

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1581188
BY BOEHRINGER INGELHEIM BACKMITTEL GMBH
TO REGISTER A TRADE MARK IN CLASS 30
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 45874 BY PURATOS S.A.**

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF application no 1581188
by Boehringer Ingelheim Backmittel GmbH
to register a trade mark in class 30**

AND

**IN THE MATTER OF opposition thereto
Under no 45874 by Puratos S.A.**

DECISION

On 9 August 1994 Boehringer Ingelheim Backmittel GmbH applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark RUSTIKAL. The application was made in Class 30 and after examination proceeded to advertisement for the specification of goods comprising:

Pre-mixes for bread and bread rolls; all included in Class 30

The application, numbered 1581188 was advertised for opposition purposes on 4 September 1996 and on 14 November 1996 Puratos S.A. filed notice of opposition to the application. The grounds of opposition are in summary:-

Section 12(1) The mark applied for is extremely similar to the opponents' registered marks and is sought to be registered in respect of goods, which if not the same, are of the same description as those for which the opponents' marks are registered.

The mark applied for so nearly resembles the opponents' registered marks that there can be no doubt that the public would be deceived or confused should the mark applied for proceed to registration, and the application should therefore be refused under Section 12(1) of the 1938 Act.

Details of the opponents' registered marks cited in the grounds of opposition are as follows:

No.	Mark	Class	Journal/Page	Specification
1218188	Rustic	30	5610/686	Flour; bread improvers being cereal based preparations; preparations made from cereals for food for human consumption; bread and biscuits (other than biscuits for animals).

No.	Mark	Class	Journal/Page	Specification
1375629	RUSTICS	30	5868/2177	Flour; bread improvers being cereal based preparations; preparations made from cereals for food for human consumption; bread, biscuits; all included in Class 30

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10 The applicants filed a counterstatement denying the grounds of opposition, asking that the Registrar exercise his discretion in their favour and register the application. The applicants also ask that they be awarded costs.

15 Only the opponents have filed evidence in these proceedings, and as neither party has requested a hearing, acting on the Registrar's behalf and after a careful study of the evidence filed I now give this decision.

20 By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Trade Marks Act.

25 **Opponents' evidence (Rule 49)**

This consists of a Statutory Declaration dated 22 July 1997 made by Jean-Francois Duquesne, Managing Director of Puratos Limited, a wholly owned subsidiary of Puratos S.A., the opponents in these proceedings. Mr Duquesne confirms that he has been employed by Puratos Limited since February 1996.

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35 Mr Duquesne begins by setting out details of the opponents' registrations for the marks RUSTIC and RUSTICS. He says that the RUSTIC mark has been used by his company with the consent of Puratos S.A. since the late 1970s, and is used in respect of three particular product lines; an improver for use in bread making, flakes for use as an ingredient or as a topping for bread, and wholemeal flour. He refers to exhibit JFD1 which consists of sack-type packaging bearing the mark RUSTIC, the name PURATOS and other non-trade mark matter.

40 He goes on to set out his company's turnover under the RUSTIC mark, (most of which post dates the relevant date), details of their major customers, and his company's activities to promote the RUSTIC mark in the United Kingdom referring to exhibits JFD2 and JFD3 which consist of an undated brochure for their RUSTIC improver, and a photograph of an articulated lorry trailer bearing the RUSTIC mark. He concludes by giving his opinion on the reputation the opponents have in the mark RUSTIC and the likelihood of confusion of this mark with the mark applied for.

45 No further evidence was filed by either party.

Decision

I now turn to consider the grounds of opposition which are based upon Section 12(1) of the Act, which states:

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12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

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a. the same goods

b. the same description of goods, or

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c. services or a description of services which are associated with those goods or goods of that description.

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The reference in Section 12 to a near resemblance is clarified by Section 68(2)(b) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion

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The established tests for grounds of opposition based upon Section 12 is set down in Smith Hayden & Co Ltd's application [1946] 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case, which, adapted for the case in hand reads as follows:

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Assuming user by the opponents of their mark RUSTIC/RUSTICS in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark RUSTIKAL normally and fairly in respect of any goods covered by their proposed registration?@

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In my comparison of the respective marks RUSTIC/RUSTICS and RUSTIKAL I will adopt the established test propounded by Parker J in Pianotist company's application [1906] 23 RPC at page 777, which reads as follows:-

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"You must take the two marks. You must judge of them both by their look and by their sound. You must consider the goods and services to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods or services. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods or services of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion -that is to say -not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods or services -then you may refuse the registration, or rather you must refuse the registration in that case."

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While it is neither likely or appropriate that marks will or should be viewed and compared by reference to each letter and syllable, it is inevitable that a comparison will refer to elements of the marks in question. I accept, however, that the proper test to be applied is what is the overall impression created by the marks, and is that overall impression such that there is a risk of confusion or deception?

When making a visual comparison of the respective marks, it is self evident that they are not short words, are similar in length and have the first five letters in common. The sixth letter in the opponents' mark is the letter "c" whereas in the applicants' mark the sixth letter is the letter "k". The letters are visually different and in some words can be pronounced differently. However, in the word "RUSTIC" the letter "c" has a hard sound and in my view is phonetically indistinguishable from a letter "k". The applicants' mark has two more letters but these are at the end of the word and in considering the similarity of the sound of the two marks, it is well established that the endings of words are generally of least importance for the purpose of distinction. (See the TRIPCASTROID case 42 RPC 264, at page 279 lines 33-40). I am therefore led to the conclusion that when compared as a whole the additional letters in the applicants' mark do not serve to distinguish, and that there is sufficient visual and phonetic similarity for there to be a likelihood of confusion or deception.

This leaves the question of the respective goods, and the surrounding circumstances of the trade in which the parties are engaged. The applicants are seeking to register their mark for goods described as "pre-mixes for bread and bread rolls", which in my view would include part-mixes to be combined with other ingredients, and also mixes that are ready for baking into loaves of bread and bread rolls, and are therefore goods which I would take to be similar to "bread" for which the opponents' mark is protected. The opponents' registrations also cover "flour" and "bread improvers" which may be the same constituent materials or nature, be for the same purpose and pass through the same channels of trade as the applicants' goods and therefore are similar goods. The opponents also have cover for "cereal based preparations" and "preparations made from cereals for food for human consumption" which would include semi-finished and finished mixtures of cereal preparations for making into bread and bread rolls, and would be the same goods as those covered by the application.

Although from the evidence it would appear that the opponents sell their products to the bakery trade, the specifications of their registrations is not limited to this, nor is the specification of the application limited in any way. Consequently, it would appear, prima facie, that the applicants and the opponents are in the same area of trade. The opponents already have two marks, RUSTIC and RUSTICS and it seems quite feasible that a person familiar with these may consider RUSTIKAL to be a further product from the same source.

Taking all of the aforesaid into account I come to the conclusion that there is a real likelihood of confusion in the minds of the relevant public should the application be registered, and consequently find that the opposition under Section 12(1) succeeds.

5 There remains the matter of the Registrar's discretion. I see nothing in the evidence filed
in this case that persuades me that I should exercise discretion in favour of the applicants.
The opponents having been successful are entitled to an award of costs in their favour and
I therefore direct the opponents pay to the applicants the sum of £235 as a contribution
towards their costs.

10 **Dated this 29 Day of April 1999**

15 **Mike Foley**
Principal Hearing Officer
For the Registrar
The Comptroller General