

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 235753 and in the matter of an Opposition thereto.

THE BUTLER'S PANTRY (MANUFACTURING) LIMITED

Applicant

(Represented by Anne Ryan & Co.)

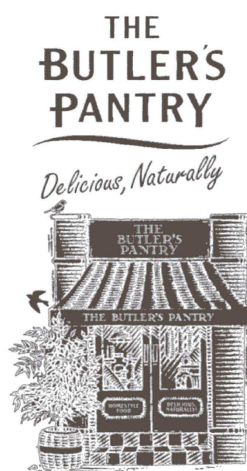
THE IRISH CHOCOLATE COMPANY LIMITED

Opponent

(Represented by MacLachlan & Donaldson)

The Application

1. On 29 November, 2006 (the relevant date), The Butler's Pantry (Manufacturing) Limited, an Irish company, of 97B Morehampton Road, Donnybrook, Dublin 4, Ireland made application (No. 2006/02684) under Section 37 of the Trade Marks Act, 1996 ("the Act") to register this sign,



as a Trade Mark in respect of the following goods and services:

Class: 29

Meat, fish, seafood and poultry, none being live, all food for human consumption; prepared salads and fruit salads; pickles, relishes, preserves; jellies, jams and marmalades; fruit preserves; fruit in syrup; pates; fillings and snack foods; prepared meals and constituents for meals; take-away snacks, mincemeat; preserved, dried and cooked fruits and vegetables; savoury spreads;

dips; mousses and chilled desserts; foodstuffs for vegetarians; packaged preparations made from such foodstuffs in the form of prepared meals or take-away snacks; edible oils, dried herbs, all included in Class 29.

Class: 30

Coffee, coffee essences and coffee extracts; teas; cocoa; drinking chocolate; flour and preparations made from cereals; bread and bakery products; sandwiches; pastry, pastries, cakes and biscuits (other than biscuits for animals); desserts and puddings; non-medicated confectionery; chocolate, chocolates and sweets; fillings; sweet spreads; ice-creams and ice confectionery; savoury spreads; sauces; including sauces for pastas; prepared meals and constituents for meals; pizzas; pies; mustard; spices; vinegar, chutneys, mayonnaise, salad dressings and sauces, all included in Class 30.

Class: 43

Catering; provision of food and drink for parties; provision of take-away meals; provision of food preparation facilities; sandwich and buffet services; sandwich bar services.

2. The application was accepted for registration and advertised accordingly under No. 235803 in Journal No. 2069 dated 04 April, 2007.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 29 June, 2007 by The Irish Chocolate Company Limited, of Clonshaugh Industrial Estate, Clonshaugh, Dublin 17, Ireland, in relation to “*non-medicated confectionery, chocolate, chocolates and sweets*” (hereinafter referred to as the said goods). The Applicant filed a counter-statement on 28 August, 2007 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 1 April, 2010. The parties were notified on 16 April, 2010 that I had decided to dismiss the opposition and to allow the mark 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 26 April, 2010.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of a number of Trade Marks (detailed in Annex 1) and then raises objection to the present application under various Sections of the Act, which I shall summarise as follows:

- Section 10(2)(b) – *likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s Trade Marks*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s Trade Marks,*
- Section 10(4) – *the Opponent enjoys unregistered rights in the State sufficient to enable the Opponent to prohibit the use of the Applicant’s mark in the State in relation to the goods covered by the application,*
- Section 6(1) – *the mark applied for is not a Trade Mark within the statutory definition*
- Sections 37(2) – *the Applicant does not use or intend to use mark in relation to goods covered by application,*
- Section 8(1)(a), (b) and (c) – *mark devoid of any distinctive character,*
- Section 8(3)(b) – *mark of such a nature as to deceive,*

Counter-Statement

6. In its Counter-Statement the Applicant denies all the grounds of opposition and states that the Applicant has been using the mark since 1987 in connection with all the goods and services for which protection is sought and that there have been no instances of confusion and no evidence of any likelihood of association between the respective marks. The Applicant denies that the Trade Mark BUTLERS is well known and that the Opponents have a substantial reputation under the mark BUTLERS.

Furthermore the Applicant considers the Notice of Opposition lodged by the Opponent as being vexatious and that “*it is absolutely nonsense for the Opponent to allege that the mark is neither being used in the Republic of Ireland nor is there a bona fide intention that it should be so used*”.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration and supporting evidence, by way of ten exhibits (B1 to B10), dated 20 February, 2008, of Colm Sorensen, a Director of The Irish Chocolate Company Limited.

I would summarise this evidence as follows:

- (i) The brand BUTLERS was first used in Ireland in 1984 and was named in memory of Ms. Marian Bailey Butler.
- (ii) The Opponents cater for the discerning chocolate lover and supply the following markets: domestic (particular to stores that are cohesive with the BUTLERS brand, that being, looking for prestige, luxury and exclusivity), duty free (domestic and international) and international retail. The Opponents have been operating a mail-order business for its chocolates for over 20 years.
- (iii) Total turnover under the BUTLERS Trade Mark since its first use is approximately €150 million. Turnover increased from €5.615 million in 2000 to €19.327 million in 2006.
- (iv) A wide range of products bearing the BUTLERS brand have been available in all 26 counties of the Republic of Ireland, and the Opponents have in excess of 10 retails outlets nationwide.
- (v) The Opponents employ over 230 people in Ireland.
- (vi) The Opponents have spent approximately €2.3 million on advertising the BUTLERS brand, in print and on television, over the past seven years (2001-2007).
- (vii) The Opponents have won many awards and received many commendations for products marketed under the BUTLERS brand.
- (viii) The Opponents also operates cafes under the name BUTLERS and has done so since 1998.
- (ix) The Opponents have opposed successfully, on the basis of the Opponent's prior rights, an attempt by the Applicant to register THE BUTLER'S PANTRY at the European Union Trade Mark Office.
- (x) The Opponent has both a national and international reputation under the Trade Mark BUTLERS and the registration of the Applicants mark could cause confusion, could lead to the Applicant's goods or services being mistaken for those of the Opponents and could undermine the Opponent's rights in the word BUTLERS.

Rule 21 Evidence

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration and supporting evidence, by way of sixteen exhibits (EB1 to EB16), dated 27 August, 2008, of Eileen Bergin, Managing Director of The Butlers Pantry (Manufacturing) Limited.

I would summarise this evidence as follows:

- (i) The Applicant has been using the mark THE BUTLER'S PANTRY logo since 1987 in connection with all the goods and services for which protection is sought.
- (ii) The Applicant's operates eight shops in Dublin (the first having opened in 1987) and supplies other food outlets in Dublin and Cork.
- (iii) The Applicant employs 87 people.
- (iv) The Applicant has received many awards relating to its goods and services. Some of these awards were presented at ceremonies at which the Opponent also received awards.
- (v) The Applicant receives on-going positive media attention and acclaim from the national media and food and drink speciality press, and has featured on radio and television shows.
- (vi) Ms. Eileen Bergin wrote and published, in 2007, a cookery book, entitled "The Butler's Pantry Recipes for All Seasons"
- (vii) The Applicants are involved in sports sponsorship (show-jumping and sailing) for over four years.
- (viii) The Applicants turnover has grown from just over €1.078 million in 2001 to €4.5 million in 2007, while expenditure on advertising has increased from €15,608 to €75,000 during the same period.
- (ix) The Applicant has a reputation in the State and at no time since 1987 has the Opponent's name ever come up when dealing with the media or been confused with the Applicant's.

Further Evidence

9. No other evidence was filed under Rule 22 or Rule 23.

The Hearing and Arguments of the Parties

10. At the Hearing the Opponent was represented by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson and the Applicant by Mr. Paul Coughlan BL, instructed by Anne Ryan & Co., Trade Mark Agents. Mr. Kennedy expressed a wish not to pursue the grounds of opposition mentioned in the Statement of Grounds other than those relating to the provisions of Sections 37, 10(2)(b), 10(3) and 10(4)(a) of the Act. Therefore, I will decide this matter on these provisions alone. They were where the focus of the arguments made in the Opponent's submission were laid, which, while expanding upon evidence already filed, did not include any additional material of significance. Likewise, the Applicant's submission expanded upon evidence already filed, but did not add anything of material significance to that evidence.

11. A summary of the main points from the submissions made at the Hearing is as follows:

Mr. Kennedy suggested that I ignore paragraphs 8-14 of the Statutory Declaration of Ms. Eileen Bergin as they were concerned with arguments and references to case law and not facts. I have disregarded them as evidence and take this opportunity to express a wish that the lodgement of such evidentiary declarations in future be confined to matters of fact.

Mr. Kennedy indicated the Opponent's willingness to restrict the opposition in regard to "sweets" to "sweets (other than sweet dishes or deserts)" and that the opposition was in terms of '*chocolates*', not '*chocolate desserts*'. Neither the offer to restrict the grounds of opposition nor the clarification drew a response from Mr. Coughlan.

Mr. Kennedy argued that the Opponent's marks are in use throughout the State, whereas the Applicant's are restricted to a relatively small area. Mr. Coughlan contested this view, pointing to substantial use, in connection with all the said goods, for over two decades, in Dublin (the capital city with a large population); claiming that the parties shared the same space, during that entire period, without any evidence of confusion; a claim that was not contradicted by the Opponents.

Mr. Coughlan argued that the many awards won by the Applicant (some at award ceremonies at which the Opponent was also honoured) were testament to the co-existence, without confusion, of two very successful and reputable brands. Mr. Kennedy pointed out

that the Applicant did not win any awards for chocolate, but for gourmet food. As regards Mr. Coughlan's claim of no confusion, Mr. Kennedy was clear that confusion became an issue only when the Applicant applied to use the mark for the said goods, and that there would be confusion if the said goods were sold in Dublin Airport (the location of the Opponent's flagship store).

Mr. Coughlan suggested that a failure by the Opponent to break down its turnover figures to reflect the national and international trading position was a significant shortcoming and demonstrated a failure on behalf of the Opponent to prove a reputation in the State. While such a breakdown was not provided, the facts are the Opponent is the number one indigenous chocolate brand in Ireland, employs 230 people in the State, sells its goods in every county of the State, has a number of own brand cafés in the State, has spent over €2.3 million on marketing between 2001 and 2007 and had a turnover of just under €20 million in 2006 alone. Even if the majority of the marketing and turnover figures relate to the export market, it is clear to me that the BUTLER brand has a reputation in the State.

Decision

Section 37(2)

12. Section 37(2) of the Act requires an applicant for registration of a trade mark to include in the application a statement that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used.
13. The Opponent raised objection under this provision, claiming that the Applicant does not use, nor has a *bona fide* intention to use, the mark applied for in relation to the said goods; a claim the Applicant describes as "*absolutely nonsense*". These claims are not well founded as evidence from the Applicant indicates that the trade mark is being used on products that fall within the specification of goods of the application and there is no reason to suspect that the Applicant does not intend to continue such use and to extend it to cover other similar goods within that specification.
14. In reality the Applicant has five years to put the mark to use before it can be attacked for non-use. As that period has not yet expired and no evidence has been produced to convince

me that the Applicant has no intention of doing so, in respect of all the said goods, I cannot find that the Applicant has no *bona fide* intention of using the mark.

15. The fact is that the application contained the statement required by Section 37(2) and no objection can lie against it based on that provision. The Opponent can challenge the veracity of that statement but, if it does so, it is effectively alleging bad faith against the Applicant (a ground for refusal under Section 8(4)(c) of the Act), and it falls that there is a strict requirement to particularise and prove that charge, which the Opponent has chosen not to do. Accordingly, I must dismiss the Opposition on this ground.

16. Having said that, one could understand it that the Opponent is claiming that its opposition under Section 37 centres on the form of the mark itself, in that use by the Applicant of the mark, in the form it is currently used, would not be use of the mark in the form in which it was applied for. I shall therefore address this point also. There is a difference between the mark applied for and the mark in use (as per the evidence filed); that difference being no more than the positioning of the words “Delicious, Naturally” - directly above the artwork in the former and directly below the artwork in the latter. The question is, does this constitute use of the mark and would the intention of using the mark in the form used currently fulfil the requirements of Section 37? Notwithstanding that these are not revocation proceedings, Section 51(2) of the Act, concerning revocation of a mark for non use, defines use of a mark as including use in a form differing in elements which do not alter the distinctive character of the mark. The difference between the mark applied for and the mark in use is so slight that I am satisfied it falls within this definition of use, and find that the mark is being used and it follows therefore, that an intention to use the mark in its current form would satisfy fully the requirements of Section 37.

Section 10(2)(b)

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

18. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.
19. The first two of these conditions are clearly fulfilled in this case. The Opponent’s marks (cited in Annex 1) were filed, at either this Office or the Office for Harmonisation of the Internal Market (OHIM), prior to 29th November, 2006 (the relevant date) and by virtue of Section 11(1)(b) of the Act, are earlier trade marks as against the present application for the purposes of Section 10. The goods of the application for registration are identical with or similar to the goods for which the Opponent’s earlier trade marks stand protected, as all specifications of goods include *chocolates*.

Comparison of the marks

20. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them,

rather than on specific points of detail that are likely to go unnoticed by the average consumer.

21. There is limited visual and aural similarity between the marks. However, the similarity that does exist relates to, in my opinion, the dominant feature of the marks, namely the word BUTLERS, (which in the case of the Applicant's mark includes an apostrophe before the 's').
22. Conceptually the marks have a low level of similarity. The shared common element of 'BUTLERS' suggests a shared conception, in that one could associate both the Opponent's and Applicant's marks with a senior male servant of a high-class household or with a shared family name. However, the evidence provided by the parties makes it clear that the 'BUTLERS' in the Opponent's marks refers to a family name, having been chosen in memory of Ms. Marian Bailey Butler, whereas the 'BUTLER'S' (and this is where the apostrophe is important) of the Applicant's mark refers unambiguously to the male servant. I find instinctively that to be the case. The Applicant's mark evokes the concept of goods being produced in a traditional or homemade fashion in a quaint or old-style store by someone with training in, and values of, what constitutes good service provision; whereas I do not find that the Opponent's marks relate to any particular concept, other than being associated with goods and services from a family or company named BUTLER.
23. Having completed a global assessment, I find that the two marks have a very low level of similarity.

Likelihood of confusion

24. The question is whether that similarity is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice² in this area and they include the following:

¹ Paragraph 23 of decision dated 11 November, 1997

² Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- a. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa,
- b. the more distinctive the earlier mark, the greater will be the likelihood of confusion,
- c. 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,
- d. 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,
- e. 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,
- f. 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,
- g. the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

25. In applying those criteria to the facts of the present case, I have reached the following conclusions:

Degree of similarity between the marks and between the goods: For the reasons set out in paragraphs 20-22 above, I regard the marks in question as having a very low level of similarity. However, the goods covered by the Application are identical to, or similar to, those of the earlier registrations (*chocolates*), which means a lower level of similarity between the marks could be deemed sufficient to declare a likelihood of confusion exists. Bearing this important consideration in mind I am satisfied nonetheless that the actual level of similarity between the marks falls way short of what is required in order for me to conclude that such a likelihood exists.

Inherent distinctiveness of the earlier mark: Some of the Opponent's marks may be regarded as having a high degree of inherent distinctiveness (particularly those with figurative elements and stylised wording), though some may not. They do, however, have an obvious capacity to identify the goods for which they are registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.

Additional distinctiveness acquired through use: The Opponents brand BUTLERS is long established, recognised easily and well known in the State, and is readily associated with chocolates and chocolate related products. I am satisfied that it has acquired substantial additional distinctiveness through use and promotion.

Overall impression created by the marks: The overall impression created by the marks in question is that they are very different. The wording is different, the concept is different and, in my opinion, the figurative element of the Applicant's mark is clearly a distinctive component that reinforced significantly that difference.

The average consumer: The class of goods covered is broad and looked at from that perspective, the consumers of the relevant goods are, the public generally and it is the likely perception of the average member of the public that I shall consider.

Overall assessment of likelihood of confusion:

26. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade marks and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's product is mistaken for that of the Opponent, or indirect confusion, whereby the

Applicant's product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. The principles set out above are very familiar to all practitioners in the field and inevitably provide a wealth of material for opposing parties to include in their submissions at hearings, which they did in this case. Nonetheless I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer of the goods in question. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under the section. The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario. In the present case, I have decided that there is no likelihood of confusion or association for the reasons stated below.

27. There is a lot more 'going on' with the Applicant's mark than just the word 'BUTLERS' and, in my opinion, the words 'THE' and 'PANTRY', and the figurative element contribute significantly to its distinctiveness and serves to distance the Applicant's mark from those of the Opponent. The visual, aural and conceptual differences between the said mark and the Opponent's marks are so obvious that a person exercising reasonable care would be unlikely to select goods bearing the 'THE BUTLER'S PANTRY (logo)' mark in place of one bearing any of the Opponent's marks. The trade marks do not look or sound sufficiently similar to make direct confusion between them a real likelihood. Even allowing for imperfect recollection, confusion seems unlikely because the distinctive and dominant features of the Applicant's mark, which create its lasting impression, are not reproduced or even suggested in the Opponent's marks.
28. In its evidence the Opponent stated that it is positioned at the premium end of the confectionery business and that its products appeal to the discerning chocolate lover. The Opponent states also that it is very particular when selecting retail outlets, selecting only

those that are cohesive with its brand, i.e. looking for prestige, luxury and exclusivity. The terms prestige, luxury and exclusivity can only be used loosely in connection with confectionery and chocolate, as these goods are, by their nature, well within the purchasing power of most consumers. Nonetheless, it is clear that the Opponent views its customers as consumers who know their chocolate, appreciate the qualities of the products offered by it and, most importantly, are prepared to pay a premium for it. That being the case it is most unlikely that these ‘discerning chocolate lovers’ would select and purchase a product bearing the dissimilar mark put forward for registration in the mistaken belief that it is the product they know by the Opponents marks, or that it is related to the Opponents products.

OHIM Decision

29. This is not the position adopted by the OHIM in opposition proceedings concerning an application by the Applicant to register as a Community Trade Mark (CTM) the words ‘THE BUTLER’S PANTRY’. There are three very important differences between the present case and that decided by the OHIM. Firstly, the mark applied for is not the same mark. Secondly, the OHIM decided that case in terms of the European public (as it must) and in so doing concluded that the word ‘THE’ would not catch the European public’s attention and the word ‘PANTRY’ would not be attributed any meaning outside the UK and Ireland. However, in these proceedings I am concerned only with the meaning of these words in an Irish context. Thirdly, the OHIM found that the conflicting signs show a medium visual and aural similarity, reinforced by a strong conceptual similarity, whereas in my opinion, as stated above (and because I am comparing different marks), the marks in question have a low level of visual and aural similarity, with little conceptual similarity.

30. The OHIM and I are not comparing like with like and, as such, it is not necessary for me to go into any detail, but I will do so for completeness. ‘THE BUTLER’S PANTRY’ is the dominant element of the Applicant’s mark and must be assessed in the context of a likelihood of confusion. Unlike OHIM I find the words ‘THE’ and ‘PANTRY’ are important and when viewed or spoken together, they convey the precise message of a particular place - a pantry, not any pantry, but the one in the possession of The Butler (the senior male servant). ‘PANTRY’ is a well-understood word in this State and is identified readily as a descriptive term for a small room where food is prepared or stored. The ‘THE’ serves to remove the possibility of the said pantry being in the possession of the Butler family or company, as the ‘THE’ is redundant when one describes such ownership.

Section 10(3)

31. Section 10(3) of the Act provides as follows:

“A trade mark which –

(c) is identical with or similar to an earlier trade mark, and

(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

32. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods³; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

33. I have already found that the first three conditions have being met – there is a level of similarity (albeit very low) with the Opponent’s marks, there is the required dissimilarity (extended to include similarity following the ECJ decision) in respect of many of the goods applied for and that the Opponent’s marks enjoy a reputation in the State. However, is that reputation entitled to protection under the Paris Convention as a well-known trade mark and does it enjoy the type of reputation that Section 10(3) seeks to protect? Such a reputation would be expected to extend beyond the limited class of consumers of the Opponent’s goods and to penetrate the consciousness of the wider public such that a substantial number of

³ In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

people would know and recognise the mark even if they had never used the Opponent's goods. In my opinion the Opponent's reputation does not reach that level and I must dismiss the opposition under Section 10(3).

34. Lest an appeal is lodged on foot of this finding, and for completeness, I will consider the other two conditions. The Applicant has established, since 1987, a brand under the 'THE BUTLER'S PANTRY' in relation to food and related services, and has a number of retail outlets from which cakes and desserts are sold. In my opinion, using or extending the use of the mark for "*non-medicated confectionery, chocolate, chocolates and sweets*" would not constitute an unusual or surprising departure for such an undertaking, and therefore, I am satisfied that the Applicant has due cause to use the mark.

35. Notwithstanding that I have found the Applicant has due cause to use the mark, would that use take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks. No evidence or convincing argument had been adduced or advanced as to how the Applicant's use of its mark might tarnish the reputation of the Opponent's marks or undermine its capacity to identify exclusively the Opponent's goods. I have already found that there is no likelihood of confusion or association between the respective marks and that the Opponent's marks do not enjoy the reputation required, and it follows that I cannot accept the Opponent's claim that the use of the Applicant's mark would result in the damage or unfair advantage that Section 10(3) seeks to avoid. Therefore, the opposition under that Section must fail on this account also.

Section 10(4)

36. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which 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,"

37. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the said mark in relation to the services covered by the application

would, as of the relevant date, have constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation would have caused damage to the Opponent. While I have previously found that the Opponent's evidence does not prove that its mark was entitled to protection under the Paris Convention as a well-known trade mark or that it had a reputation as referred to in Section 10(3), I do accept that the Opponent had, prior to the relevant date, a protectable goodwill under the marks in relation to the said goods.




38. That being said, I could not accept that the use by the Applicant of a mark, which is quite different from the Opponent's marks, could, on any reasonable interpretation, constitute a misrepresentation leading to damage. For the same reason that I have decided against the Opponent on the other grounds of opposition, I have also decided that the objection under this Section is not sustainable. For the use by the Applicant of its trade mark to be liable to be prevented by virtue of the law of passing off, it would be necessary for the Opponent to show that such use would constitute a misrepresentation, leading to damage, that the goods so marked were those of the Opponent. In the absence, as I have found, of any likelihood of confusion or association between the respective marks, I cannot see how there could be any misrepresentation as to the provenance of the Applicant's goods by virtue of the use of the said trade mark and nor is it conceivable that the Opponent could suffer loss or damage if the Applicant's mark were used in a normal and fair manner as a trade mark for the relevant goods. The basic ingredients of an action for passing off have not been established and I do not believe, therefore, that the use by the Applicant of the mark propounded for registration would have been liable to be prevented by the law of passing off and I dismiss the opposition under Section 10(4) accordingly.

39. For these reasons, I have decided that the prior registration and use of the Opponent's trade marks do not constitute grounds for refusal of the application to register THE BUTLER'S PANTRY (logo). Therefore, I have decided to dismiss the opposition and to allow the mark to proceed to registration.



Dermot Doyle
Acting for the Controller
3rd June 2010

ANNEX I

Trade Mark Registrations Referred to in the Schedule to the Notice of Opposition, as filed

Number	Date	Mark	Classes/Goods
228486	21/11/2003	<p>BUTLERS CHOCOLATE CAFÉ</p> 	<p>Class: 30 Milk based beverages; chocolate based and chocolate flavoured beverages; milk shakes and chocolate milk shakes; chocolates; fudges; peppermint creams and confectionery; cakes; biscuits; ice creams; chocolate spreads; ice beverages with a chocolate base; preparations containing chocolate for making into beverages.</p> <p>Class: 32 Non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; mineral and aerated waters.</p> <p>Class: 33 Liqueurs; cream liqueurs; chocolate based liqueurs; alcoholic beverages (except beers); wines; spirits.</p>
138878	06/11/1989		<p>Class: 30 Chocolates, fudges, peppermint creams and confectionery (non-medicated), biscuits and cakes, all being goods made in Ireland.</p>
224623	21/05/2002		<p>Class: 30 Chocolates; fudges; peppermint creams and confectionery; biscuits; cakes; ice cream; breakfast cereals; sauces (condiments); chocolate spreads; snack foods in Class 30.</p> <p>Class: 35 Retail services pertaining to food and drink products.</p> <p>Class: 43 Cafes; restaurants, snack bars, provision of food and drink.</p>

Number	Date	Mark	Classes/Goods
002680197	30/04/2002	BUTLERS	<p>Class: 29 Preserved, dried and cooked fruits and vegetables; jellies; jams; prepared nuts; snack foods in class 29; chocolate nut butter; milk shakes; yoghurts; flavoured milk based drinks.</p> <p>Class: 30 Chocolates; fudges; peppermint creams and confectionery; biscuits; cakes; ice cream; breakfast cereals; sauces (condiments); chocolate spreads; snack foods in class 30.</p> <p>Class: 33 Liqueurs; chocolate flavoured liqueurs.</p> <p>Class: 35 Retail services pertaining to food and drink products.</p> <p>Class: 43 Cafés; restaurants, snacks bars, provision of food and drink.</p>
002680213	30/04/2002	BUTLERS IRISH	<p>Class: 29 Preserved, dried and cooked fruits and vegetables; jellies; jams; prepared nuts; snack foods in class 29; chocolate nut butter; milk shakes; yoghurts; flavoured milk based drinks.</p> <p>Class: 30 Chocolates; fudges; peppermint creams and confectionery; biscuits; cakes; ice cream; breakfast cereals; sauces (condiments); chocolate spreads; snack foods in class 30.</p> <p>Class: 33 Liqueurs; chocolate flavoured liqueurs.</p> <p>Class: 35 Retail services pertaining to food and drink products.</p> <p>Class: 43 Cafés; restaurants, snacks bars, provision of food and drink.</p>

001532563	29/02/2000	 <p>The logo for Butlers Chocolate Cafe features the brand name in a cursive script. Below the name is a banner with the slogan "EXPERIENCE TWO GREAT PLEASURES TOGETHER".</p>	<p>Class: 29 Preserved, dried and cooked fruits and vegetables; jellies; jams; prepared nuts; snack foods in class 29; chocolate nut butter; dairy products; milk shakes; yoghurts; flavoured milk based beverages.</p> <p>Class: 30 Chocolates; fudges; peppermint creams and confectionery; biscuits; cakes; ice cream; breakfast cereals; sauces (condiments); chocolate spreads; snack foods in class 30.</p> <p>Class: 42 Cafes; restaurants, snack bars, provision of food and drink.</p>
000797597	06/04/1998	 <p>The logo for Butlers features a small crest of a knight on horseback above the brand name "Butlers" written in a cursive script.</p>	<p>Class: 29 Preserved, dried and cooked fruits and vegetables; jellies; jams; prepared nuts; snack foods in Class 29; chocolate nut butter; dairy products; milk shakes; yoghurts; flavoured milk based drinks.</p> <p>Class: 30 List of goods and services Chocolates; fudges; peppermint creams and confectionery; biscuits; cakes; ice cream; breakfast cereals; sauces (condiments); chocolate spreads; snack foods in Class 30.</p> <p>Class: 33 List of goods and services Liqueurs; chocolate flavoured liqueurs.</p>