

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 214302 and in the matter of an Opposition thereto.

“PODRAVKA” D.D. PREHRAMBENA INDUSTRIJA

Applicant

SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

Opponent

The application

1. On 2 July, 1997, “Podravka” D.D. Prehrambena Industrija, a Croatian company of Ulica Ante Starcevica 32, HR-43300 Koprivnica, Croatia, made application (No. 97/2465) to register the device shown below as a trade mark in Classes 29 and 30 in respect of a specification of goods that was amended in the course of the examination of the application to read as indicated:



Class 29: “Preserved, dried and cooked vegetables, particularly salted and pickled vegetables, soups and preparations for making soups, including vegetable soups preparations and bouillon concentrates.”

Class 30: “Sauces (except salad dressings), seasonings, spices, condiments, food additives included in Class 30, mixture of salted and dried vegetables for use as food seasoning.”

2. The Application was accepted for registration and advertised accordingly under No. 214302 in Journal No. 1888 on 19 April, 2000.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 18 July, 2000 by Société des Produits Nestlé S.A., a Société Anonyme organised and existing under the laws of Switzerland of Case Postale 353, 1800 Vevey, Switzerland. The Applicant filed a counter-statement on 31 October, 2000 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Mark Rules, 1996.
4. Acting for the Controller, I decided the opposition on 16 June, 2005. The parties were notified on that date that I had decided to uphold the opposition and to refuse registration of the mark. 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 made a number of statements and claims, which may be summarised as follows:
 - (i) The Opponent is the proprietor of a number of registered trade marks (see Appendix A) and has a very substantial reputation in Ireland under those trade marks.
 - (ii) The mark which the Applicant has sought to register offends against the provisions of Section 10(2)(b) of the Act in that it is similar to the earlier trade marks owned by the Opponent and is to be registered for goods identical with or similar to those for which the Opponent's trade marks are protected so that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the Opponent's marks.
 - (iii) The Applicant's mark is devoid of distinctive character and registration would therefore offend against Section 8(1)(b) of the Act.
 - (iv) The Applicant's mark is of such a nature as to deceive the public and registration would therefore offend against Section 8(3)(b) of the Act.

- (v) The use of the Applicant's mark is prohibited in the State by an enactment or rule of law and registration would therefore offend against Section 8(4)(a) of the Act.
- (vi) The application for registration is made in bad faith and registration would therefore offend against Section 8(4)(b) of the Act.
- (vii) The use of the Applicant's mark in Ireland is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade and registration would therefore offend against Section 10(4)(a) of the Act.
- (viii) The Applicant does not use, nor does it have a *bona fide* intention of using, the mark and registration would therefore be contrary to the provisions of Sections 37(2) and 42(3) of the Act.

Counter-Statement

6. In its Counter-Statement, the Applicant denies all of the grounds of opposition raised against the application except that it admits that the Opponent is registered as proprietor of the trade marks cited in the Notice of Opposition but it does not admit the validity of those registrations or that the Opponent has a substantial reputation in Ireland under those marks.

The evidence

Rule 20

7. Evidence filed by the Opponent under Rule 20 consisted of a Declaration (and Exhibits 1 - 5) dated 21 January, 2002, of Jean-Pierre Maeder, Head of the Trademark Department of Société des Produits Nestlé S.A., the Opponent. I would summarise his averments as follows:

- (i) the Opponent's Registered Trade Marks Nos. 52877-80¹, 52887-90 and 52892-5 were first used in Ireland in approximately 1925 and use has continued since that date;
- (ii) the trade mark CHEF and the device of a chef's head have been used by the Opponent in both the retail and food service sectors in respect of the following goods: sauces, ketchup, salad cream, mayonnaise, pasta sauces, curry sauces,

- tex mex sauces, beetroot, pickles, gherkins, malt distilled vinegars and dehydrated snacks (*product photographs exhibited to show manner of use*);
- (iii) turnover in goods sold under the marks between 1989 and 2000 was approximately £80 million and more than £5 million was spent on advertising and making the marks known in Ireland in the period 1994 to 2000 (*photographs of posters and point of sale displays and video of TV advertising exhibited*);
- (iv) goods bearing the marks have been sold in all 26 counties of the State and in all major towns and cities and have also been exported to Northern Ireland and Great Britain (*copy invoices exhibited*).

Rule 21

8. Evidence filed by the Applicant under Rule 21 consisted of a Declaration (and Exhibits PPI1-PPI3) dated 29 April, 2003 of Željko Đurđina, Vice President of “PODRAVKA” D.D. PREHRAMBENA INDUSTRIJA, the Applicant. In addition to some criticisms of the Opponent’s evidence and some comments as to the merits of the opposition, Mr. Đurđina’s Declaration contains the following relevant facts:

- (i) the Applicant’s mark is the subject of an international registration (No. R410800) and co-exists on the international register with the Opponent’s mark that is the subject of Registration Nos. 52887-90 (International Registration No. R250186) (*copies of International Registrations exhibited*);
- (ii) very many trade marks used in relation foodstuffs contain the image of a chef (*copies of National and Community Trade Mark Applications and Registrations exhibited*);
- (iii) the Applicant has used its trade mark in Ireland (*photograph of product and copy invoice exhibited*) and the Opponent has not objected to that use.

Rule 22

9. Rule 22 provides for the filing of evidence in reply by the Opponent but, by letter dated 17 November, 2003, the Opponent indicated that it did not intend to file evidence under the Rule and nor did it wish to be heard but requested that the

¹ The Declaration refers to Nos. 52877-89 but this appears to be a typographical error.

opposition be determined on the basis of the materials already filed. The Applicant subsequently indicated that it did not wish to be heard in the matter either.

The issues

10. While several grounds of opposition have been raised by the Opponent in the Notice of Opposition, a number of these have not been supported by any evidence or argument. These include the allegations that the mark which the Applicant has sought to register is of such a nature as to deceive the public (*Section 8(3)(b)*), that its use is prohibited by law (*Section 8(4)(a)*), that the application for registration was made in bad faith (*Section 8(4)(b)*) and that the Applicant does not use or propose to use the mark (*Sections 37(2) and 42(3)*). It is incumbent on an Opponent that makes allegations of this nature to back them up by reference to concrete evidence and, in the absence of any such evidence in this case, I have no hesitation in dismissing the opposition on the grounds mentioned.

11. The remaining grounds of opposition are those under Section 8(1)(b) (*devoid of distinctive character*), Section 10(2)(b) (*confusing similarity*) and Section 10(4)(a) (*law of passing off*). A decision in favour of the Opponent under any one of those grounds determines the matter and obviates the need for consideration of the other grounds but I have considered each separately in order to give a comprehensive decision on the opposition to the application.

Section 8(1)(b) – is the trade mark devoid of any distinctive character?

12. Section 8(1)(b) of the Act prohibits the registration of marks that are devoid of any distinctive character. The European Court of Justice (ECJ) has made it clear in a number of cases² that that prohibition serves a public interest in restricting registration to only those marks that can perform the essential function of a trade mark, viz., to act as a guarantee to the consumer that the goods or services marketed under the mark emanate from its proprietor. In order to perform that function, a trade mark must possess sufficient distinctiveness such that consumers can rely on it alone to identify the relevant goods/services and to distinguish them from those having a different origin. That assessment was reiterated by the ECJ in Case C104/01, *Libertel*

² Case C-39/97, *Canon*, Case C-299/99, *Philips*, Case C-517/99, *Merz & Krell*, etc.

Groep BV and Benelux-Merkenbureau, in paragraph 62 of which the following passage appears:

“It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. In that connection, regard must be had both to the ordinary use of trade marks as a badge of origin in the sectors concerned and to the perception of the relevant public.”

13. The present application is in respect of a range of foodstuffs in Classes 29 and 30 and the question to be considered is whether, having regard to the ordinary use of trade marks in relation to such goods and to the perception of consumers, the Applicant’s mark is such as to identify its goods and to distinguish them from the goods of other undertakings. The evidence filed by the Applicant includes copies of National and Community Trade Mark Applications and Registrations (*Exhibit PPI2 to the Declaration of Željko Đurđina*) from which it is clear that the device of a chef is frequently used as a trade mark, or part thereof, for the relevant goods. That is not surprising as it is a device that has an obvious connection with those goods and is apt to convey to consumers, in a subliminal manner, the message that goods so marked have been prepared under the supervision of a chef. While that may be a quite fanciful notion, given the manner of preparation of most mass-produced foods, it is, nevertheless, an effective way of imbuing the origin of the goods with a personal identity and is an attractive marketing device for producers of foodstuffs.
14. Given the widespread use of chef devices in trade marks for foodstuffs, it may reasonably be questioned whether the device of a chef, *per se*, is capable of distinguishing the goods of any one undertaking from those of others or whether it is necessary for the device to be accompanied by some additional distinguishing feature, such as a name or other word, in order to create a trade mark with the requisite distinctive character. The Opponent has not articulated the basis for its objection to the present application under Section 8(1)(b) but I think it is reasonable to assume

that that is the premise on which it is advanced. In that regard, it is important to recall that the Applicant has not sought registration of the device of a chef, *per se*, but of the specific image shown in paragraph 1 above. That image is of smiling, winking character who is holding his left hand aloft in a gesture typical of satisfaction or approval. Notwithstanding the fact that consumers are used to seeing representations of chefs on the labels of foodstuffs such as those covered by the present application, I think that this particular image displays sufficient individual character as to be likely to impress itself on the mind of the average consumer such that he would be more likely than not to recall and identify it on the occasion of a subsequent purchase. That being the case, the trade mark cannot be said to be devoid of any distinctive character and its registration in the name of the Applicant would not be contrary to the public interest underlying the prohibition on the registration of non-distinctive marks, i.e., that registered trade marks should serve to guarantee the identity of the origin of the goods in respect of which they are registered. For that reason, I find that the objection to registration under Section 8(1)(b) of the Act is not supported and I dismiss it accordingly.

Section 10(2)(b) – is the trade mark confusingly similar to the Opponent’s marks

15. Section 10(2)(b) of the Act prohibits the registration of a trade mark “*if, because 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*”. An “earlier trade mark” is defined in Section 11 of the Act as including a registered trade mark which has a date of application for registration earlier than that of the trade mark in question and all of the Registered Trade Marks cited by the Opponent in the Notice of Opposition clearly satisfy that requirement as against the present application.

Identical or similar goods

16. The goods in respect of which those marks are protected are itemised in Appendix B. Several of the goods of the application are identical with those goods and the remainder are similar to them. So, for example, “*preserved, dried and cooked vegetables*” in the application is identical with “*canned, bottled, compressed, dried and preserved foods*” in Registration Nos. 52877, 52887 and 52892; “*soups and*

preparations for making soups, including vegetable soup preparations and bouillon concentrates” in the application is identical with or similar to “*soups*” in those same registrations; “*sauces*” and “*spices*” are included in the application and in Registration Nos. 52878, 52888 and 52893 and the remaining goods of the application in Class 30 are identical with, or similar to, the remaining goods of those registrations. Thus the second requirement of Section 10(2)(b), viz., identity or similarity of goods, is also satisfied in this case.

Similar marks

17. Of the several earlier registrations cited in the Notice of Opposition, the mark to which the Applicant’s mark bears most similarity is that registered under Nos. 52892-52895. The respective marks are as follows:

Applicant’s mark



Opponent’s mark



18. Visually, those marks are highly similar as they create the same overall visual impression and differ only in respect of matters of relatively small detail, such as the different directions in which the characters face and the fact that the hand is shown in one and not in the other. The marks are identical from a conceptual aspect insofar as each could fairly be described as “a chef’s head”. The fact that neither mark includes any verbal element strengthens the conceptual similarity between them as there is nothing to dilute or alter the concept that they convey, i.e., a chef’s head.

Likelihood of confusion

19. In Case No. C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV*, the ECJ set out the criteria to be applied in assessing the likelihood of confusion between marks. Those criteria may be summarised as follows:

- the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case,
- a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa,
- the more distinctive the earlier mark, the greater will be the likelihood of confusion,
- in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings,
- in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations,
- a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed,
- the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,

- it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

20. Applying those criteria to the facts of this case, I would make the following observations:

- There is a high degree of similarity between the goods of the application and those for which the Opponent's earlier mark (Registration Nos. 52892-52895) is protected. There is also a high degree of similarity between the Applicant's mark and the Opponent's mark, the subject of those registrations.
- The Opponent's chef device mark (as registered under Nos. 52892-52895) is not inherently highly distinctive but it must be taken to have acquired significant factual distinctiveness by virtue of the long-standing and extensive use made of it. In this latter regard, I note the Applicant's criticism³ of the Opponent's evidence of use of its marks and, in particular, of the fact that the Opponent's claimed use is not substantiated by reference to invoices of transactions occurring prior to the date of the present application, which is the relevant date. Nevertheless, Mr. Maeder has averred to sales of the Opponent's products under its marks on a massive scale over a period of more than ninety years prior to the relevant date. In light of my own familiarity with the Opponent's products, which I believe would be shared by consumers generally and which it would be wrong to ignore, I am prepared to accept Mr. Maeder's averments and to regard the Opponent's chef device trade mark as having acquired a high level of distinctiveness in relation to the relevant goods.
- The goods covered by the application are everyday food items purchased by consumers generally. The average consumer may not be expected to pay particularly close attention to the selection of those goods and, so, the overall or "at a glance" impression created by the trade marks under which the goods are marketed is significant in determining the consumer's choice.

³ in the Declaration of Željko Đurđina filed as evidence under Rule 21 – see paragraph 8 above.

21. Given that the overall impression created by the Applicant's mark is essentially the same as that created by the Opponent's mark registered under Nos. 52892-52895 and having regard to the fact that the purchase of the goods in question does not normally involve particular care and attention on the part of the consumer, it seems to me that there is a high probability of confusion between the respective marks on the part of consumers. I find, therefore, that the application is open to objection under Section 10(2)(b) of the Act in light of the Opponent's earlier registrations under Nos. 52892-52895 and I refuse the application accordingly.

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

22. 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,”

23. In considering an objection to the registration of a mark based on Section 10(4)(a), it is necessary to decide whether the essential ingredients of a passing off action would be present if the Applicant were to use the mark in the State in relation to the goods of the application. In other words, does the Opponent have the necessary goodwill or reputation under its mark and would the use by the Applicant of the mark put forward for registration constitute a misrepresentation as to the origin of the relevant goods that would be likely to cause damage to the Opponent?

24. I have already indicated that I accept the Opponent's evidence as to its long and extensive user of the word CHEF and the device of a chef's head in relation to a range of products that are identical with or similar to those covered by the present application. I have also found that there is a high probability of confusion among consumers between the Applicant's mark and the Opponent's trade mark registered under Nos. 52892-52895, which is essentially the same as the device that has been




used by the Opponent for many years. Such confusion would be likely to lead to consumers who are loyal to the Opponent's products purchasing the Applicant's goods in the mistaken belief that they are those of the Opponent, with the result that the Opponent would suffer damage. It follows that I am satisfied that the use by the Applicant of the mark propounded for registration would be liable to be prevented by virtue of the law of passing off and that the application must also be refused under Section 10(4)(a) of the Act.

Tim Cleary
Acting for the Controller

11 July, 2005

APPENDIX A

Opponent's Registered Trade Marks cited in Notice of Opposition

No.	Mark	Class	Date
52877-52880	CHEF	29-32	26/11/1937
52887-52890		29-32	26/11/1937
52892-52895		29-32	26/11/1937
123236-123238		29, 30 and 32	02/10/1985

APPENDIX B

Goods for which the Opponent's marks are registered

Reg. No.	Class	Goods
52877, 52887, 52892 ⁴	29	Meats and their extracts including potted meat, meat paste, beef tea, galantines and patties, but not including frozen and fresh poultry, game and eggs; fish pastes; preserved fish; potted fish; soups; pickles; relish and salad cream; salad oil; mayonnaise; herbs included in the class; tinned tomatoes; tinned fruits; tinned vegetables; peas and beans included in the class; ready meals, such as haricot mutton, stewed steak, hotpot and Irish stew; veal, ham and tongue roll; sausages; mincemeat; junket crystals; jellies; jams; marmalade; lemon curd; groceries included in the class; milk; butter; cheese; margarine; oils and fats for human consumption; peel; canned, bottled, compressed, dried and preserved foods, all being foods or ingredients in foods but not including wheat foods.
52878, 52888, 52893	30	Flavouring essences included in the class; sauces; vinegar; spices; mustard; pepper; curry powder; household salt; chutney; tomato cream; tomato catsup; puddings; spaghetti; ices; ice, natural and artificial; tea; sugar; syrups included in the class; honey; flour included in the class; groceries included in the class; sugar preparations; cocoa; chocolate; confectionery; coffee and coffee preparations; yeast; baking powder; corn flour; custard powder.
52879, 52889 ⁵ , 52894 ⁶	31	Herbs included in the class; olives; natural and artificial animal foods; peas and beans included in the class.
52880, 52890, 52895	32	Flavouring essences included in the class; syrups included in the class.
123236	29	Extracts from vegetables, fruit, meat, poultry, fish and from vegetal sea foods; jellies and dairy products; all for food; fruit preserves and vegetable preserves; prepared meals consisting principally of foodstuffs included in Class 29; milk; protein derived from soya beans for use as a substitute for dairy products; yoghurt; edible oils and edible fats; mayonnaise, eggs, jams; food preparations having a base of vegetable, milk, meat, fish or of edible fats, all for use as sandwich spreads; soups and bouillon.
123237	30	Farinaceous products, preparations made from cereals or from rice, all for food for human consumption, rice, flour, sugar, ice-cream, sauces, cocoa,

⁴ Goods as indicated except for the omission of the words "all being foods or ingredients in foods but not including wheat foods".

⁵ Goods as indicated except for the omission of "olives".

⁶ Goods as indicated except for the omission of "peas and beans included in the class".

		chocolate, tea, tea extracts, coffee, coffee extracts and coffee essences; chicory and chicory mixtures, all for use as substitutes for coffee, non medicated confectionery, vinegar, condiments; and food preparations included in Class 30 for use as sandwich spreads and for making puddings.
123238		Non-alcoholic beverages; syrups, essences and extracts, all for the preparation of non alcoholic beverages; all included in Class 32; and fruit juices.