

O-040-15

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 2509517  
IN THE NAME OF MONTANA BAKERY LTD  
IN RESPECT OF A SERIES OF THREE TRADE MARKS:

**MONTANA BAKERY**

Montana Bakery

montana bakery

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF  
UNDER NO 84440 BY ITALIA ALIMENTARI S.P.A. and INALCA SOCIETÁ PER AZIONI.

## BACKGROUND

1. Trade mark No. 2509517 shown above stands registered in the name of Montana Bakery Ltd (the proprietor). It completed its registration procedure on 24 February 2012 and is registered for the following goods in class 30 and services in class 43:

### **Class 30**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread; speciality breads; baguettes; ciabatta; focaccia; petit pains; fresh and frozen bread; garlic bread; malt bread; bread buns and rolls; croissants; bread casings filled with fruit; bread concentrates; bread improvers; bread improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; bread products containing cooked foods; bread products for food; bread products; breadcrumbs; breadsticks; grossini; Danish bread and bread rolls; filled bread products; filled bread rolls; ginger-bread; hamburgers being cooked and contained in a bread bun or roll; hotdogs being cooked sausages in bread rolls; malted bread mix; mixes for the preparations of bread; pitta bread; pre-baked bread; rye bread; semi-baked bread; snack foods consisting principally of bread; stuffed bread; toasted bread; toasted bread products; unfermented bread; unleavened bread; wholemeal bread; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs; pizza; pizza bases; pastry; bakery products; bakery products for human consumption; fruit and cream fillings for bakery products; food mixes for making bakery products; mixes and preparations for making bakery products; ices; muesli; noodles; halvah; pies; honey; treacle; syrup; yeast; baking-powder; salt, pepper, mustard; vinegar; sauces (condiments); spices; fruit sauces; ice.

### **Class 43**

Services for providing food and drink; baking and bakery services; consultancy services relating to baking techniques; catering for the provision of food and drink; advisory services relating to catering; business catering services; contract catering services; catering services for airlines and airports; catering services for hospitals, holiday camps, hotels, motels, restaurants and retirement homes; cooking services; food cooking services; confectionery services; cafes; cafeterias; canteens; pizzerias; self-service restaurants; snack-bars; sandwich bars; bar and restaurant services; rental and hire of cutlery, crockery, chairs, tables, table linen and glassware; accommodation and restaurant booking and reservation services; providing temporary accommodation; hotel and motel reservations; provision of conference and exhibition facilities; advice, information and consulting services in relation to all the aforesaid services.

2. On 12 June 2012, Italia Alimentari S.P.A. and Inalca Societ  per Azioni (the applicants)<sup>1</sup> filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) which state:

“47(2) The registration of a trade mark may be declared invalid on the ground-

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

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<sup>1</sup> The application was filed in the name of Montana Alimentari S.P.A. but following a change of company name and the addition of a related company as co-applicant the application stands in the names given in paragraph 2 of this decision.

(b) that there is an earlier trade mark in relation to which the conditions set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

“5. - (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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) ...

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom 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, or...”

3. The applicant relies upon the following Community Trade Marks (CTMs), goods and services:

Mark details:	Goods and services:
<p><b>CTM:</b> 1719376</p>  <p><b>Filing date:</b> 22 June 2000</p> <p><b>Date of registration:</b> 17 November 2006</p>	<p><b>Class 29</b> Meat, poultry, preserved and cooked vegetables, preserves, food in brine.</p> <p><b>Class 30</b> Sandwiches and preparations made from cereals.</p>
<p><b>CTM:</b> 2869782</p>  <p><b>Filing date:</b> 30 September 2002</p>	<p><b>Class 43</b> Outside catering.</p>

<b>Date of registration:</b> 20 January 2010	
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4. 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

5. The applicant's mark 1719376 (MONTANA and background) is an earlier mark, which is subject to proof of use because, at the date of the application for invalidity it had been registered for five years.<sup>2</sup> The applicant's mark 2869782 (MONTANA Grill and background) had not been registered for five years at that date so is not subject to proof of use. Consequently, the applicant is entitled to rely on its full specification for ‘outside catering’ in respect of the latter mark.

6. On 3 September 2012, the proprietor filed a counter statement in which denies the grounds of invalidation. At paragraph 4 it states:

*“The Registered Proprietor’s common law rights established in the UK in the business name and trade mark MONTANA BAKERY pre-date the filing dates of both the Joint-Applicants’ CTM registrations relied upon in these proceedings by over two years in the case of CTM registration No. 1719378 MONTANA (stylised) and over four years in the case of CTM registration No. 2869782 MONTANA Grill (stylised). Such rights confer upon the Registered Proprietor the right to prohibit the use and registration of the [Applicants’] later filed marks by virtue of the common law tort of passing off.”*

7. Tribunal Practice Notice (TPN) 4/2009 is titled “Trade mark opposition and invalidation proceedings – defences.” Under the heading “The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark”, the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

mark, are wrong in law. **If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.**"

8. The proprietor has made no such application. Consequently, I will say no more this submission.

9. The applicants filed evidence and the proprietor filed submissions during the period allowed for evidence. I will refer to these as necessary below. A hearing took place on 13 November 2014, by video conference. The proprietor did not attend. The applicants were represented by Mr Michael Conway of Haseltine Lake LLP.

## **EVIDENCE**

### **The applicants' evidence**

#### Witness statement of Heather Orr with exhibits HO1 – HO15

10. Ms Orr is a trade mark attorney at Haseltine Lake LLP. Her witness statement is dated 14 January 2013.

11. The point being made by Ms Orr in her statement is that *"a number of bakeries make and sell both bread and bread filled products such as sandwiches"*.

12. I am prepared to accept this assertion based on my own experience and will not proceed to outline the exhibits here.

#### Witness statement of Giorgio Pedrazzi with exhibits GP1 – GP24.

13. Mr Pedrazzi is the Managing Director, Sales and Marketing Director and Chairman of the Board of directors at Italia Alimentari S.p.A.<sup>3</sup> His witness statement is dated 18 January 2013. It is not clear what the relationship is between this company and the other applicant in these proceedings, Inalca Società Per Azioni, however, as Mr Pedrazzi states he is authorised to make the statement and has access to company records, I presume his use is with the consent of the proprietor of the earlier marks.

14. Mr Pedrazzi states, as follows:

*"4. Montana produces an extensive range of meat products and snacks, including cured meat, cold cuts, hot dogs, hamburgers, prepared meals, pizzas, paninis, focaccias and sandwiches. The company also operates a gourmet division which offers a range of other food products including meat and poultry, preserved and pickled vegetables, sweet breads, cakes, deserts, sauces and oils. Montana also owns a gourmet restaurant at which it sells freshly made food under the MONTANA brand."*

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<sup>3</sup> Formerly Montana Alimentari S.P.A

15. Exhibits GP1 and 2 are product brochures for 'Mister Panino' dated 2007 and 2008. The prints are of poor quality and the brochures are in Italian. Images on each page show a range of sandwiches, toasted sandwiches, filled breads, hot dogs, hamburgers and pizzas. The 2007 brochure comprises twelve pages, seven of which show the MONTANA mark at the bottom of the page in the following form:



16. The 2008 brochure comprise fourteen pages, six of which show the MONTANA mark at the top or bottom of the brochure page, in the form I have shown above.

17. Exhibit GP3 is a brochure for a snack grill vending machine which Mr Pedrazzi states is from 2011. The brochure comprises eight pages, five of which feature the MONTANA mark as registered, including the front and back covers. The brochure is in Italian, but it is clear from the images that the range of products sold from the vending machine are hamburgers, hot dogs, tortilla wraps and filled pizzas.

18. GP4 is described as photographs of sandwiches bearing the Montana mark. The exhibit consists of nine white pages on which images of packets of sandwiches have been presented. There is no other information provided on the pages and they are not dated. 37 packets of sandwiches show the MONTANA mark as registered.



19. A further 3 show the mark in the following form:



20. The remaining 4 show the mark in gold text with no outline and the word GOURMET presented below the word MONTANA in smaller type.



21. Exhibit GP5 is an undated close-up photograph of what look to be hamburger rolls. The MONTANA mark can be made out on the packaging.

22. Exhibit GP6 and 7 are images of panettoni. The first is small and the mark cannot be seen on the product: the goods are described as 'Pandoro Paluani Montana Gourmet'.

The page has a print date of 20 December 2012 and is taken from www.montanagourmet.it. The second is an enlarged view of a similar product. The label has the word MONTANA at the top with a smaller word underneath. The print quality is poor but the smaller word looks to be 'GOURMET'. The page is not dated.

23. Exhibit GP8 is a page taken from the same website with a print date of 20 December 2012. Four jars are shown at the bottom of the page. The labels are too small to be read but descriptions in Italian are provided below the jars. Mr Pedrazzi states that the jars contain balsamic vinegar white truffle, artichokes, grilled mushrooms and pumpkin preserves.

24. Exhibit GP11 is printed from the same montanagourmet website and shows a gift box/envelope with a black label on the front. The lettering on the label is the word MONTANA with the smaller word GOURMET presented below it. A selection of goods is shown which may be included in the gift box. These are an assortment of MONTANA and non-MONTANA branded goods.

25. Exhibit GP10 is a page taken from www.montanafood.it showing prepared Bolognese meat sauce in cartons and cans. The page also provides a recipe and was printed on 20 December 2012. The mark is shown in the form as registered.

26. Exhibits GP9, GP12 and GP13 are photographs of meat products. The pages are white and undated with photographs of the goods pasted onto them. Whole hams, chicken roll and salamis are shown, as well as sliced packaged meats and hamburgers/meatballs. The range of marks shown on the goods are those I have already reproduced above.

27. Exhibits GP15-19 are invoices for the years 2007-2011. These total 595 pages and are in Italian. A translation of some of the key descriptions is provided at exhibit GP20. I will not itemise the invoices here but will refer to them, and my conclusions arising from them, as necessary below.

28. Exhibit GP25 is described by Mr Pedrazzi as an overview of sales of MONTANA branded products in different European countries for the years 2001-2012. The currency relevant to the figures is not identified. Figures are provided for 27 countries. I have elected to show a snapshot of the figures by listing those for the UK, France and Germany for 2007-2012 which are as follows:

	<b>UK</b>	<b>France</b>	<b>Germany</b>
<b>2007</b>	335,522.08	265,803.37	688,894.12
<b>2008</b>	388,458.65	262,355.63	811,962.02
<b>2009</b>	401,337.46	133,614.84	1,010,192.86
<b>2010</b>	429,892.49	163,416.10	1,202,875.01
<b>2011</b>	462,121.97	163,789.41	1,193,955.03
<b>2012</b>	396,980.10	94,576.66	1,097,702.38

29. This completes my summary of the evidence to the extent I consider it necessary.

### **The MONTANA mark**

30. The applicants' MONTANA mark completed its registration procedure on 17 November 2006. The application for invalidation was made on 12 June 2012. Consequently, this mark

is subject to proof of use, as per Section 47(2) of the Act and the proprietor has requested the applicants prove use of it in respect of all of the goods for which it is registered.

47 (2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)\* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,  
(b) the registration procedure for the earlier trade mark was not completed before that date, or  
(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or  
(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and  
(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

31. The relevant period is the five year period ending on the date of application for invalidation, namely 13 June 2007 to 12 June 2012. The onus is on the opponent, under section 100 of the Act, to show use of their mark during this period in respect of those goods on which it seeks to rely. In reaching a conclusion on this point, I must apply the



same factors as I would if I were determining an application for revocation based on grounds of non-use.

32. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

33. There is no de minimis level for genuine use, although, I bear in mind that the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”.

34. The earlier mark is a CTM which means that genuine use must be in the EC. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (“*ONEL*”) the CJEU said:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

35. Regarding the territorial scope of the use, the CJEU went on to say:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal

market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

36. In addition, I will keep in mind the guidance from Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07* comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

“(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].”

37. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20. The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

38. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in

relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

39. Also relevant are the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,<sup>4</sup> where he summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

40. First, I have to identify, as a matter of fact, whether the trade mark relied on by the applicants have actually been genuinely used and, if so, in respect of which goods. Having reached a conclusion on that point, I must then go on to decide what constitutes a fair specification.

41. The applicants rely upon the following goods:

**Class 29**

Meat, poultry, preserved and cooked vegetables, preserves, food in brine.

**Class 30**

Sandwiches and preparations made from cereals.

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<sup>4</sup> BL O/345/10

42. In considering the applicants' evidence, it is a matter of viewing the picture as a whole. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, Mr Geoffrey Hobbs Q.C.<sup>5</sup>, sitting as the Appointed Person, stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. V. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

43. In *Awareness Limited v Plymouth City Council*<sup>6</sup>, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having

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<sup>5</sup> *BL O/404/13*

<sup>6</sup> *BL O/230/13*

regard to the interests of the proprietor, the opponent and, it should be said, the public.”

44. And further at paragraph 28:

“28. ... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

### **Proof of use and fair specification**

45. Commonly, the mark is used in the form as registered. This can be seen on invoices and promotional material as well as on the goods themselves, including, inter alia, sandwich packaging, burgers and cured meats. In addition, the mark is shown in gold text on a black background in respect of the applicants’ ‘gourmet’ range of goods.

46. Where the goods are identified, they are always referred to as ‘Montana’ goods. The applicants have provided invoices dated between 2007 and 2011 which amount to 595 pages. They are broken down into the respective years but are not in date order and all list the goods in Italian. A translation of the goods is provided at exhibit GP20. The invoices show sales of meat and sandwiches to a number of countries including, inter alia France, Germany, Italy and the UK. See, for example, page 103 dated 14 November 2007 showing a range of meat goods sold in Italy, page 178 dated 7 February 2008 for sales of meat goods to Germany and pages 322, 333, 478, 490, 535 and 562 which show sales of meat to France and the UK and sandwiches in Italy, throughout the relevant period.

47. Sales figures have not been provided for Italy, which is where the applicants are based. At exhibits GP21-GP24, Mr Pedrazzi provides some figures for the Cremonini Group which would appear to include Mr Pedrazzi’s company, though the relationship between them is not explained. The figures provided in respect of cured meats and snacks refer to more than one company and would seem, from the subsequent analysis, to include the Italian and wider European markets. It is not possible for me to draw any conclusions from these figures with regard to the applicants’ sales under the mark for the relevant goods in Italy.

48. With regard to use in other areas of the EU, Mr Pedrazzi provides several pages of figures relating to 25 European countries. The currency is not given but since the applicants’ business is based in Italy and all of the invoices are in Euros and considering the presentation of the figures, I will presume that the figures are in Euros. For 2007 – 2011 these figures amount to approximately 5 million in Germany, 2 million in the UK and 1 million in France. There is no indication of to which goods these figures refer.

49. The range of goods available, under the MONTANA mark, is often shown on undated pages with no background: there is some evidence from the parties' website and product catalogues, though these are in Italian.

50. Although the evidence could have been better marshalled, when considered as a whole it shows that they have been trading in MONTANA goods throughout the relevant period, in respect of a range of goods. Sales have taken place in a large number of EU countries, though to what extent and for which goods I cannot be sure. The EU/UK market for the relevant goods is extremely large, however, whilst I am unable to conclude that the opponent has a large share of that market, the test is one of real commercial exploitation rather than prominence. The sales figures for the UK together with invoices which relate to a number of EU Member States are, in their totality, sufficient to show genuine use of the mark in the community during the relevant period. Having established that there has been genuine use, I must now go on to consider what constitutes a fair specification.

51. With regard to a fair specification for the goods, the applicants have shown numerous examples of use in respect of a range of meat products in class 29 and a substantial range of sandwiches in class 30. I have not been provided with any evidence of use in respect of preserved and cooked vegetables, preserves and food in brine in class 29 or preparations made from cereals in class 30. In support of this finding, the translation document provided by Mr Pedrazzi at GP20 in respect of the goods shown on invoices for the relevant period lists the categories of goods as, 'meat products', two types of sandwiches, bruschetta/pizza slices and non-food. No translations are given for preserved and cooked vegetables, preserves, food in brine or preparations made from cereals.

52. In his evidence, Mr Pedrazzi provides at exhibit GP8 (page 45) a print from [www.montanagourmet.it](http://www.montanagourmet.it) which shows four jars of food. It is not entirely clear what these jars contain and there is no translation provided for them. This is the only example of such goods in the evidence. None of the sales figures provided are broken down into categories of goods. I have no evidence that any goods of this type have ever actually been sold.

53. Consequently, I find that the use shown by the applicants is sufficient to show use in respect of 'meat and poultry' in class 29 and 'sandwiches' in class 30. This is how the average consumer would refer to these goods and it is neither too broad nor too picky and this is the fair specification on which I will proceed.

### **Grounds of invalidity**

54. The applicants rely on two marks and two grounds 47(2)(a) and (b) and sections 5(2)(b) and 5(4)(a) of the Act. I will consider both marks under the 5(2)(b) ground, starting with the MONTANA Grill mark, before moving on to consider the 5(4)(a) ground.

### **Section 5(2)(b) case law**

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.



## **The principles**

(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.

## **The average consumer and the nature of the purchasing act**

55. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

56. In its counterstatement the Registered Proprietor states:

*“8. The bakery services and related goods produced and supplied by the Registered Proprietor in the UK are of a particular nature and are almost exclusively for sale in well known UK supermarkets such as Marks & Spencer, Waitrose and Sainsbury’s. Moreover, the Registered Proprietor’s goods are produced bearing the labels of the retailers in whose stores the Registered Proprietor’s goods are to be sold. The primary consumers to be considered in the context of the Registered Proprietors MONTANA BAKERY trade mark and common law lights are consequently the retailers of such goods and not the general public.”*

57. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

58. Outside catering services are normal everyday services provided to members of the general public. They may be commissioned by businesses providing catering on a regular basis or as part of a particular event or function. A member of the public is likely to pay no more than an average level of attention to the purchase, whereas a business commissioning the services is likely to pay an above average level of attention to what is not a casual purchase. They may need to consider, inter alia, the nature of the event, cost and venue. In both cases the purchase is likely to be primarily visual, being made from advertising leaflets, flyers and websites and in the case of a member of the general public, possibly at the point of sale. However, I do not rule out the potential for oral use of the mark.

### **The MONTANA Grill mark**

#### **Comparison of services**

59. The services to be compared are as follows:

<b>The applicants’ services</b>	<b>The registered proprietor’s goods and services</b>
<b>Class 43</b> Outside catering	<b>Class 30</b> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread; speciality breads; baguettes; ciabatta; focaccia; petit pains; fresh and frozen bread; garlic bread; malt bread; bread buns and rolls; croissants; bread casings filled with fruit; bread concentrates; bread improvers; bread

The applicants' services	The registered proprietor's goods and services
	<p>improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; bread products containing cooked foods; bread products for food; bread products; breadcrumbs; breadsticks; grossini; Danish bread and bread rolls; filled bread products; filled bread rolls; ginger-bread; hamburgers being cooked and contained in a bread bun or roll; hotdogs being cooked sausages in bread rolls; malted bread mix; mixes for the preparations of bread; pitta bread; pre-baked bread; rye bread; semi-baked bread; snack foods consisting principally of bread; stuffed bread; toasted bread; toasted bread products; unfermented bread; unleavened bread; wholemeal bread; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs; pizza; pizza bases; pastry; bakery products; bakery products for human consumption; fruit and cream fillings for bakery products; food mixes for making bakery products; mixes and preparations for making bakery products; ices; muesli; noodles; halvah; pies; honey; treacle; syrup; yeast; baking-powder; salt, pepper, mustard; vinegar; sauces (condiments); spices; fruit sauces; ice.</p> <p><b>Class 43</b>  Services for providing food and drink; baking and bakery services; consultancy services relating to baking techniques; catering for the provision of food and drink; advisory services relating to catering; business catering services; contract catering services; catering services for airlines and airports; catering services for hospitals, holiday camps, hotels, motels, restaurants and retirement homes; cooking services; food cooking services; confectionery services; cafes; cafeterias; canteens; pizzerias; self-service restaurants; snack-bars; sandwich bars; bar and restaurant services; rental and hire of cutlery, crockery, chairs, tables, table linen and glassware; accommodation and restaurant booking and reservation services; providing temporary accommodation; hotel and motel reservations; provision of conference and exhibition facilities; advice, information and consulting services in relation to all the aforesaid services.</p>

60. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

61. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>7</sup> (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

62. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

63. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>8</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

64. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in

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<sup>7</sup>[1996] R.P.C. 281

<sup>8</sup>BL O/255/13

question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

65. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark*<sup>9</sup>:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

66. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

67. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

68. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*:<sup>10</sup>

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

69. And *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 in which the GC explained when goods were complementary:

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<sup>9</sup> *BL O-399-10*

<sup>10</sup> [2012] *EWHC 3158 (Ch)* at [12]

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

### **The proprietor’s services in class 43**

70. The applicants’ services are outside catering services which are, and I bear in mind *Avnet*, services for the provision of catering at remote sites, the word ‘outside’ referring to the fact that the services are not provided in one constant location such as an individual restaurant. Consequently, the services include a wide range of types of catering which would include the following services in the proprietor’s specification:

Services for providing food and drink; baking and bakery services; catering for the provision of food and drink; business catering services; contract catering services; catering services for airlines and airports; catering services for hospitals, holiday camps, hotels, motels, restaurants and retirement homes; cooking services; food cooking services; confectionery services; cafes; cafeterias; canteens; pizzerias; self-service restaurants; snack-bars; sandwich bars; bar and restaurant services.

71. Accordingly, in accordance with *Meric*, these are identical services.

72. The proprietor’s rental and hire of cutlery, crockery, chairs, tables, table linen and glassware are one step removed from catering services but there is a symbiotic relationship between them to the extent that they may well be provided as part of an outside catering contract. Accordingly, the users, uses and trade channels may be the same. The services are not in competition with each other. I find there to be a medium degree of similarity between these services.

73. The same is true of consultancy services relating to baking techniques; advisory services relating to catering and advice, information and consulting services in relation to all the aforesaid services. The advice and information services relate to the creation and provision of foods, i.e. catering and consequently, share a close relationship. The users, uses and the trade channels are likely to be the same where the provider of outside catering provides advice in respect of that service. I find there to be a medium degree of similarity between these services.

74. The proprietor also has in its specification, accommodation and restaurant booking and reservation services. These services differ in purpose from outside catering which intends to satiate hunger, whereas the applicants’ services are used to book a room or make a restaurant reservation. Whilst catering services may be provided in a hotel or restaurant, this does not negate the fact that the services are several steps apart. The core meanings of the services are different. One is a booking service the other is a catering service, resulting in different users, uses and trade channels. I find these services to be dissimilar.

75. The applicants put forward the view that providing temporary accommodation; hotel and motel reservations are services provided by hotels, which commonly have restaurants and provide catering services for conferences and events. As a result they conclude that these services are closely similar. Hotels commonly provide a range of services which can include spa and leisure facilities, this does not mean they are similar services. In my view the proprietor's services provide accommodation or the opportunity to reserve accommodation for some point in the future. The applicant's services aim to provide food/refreshment, in other words satiate hunger. Having considered the nature of the services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing services coincide. These are dissimilar services.

76. The same is true of the provision of conference and exhibition facilities. The purpose of these services is clear and does not coincide with outside catering services. They are not in competition nor are they complementary, the uses and, therefore, users are different and they are unlikely to be provided by the same undertaking. These are dissimilar services.

### **The proprietor's goods in class 30**

77. There are several Registry decisions which have considered the similarity of prepared foods and ingredients to the provision of services in class 43.<sup>11</sup> Applying the same analysis, there is a similarity between the applicants' outside catering services and the following of the proprietor's goods:

bread casings filled with fruit; bread products containing cooked foods; bread products for food; pizza; pizza bases; pastry; bakery products; bakery products for human consumption; filled bread products; filled bread rolls; ginger-bread; hamburgers being cooked and contained in a bread bun or roll; hotdogs being cooked sausages in bread rolls; snack foods consisting principally of bread; stuffed bread; toasted bread; toasted bread products; halvah; pies; bread; speciality breads; baguettes; ciabatta; focaccia; petit pains; fresh and frozen bread; garlic bread; malt bread; bread buns and rolls; croissants; bread products; breadsticks; grossini; Danish bread and bread rolls; pitta bread; pre-baked bread; rye bread; semi-baked bread; unfermented bread; unleavened bread; wholemeal bread; noodles; muesli; ices.

78. 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' catering 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.

79. The remaining goods in class 30 are ingredients, constituent parts of meals, flavourings or goods which need further processing. None of them are prepared meals or

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<sup>11</sup> See O-001/10, CUCINA, O-198/12, FLAMIN GRILL and O-299-14 PROVENANCE BRANDS

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 satiate 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 applicants' outside catering services and the following goods:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread concentrates; bread improvers; bread improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; breadcrumbs; malted bread mix; mixes for the preparations of bread; fruit and cream fillings for bakery products; food mixes for making bakery products; mixes and preparations for making bakery products; ices; honey; treacle; syrup; yeast; baking-powder; salt, pepper, mustard; vinegar; sauces (condiments); spices; fruit sauces; ice; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs.

### **Comparison of marks**


80. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Case C-591/12P, Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

81. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

82. The marks to be compared are as follows:



The applicants' mark	The proprietor's mark
	<p data-bbox="805 286 1257 331">MONTANA BAKERY</p> <p data-bbox="805 398 1157 443">Montana Bakery</p> <p data-bbox="805 510 1157 555">montana bakery</p>

83. The proprietor's mark is registered for a series of three marks. As they differ only in respect of the case used, for ease of reference I will refer to the marks collectively as MONTANA BAKERY. The two words which make up the mark do not hang together. The overall impression of the mark is dominated by the word MONTANA which is at the beginning, the second word simply being seen by the average consumer as a description of the undertaking.

84. The applicants' mark consists of the two words 'MONTANA', in upper case and 'Grill' in title case. The background black shape will be seen as simply that, a background. Any stylisation in the mark is minimal and would not be given any trade mark significance by the average consumer. The words present in the mark do not hang together. The overall impression of the mark is dominated by the word 'MONTANA' which is the first word in the mark and is presented in a larger typeface above the word 'Grill'. The word 'Grill' will be seen as indicating the nature of the services.

85. Both marks begin with the word MONTANA. The proprietor's is followed by the word 'BAKERY', the applicants' by the word 'Grill'. Taking all of these factors into account, I find the marks share a moderate degree of visual and aural similarity.

86. With regard to conceptual similarity, at paragraph 22 of their skeleton argument the applicants' submit that MONTANA is an invented word, which is highly distinctive for the goods and services at issue. I disagree.

87. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>12</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>13</sup>

88. I am aware that Montana is a North Western state of the United States. However, this is not a notorious fact of the kind which would allow me to take judicial notice of the point. In my view whilst Montana's exact location may not be known to the average UK consumer it would be considered to refer to a geographic location, whether it is a city, a state, in the US or elsewhere. I cannot conclude that the average consumer would

<sup>12</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>13</sup> See the comments of Anna Carboni sitting as the Appointed Person in the *Chorkee* case, BL O-048-08

consider it to be an invented word. Furthermore, whatever the average consumer's interpretation of MONTANA is, it will be the same for both marks.

89. Given that the second words of both marks, namely, 'Grill' and 'Bakery' will simply be seen as referring to the nature of the parties' respective businesses I find the marks to be conceptually similar to a high degree.

### **Distinctive character of the earlier mark**

90. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

91. As I have concluded above, the mark will be seen as referring to a location, though its exact geographic location may not be understood. The word 'Grill' alludes to the nature of the business which will be seen as originating or being located in Montana. With regard to 'outside catering services' the mark does not describe or allude to the goods in question. The mark has an average degree of inherent distinctive character of the kind possessed by a normal trade mark.

### **Likelihood of confusion**

92. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>14</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

93. I have found the marks to have a moderate degree of visual and aural similarity and a high degree of conceptual similarity. I have found the earlier mark to have a normal level of inherent distinctive character and have found some of the proprietor's goods to be similar to those of the applicants. I have identified the average consumer, namely a member of the general public or a business and have concluded that the purchase will be primarily visual, though I do not discount an aural element particularly where word of mouth recommendations play a part. The level of attention paid to the purchase will vary, ranging from average, where the consumer is a member of the general public purchasing everyday foodstuffs, to above average in the case of a consumer or business entering a contract for the provision of catering services.

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<sup>14</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 27

94. Given the respective conceptual impressions provided by the marks, when encountering them the average consumer may misremember what the mark was that they had encountered previously, 'MONTANA Grill' or 'MONTANA BAKERY', giving rise to direct confusion.

95. In any event, if I am found to be wrong in this, I am mindful of *L.A. Sugar Limited v By Back Beat Inc*<sup>15</sup>, in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

96. In my view, the change of the second, non-distinctive, word in the marks, from 'Grill' to 'Bakery' falls squarely within the types of indirect confusion identified in *LA Sugar*, particularly the points at (b) and (c), though this is by no means an exhaustive list but serves to provide a number of examples of types of indirect confusion. In my view, encountering these marks would lead to the average consumer making a connection between them that would result in a belief that the goods are being provided by an economically linked undertaking.

97. The test for the assessment of a likelihood of confusion is a cumulative one meaning that where there is no similarity between the goods/services, there can be no likelihood of confusion. Accordingly, as a consequence of my findings above, the applicant's request to invalidate the registered proprietor's trade mark has succeeded under section 5(2)(b) of

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<sup>15</sup> Case BL-O/375/10

the Act and, under the provisions of 47(6) of the Act in respect of the following goods and services:

**Class 30**

Bread; speciality breads; baguettes; ciabatta; focaccia; petit pains; fresh and frozen bread; garlic bread; malt bread; bread buns and rolls; croissants; bread casings filled with fruit; bread products containing cooked foods; bread products for food; bread products; breadsticks; grossini; Danish bread and bread rolls; filled bread products; filled bread rolls; ginger-bread; hamburgers being cooked and contained in a bread bun or roll; hotdogs being cooked sausages in bread rolls; pitta bread; pre-baked bread; rye bread; semi-baked bread; snack foods consisting principally of bread; stuffed bread; toasted bread; toasted bread products; unfermented bread; unleavened bread; wholemeal bread; pizza; pizza bases; pastry; bakery products; bakery products for human consumption; noodles; muesli; ices; halvah; pies.

**Class 43**

Advice, information and consulting services in relation to all the aforesaid services. Services for providing food and drink; baking and bakery services; consultancy services relating to baking techniques; catering for the provision of food and drink; advisory services relating to catering; business catering services; contract catering services; catering services for airlines and airports; catering services for hospitals, holiday camps, hotels, motels, restaurants and retirement homes; cooking services; food cooking services; confectionery services; cafes; cafeterias; canteens; pizzerias; self-service restaurants; snack-bars; sandwich bars; bar and restaurant services; rental and hire of cutlery, crockery, chairs, tables, table linen and glassware.

**The MONTANA mark**

98. Having reached these conclusions I will move on to consider the proprietor’s remaining goods and services in light of the applicants’ MONTANA mark (CTM 1719376) in classes 29 and 30 in respect of section 5(2)(b) and the provisions of 47(6) of the Act.

99. The remaining goods and services to be compared are as follows:

<b>The applicants’ goods</b>	<b>The proprietor’s goods and services</b>
<p><b>Class 29</b> Meat, poultry</p> <p><b>Class 30</b> Sandwiches</p>	<p><b>Class 30</b> Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread concentrates; bread improvers; bread improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; breadcrumbs; malted bread mix; mixes for the preparations of bread; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs; fruit and cream fillings for bakery products; food mixes</p>

	<p>for making bakery products; mixes and preparations for making bakery products; honey; treacle; syrup; yeast; baking-powder; salt, pepper, mustard; vinegar; sauces (condiments); spices; fruit sauces; ice.</p> <p><b>Class 43</b> Accommodation and restaurant booking and reservation services; providing temporary accommodation; hotel and motel reservations; provision of conference and exhibition facilities.</p>
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### **The proprietor's services in class 43**

100. I have already made a finding in respect of the applicants' services in class 43 in the specification for its Montana Grill mark, compared to the proprietor's class 43 services. Evidently the applicants' goods in class 29 and class 30, in respect of its MONTANA mark cannot put the applicant in any better position with regard to the remaining services in class 43. Having considered the nature of the goods and services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods and services coincide. The proprietor's class 43 services are dissimilar to the applicant's goods.

### **The applicants' class 29 goods**

101. In their submissions, skeleton argument and at the hearing the applicants have made no suggestion that any of the goods in class 30 of the proprietor's specification are similar to their own goods in class 29. In my view, other than at a very high level, in that the goods are bought by members of the general public and are food goods, I see no meaningful coincidence between these goods. The proprietor's class 30 goods and the applicants' class 29 goods are dissimilar.

### **The applicants' class 30 goods**

102. The proprietor's specification includes a number of goods which are used in bread and pastry making. These are, flour and preparations made from cereals; bread concentrates; bread improvers; bread improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; malted bread mix; mixes for the preparations of bread; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs; breadcrumbs; food mixes for making bakery products; mixes and preparations for making bakery products; fruit and cream fillings for bakery products; yeast and baking-powder.

103. The users of these goods will be those engaged in making bread and pastry, either professionally or in a domestic context. Sandwiches may be bought by anyone and are used to satiate hunger. They are available in a large number of outlets from petrol stations to supermarkets where they will be purchased as takeaway items. They are also available in establishments where they may be consumed on the premises, such as bars, restaurants, cafes and canteens. The proprietor's goods are not so readily available and may require purchase from a specialist supplier. These goods are clearly not in

competition. With regard to the complementarity of the goods, while I would be likely to find such a relationship between these goods and the finished bread and pastry products, which are essentially the baked versions of these doughs, I am unable to find such a relationship between these goods and sandwiches which are further removed.

104. Taking all of these factors into account these goods in the proprietor's specification are dissimilar to sandwiches in the applicants' specification.

105. In making a comparison between the remaining proprietor's goods in class 30 and the applicants' registration for sandwiches, I bear in mind the comments of the GC in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>16</sup> in which it considered the relationship between finished articles, their component parts and resultant similarity in the following terms:

"The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

106. With regard to the comparison between coffee, tea, cocoa, artificial coffee and ice in the proprietor's specification and sandwiches, the applicants' submit that:<sup>17</sup>

*"These goods are similar to "sandwiches" in earlier CTM registration no. 1719376, on the grounds that they are often sold alongside sandwiches in, for example, cafes, and are complementary to sandwiches to the extent that these goods are commonly consumed together."*

107. First, with regard to ice<sup>18</sup>, in my experience it is not common to see ice sold alongside sandwiches in cafes, or any other establishment. In the absence of any submissions or evidence to the contrary I cannot find any similarity between ice, i.e. frozen water and sandwiches. These are dissimilar goods.

108. Coffee, tea, cocoa and artificial coffee are beverages which will be purchased to slake thirst. Sandwiches are a prepared finished food product which will be eaten as a meal to satiate hunger. The uses and nature of the goods are different and they are clearly not in competition. With regard to the applicants' submissions, these goods cannot be considered to be complementary on the basis of the case law i.e. they are not indispensable or important to the use of the opponent goods and as Daniel Alexander commented in LOVE, the fact that they are used [sold] together does not mean they are complementary in a trade mark sense. These are dissimilar goods.

109. The applicants submit that rice, tapioca and sago are derived from cereal and are therefore 'closely similar' to sandwiches. As far as I am aware neither tapioca nor sago are cereals, and in any case, in the absence of any explanation of the view that these are similar goods, having applied the relevant case law, I can see no similarity between these goods. Rice, tapioca and sago are dissimilar to sandwiches.

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<sup>16</sup> Case T-336/03

<sup>17</sup> Point 21 (v) of the skeleton argument, page 7

<sup>18</sup> I have already dealt with 'ices' above at paragraph x.

110. The remaining goods are sugar, honey; treacle; syrup; salt, pepper, mustard; vinegar; sauces (condiments); spices and fruit sauces, all of which are used to add flavour to food (and possibly drinks). The uses and trade channels are different, they are not in competition, nor are they complementary in accordance with the case law outlined above. The only similarity the applicants have brought to my attention is in respect of their 'preserved vegetables' and 'preserves', neither of which have been maintained following my assessment of proof of use. In conclusion, these goods are dissimilar to the applicants' sandwiches.

111. Having concluded that there is no similarity between the proprietor's remaining goods in class 30 and its services in class 43 to the applicants' goods in classes 29 and 30, there is no need for me to go on to consider the matter further.<sup>19</sup>

## **Conclusion**

112. The invalidation succeeds under 5(2)(b) and the provisions of 47(2)(a) of the Act in respect of the following goods and services:

### **Class 30**

Bread; speciality breads; baguettes; ciabatta; focaccia; petit pains; fresh and frozen bread; garlic bread; malt bread; bread buns and rolls; croissants; bread casings filled with fruit; bread products containing cooked foods; bread products for food; bread products; breadsticks; grossini; Danish bread and bread rolls; filled bread products; filled bread rolls; ginger-bread; hamburgers being cooked and contained in a bread bun or roll; hotdogs being cooked sausages in bread rolls; pitta bread; pre-baked bread; rye bread; semi-baked bread; snack foods consisting principally of bread; stuffed bread; toasted bread; toasted bread products; unfermented bread; unleavened bread; wholemeal bread; pizza; pizza bases; pastry; bakery products; bakery products for human consumption; noodles; muesli; ices; halvah; pies.

### **Class 43**

Advice, information and consulting services in relation to all the aforesaid services. Services for providing food and drink; baking and bakery services; consultancy services relating to baking techniques; catering for the provision of food and drink; advisory services relating to catering; business catering services; contract catering services; catering services for airlines and airports; catering services for hospitals, holiday camps, hotels, motels, restaurants and retirement homes; cooking services; food cooking services; confectionery services; cafes; cafeterias; canteens; pizzerias; self-service restaurants; snack-bars; sandwich bars; bar and restaurant services; rental and hire of cutlery, crockery, chairs, tables, table linen and glassware.

113. The invalidation fails under 5(2)(b) and the provisions of 47(6) of the Act the applicant's in respect of the following goods and services:

### **Class 30**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread concentrates; bread improvers; bread

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<sup>19</sup> *The test is a cumulative one, see Vedral SA v OHIM C-106/03*

improvers being cereal based preparations and bread improvers containing soya flour; bread mixes; breadcrumbs; malted bread mix; mixes for the preparations of bread; wholemeal bread mixes; dough for bread and pastry; fermented doughs and long fermented doughs; fruit and cream fillings for bakery products; food mixes for making bakery products; mixes and preparations for making bakery products; honey; treacle; syrup; yeast; baking-powder; salt, pepper, mustard; vinegar; sauces (condiments); spices; fruit sauces; ice.

### **Class 43**

Accommodation and restaurant booking and reservation services; providing temporary accommodation; hotel and motel reservations; provision of conference and exhibition facilities.

114. I will now go on to consider the applicants' request for invalidation under section 47(2)(b) and 5(4)(a) of the Act.

115. The applicants rely on the plain word MONTANA which they state was first used in the UK on 23 October 1996 and has been used nationally since that date. With regard to the goods and services for which use of the word is claimed, the applicants state:

*"The trade mark has been used in respect of a range of goods and services including those covered by Community registrations no.s 1719376 and 2869782, details of which are attached."*

116. I am unable to determine which goods are included within the term 'a range of goods and services' and furthermore, the evidence filed by the applicants does not show use of the mark for any goods or services which are not included within the specification of the two CTM marks relied on for the 5(2)(b) grounds.

117. The earliest date shown in evidence is an invoice dated 18 January 2007 to a business in London. Even if the evidence was sufficient to establish the goodwill required to get a passing-off action off the ground put simply, the applicants are in no better position under section 5(4)(a) of the Act than they are under 5(2)(b).

### **COSTS**

118. Both parties have achieved a measure of success and I consider both should bear its own costs.

**Dated this 27th day of January 2015**

**Ms Al Skilton  
For the Registrar,  
the Comptroller General**