969 and in the matter of an Opposition thereto.

CUISINE EXPRESS FRESH FOODS LIMITED

Applicant

CUISINE DE FRANCE LIMITED

Opponent

Application for registration

1. On 25 February, 2000, Cuisine Express Fresh Foods Limited, and Irish company of Unit 16, Cookstown Business Centre, Tallaght, Dublin 24 made application (No. 2000/00650) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the words CUISINE EXPRESS as a trade mark in respect of a specification of goods and services in Classes 29, 30, 31, 32 and 42 which was amended in the course of the examination of the application to read as follows.

Class 29: *Meat, fish, poultry, game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

Class 31: *Fresh fruits and vegetables.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 42: *Catering services; café, cafeteria, canteen and restaurant services; snack bar services; bar services.*

2. The application was accepted for registration and advertised accordingly under No. 222969 in Journal No. 1944 on 12 June, 2002.

3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 29 August, 2002 by Cuisine de France Limited of Belgard Square, Tallaght, Dublin 24. The Applicant filed a counter-statement on 3 December, 2002 and evidence was subsequently filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a Hearing before me, acting for the Controller, on 28 June, 2007. The parties were notified on 1 August, 2007 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 in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 24 August, 2007.

Scope of the opposition

5. The opposition is based on both the so-called “absolute grounds” and “relative grounds” for refusal of an application for registration. The absolute grounds objections are to the effect that the words CUISINE EXPRESS are not capable of functioning as a trade mark for the goods and services in question, that they are devoid of any distinctive character in respect of those goods and services and that they constitute a sign that designates certain essential characteristics of those goods and services. Those objections arise under Section 8 of the Act, specifically paragraphs (a), (b) and (c) of subsection (1) of that Section. The relative grounds objections are based on the Opponent’s use and registration¹ of the trade mark CUISINE DE FRANCE and arise under Section 10 of the Act, specifically sub-sections 2(b) and 4(a).

The evidence²

Rule 20

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits CDF1-CDF3), dated 18 February, 2004, of Patrick McEniff, one of its directors. He says that,

¹ See Annex 1

² review of the evidence confined to matters of relevant fact or claimed fact

- 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,
- 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,
- by mid 1992, goods bearing the mark were 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 and the Opponent had the exclusive use of the word for some considerable time.

Rule 21

7. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits FR1-FR4) dated 9 June, 2005 of Frank Robinson, one of its directors. He says that,

- the trade mark CUISINE EXPRESS was first used in 1999 in respect of a range of sandwiches,
- the Applicant is the second largest sandwich manufacturer in Ireland, producing all types of sandwiches, wraps, rolls and baps,
- it currently produces up to 45,000 units per week under a number of different trade marks, including CUISINE EXPRESS,

- it sells into a range of different outlets throughout the State, including retail multiples, service stations, restaurants, snack bars, canteens, airports, railway stations and ferries, and also supplies a number of contract caterers
- the trade mark CUISINE EXPRESS has been promoted by the Applicant's sales representatives visiting various retail outlets and contract caterers throughout the State,
- there are several trade marks containing the word CUISINE on the Irish and Community Registers and both "Dunhill Cuisine" and "Irish Culinary Cuisine Limited" are in use in Ireland.

The hearing and arguments of the parties

8. At the hearing the Opponent was represented by Norman MacLachlan, Trade Mark Agent of MacLachlan & Donaldson and the Applicant by Michael Kiernan, Trade Mark Agent of Tomkins & Co.
9. Recalling an earlier decision of mine to allow the registration as a trade mark of a device containing the words COMPLETE CUISINE in the face of opposition from the present Opponent³, Mr. MacLachlan argued that the present matter could be distinguished from that case on the basis that the mark at issue here contains no figurative element and consists merely of words that display no distinctive character in the context of the relevant goods and services. In particular, he asserted that the word EXPRESS, being entirely descriptive of a characteristic of those goods and services, was not such as to distract the average consumer's focus from the word CUISINE, which has become associated with the Opponent by virtue of long and substantial use. The average consumer of the goods dealt in by both the Opponent and the Applicant is someone who is often in a hurry when purchasing a take-away snack and who may well be confused as between two trade marks commencing with the word CUISINE, which is not a common word

³ decision dated 27 November, 2006 in the matter of Trade Mark No. 216351, COMPLETE CUISINE (and device) in Classes 16, 29 and 30

for goods of that nature. As regards the Opponent's objections on absolute grounds, Mr. MacLachlan asserted that European Court of Justice (ECJ) jurisprudence established clearly that a word trade mark consisting of no more than a combination of elements, each of which is descriptive in its own right of the goods or services in question, is itself descriptive and non-distinctive as regards those goods or services. Both CUISINE and EXPRESS designate, in common parlance, essential characteristics of the goods and services of the application and the mere combination of those words into the term CUISINE EXPRESS cannot create a distinctive trade mark. A registration of that term as a trade mark would be contrary to the public interest in that it could interfere with the use by undertakings other than the Applicant of common terms such as "express cuisine" or "fast food".

10. Mr. Kiernan replied that, in view of the visual, phonetic and conceptual differences between the respective trade marks in this case, a finding in favour of the Opponent would amount to a finding that the Opponent enjoys exclusive rights to the word CUISINE when applied to a range of foodstuffs and services for the provision of food. That cannot be the case and the registrations of the Opponent's trade mark CUISINE DE FRANCE under the Trade Marks Act, 1963 under Nos. B152606 and B152607 are subject to disclaimers of any exclusive rights in that very word. The likelihood of confusion must be assessed by reference to the trade marks in their entirety, not just their shared element, and the fact that the Opponent has not adduced any evidence of actual confusion, notwithstanding that the Applicant's mark is in use in the State, is indicative of the fact that no such confusion is occurring or is likely to occur. As to the Opponent's objections under Section 8, Mr. Kiernan asserted that the present mark does no more than allude to characteristics of the goods and services of the application; it does not directly describe them. Viewed in its totality, the mark would be perceived by the average consumer as a brand name of a single undertaking, used to differentiate its products from those of its competitors.

Grounds of decision

Absolute grounds objection

11. The relevant parts of Section 8 of the Act insofar as the present case is concerned read as follows:

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

- (a) signs which do not satisfy the requirements of section 6(1)⁴;*
- (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, the time of production of goods or of rendering of services, or other characteristics of goods or services;*

12. While the Opponent has raised objection under each of the specific provisions mentioned above, its argument in support of those objections is essentially the same in each case, namely, that the word combination CUISINE EXPRESS is descriptive of characteristics of the goods and services of the application and is, as a consequence, lacking in the distinctive character required to allow it to function as a trade mark. I have decided therefore, for the purposes of this statement of grounds of my decision, to simply set out my reasons for rejecting that argument and for allowing the Applicant's trade mark to proceed to registration without differentiating between the various provisions on which the Opponent's objection is grounded.

13. The Opponent's case is founded on pronouncements of the ECJ in two well-known cases, namely, Case No. C-191/01, *Office for Harmonisation in the Internal Market (Trade Marks and Designs) –v- Wm. Wrigley Jr. Company [DOUBLEMINT]* and Case No. C-265/00, *Campina Melkunie BV –v- Benelux-Merkenbureau [BIOMILD]*, as follows:

DOUBLEMINT

“30. ... signs and indications which may serve in trade to designate the characteristics of the goods or services in respect of which registration is

⁴ in the present case, the requirement that the sign be capable of distinguishing the goods or services of the Applicant

sought are ... deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark

31. By prohibiting the registration as ... trade marks of such signs and indications, [the legislation] pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. [It] accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks

32. In order ... to refuse to register a trade mark ..., it is not necessary that the signs and indications composing the mark actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient ... that such signs and indications could be used for such purposes. A sign must therefore be refused registration ... if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

BIOMILD

“39. As a general rule, the mere combination of elements, each of which is descriptive of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

.....

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics

unless there is a perceptible difference between the neologism and the mere sum of its parts; that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

14. At the hearing, Mr. MacLachlan argued that the present case is on all fours with DOUBLEMINT and BIOMILD and that the inevitable conclusion is that the word combination CUISINE EXPRESS is descriptive of the goods and services of the application and, therefore, devoid of any distinctive character. I respectfully disagree. In my opinion, the term CUISINE EXPRESS is more than the mere sum of its parts and is not simply synonymous with the familiar term, “fast food”. If it is to be regarded as such, then the word “express” must be seen as used in its adjectival form (*quick, fast, rapid*), rather than as a noun (*Orient Express*) or a verb (*to express one’s feelings*). But the relative positioning of the words forming the mark constitutes an inversion of grammatical convention whereby an adjective is placed before the noun to which it relates, e.g., “black cat”, “tall man”, “fast food”, etc., and, if anything, the present mark may be seen as more akin to that which was approved for registration by the ECJ in Case C-383/99, *The Proctor & Gamble Co. –v- Office for Harmonisation in the Internal Market (Trade Marks and Designs) [BABY-DRY]*. In that case, the ECJ observed that,

“As regards trade marks composed of words,..., descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a Community trade mark.”

15. The ECJ went on to find that, by virtue of the syntactically unusual juxtapositioning of the words forming the trade mark BABY-DRY, it was to be

regarded as a lexical invention and, therefore, a term that displayed sufficient distinctive character as to be capable of registration as a Community Trade Mark. The same can be said of CUISINE EXPRESS, when that term is equated with “fast food”, and I am not persuaded that the mark is open to objection under Section 8 merely because the words of which it is composed are synonyms for “food” and “fast”, respectively. Nor do I accept the suggestion made on behalf of the Opponent that BABY-DRY has become bad law and has effectively been reversed by DOUBLEMINT and BIOMILD. The concept, first expounded in BABY-DRY, of any perceptible difference between the combination of words forming a trade mark and the terms used or understood by the relevant consumers to designate goods or services or their essential characteristics is reiterated and reinforced in the later cases.

16. Indeed, ECJ jurisprudence has consistently directed consideration of trade marks in their totality and of the overall impressions that they are likely to form in the mind of the average consumer of the goods or services in question, rather than any detailed analysis of their component parts. The average person does not normally engage in any such analysis. The market economy has developed to a point where the average consumer is exposed to the use of trade marks in almost every aspect of his daily life so that he has come to perceive and assimilate the overall impressions created by trade marks intuitively and subliminally. In trying to assess whether a given trade mark has the requisite distinctiveness to permit of its registration, one must therefore attempt to gauge the likely “gut reaction” of the consumer to it and to ask whether he is likely to perceive it as an indication of specific commercial origin or merely as a product describer.

17. Looked at in that light, it seems to me that CUISINE EXPRESS is a sufficiently unusual word combination, having an uncertain meaning, as to be regarded as a distinctive trade mark and eligible for registration as such. In my opinion, CUISINE EXPRESS evokes the notion of a food train (as in the aforementioned “Orient Express” or in “Midnight Express”), which is a fanciful concept, even in the context of the foodstuffs and food-related services covered by the application for registration. The immediate impression created in one’s mind by the mark is overwhelmingly that of a brand name that has been chosen by an undertaking (the

Applicant) to convey the idea of speed of delivery or ready accessibility of the goods or services bearing the name. To that extent, it makes an entirely permissible allusion to certain characteristics of those goods and services but it does not *designate* (in other words, directly name) those characteristics and it certainly does not do so in terms that could be described as common parlance for the average consumer. I have never heard the term “cuisine express” used in place of the generic term “fast food” and I cannot imagine it being used in that fashion by the average person. Nor is that the immediate overall impression created by the term such that it is likely to be perceived by the average consumer, first and foremost, as simply a reference to fast food. It is not a word combination that needs to be left free for use by all undertakings in the fast food business and its registration as a trade mark in the name of the Applicant will not act as any impediment to the free conduct of trade in the goods and services covered by the application for registration.

18. As to the suggestion that, by virtue of the provisions of the Act relating to infringement by use of a sign that is similar to a registered trade mark, the registration of CUISINE EXPRESS could operate to prevent the use by others of the terms “express cuisine” and “fast food”, I do not regard that as a valid argument against acceptance of the application for registration. Certainly, the Controller is required to conduct a thorough examination of every application for registration of a trade mark and to consider all of the grounds for refusal of registration and the policy objectives underpinning each of them, including as to the likely effect on other commercial undertakings if a mark is registered. Care must be taken, however, not to stray into unwarranted speculation as to what might happen in a given case if a mark is registered and a similar sign is then used by a competitor. Determination of the respective rights and entitlements of the parties concerned in any such scenario is a matter for the courts alone and it is not for the Controller to seek to anticipate possible future disputes in the context of an application for registration. In the context of Section 8 of the Act, the Controller’s function is to decide whether a trade mark is intrinsically entitled to or precluded from registration and that determination must be made by reference to the trade mark itself and not to other trade marks or signs that may or may not be regarded as similar to it. In the present case, I am satisfied, for the reasons that I have

stated, that the mark propounded for registration is a distinctive trade mark and that it is not precluded from registration by the prohibition on the registration of descriptive signs or indications. Accordingly, I see no reason to refuse registration under Section 8 and I have decided to dismiss the opposition grounded on that Section of the Act.

Relative grounds objection

19. The relevant parts of Section 10 of the Act, insofar as the present application is concerned, read as follows:

(2) 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 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 of the later trade mark with the earlier trade mark.

.....

(4) 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;

20. Here again, the facts of the case and the arguments of the parties mean that it is not necessary to consider each of those two provisions individually. In each case, the matter turns on whether the use by the Applicant of the trade mark CUISINE EXPRESS in relation to any of the goods and services covered by the application would be likely to cause confusion on the part of consumers, in the sense that they might associate the goods or services concerned with the goods of the Opponent marketed under its trade mark CUISINE DE FRANCE, which was well

established by the time this application was filed. The likelihood of confusion must be assessed from the perspective of the average consumer of the goods and services in question, being, in this case, the average person because the goods and services are aimed at consumers generally. The scenario to be considered is, therefore, that of the average person, who is already familiar with the Opponent's trade mark CUISINE DE FRANCE used in relation to the goods for which it is protected and who is exposed in the course of a typical shopping experience to goods or services of the kind covered by the application and bearing the trade mark CUISINE EXPRESS. For some of the goods of the application, e.g., beers and mineral waters, it is plain that confusion is not at all likely because the Opponent's mark is neither protected nor known in relation to those goods. For present purposes, it is appropriate to focus on the goods for which the Applicant seeks registration of CUISINE EXPRESS and in respect of which CUISINE DE FRANCE is already both protected and known to the average person, namely, bakery items such as breads and pastries.

21. Those goods are relatively inexpensive everyday food items, the selection and purchase of which are not the subject of detailed examination and deliberation on the part of the average consumer. While consumers may consider such factors as price, calorie content, ingredients, etc. in making their selections, the primary consideration in the mind of the average consumer is likely to be taste. That is not a factor that can be assessed by means of an examination of the goods themselves, so the consumer must place reliance on brand names to identify the products of different manufacturers and to distinguish between those that he likes and those that he dislikes. The goods are normally selected as self-serve items rather than being asked for by brand name and, so, the visual and conceptual comparisons of the respective marks are more significant than the aural comparison in the assessment of the likelihood of confusion.
22. Having regard to the foregoing considerations, I have come to the conclusion that there is not a likelihood of confusion on the part of consumers between bakery items marketed under the names CUISINE DE FRANCE and CUISINE EXPRESS. The overall visual and conceptual impressions formed by those marks are quite different, notwithstanding the fact that CUISINE is the first word

in each. The message conveyed by CUISINE DE FRANCE is quite specifically “French cuisine”. Conceptually, the message given by “DE FRANCE” is at least as significant as “CUISINE”, which has only a low degree of distinctiveness in the context of food items. As I have already stated, CUISINE EXPRESS evokes a different concept, which is not specifically related to “Frenchness” despite the French origin of the word “cuisine”. On a visual comparison, the fact that both marks commence with CUISINE is significant but it is counterbalanced by the quite clear visual differences between DE FRANCE and EXPRESS. Overall, I would say that there is not much more than a passing similarity between CUISINE DE FRANCE and CUISINE EXPRESS and that they are not liable to direct confusion on the part of the average consumer exercising ordinary care, and even allowing for imperfect recollection. The word CUISINE is not such a dominant component of either trade mark, in terms of the overall impression created by the mark, that its inclusion in both is likely to lead to confusion.

23. I was also urged to consider the possibility of confusion by association whereby consumers might perceive a link between CUISINE DE FRANCE and CUISINE EXPRESS products because of the claimed novelty of the use of the word CUISINE in relation to the kinds of everyday food items sold by both the parties to these proceedings. I take the view, however, that the reputation built up by the Opponent under its trade mark CUISINE DE FRANCE must be seen as attaching to the mark in its entirety and not just the component, CUISINE, whether or not the Opponent was the first to use that word in relation to goods of the kind under consideration here. The trade mark CUISINE DE FRANCE is not apt to be dissected in that manner; its two components (if they can be called that), CUISINE and DE FRANCE are mutually complementary and there is no evidence to suggest that the admittedly widespread use of CUISINE DE FRANCE has caused consumers to associate the word CUISINE alone with the Opponent. The indivisible character of the trade mark CUISINE DE FRANCE makes it unlikely, in my view, that the average person would assume that CUISINE EXPRESS was some new range or line of products under the CUISINE DE FRANCE brand. In the context of the particular goods under consideration, CUISINE EXPRESS has an independent identity and is not evocative of CUISINE DE FRANCE in such a way as to cause consumers to make an




association between the two. I find, therefore, that there is not an appreciable likelihood of either direct or indirect confusion on the part of consumers if the trade mark CUISINE EXPRESS is used in relation to bakery products notwithstanding the Opponent's prior use of CUISINE DE FRANCE in relation to those goods. That finding applies, *a fortiori*, in respect of the other goods and services covered by the application for registration and in respect of some of which only the Opponent's trade mark is protected but not known by consumers. For these reasons, I have decided to also dismiss the opposition grounded on Section 10 of the Act.

Tim Cleary

Acting for the Controller

12 November, 2007

**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 (as for B152606)</p> <p>Class 30 (as for B152607)</p>