

O-118-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2421193
BY THE CHOCOLATE AFFAIR
TO REGISTER THE TRADE MARK:**



IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION NO 94701
BY LINDA BARRIE**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2421193

By The Chocolate Affair

To register a trade mark in Class 43

and

IN THE MATTER OF Opposition No 94701

By Linda Barrie

BACKGROUND

1. On 6 May 2006 The Chocolate Affair (“CA”) applied to register the following trade mark for the following service:



Class 43 – Catering service providing chocolate fountain and dips.

2. On 12 October 2006 Linda Barrie (“LB”) filed a notice of opposition to the above application based on the sole ground of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). LB relies on her own trade mark, namely UK Registration 2401412; the details of her trade mark are shown below:

Trade Mark	Date of filing	Specification
CHOCFAFFAIR	13 September 2005	Confectionery; chocolate; products made from or containing chocolate; swizzle sticks; beverages made from or containing chocolate; preparations for making chocolate drinks.

3. CA filed a counterstatement denying the ground of opposition.

4. Both sides filed evidence, this is summarised below. Neither side requested a hearing or filed written submissions in lieu of attending a hearing. Both sides have however made some submissions both as part of their evidence and in other documentation on record; these will be drawn upon and taken into account in this decision, but I do not intend to summarise them separately.

Opponent's evidence

Witness statement of Rowena Bercow

5. Ms Bercow works for BRANDED!, LB's representatives in this matter. Her evidence is opinion rather than fact. She states that AFFAIR is the distinctive element of each mark (the rest being descriptive). She states that chocolate is a luxury product prepared and consumed in various forms, sold at various outlets and served by caterers at diverse events and that the use of a mark with the same distinctive element sold or served in any type of outlet, venue or event, is likely to lead to confusion amongst the public.

Witness statement of Carin Burchell

6. Ms Burchell also works for BRANDED!. Her evidence is procedural in nature. It is filed merely to confirm that the evidence of LB (detailed below) is a true copy of the witness statement filed earlier in the proceedings (the original copy of the evidence having been lost). Nothing turns on this.

Witness statement of LB

7. LB is the proprietor of UK registration 2401412. LB's evidence primarily details the coining of her business name. In summary, it was coined after an evening in the company of six of her friends. Five names were initially considered but CHOCAFFAIR was eventually decided upon. LB states that we (presumably the group of friends) loved the similarity between the words "affair" and "fair trade" and the feeling of indulgence and naughtiness it evoked. She completes her evidence by stating that she is the proprietor of the domain name "www.chocaffair.com" which is used to promote and sell her products.

Applicant's evidence

Witness statement of Brian Charles De Silva & Suzanne Thomas

8. The witnesses are partners in CA. Their evidence details how their business name was selected. In summary, much debate and deliberation went into this, as part of which the web-sites of Companies House and the Patent Office (now known as the UK Intellectual Property Office) were consulted. After settling on the name "The Chocolate Affair" the domain name "www.thechocolateaffair.co.uk" was registered. The name was chosen to conjure up an image of indulgence and naughtiness in order to tempt customers to use their services and to spoil the customers' guests at their parties.

9. The evidence also highlights the lack of any instances of confusion in the 18 months that CA has been trading. Also highlighted is the fact that their chocolate fountains use warm flowing Belgium chocolate whereas the opponent's product is, they say, a chocolate drink. They state that CA operates in Chelmsford and the surrounding areas whereas LB is based in York and sell nationwide over the Internet. Also provided are the witnesses' opinions on the similarity between the marks, they feel they are very different.

DECISION

Section 5(2)(b)

The law

10. Section 5(2)(b) of the Act states:

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

(a)

(b) it is similar to an earlier trade mark and it 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.”

11. 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.”

12. Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

13. LB's trade mark was filed on 13 September 2005. CA's trade mark was filed on 6 June 2006. Neither party has claimed any form of priority. LB therefore has an earlier trade mark as defined in section 6(1) of the Act. In relation to the proof of use requirements, LB's trade mark has not been registered for five years or more even at the date of writing this decision let alone at the date of publication of CA's trade mark. Therefore, the proof of use provisions do not apply. **Consequently, all of the goods covered by LB's trade mark must be taken into account.**

14. When reaching my decision I have taken into account the helpful guidance provided by the European Court of Justice ("ECJ") in a number of judgments relating to Article 7(2) of the Directive (Section 5(2) as incorporated into the Act), notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) 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; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Relevant public and the purchasing act

15. As matters must be judged through the eyes of the average or relevant consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. Catering relates to the provision of food (or as in CA's service the provision of chocolate fountains and dips) at social events such as parties and weddings etc¹. I do not regard CA's service to be a particularly technical one and will be aimed at a broad spectrum of the general public. However, those likely to encounter it will be of a much narrower range than those who may encounter a general consumer item. The relevant consumer is also likely to include corporate customers who may wish to use CA's service for business events. Furthermore, the relevant consumer would also include what I would describe as intermediaries, for example, hotels who may be asked by a customer to provide CA's service as part of an overall wedding package. Irrespective of the part of the relevant consumer focused on, the purchasing act will be reasonably considered given that the selection of a caterer, regardless of the type of food provided, is likely to be an important choice for the customer in order to ensure that the catered for event is a success.

16. In relation to LB's goods, these are general consumer items and the relevant public is the general public at large. The purchasing act is likely to be less considered than CA's service as the goods are relatively inexpensive everyday items. However, brand loyalty and/or taste will still play a part in the selection process, the purchasing act will therefore not be a completely ill thought out process. Ms Bercow states in her evidence that chocolate is a luxury product; I reject this argument. Whilst there may be some chocolate products that are more expensive and/or of perceived better quality than others, it is still generally regarded as an everyday general consumer item.

Similarity of trade marks

17. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). For ease of reference, the respective trade marks are:

Applicant's trade mark



Opponent's trade mark

CHOCAFFAIR

¹ Collins English Dictionary – 5th Edition.

18. From a visual point of view, CA's mark has the device of what I (and the relevant consumer) would take to be a chocolate fountain and it also has pictures of chocolate dipped strawberries in place of the letter A in the words "chocolate" and "affair". Whilst this adds a visual figurative difference between the respective marks, the impact of this figurative difference is lessened (although I do not ignore it altogether) because these elements are non-distinctive in nature for the service concerned, and thus, even the picture of the chocolate fountain (which is not insignificant in terms of size) could not be considered as a dominant and distinctive element of the mark.

19. The dominant and distinctive element of CA's mark are the words "The Chocolate Affair". The only element in LB's mark is the word "CHOCAFFAIR". Although in LB's mark the word chocolate is abbreviated to CHOC and the word AFFAIR is then conjoined to it, the eye will still see the individual elements of it. This therefore creates a degree of visual similarity. However, I cannot say that the degree of visual similarity is particularly high given the visual impact of CA's mark as a whole, together with the conjoining of the words and the abbreviation of the word "chocolate" in LB's mark.

20. From an aural point of view, CA's mark will have the simple and obvious pronunciation of THE CHOCOLATE AFFAIR. LB's mark will be pronounced, irrespective of the conjoining of its elements, as CHOC AFFAIR. The words used will therefore and self evidently create a phonetic resonance that will not go unnoticed by the relevant consumer. The marks are aurally similar.

21. In terms of conceptual similarity, both CA and LB suggest in evidence the same conceptual significance from their marks, namely, a concept of indulgence and naughtiness. I come to a similar view; both marks conjure up a love affair with chocolate. Consequently, the marks are not only conceptually similar, they are conceptually identical. **Overall, I assess the marks as being similar to a reasonable degree.**

Similarity of goods/services

22. CA's service is a catering service for the provision of chocolate fountains and dips. LB's goods cover chocolate and confectionery at large as well as chocolate drinks. CA has observed that LB's product is a chocolate drink, however, I cannot limit my analysis to these goods given that LB's specification is much wider than this and that the proof of use provisions do not apply to LB's mark. Indeed, LB's best case is likely to be in relation to chocolate itself when taking into account the services of CA. To what extent are these goods and services similar?

23. All relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account.

Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

24. Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

25. In terms of the nature of the goods and services, they clearly differ. One is a physical product whereas the other relates to the provision of a service. There is however a slight overlap in relation to the intended purpose as both the goods and the service have the same ultimate end result, namely, the consumption of chocolate in some form. I refer to this overlap as slight because the service in question is a catering service, a more rounded and realistic answer to the question of intended purpose is that the intended purpose of the service is the provision of a catering facility at parties and events for guests to enjoy a chocolate fountain and accompanying dips, whereas, the intended purpose of chocolate is the simple consumption of the goods by the general public; put simply, one is to cater for guests enjoyment at special events the other is for simple human consumption.

26. The method of use of chocolate and other confectionery is by way of oral consumption. There is no real tangible method of use of a catering service. Easier to compare in terms of the assessment of similarity are the users of the goods and services. The user of chocolate is the general public. The general public are also potential users of the catering services, but a much narrower range of them are likely to call upon the type of catering service involved. The catering service would also be used by corporate customers requiring catering for corporate events and functions. Also a potential user would be intermediaries (as I have described in my assessment of the relevant consumer), however, I cannot rule out the possibility that the end user in these circumstances (the general public) could be made aware of the trading name of the caterer, for example, by the placement of business cards or other signs. This equates to there being some overlap, albeit a narrowly focussed one, in terms of users. I should add however that this degree of overlap is of limited significance given that general consumer items will by their very nature be used by or encountered by the general public at large, this, in itself, is unlikely to make the goods or services involved similar.

27. The trade channels of the respective goods and service are quite different. Chocolate and other types of confectionery are traditionally sold through supermarkets and other retail establishments (I note that the opponent trades on-line - this represents another form of trade, albeit not the most common form) whereas someone wishing to procure the services of a caterer who will provide a chocolate fountain and dips is more likely to inspect relevant trade directories or will undertake Internet searches to identify a relevant and appropriate service provider.

28. In relation to competitive uses, it could be argued that someone wishing to provide a chocolate fountain and dips at their special event may opt to cater for it themselves by buying in chocolate and dipping ingredients and purchasing or hiring a chocolate fountain, rather than employ a caterer to provide this as a package. Whilst this creates a

degree of competition, I am conscious that chocolate itself is only one ingredient in this form of potential competitive use and is unlikely to be regarded as directly competitive in the same way as, for example, the hire of chocolate fountains against a catering service package where, in these circumstances, the competitive aspect would be regarded as much more direct.

29. Any potential complementary uses are another factor to consider. This would be relevant if the goods are indispensable for the use of the service and/or vice versa. I can only see the potential complementary use working in one direction; the use of a catered for chocolate fountain service is in no way indispensable for the use of chocolate or any other form of confectionery. However, there is a degree of complementary use in the opposite direction given that a catered for chocolate fountain could not operate without chocolate. The degree of complementarity is however not as stark as, for example, if the goods were chocolate against the physical product of a chocolate fountain machine; here the complementary nature of the goods would be much more clear (albeit still in only one direction).

30. Overall, there is, in my view, a link between the respective goods and the service, but, where I have found similarity, together with its degree, balanced against where I have found dissimilarity, **lead me to conclude that this link results in a degree of similarity that is at the lower end of the scale.**

Distinctiveness of the earlier trade mark

31. The distinctiveness of the earlier mark is another important factor to consider because the more distinctive (based either on inherent qualities or because of the use made of it) the earlier mark, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph. The earlier mark is CHOCAFFAIR. LB has filed no evidence to show that its distinctiveness has been enhanced through use; I therefore only have its inherent qualities to consider. The mark clearly alludes to chocolate, and, as LB puts it, is suggestive of indulgence and naughtiness. Given this, I cannot say that the mark is inherently highly distinctive in the same way as an invented word or a word that is completely fanciful for the goods involved. Nevertheless, the mark as a whole says little about the characteristics of the goods. **Overall, I consider the mark to be one of at least an average level of distinctiveness.**

Likelihood of confusion

32. I have assessed the marks to be reasonably similar but the degree of overlap between the respective goods and service to be at the lower end of the scale. I have assessed the earlier mark to be of an average degree of the distinctive character. Do these, and the other relevant factors, combine to create a likelihood of confusion?

33. Whilst evidence has been filed by both CA and LB, it does little to establish whether or not the relevant consumer will be confused about the trade origin of the goods/service marketed under the respective marks. There is, for example, no evidence to inform me as to whether the relevant consumer is used to seeing the respective goods/services co-

branded. Nevertheless, LB's position is that any form of chocolate sold or offered in any manner under a sign that shares the same distinctive element will lead to confusion. Whilst I understand this claim, it largely ignores the inter-dependence between the various factors that need to be taken into account.

34. In my view, and taking into account the inter-dependency of the various factors, the uses of the respective marks in relation to the respective goods and service will not lead to a likelihood of confusion. I come to this view for a number of reasons. On the face of it, I see no reason why a relevant consumer encountering CA's catering service providing chocolate fountains and dips under "The Chocolate Affair" sign will believe there to be an economic link between chocolate or other confectionery sold under LB's CHOCAFFAIR sign or vice versa. I regard the overlap between the goods and service to be low (although I cannot say that this degree of similarity could never lead to a likelihood of confusion) and that in my experience, and with no evidence to counter my understanding, it is not common for confectionery manufacturers to provide forms of catering service or, for caterers in this field to provide goods for sale under their trading signs. It may be that a consumer who knows of one mark and who then encounters the other may pause to wonder as to whether there is an economic link, but due to the degree and nature of overlap between the goods and service, this will not transcend to the end result that the consumer is likely to be confused about the economic origin of the goods or service. This is particularly so, in my view, given that the earlier mark itself is not of a highly distinctive character or one whose distinctive character has been enhanced through use; if this were not the case, then the relevant consumer may be more likely (although not guaranteed) to be confused about the trade origin of the goods.

35. Taking all things into consideration, I am left with the view that the relevant consumer, who is considered to be reasonably circumspect and observant, may notice the similarities between the respective marks, but, due to the goods and service involved, this will be viewed as nothing more than a co-incidental sharing of a similar averagely distinctive trade name and, consequently, they would not believe the respective undertakings to be the same or to be economically linked. **The opposition under section 5(2) of the Act fails.**

CONCLUSION

36. As section 5(2) is the only ground of opposition, the opposition as a whole fails. In the circumstances the application for registration should proceed to registration in respect of:

Class 43 – Catering service providing chocolate fountain and dips.

COSTS

37. The applicant has been successful and is entitled to a contribution towards their costs. I order LB to pay CA the sum of £432. This sum is calculated as follows:

Considering notice of opposition	£133
Statement of case in reply	£200
Preparing and filing evidence	£66
Considering evidence	£33
Total	£432

38. It should be noted that in this breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the opponent has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6²:

“48.6-(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

39. The applicant must pay the opponent the above sum within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of April 2008

Oliver Morris
For the Registrar
The Comptroller-General

² Mr Simon Thorley QC, sitting The Appointed Person in *Adrenalin Trade Mark* (BL 0/040/02), confirmed the applicability of this Rule to costs before the Registrar of Trade Marks.