

O-436-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3013926
BY BUDGENS STORES LIMITED TO REGISTER THE SERIES OF TWO
TRADE MARKS**



AND



IN CLASSES 3, 4, 6, 16, 29, 31, 33, 34, 35, 36 AND 43

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 401192
BY WM MORRISON SUPERMARKETS PLC**

BACKGROUND AND PLEADINGS

1) On 15 July 2013, Budgens Stores Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following series of two marks (“the marks”):



and



2) The list of goods and services has been restricted since the application was filed and it is now in respect of the following list:

Class 3: *Bleaching preparations included in Class 3; substances for laundry use; cleaning, polishing and scouring preparations; abrasive preparations (not for dental use); soaps, perfumes, essential oils; cosmetics; hair lotions; dentifrices.*

Class 4: *Fire lighters; fuels and illuminants; hydrocarbons and compositions thereof; barbeque liquid lighters; charcoal; candles; all included in Class 4.*

Class 6: *Aluminium foil; ironmongery; items of metal hardware; key rings, key holders and key fobs; fastening, securing and locking devices; parts and fittings for all the aforesaid goods all included in Class 6.*

Class 16: *Paper; paper articles; cardboard articles; cardboard; printed matter; periodical publications; books; photographs; stationery; adhesive materials (stationery); paint brushes; office requisites (other than furniture); wrapping and packaging materials; greaseproof paper; waxed paper; cling film; tissues; toilet paper and kitchen rolls; all included in Class 16, all relating to ready meals.*

Class 29: *Meat, fish, poultry and game, fruits and vegetables all being ingredients for use in ready-made and prepared meals*

Class 31: Agricultural, horticultural and forestry products and grains, fresh fruits and fresh vegetables; live plants and natural flowers; malt; all included in Class 31.

Class 33: Wines, spirits (beverages) and liqueurs; all included in Class 33.

Class 34: Tobacco, cigarettes and cigars; matches.

Class 35: *The bringing together, for the benefit of others, of printed matter, periodical publications, books, magazines, newspapers, photographs, stationery and posters, all relating to ready meals; **the bringing together, for the benefit of others,** of preparations and substances all for laundry use, waxing, polishing, cleaning, scouring and abrasive substances and preparations, non-medicated toiletries, cosmetic preparations, skin care preparations, antiperspirants, perfumes, body sprays and eau de cologne, essential oils, pot pourri, dentifrices, depilatory preparations, toilet articles, shampoos, soaps, essential oils, sun-tanning preparations, after-shave lotions, shaving preparations, bath salts (not for medical purposes), beauty masks, bleaching preparations for cosmetic purposes, pumice stone, cotton wool and sticks for cosmetic purposes, non-medicated talcum powder for toilet purposes, emery, false eyelashes, false nails, nail care preparations, nail varnish, colorants, dyes, lotions, waving, styling preparations and spray for hair, incense, tissues impregnated with cosmetic lotions, cosmetic preparations for slimming purposes, cosmetic preparations for the care of babies' and infants' bodies, paint stripping preparations, sandpaper, shoe polish and wax, industrial oils and greases, motor oils, fuels, lubricants, firelighters, candles, wicks, tapers, night lights, illuminants, dust absorbing, wetting and binding compositions, charcoal, coke, coal, wood for burning, briquettes, ironmongery, door and window furnishings made of metal or made wholly or substantially of metal, door knockers, metal gates, gravestones of metal, climbing iron, metal number plates, spurs, metal stirrups, tent pegs of metal, safes, nuts, bolts, screws, barrels, nails, locks, keys, metal letter boxes, ladders (metal), shelving, greenhouses, cloches, huts, portable sheds and frames (all being metal or wholly or substantially of metal), work benches, bins, boxes, articles for use as plumbing fittings, materials for use in plumbing, metallic foil, chains for animals, animal traps, paper, copying and recording paper, greeting cards, catalogues, cardboard, cardboard wrapping and packaging, adhesive materials and tapes, office requisites, teaching materials, playing cards, drawing and painting instruments and requisites, paint brushes, easels, modelling materials, paintings, postcards, confetti, bookends, bubble packs, chalk, blackboards, writing slates and tablets, erasing articles, fountain pens and nibs, paperweights, table linen of paper, bags for microwave cooking, paper replacement bags for vacuum cleaners, bags of paper or plastic,*

*plastic cling film, toilet paper, albums and almanacs, babies' diapers and napkin-pants, blinds of paper, terrestrial globes, tickets and timetables, paper tissue for removing makeup, paper towels, wrapping paper, printed plastic cards, printed cards, bank cards, cash cards, debit cards, credit cards, cheque cards, cheques, cheque books, address stamps and machines, aquaria tanks, **meat, fish, poultry and game, vegetables and fruit all being ingredients for use in readymade and prepared meals, alcoholic beverages, agricultural, horticultural and forestry products and grains, live animals, fresh fruits, vegetables and herbs, seeds, natural plants and flowers, foodstuffs and beverages for animals, malt,** products for animal litter, litter for animals, dried flowers and plants, tobacco, cigars and cigarettes, smokers' articles, matches, herbs for smoking, **enabling customers to conveniently view and purchase the aforesaid goods from a supermarket; provision of information to customers and advice and assistance in the selection of aforesaid goods brought together as above.***

Class 36: *Credit services; credit, debit and charge card services.*

Class 43: *Restaurant and take away services; all included in Class 43.*

3) The application was subsequently published in the Trade Marks Journal and on 11 November 2013, Wm. Morrison Supermarkets plc ("the opponent") filed notice of opposition to the application. The grounds of opposition are in summary:

- a) the application offends under Section 3(1)(b) and Section 3(1)(c) of the Act because the marks are devoid of any distinctive character and/or consist exclusively of signs or indications which may serve in trade to designate a characteristic of the goods and services. In the alternative, the application offends under Section 3(1)(d) of the Act because the marks consists of signs or indications that have become customary in the current language or in the *bona fide* and established practices of the trade.
- b) in the alternative, the application offends under Section 5(2)(b) of the Act because the marks are similar to an earlier mark in the name of the opponent and in respect of similar or identical goods. The relevant details of this earlier mark are:

| Relevant details | Goods relied upon |
|--|---|
| <p>2546951</p> <p>MORRISONS DINNER MADE EASY</p> <p>Filing date: 7 May 2010</p> <p>Date of entry in register: 13 August 2010</p> | <p>Class 29: <i>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and milk products; edible oils and fats; ingredients for food in class 29.</i></p> <p>Class 30: <i>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; essences for food stuffs; herbal infusions; ingredients for food in class 30.</i></p> |

This ground of opposition is directed at only some of the goods and services claimed and these are highlighted in the restricted list of goods and services in paragraph 2, above.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wishes to be heard and I give my decision following careful consideration of the papers.

Opponent's Evidence

6) This consists of a witness statement by Jorandi Daneel, Trade Mark Attorney with Marks & Clerk LLP, the opponent's representative in these proceedings. At her Exhibit JD1, Ms Daneel provides numerous Internet extracts showing use of circular sauce or syrup designs as a decoration on a plate of food.

7) At Exhibit JD2, Ms Daneel provides extracts from the Intellectual Property Office's own database illustrating numerous trade mark registrations where the marks include the words "Made Easy". Many have particular visual presentations that I need not reproduce here, but the word elements present in the marks listed are:

Arborail deck rails made easy
ASDA MEALS MADE EASY
AToM MORGAGES MADE EASY
CLASSIC MOVE Conveyancing made easy

Cliptool fencing made easy
Easyfood.co.uk ordering food made easy
FLORA 2000 INTERNATIONAL DELIVERY MADE EASY
Gelert since 1975 outdoors made easy
Living made easy
Mortgages made easy
SMART CHOICES MADE EASY
EURO MADE EASY
Econocom, Technology Made Easy
Pepper and Stew African food made easy
Certo Acquaantia Reporting Made Easy
Fruit Made-Easy
FRESH MADE EASY

8) This exhibit also includes a representation of the following mark (2618585) registered in respect of various food and drink products:



9) Exhibit JD3 consists of further Internet extracts, this time illustrating various third parties using the phrase “Made Easy” in respect of their products and services. These illustrate the words “made easy” appearing in the phrases “wine shopping made easy”, “African food made easy”, “parcels made easy – at your local corner shop!”, “returns made easy”, “shopping made easy”, “CardsMadeEasy”, “discover premium beauty, made easy”, “home cleaning made easy”, “cooking made easy and fun”, “planet-friendly food made easy”, “midweek meals made easy”, “Ching’s Chinese food made easy”, “Caribbean Food Made Easy...”, “Roofing made easy”, “toy shopping made easy”, “baking made easy”, “ice cream made easy”, “soapmaking made easy”, “cooking without made easy”, “healthy lunches made easy”, “beautiful lettering made easy” and “100% natural skincare made easy”.

10) In addition, there is one further extract that shows the mark reproduced at paragraph 8, above, in use.

11) Ms Daneel states that these exhibits illustrate that the phrase “make easy” is a common phrase used by a number of companies in commerce to refer to products prepared, or being capable of being prepared, in a simple and easy manner. She further submits that as a result of this use, the evidence shows that the phrase would be perceived by the consumer as indicating the aforesaid characteristics of the products.

Applicant's Evidence

12) The applicant's evidence consists of a witness statement by Sally Ann Schupke, trade mark attorney with Chancery Trade Marks, the applicant's representative in these proceedings. At Exhibit 2, Ms Schupke also provides evidence of other "made easy" marks existing side-by-side on the UK trade mark register and essentially duplicates the evidence of the opponent.

13) At Exhibit 3, Ms Schupke provides a copy of the official examination report issued by the Intellectual Property Office to illustrate that no objection was raised to the application based on Section 3(1) of the Act.

DECISION

The Section 3 grounds

14) The relevant parts of Section 3(1) of the Act are as follows:

3. - (1) The following shall not be registered –

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

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

15) Section 1(1) of the Act reads:

1. - (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

Section 3(1)(c)

16) I find it convenient to firstly consider the ground based upon Section 3(1)(c) of the Act. The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No

40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

17) The proviso to section 3(1) of the Act provides an exception to this exclusion. If a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee* C-108/97) then registration may be granted. However, the applicant does not rely upon this exception and I only have the *prima facie* case to consider.

18) The opponent submits that the term "made easy" is used descriptively to refer to products prepared or capable of being prepared in a simple and easy

manner. It claims that the numerous extracts from the Internet, exhibited in its evidence, support this. The evidence falls short of illustrating this. What is clear from the evidence is that descriptive phrases that consist of a noun or verb plus the words “made easy” are used by numerous traders (see Ms Daneel’s Exhibit JD3), but not that the phrase “made easy” alone is commonly used. The marks at issue do not contain a noun and further also contain a device element that resembles a swirl of sauce or syrup. Whilst the opponent submits evidence to illustrate numerous depictions on the Internet of plates of food where the plate has been decorated such swirls in various designs, the marks in question are absent a plate depiction. That said, I concede that the device is reminiscent of a swirl of sauce or syrup.

19) The opponent’s evidence does include one example where the words “made easy” appear without additional words. This is a registered mark in the UK as shown in paragraph 8, above. Therefore, its use shown in Ms Daneel’s Exhibit JD3 does not assist the opponent’s submissions that the marks are descriptive.

20) The absent of a noun or verb appearing before the words “made easy” and the addition of the sauce or syrup swirl being presented as a border to the word element of the marks results in the individual elements combining to create a mark that is more than the sum of its parts and does not exclusively designate a characteristic of the goods and services. Whilst the average consumer will perceive an allusion to artistically presented food and to easily prepared goods and related services, the mark when considered as a whole does not have a sufficiently direct and specific relationship with the goods and services listed in the applicant’s specifications.

21) Taking account of the above, I conclude that the ground of opposition based upon Section 3(1)(c) of the Act fails.

22) This finding is not disturbed by the fact that one of the marks in the series is in colour and the other is not.

Section 3(1)(b)

23) The principles to be applied under Article 7(1)(b) of the CTM Regulation (equivalent to Section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

24) Section 3(1)(b) includes within its scope those marks which, whilst not designating a characteristic of the relevant goods will nevertheless fail to serve the essential function of a trade in that they will be incapable of designating origin.

25) The public interest role underlying section 3(1)(b) is about what the average consumer thinks, in this case the general public. Does the mark have the capacity to identify the origin of the goods and services thereby enabling the average consumer to repeat the purchasing experience or to avoid repeating it? Whether the trade mark performs this essential function will be a matter of first impression because the average consumer does not analyse marks beyond what is usual for a reasonably well-informed and reasonably observant and circumspect person in the ordinary course of purchasing the relevant goods.

26) As I have already said, the applicant's marks consists of the words "made easy" and a device reminiscent of a swirl of sauce or syrup creating the illusion of a border around the word elements. The evidence fails to establish that the words "made easy" are used or need to be kept free to be used by traders except as part of a longer phrase also incorporating a noun or a verb appearing before the words "made easy". The words appearing without a qualifying noun or verb together with the bordering device element is sufficient, when taken as a whole, to impart an impression of trade origin upon the consumer. Therefore, the applicant's marks are capable of identifying the applied for goods and services as originating from a particular undertaking, and thus to distinguish those goods and services from those of other undertakings.

27) In summary therefore, I find that the applicant's marks are distinctive in respect of the goods and services covered by the application and the ground based upon Section 3(1)(b) of the Act fails.

Section 3(1)(d)

28) In *Telefon & Buch Verlagsgesellschaft mbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of Section 3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they

are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

29) The marks in question consist of the words “made easy” together with a device element that I have categorised as being reminiscent of a decorative swirl of sauce or syrup. The combination of these elements creates a whole and there is no evidence before me to demonstrate that such a combination of elements is used in a customary way by the trade. Further, I have already concluded that the mark is not descriptive, nor devoid of any distinctive character. In light of all of this the grounds based upon Section 3(1)(d) must also fail.

Section 5(2)(b)

30) In light of my findings in respect of the grounds based upon the various parts of Section 3(1) of the Act, I must also go on to consider the opponent’s case based upon Section 5(2)(b) of the Act.

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

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

32) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

33) The opponent’s mark was applied for before the contested marks and qualifies as an earlier mark under Section 6(1) of the Act. Further, it completed its registration procedures less than five years before the publication of the contested application and consequently it is not subject to the proof of use provisions set out in Section 6A(1) of the Act. The significance of this is that the opponent may rely upon the full list of goods listed in its registration.

34) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

35) Both parties' Class 29 specifications include the terms *meat, fish, poultry and game*. This represents the high point of the opponent's case. If it cannot succeed against identical goods then it will not be successful against similar goods or services.

The average consumer


36) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

37) I have restricted my considerations to where identical goods are involved. These are identified at paragraph 35, above. These goods are ordinary grocery products that are generally low cost and purchased by the ordinary retail purchasing public. They are purchased on a regular basis, normally by selection from a supermarket or other shop shelf, but also sometimes (and increasingly so) online. The nature of the purchasing act is therefore, primarily visual and

generally will not involve a great deal of care. However, I do not ignore that aural considerations may be a factor.

Comparison of marks

38) Nothing hangs on the colour aspects present in the first of the applicant's marks. Therefore, I will compare the opponent's mark only with the applicant's second mark. For ease of reference, the respective marks are:

| Opponent's mark | Applicant's marks |
|----------------------------|--|
| MORRISONS DINNER MADE EASY |  |

39) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details . The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

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

40) The applicant's marks consist of the words "made easy" and the device of a sauce or syrup swirl. These are two distinct elements of the marks where the word elements are marginally more dominant than the device element; they both contribute to, and combine to create the distinctive character of the marks. In respect of the opponent's mark, it consists of the four words "Morrisons Dinner Made Easy". The words "Dinner Made Easy" serve a descriptive purpose to inform the consumer that the goods are intended to make their dinners easier to make. The dominant and distinctive element is therefore the word "Morrisons".

41) Having identified the dominant and distinctive elements of the respective marks, I now compare the marks and consider their similarities from a visual,

aural and conceptual viewpoint. Visually, both parties' marks contain the words "made easy" and they are an obvious point of similarity. However, in all other respects, the respective marks are different. The applicant's marks also contain the swirl device that borders the word elements, whereas the opponent's mark prefixes the two words with the words "Morrisons Dinner". Taking all of this into account, I conclude that the respective marks share only a low level of visual similarity.

42) Aurally, the applicant's marks will be expressed as "Made Easy" because no attempt will be made to express the device element". The opponent's mark will be expressed as "Morrisons Dinner Made Easy". Therefore, the respective marks share the last two words/three syllables of the opponent's mark resulting in a moderate degree of aural similarity.

43) Conceptually, the applicant's mark will be understood as a strong allusion to something undefined being made easy. The opponent's mark, on the other hand, will be understood as a reference to dinner i.e. a meal being easier to make and obtained from or created by somebody called "Morrison". The fact that there is a letter "s" at the end of the name will not alter this perception. There is some overlap in these concepts and it results in a moderate level of similarity.

Distinctive character of the earlier trade mark

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

45) The opponent has not provided any evidence of use of its mark and I, therefore, only have to consider the inherent level of distinctive character. In this respect, I have already commented that the words "Dinner Made Easy" is descriptive and as such, is not endowed with any distinctive character. Such character exists because of the presence of the word "Morrisons" at the start of the mark. The impact upon the mark as a whole is to endow it with a reasonable level of distinctive character.

Likelihood of confusion

46) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the

interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

47) I have confined my considerations to where the goods are identical and I have found that in respect of these goods, the average consumer is the ordinary retail purchasing public and that the purchasing act is primarily visual in nature. I have also found that the earlier mark is endowed with a reasonable level of distinctive character and that it shares a low level of visual similarity and a moderate level of aural and conceptual similarity.

48) I have also identified that the word “Morrisons” is the dominant distinctive element of the earlier mark and that the phrase “Dinner Made Easy” performs a descriptive function. I keep in mind the guidance of Mr Iain Purvis Q.C., sitting as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 where he pointed out the following:

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

49) Not only I have found that the word “Morrisons” is the distinctive element of the opponent’s mark, it also appears at the beginning of the mark. The General Court (“the GC”), in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, has noted that the beginnings of word tend to have more visual and aural impact than the ends. By analogy, the same applies to the first word in a multi-word mark. Finally, I also keep in mind that descriptive or non-distinctive matter is given less weight when comparing marks (see *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraphs 222 and 23).

50) In taking all of the above into account, I conclude that there is no likelihood of confusion. The element that is common to both marks, the words “Made Easy” appear in the opponent’s mark only as part of a descriptive term. Consequently, the average consumer is not likely to make a link between the two marks other than possibly the vaguest of bringing to mind. The opponent’s own evidence has illustrated that the words “made easy” when prefixed with a verb or noun, is commonly used in a descriptive way, in trade. The applicant’s mark, on the other hand, has at least the minimum level of distinctive character for registration because of the visual impression created by the combination of its elements and because the words “Made Easy” are in the abstract. When not prefixed by a verb or noun, these words have an element of unusualness that will not be lost on the average consumer even accepting that there is not a great deal of care involved in the purchasing act.

51) The opposition based upon Section 5(2)(b) of the Act fails.

COSTS

52) The opposition having failed, the applicant is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I keep in mind that both sides filed evidence, but this was relatively light in nature. I award costs on the following basis:

| | |
|--|-------------|
| Considering statement and preparing counterstatement | £300 |
| Evidence | £600 |
| Total: | £900 |

53) I order Wm Morrison Supermarket plc to pay Budgens Stores Limited the sum of £900 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 8th day of October 2014

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