

O-210-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION

No. 2355496

BY BBC ICE CREAM LLC

TO REGISTER THE TRADE MARK

ICE CREAM

IN CLASSES 3, 14, 18 & 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 96116 BY

MS Y DOZIE t/a HIGH HEELS AND ICE CREAM LTD

BACKGROUND

1) On 10 February 2004, BBC Ice Cream LLC applied to register the trademark **ICE CREAM** in respect of:

Class 3: Preparations for the care of the hair, scalp, face, skin and body; cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pomades, lip pencils; makeup removers; makeup applicators in the nature of cotton swabs for cosmetic purposes; facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, facial lotions and non-medicated facial treatments, wrinkle removing skin care preparations; anti-aging preparations for use on the skin; nail care preparations, nail polishes, nail polish removers, nail creams, cuticle removing preparations, nail buffing preparations; skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, massage oils, essential oils for personal use; talcum powder, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts; skin cleansers, body scrubs; body fragrances; body and hand lotions, body gels, shower gels, body oils, body powders, body exfoliants, body masks, body mask creams and lotions, body creams; shaving preparations, shaving balm, after-shave preparations; skin abrasive preparations; non-medicated lip care preparations, lip cream; sunscreen preparations, sun-block preparations, sun-tanning preparations and after-sun lotions; self-tanning preparations for use on the body, self tanning milk and cream, accelerated tanning cream, self-tanning lotions, gels and sprays; perfume, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water; toothpaste, teeth whitening preparations, mouthwashes; deodorant and antiperspirant; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened cosmetic tissues and towelettes; cotton sticks for cosmetic purposes, all purpose cotton swabs for personal use and cosmetic purposes; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; aromatherapy creams, lotions and oils; hair care products, shampoos, conditioners, hair mousse, hair gels, hair frosts, hair creams, hair rinses, hairsprays, hair colour, hair waving lotion, permanent wave preparations, hair lighteners, hair dyes, hair emollients, hair mascara, hair pomades, hair colour removers, hair relaxers, hair relaxing preparations, hair straightening preparations, hair styling preparations; hair removing cream, and hair care preparations; baby wipes; antibacterial pre-moistened cosmetic wipe preparations for use on the skin cosmetics; disposable wipes impregnated with chemicals or compounds for personal hygiene and household use; contact lens cleaning preparations; preparations for cleaning eyeglasses, pre-impregnated cloths for cleaning spectacles; excluding bath bombs.

Class 14: Jewellery and related accessories; items made of precious metal, or coated therewith; pendants; lapel pins; ornamental lapel pins; pins being jewellery; ear clips; tie pins and clips; bolo ties with precious metal tips; cuff-links; badges of precious metal; belt buckles of precious metal; jewellery; costume jewellery; jewellery chains; jewellery pins for use on hats; hat ornaments and pins of precious metal; holiday ornaments of precious metal; jewellery boxes and cases of precious metal; match boxes of precious metal; snuff boxes and serviette rings of precious metal; watches and related accessories; wristwatches; pocket watches; stop watches; watch straps and bands; watch chains and fobs; watch cases;

clocks; alarm clocks; clocks incorporating radios; wall clocks; figurines and sculptures of precious metal; piggy banks made of precious metal; book markers of precious metal; precious metal money clips; ashtrays of precious metal; bottle closures of precious metal; coffee services, tea services and toothpick holders of precious metal; vases of precious metal; cruets of precious metal; cruet stands for oil or vinegar of precious metal; flower bowls of precious metal; busts, figures, figurines, statues, statuettes and stirring rods of precious metal; candlesticks, candle holders, candle rings and candle holders of precious metal; non-electric candelabras made of precious metal; cigarette holders and lighters of precious metal; match boxes and holders of precious metal; letter openers of precious metal.

Class 18: Items made of leather or imitation leather; all-purpose sports and athletic bags, fanny packs, backpacks, knapsacks, sports packs, waist packs, gym bags, duffel bags, tote bags, book bags, hand bags, purses, clutch purses, change purses, shoulder bags, carry-on bags, travel bags, garment bags for travel, leather shopping bags, beach bags, satchels, luggage, luggage tags, trunks, suitcases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty, cosmetic bags sold empty, tool bags sold empty, attache cases, briefcases, briefcase-type portfolios, men's clutches, business cases, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key chains, coin pouches, wallets, billfolds, umbrellas and parasols.

Class 25: Clothing; jackets, coats, parkas, raincoats, blazers, blouses, shirts, T-shirts, skirts, dresses, trousers, jeans, shorts, sweaters, cardigans, scarves and belts; footwear; headwear; jerseys, uniforms, athletic uniforms, pants, cycle pants, slacks, denim jeans, overalls, coveralls, jumpers, jump suits, boxer shorts, under shirts, night shirts, rugby shirts, polo shirts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, vests, fleece vests, pullovers, fleece pullovers, snow suits, anoraks, ponchos, dinner jackets, sports jackets, sportswear, golf and ski jackets, reversible jackets, suits, turtlenecks, swimwear, beachwear, caps, berets, hats, headbands, wrist bands, headwear, ear muffs, aprons, scarves, bandanas, belts, braces for trousers, suspenders, neckwear, neckties, ties, bow ties; babies' wear, cloth bibs, cloth diapers, booties; infantwear; underwear, briefs, trunks, bras, sports bras, singlets, socks; loungewear, robes, bathrobes, pajamas, sleepwear, night gowns; lingerie, camisoles, slips, stockings, body stockings, pantyhose, hosiery, knit hosiery, leg warmers, bodysuits, leggings, tights, leotards, unitards; gloves, mittens; footwear, shoes, sneakers, boots, galoshes, sandals, zori, slippers and rainwear.

2) An International priority date of 13 August 2003 was claimed based on an OHIM registration. The application was examined and accepted, and subsequently published for opposition purposes on 2 November 2007 in Trade Marks Journal No.6708.

3) Ms Y Dozie t/a High Heels and Ice Cream Limited (hereafter the opponent), filed a notice of opposition, dated 4 February 2008, subsequently amended. The grounds of opposition are in summary:

- a) The opponent is the proprietor of the following trade mark:

| Trade Mark | Number | Application Date and Registration Date | Specification |
|--|---------------|---|--|
| High Heels and Ice Cream | 2334360 | 06.06.03 & 10.09.04 | Class 3: Cosmetics, soaps, perfumery, essential oils, hair lotions, deodorants for personal use, dentifrices. |
| | | | Class 9: Compact discs, digital music, mouse mats, dvd's. |
| | | | Class 14: Jewellery. |
| | | | Class 16: Printed matter, stationery, paper, cardboard and goods made from these materials, printed publications. |
| | | | Class 21: Glassware, porcelain and earthenware. |
| | | | Class 24: Textiles and textile goods. |
| | | | Class 32: Beverages. |
| | | | Class 35: Advertising services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store specialising in the marketing of cosmetics, soaps, perfumery, essential oils, hair lotions, deodorants for personal use, dentifrices, compact discs, digital music, mouse mats, DVDs, spectacles and sunglasses, jewellery, printed matter, stationery, paper, cardboard and goods made from these materials, printed publications, glassware, porcelain and earthenware, textiles and textile goods, clothing, handbags, footwear and headgear and non-alcoholic beverages, from an Internet website specialising in the marketing of the aforesaid goods by means of telecommunications, and from a catalogue specialising in the aforesaid goods by mail order or by means of telecommunications. |
| | | | Class 41: Entertainment including radio, television and film entertainment; book launches; live entertainment; music concerts; film production; online electronic publications (non-downloadable). |
| Class 43: Restaurant, bar and catering services. | | | |

b) The opponent states that the mark applied for is similar to the opponent's earlier registration and that the goods applied for are similar to the opponent's goods in Classes 3, 14, 24 and 35. The opponent states that the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) On 17 June 2008 the applicant filed a counterstatement which denied the opponent's claims, other than accepting that the opponent's mark is registered and that the goods of the two parties in Classes 3 and 14 are identical or similar. The applicant puts the opponent to strict proof of use.

5) Both sides filed evidence. Neither party wished to be heard, although both submitted written submissions which I shall refer to as and when relevant. Both ask for an award of costs.

OPPONENT'S EVIDENCE

6) The opponent, Ms Dozie, filed a witness statement, dated 9 January 2009. She states that the mark in suit would cause confusion. She states that her mark "has been in the public domain for some years and is scheduled to be launched this year. The brand is currently in development." At exhibit 1 she provides a book called "High Heels and Ice Cream" written by Lolita Flowers. Ms Dozie states that cosmetic bottles are being developed but "due to the confidentiality surrounding potential Patent applications, pending prototype approval, I cannot provide further documents at this stage". She also states that there are three blogs called "High Heels and Ice Cream" in existence but she does not provide copies of excerpts from them.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 9 April 2007, by Abida Rifat Chaudri, a solicitor representing the applicant. Throughout her statement she refers to her client as the opponent but this is clearly a mistake. She states that she has carried out a number of searches using the Google search engine. The searches are all dated 9 April 2009, after the relevant date. She states that she searched under "Ice Cream", then from the references provided she searched "ice cream sneakers", "ice cream shoes" and "ice cream clothing". Copies of these pages are at exhibit ARC1. There would appear to be no references to the opponent but a considerable number refer to the applicant. She provides further printouts from searches regarding "ice cream", "billionaire boys club", "Pharrell Williams" and "Tomoaki Nagao" at exhibit ARC2. Ms Chaudri does not comment on the results. At exhibit ARC3 she provides a history of the applicant and also locations of its stores in the UK, none of which would appear to be relevant.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

"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,

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

11) The opponent is relying upon her trade mark listed in paragraph 3 which is clearly an earlier trade mark. It was registered on 10 September 2004 and given that the application was published for opposition purposes on 2 November 2007 it is therefore not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

12) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

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

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

13) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods and services in each parties' specification.

14) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the

Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

15) The opponent has singularly failed to show that she has a reputation in the goods and services for which its mark is registered. The opponent has not provided turnover figures, market share or any independent trade evidence. It is certainly not sufficient for her to enjoy enhanced protection because of reputation. However, I do accept that the opponent’s mark is inherently highly distinctive for the goods and services for which it is registered.

16) Clearly the average consumer for the goods and services of the two parties must be the average citizen of the UK. I shall now consider the goods and services of the two parties. The applicant accepted in its counterstatement that the goods of the two parties in each of Classes 3 and 14 were identical or similar. For ease of reference, I set out the goods of the applicant and the limited range of goods and services relied upon by the opponent in this opposition which now require to be compared.

| Applicant’s specification | Opponent’s specification |
|--|---|
| Class 18: Items made of leather or imitation leather; all-purpose sports and athletic bags, fanny packs, backpacks, knapsacks, sports packs, waist packs, gym bags, duffel bags, tote bags, book bags, hand bags, purses, clutch purses, change purses, shoulder bags, carry-on bags, travel bags, garment bags for travel, leather shopping bags, beach | Class 3: Cosmetics, soaps, perfumery, essential oils, hair lotions, deodorants for personal use, dentifrices. |

| | |
|--|---|
| <p>bags, satchels, luggage, luggage tags, trunks, suitcases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty, cosmetic bags sold empty, tool bags sold empty, attache cases, briefcases, briefcase-type portfolios, men's clutches, business cases, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key chains, coin pouches, wallets, billfolds, umbrellas and parasols.</p> | <p>Class 14: Jewellery.</p> |
| | <p>Class 24: Textiles and textile goods.</p> |
| <p>Class 25: Clothing; jackets, coats, parkas, raincoats, blazers, blouses, shirts, T-shirts, skirts, dresses, trousers, jeans, shorts, sweaters, cardigans, scarves and belts; footwear; headwear; jerseys, uniforms, athletic uniforms, pants, cycle pants, slacks, denim jeans, overalls, coveralls, jumpers, jump suits, boxer shorts, under shirts, night shirts, rugby shirts, polo shirts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, vests, fleece vests, pullovers, fleece pullovers, snow suits, anoraks, ponchos, dinner jackets, sports jackets, sportswear, golf and ski jackets, reversible jackets, suits, turtlenecks, swimwear, beachwear, caps, berets, hats, headbands, wrist bands, headwear, ear muffs, aprons, scarves, bandanas, belts, braces for trousers, suspenders, neckwear, neckties, ties, bow ties; babies' wear, cloth bibs, cloth diapers, booties; infantwear; underwear, briefs, trunks, bras, sports bras, singlets, socks; loungewear, robes, bathrobes, pajamas, sleepwear, night gowns; lingerie, camisoles, slips, stockings, body stockings, pantyhose, hosiery, knit hosiery, leg warmers, bodysuits, leggings, tights, leotards, unitards; gloves, mittens; footwear, shoes, sneakers, boots, galoshes, sandals, zori, slippers and rainwear.</p> | <p>Class 35: Advertising services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store specialising in the marketing of cosmetics, soaps, perfumery, essential oils, hair lotions, deodorants for personal use, dentifrices, compact discs, digital music, mouse mats, DVDs, spectacles and sunglasses, jewellery, printed matter, stationery, paper, cardboard and goods made from these materials, printed publications, glassware, porcelain and earthenware, textiles and textile goods, clothing, handbags, footwear and headgear and non-alcoholic beverages, from an Internet website specialising in the marketing of the aforesaid goods by means of telecommunications, and from a catalogue specialising in the aforesaid goods by mail order or by means of telecommunications.</p> |

17) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition.

18) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

19) Further, I also bear in mind the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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 meanings attributable to the rather general phrase.”

20) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:

“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).”

21) I will first compare the opponent’s goods in Classes 3, 14 and 24, which cover, broadly speaking cosmetics and perfumes, jewellery and textiles with the applicant’s goods in Classes 18 and 25 which are broadly speaking bags and clothing. Clearly, these are not in any way similar goods and the applicant puts forward no reasons why they should be considered to be similar, but merely makes a blanket assertion that the goods of both parties are similar.

22) I now turn to compare the opponent’s services in Class 35 with the applicant’s goods in Classes 18 and 25. The opponent’s services in this class includes “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store specialising in the marketing ofclothing, handbags, footwear and headgear”. The Court of First Instance in case T116/06 *OAKLEY* said at paragraph 54:

“Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or

at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the court held in paragraph 34 of *Praktiker Bau- und Heimwerkermarkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

23) In my view the average consumer is very used to “own branded” goods and would not be surprised by a shop, or even a supermarket, using its own brand on clothing. Therefore, the services of the opponent in Class 35 must be deemed to be complementary to the class 18 & 25 goods of the applicant.

24) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

| Applicant’s Trade Mark | Opponent’s Trade Mark |
|------------------------|--------------------------|
| ICE CREAM | High Heels and Ice Cream |

25) The opponent’s mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The opponent contended that the words “HIGH HEELS” could not be considered the distinctive element of the opponent’s mark as it has footwear in its Class 35 specification. The opponent contends that “High Heels is a generic term for a non-flat shoe and on its own has no magnetic pull because it is so widely used in every day [sic].” However, for every part of the opponent’s specification (other than the retailing of shoes) the words “HIGH HEELS” have no meaning and would be considered inherently distinctive if used on, for example, beverages, glassware, CDs, soap and advertising services. I do not accept the contention that the average consumer would ignore the first two words of the opponent’s mark simply because they were familiar words with a well known meaning, but which had no connection to any of the goods and services. If I were to accept this contention then in a similar manner I would have to accept that the second part of the opponent’s mark “ICE CREAM” was also familiar words with a well known and which also had no connection to any of the goods and services.

26) The applicant contends

“14. HIGH HEELS AND ICE CREAM comprises of two core elements, namely “HIGH HEELS” and “ICE CREAM” with each element fused by the conjunction “AND”. These elements, conjoined, are of an unusual juxtaposition and provide an obscure combination. It is that conjunction that makes the Earlier Mark memorable and striking.

15. By way of illustration, any chemist would be fully familiar with the concept of combining two elements of hydrogen and one element of oxygen to create water; those combined elements (when conjoined) become visually, conceptually and aurally distinct from the elements themselves. Following the ECJ’s decision in *BIOMILD*, C-265/00

Campina Meklunie BV v Benelux-Merkenbureau, the combination (HIGH HEELS AND ICE CREAM) is greater than the sum of its parts (HIGH HEELS and ICE CREAM).

16. The first part of a mark is the most important element because it is the most memorable part of the trade mark. That is even more so when the first part of a mark constitutes an alliteration such as HIGH HEELS. The repetition of the letter “H” in these two words will assist (both visually and aurally) in recalling to mind the mark as a whole.”

27) I fully accept that the beginnings of marks are important. I also accept the concept that a combined mark can be greater than the sum of its parts. However, this is usually when the combination has a meaning, either by nature or nurture. For example “Curl up and dye” is a popular name for hairdressers. It clearly describes two of the activities they carry out but it also has an additional meaning as a phrase. The mark in suit conjures up two very distinct and different images, one of a pair of shoes with stiletto or high heels and the other of some ice cream, either in a bowl or a cornet. These images have nothing in common and simply conjoining does not form a single image. Unlike “high heels and handbags” there is no common thread of goods being purchased at the same time in order to ensure that coordinate. I therefore disagree with the contention that the sum is greater than its parts. To my mind the mark has two distinct elements and conjoining with the word “and” does not form a new image of the two parts combined. The opponent contends that the combination is likely to create “an evocative and sensual meaning”. I do not agree with this contention. To my mind the elements “High Heels” and “Ice Cream” are equally distinctive elements.

28) Clearly, the marks of the two parties have a degree of visual, aural and conceptual similarity as they share two words (ICE CREAM). Equally clearly there are a number of dissimilarities as the opponent’s mark has at its beginning the words “High Heels and”. I accept that as the common aspects are at the end of the opponent’s mark mean that the average consumer could not avoid seeing the initial part of the opponent’s mark which would bring to mind a vivid image immediately upon seeing the words “HIGH HEELS”. However, the common parts are equally distinctive for the goods and services, indeed when used on shoes the second part of the opponent’s mark has even greater distinctiveness than the initial element as it is descriptive of some shoes.

29) I take of all of the above into account when considering the marks globally. To my mind, the similarities, are such that they outweigh any differences and when used on goods which are identical such as those in Classes 3 and 14 or which are complimentary such as those in Classes 18 and 25 there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds.

COSTS

30) As the opponent has been successful she is entitled to a contribution towards her costs. Ms Dozie has represented herself. As such I must consider costs due to a private litigant. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley Q.C. sitting as the Appointed Person, observed that:

“6. Under section 68 of the Trade Marks Act 1994, the Registrar is given a wide discretion to award costs. The principles upon which the Registrar will exercise that discretion are set out in a Tribunal Practice Note (TPN 2/2000 – see *Kerly’s Law of Trade Marks* 13th edition page 1009). In general the Registrar proceeds by reference to a scale of costs and it is a long established practice that costs in proceedings before the Registrar are not intended to compensate parties for the expense to which they may have been put. Mr. Knight expressed the policy behind the scale of costs in his decision in this case as follows:

‘That scale of costs is meant to be a reasonable scale based upon the policy that no-one should be deterred from seeking to register their intellectual property rights or indeed defend their intellectual property rights so that, for example, if a litigant in person loses an action before the trade mark registry, he or she would know fairly clearly in advance the sum of money they may have to pay to the other side.’

7. Plainly however a pre-requisite of making an award of costs on the scale of costs is that the award should not exceed the costs incurred.

8. It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.

...

10. As indicated above, the Registrar is given a wide discretion as to costs. The practice note is, and is intended to be, merely guidance as to how the Registrar will, in general, exercise that discretion. It does not and cannot impose a fetter upon the overriding discretion.

11. Part 44.3 of the CPR sets out the circumstances which should be taken into account when a court exercises its discretion as to costs and in my judgment exactly the same principles apply to the Registrar.”

31) I also rely upon the comments of Richard Arnold QC, acting as the Appointed Person in *South Beck* BL O/160/08 where he commented:

“34. The Registrar is not bound by the CPR. On the other hand, the Registrar is entitled to, and does, have regard to the CPR in exercising his powers in circumstances where the Trade Marks Act 1994 and Trade Marks Rules 2000 do not make specific provision. Section 68 of the 1994 Act and rule 60 of the 2000 Rules give the registrar discretion to “award to any party such costs as she may consider reasonable”, but do not place any constraints upon the exercise of that discretion. I agree with Mr Thorley that (i) an award of costs should not exceed the costs incurred and (ii) a litigant in person should not be in any more favourable position in proceedings in the Registry than he would be in High Court proceedings under CRP r. 48.6. So far as the first point is concerned, I note that paragraph 8 of TPN 4/2007 now states:

“Depending on the circumstances the Comptroller may also award costs below the minimum indicated by the standard scale. For example, the Comptroller will not normally award costs which appear to him to exceed the reasonable costs incurred by a party.”

35. Turning to the second submission, I agree with counsel for the opponent that the hearing officer appears to have misapplied CPR r. 48.6 and to have awarded the applicant two-thirds of the scale costs he would have awarded a professionally represented litigant without reference to the applicant’s actual loss or any figure calculated in accordance with r. 48.6(4)(b).

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings. The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.”

32) In accordance with these principles I direct Ms Dozie to provide a brief schedule of costs setting out any disbursements incurred, any other financial losses claimed and a statement of the time spent in dealing with the proceedings. This should be submitted to the Registry, and copied to the applicant’s agent, within one month of the date of issue of this decision. The applicant will then have two weeks to provide comments on these costs. I shall then issue a supplementary decision concerning the costs.

Dated this 28 day of June 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**