

O-044-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3048178 IN THE NAME OF J SAINSBURY PLC

AND IN THE MATTER OF OPPOSITION No. 402706 BY TOP DOG EATS LIMITED

DECISION

1. This is an appeal from the decision of Ms Al Skilton, acting for the Registrar, dated 23 June 2015 (O-292-15) in Opposition proceedings.
2. On 24 March 2014 J Sainsbury plc ("*the Applicant*") filed Trade Mark Application No. 3048178 requesting registration of the mark SAINSBURY'S TOP DOG.
3. The application was made in respect of the following goods:
 - Class 29
Meat, poultry and game; hot dogs; meat extracts; meat products; meat pies; sausages; mincemeat; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29; constituents for meals in Class 29
4. On the 18 August 2014 Top Dogs Eats Limited ("*the Opponent*") filed a Notice of Opposition. The single Ground of Opposition was under Section 5(2)(b) of the Trade Marks Act 1994 ("*the Act*"). The Opponent relied upon two earlier marks:
 - (1) Community trade mark No. 11837101 for the mark TOP DOG relied upon in respect of the following services in Class 43:
 - Services for providing food and drink; Bar services; Cafés, Cafeterias; Canteens; food and drink catering; Restaurants; Self-service restaurants; Snack-bars.
 - (2) UK registered trade mark No. 3003275 for the mark top dog relied upon in respect of the following services in Class 43:
 - Restaurant services; Restaurants; Restaurants (self-service-); Restaurants (Self-service -); Drink dispensing machines (rental of); Fast food restaurant services; Fast-food restaurants; Food preparation; Food preparation services; Food service apparatus (rental of -); Hospitality services[food and drink]; Ice cream parlour services; Pizza parlors; Provision of food and drink;

Provision of food and drink in restaurants; Provision of information relating to restaurants; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (Self-service -); Salad bars; Selfservice cafeteria services; Self-service restaurants; Services for providing food and drink; Snack bar services; Snackbars; Tea room services; Tearooms; Wine bars.

5. On 23 September the Applicant filed a counterstatement, denying the grounds of opposition.
6. The Opponent filed evidence. Neither side requested a hearing and neither side filed written submissions in lieu of attendance at a hearing.
7. In the course of her Decision the Hearing Officer:
 - (1) Set out the legal principles, identified by reference to the case law of the CJEU, to be applied to the assessment of the likelihood of confusion between two marks under section 5(2)(b) of the Act (paragraphs 12, and 51, 52 and 59 of the Decision);
 - (2) Set out the legal principles to be applied to the determination of the relevant ‘average consumer’ from whose perspective the assessment under section 5(2)(b) of the Act must be made (paragraphs 13 to 14 of the Decision);
 - (3) Identified the legal principles to be applied to the comparison of the goods and services in issue (paragraphs 17 to 25 of the Decision);
 - (4) Identified the legal principles to be applied to the comparison of the marks (paragraphs 29, 30 and 40 of the Decision); and
 - (5) Identified the legal principles to be applied to the assessment of the degree of distinctiveness of the earlier mark (paragraphs 44, 46 and 47 of the Decision).
8. With respect to the average consumer the Hearing Officer found that:
 - (1) The average consumer was a member of the general public and that the selection of the goods/services would be primarily visual although oral use of the marks was not to be ruled out (paragraph 15 of the Decision); and
 - (2) The average consumer would pay a moderate degree of attention to the purchase of the Applicant’s goods and would pay a higher degree of attention to the selection of the Opponent’s services (paragraph 15 of the Decision).

9. With respect to the assessment of the similarity between the goods and services in issue the Hearing Officer found as follows in paragraphs 26 to 28 of the Decision:

26. All of the opponent's services in the specification for both of its earlier marks relied on in these proceedings are services for the provision of food and drink, be that in, inter alia, a restaurant, café or pizza parlour. The applicant's goods are food goods in class 29. There are several Registry decisions which have considered the similarity of prepared foods and ingredients to the provision of services in class 43¹. Applying the same analysis, there is a similarity between the opponent's services and the following of the applicant's goods:

hot dogs; meat products; meat pies; sausages;
hamburgers; beef burgers; poultry products; snack foods
in Class 29; prepared meals in Class 29.

27. This is because all of these goods are in a form which is ready to eat and may be selected as an alternative to eating at a catering venue of the type provided by the applicant. Consequently, the respective goods and services have the same end users and purpose and are in competition. Food goods which are ready to eat are essential to the provision of the applicants' services giving rise to the position outlined in *Boston Scientific* where the average consumer is likely to consider that the goods and services have the same source. There is a high degree of similarity between these goods and services.

28. The remaining goods in class 29 of the application are ingredients, constituent parts of meals and food extracts, all of which need further processing. None of them are prepared meals or snacks of the type identified above. It is unlikely that the average consumer would consider these types of goods, the 'raw' food goods, to be provided by the same undertaking as the service. There are no shared channels of trade. The purpose of the goods is to create food/meals by, in most cases, combining a number of them. They are a step removed from the catering services which provide food to satisfy hunger. They are not in competition, the users and uses are not the same. In the absence of any evidence to the contrary, I am unable to find any similarity between the opponent's services for the provision of food and drink and the following goods:

Meat, poultry and game; meat extracts; mincemeat;
constituents for meals in Class 29.

¹ See O-001/10, CUCINA, O-198/12, FLAMIN GRILL and O-299-14 PROVENANCE BRANDS [Foot note of cases given by the Hearing Officer]

10. With respect to the assessment of the similarity of the marks in issue the Hearing Officer found that the marks were visually, aurally and conceptually similar to a medium degree (paragraph 36, 39 and 43 of the Decision).
11. The Hearing Officer went on to find that with regard to the services provided by the Opponent (i.e. services for the provision of food and drink), the mark TOP DOG possessed a normal degree of inherent distinctive character (paragraph 48 of the Decision).
12. Having made those findings the Hearing Officer assessed the likelihood of confusion and found that save with respect to the goods for which she had found no similarity that the average consumer (whether a member of the general public or a business purchaser) would consider the common element TOP DOG to indicate goods being provided by the same or economically linked undertaking (paragraphs 60 and 61 of the Decision).
13. On the basis of those findings the Hearing Officer:
 - (1) Allowed Opposition No. 402706 by the Opponent to Trade Mark Application No. 3048178 by the Applicant in respect of the following goods '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*';
 - (2) Rejected Opposition No. 402706 in respect of the following goods '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*'; and
 - (3) Made no order as to costs.
14. The Grounds of Appeal raise essentially a single point on which the Hearing Officer is said to have erred. That error was identified as follows. Having correctly identified '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' as similar to the Class 43 services relied upon by the same reasoning the Hearing Officer could and should have found that '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' were similar to the Class 43 services relied upon and then gone on to apply the same approach to all the goods specified in the application and find a likelihood confusion. By drawing the distinction in the way that she did it is said that the Hearing Officer had allowed registration of goods which encompassed those for which registration had been refused. That in turn would create ambiguity on the register.
15. As far as I am aware no Respondent's Notice was filed by or on behalf of the Applicant.

16. In the light of the indications from both the parties to the appeal that they did not wish to attend the hearing fixed in accordance with The Trade Mark Rules 2008, I directed that in accordance with Rule 73(3)(b) that the hearing of the appeal be vacated and that pursuant to Rule 73(3)(a) any written representations which the parties wished me to take into account be provided by 16 October 2015.
17. The Grounds of Appeal were more expansively addressed in the written submissions on 16 October 2015 filed on behalf of the Opponent by Bird & Bird LLP and which I have taken into account.
18. Neither the Applicant, not its representatives, have supplied me with any written materials to consider on the appeal.
19. The appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
20. In my view, quite correctly, the Opponent did not challenge either in its Grounds of Appeal or in its written submissions the correctness of the legal approach to the required assessment that the Hearing Officer identified in her Decision. Nor did the Opponent challenge the findings made with regard to the identity of the average consumer, the assessment of the similarity of the marks, or the assessment of the distinctiveness of the earlier marks.
21. The challenge to the Decision is in substance that the logic of the Hearing Officer's reasoning that led to the finding of a conflict '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' applies in equal measure to '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' and in those circumstances the Opposition should have been allowed in its entirety.
22. It seems to me that the Opponent is correct. I do not believe that the distinction which the Hearing Officer sought to draw, in paragraphs 26 to 28 of her Decision, between the various different goods specified in the application can be maintained.
23. Firstly, Class 29 is concerned with goods, mainly foodstuffs of animal origin that have been prepared for consumption or conservation. '*Meat, fish, poultry*' form a part of the class heading for Class 29 and it seems to me that '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' are, as stated by the Opponent, a subset of the

goods identified within the wording of the class heading. It does not seem possible to me to suggest otherwise.

24. Secondly, it does not seem to me that the reasoning behind the distinction drawn by the Hearing Officer between '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' being goods '*which [are] ready to eat*' and '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' being goods '*which need further processing*' or are to be regarded as '*the "raw" food goods*' can be drawn in the way that is suggested by the Hearing Officer.
25. All of the goods within Class 29 have been prepared for consumption or conservation. It seems to me that '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' do not necessarily require further processing or indeed cooking before they are '*ready to eat*'.
26. As recognised in paragraph 22 of the Decision O-001-10 Cucina Trade Mark and relied upon by the Hearing Officer '*Meat, fish, poultry*' '*will include such products which have been cooked, smoked, marinated, etc eg roast beef and kippers; not just products in completely unprocessed form*' i.e. will include goods that are '*ready to eat*' and need no '*further processing*' and/or are not properly to be regarded as '"*raw*" food goods'.
27. It is also the case that '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' may be '*ready to eat*' and need no '*further processing*' or may be regarded as '"*raw*" food goods'.
28. In these circumstances, the effect of the finding of similarity of these goods with the Class 43 services relied upon carried with it an acceptance by the Hearing Officer that whether such goods were '*ready to eat*' and needed no '*further processing*' or were to be properly to be regarded as '"*raw*" food goods' made no difference to the finding of similarity.
29. The uncontested (although not very extensive) evidence before the Hearing Officer was such as to show that well known restaurant /takeaway service providers e.g. Pizza Express, Starbucks and Nando's sold and supplied their branded products through supermarkets both in respect of products that were '*ready to eat*' and needed no '*further processing*' and products that were properly to be regarded as '"*raw*" food goods' and/or '*constituents of meals*'.
30. Therefore, in the circumstances of the present appeal where there is an unchallenged finding that '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' are

similar to the services in Class 43 it seems to me that the logic behind such a finding must be equally applied to '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*'.

31. It also seems to me that had all the goods specified in the application been found to be similar to the services in Class 43 the unchallenged reasoning in paragraphs 60 and 61 of the Decision must likewise apply to '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' such that the same result must follow with respect to the assessment of the likelihood of confusion.
32. In my view, the effect of the Decision of the Hearing Officer to allow registration to proceed with a broad specification, that is to say in respect of '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*', is to permit registration of a mark in respect of goods for which there is an unchallenged finding of conflict. Such a result is impermissible.
33. I therefore allow the appeal and on that basis allow Opposition No. 402706 in its entirety. I shall award the Opponent: (1) £700 in respect of the costs of the proceedings before the Registrar; and (2) £500 in respect of the costs of the Appeal. Such costs to be paid within 14 days of this decision.

Emma Himsworth Q.C.

Appointed Person

21 January 2016