

O-383-11

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2507274
IN THE NAME OF IRMA MANAGEMENT LIMITED TRADING AS
JUDE'S ICE CREAM
IN RESPECT OF THE TRADE MARK:**

HOKEY POKEY

AND

**AN APPLICATION (NO 83829) FOR A DECLARATION OF INVALIDITY BY
GREYLEG INVESTMENTS LTD**

THE BACKGROUND AND THE PLEADINGS

1) The trade mark the subject of these proceedings stands in the name of Irma Management Limited trading as Jude's Ice Cream ("Irma"). It was filed on 27 January 2009, it was published in the Trade Marks Journal on 15 May 2009, and it completed its registration procedure on 21 August 2009. The trade mark consists of the words HOKEY POKEY and is in respect of ice cream and frozen yoghurt in class 30.

2) On 28 July 2010 Greyleg Investments Ltd ("Greyleg") applied for a declaration of invalidity in respect of the above trade mark on grounds under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act"). Greyleg relies upon a single trade mark of which it is the proprietor, namely UK registration 2229658, which also consists of the words HOKEY POKEY. The mark is registered in respect of confectionery in class 30. Greyleg's mark was filed on 17 April 2000 and it completed its registration procedure on 22 September 2000. The relevance of these dates are that: i) the mark constitutes an earlier mark as defined by section 6 of the Act, and ii) the proof of use provisions set out in section 47(2)(A)¹ apply, meaning that the use conditions set out in those provisions are relevant in these proceedings; Greyleg must, therefore, demonstrate that it has made genuine use of its mark.

3) The somewhat unusual aspect of this case is that subsequent to the application for invalidation being made, but after it had filed a defence, Irma voluntarily surrendered its registration. Despite this, Greyleg chose to still proceed with its application for a declaration of invalidity. Whilst unusual, this is clearly permissible as, if Greyleg succeeds, Irma's registration will be deemed never to have been made as opposed to it being surrendered as of the date of surrender². Furthermore, despite surrendering its mark, Irma still defended its position.

4) Both sides filed evidence and both sides attended a hearing before me on 5 August 2011. The parties represented themselves at the hearing, the main protagonists being Mr Charles Mezger of Irma and Mr David Garnsworthy of Greyleg; Mr Garnsworthy was assisted at the hearing by other members of his family who are all also involved in Greyleg's business.

5) The evidence of the parties deals with: i) whether Greyleg has made genuine use of its mark and, ii) what significance the term HOKEY POKEY has on the UK average consumer of ice-cream (or confectionery). To set things in context for the rest of my decision, and to explain the relevance of the evidence, I should explain the basis upon which Irma defends its position. It originally referred to the

¹ See section 47(2)(A) of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

² The registration was surrendered on 22 March 2011.

differences in the specifications and, also, that there would be no likelihood of confusion as to origin of the respective goods due to the meanings attributable to the expression HOKEY POKEY. Following its voluntary surrender, it became clear that the defence is based, essentially, on the average consumer being aware of HOKEY POKEY as a common description of a particular type/flavour of ice-cream (and possibly also an alternate name for honeycomb) and, therefore, the average consumer will not be confused as to economic origin because the words do not point to economic origin. It should be stressed at this point, a point I also stressed at the hearing before me (and also at an earlier case-management conference), that the validity of Greyleg's earlier mark is not in issue. A registered trade mark is deemed to be valid³ in legal proceedings for which that mark is in issue. Irma has not sought to seek the invalidation of Greyleg's mark. Irma's mark would also benefit from a presumption of validity (these invalidation proceedings being based on a conflict with an earlier mark as opposed to any alleged descriptive/generic nature) but it has already surrendered the mark, such a surrender being based, in part, on Irma believing HOKEY POKEY to be generic. It is not possible for Irma to invalidate its own mark so it seems appropriate that the presumption of validity can, effectively, be waived by Irma. These are highly unusual circumstances. I consider that, in the circumstances, I am required to consider the meaning of the words HOKEY POKEY from the perspective of the average consumer in determining whether there exists a likelihood of confusion.

THE RELEVANT PERIOD/DATE

6) In terms of Greyleg's mark having been put to genuine use, such use must be within the five year period ending on the date of Greyleg's application for invalidation. The relevant period is, therefore, 29 July 2005 to 28 July 2010. In terms of establishing a likelihood of confusion on the part of the average consumer, this must be established as of the date of application of Irma's mark, namely: 27 January 2009.

THE EVIDENCE

Evidence relating to the use made by Greyleg of its Hokey Pokey mark

7) Greyleg has provided a large amount of evidential material. Various witnesses have provided evidence. I will begin with the evidence of Mr David Garnsworthy. He explains that the mark HOKEY POKEY was previously used by The Chocolate Society. He explains that the trade mark came into the control of his sons in March/April 2010. Mr Garnsworthy has provided assistance to his sons' business (presumably Greyleg) as he has a background in accounting. He has been able to obtain information from two previous employees of The Chocolate Society and he has also been able to interrogate various computer records. He refers to evidence of use in relation to a number of products, namely: chocolate,

³ See section 72 of the Act.

chocolate slabs, honeycomb, bonbons, ice cream, milk shakes. Some of the material exhibited to his witness statement includes:

- i) A “to whom it may concern” letter from Jennifer Nugent, ex sales manager of The Chocolate Society. She refers to Hokey Pokey being a brand name. She refers to wholesale and retail sales. She says that bags were sold to outlets that would use it in different products such as ice cream and slabs. Two shops were also run selling Wicked, Milkey and Original Hokey Pokey; Hokey Pokey was also used in slabs and ice-cream sold in the shop. Hokey Pokey was also used in amenity bags sold to the Dorchester Hotel for room service.
- ii) An email from Allan Bendelow to Al Garnsworthy; the former also worked for The Chocolate Society. In this email he says that Hokey Pokey was used to make various products including: being enrobed in chocolate, sold bare, in ice cream, crushed and put into bars, in various pralines, in cheesecake, in a truffle.
- iii) A letter to Al Garnsworthy from Cheryl Vaughan of Chocs Away Limited. In this letter Ms Vaughn says that her company has sold Chocolate Society Hokey-Pokey for a number of years. She discovered it in 2003. It appears from her letter that it is a popular product. She does not identify the nature of the product. A purchase order form from November 2010 between Chocs Away Limited and The Chocolate Society is provided showing the sale of 24 250g bags of Wicked Hokey Pokey and 48 250g bags of Milkey Hokey Pokey.
- iv) Invoices issued by The Chocolate Society dated between November and December 2005. There are approximately 30 in total. The invoices include designations such as “CS Hokey Pokey – Milkey”, “CS Hokey Pokey – Original”, “CS Hokey Pokey Hamper”, “CS Hokey Pokey – Creamy”, “CS Hokey Pokey – Wicked”, “CS Hokey Pokey – Milk Bar”.
- v) Further invoices (approximately 58) from various dates in 2006. The above designations are used. Additional products include: “Hokey Pokey Egg Milk with white Hokey Pokey” & “Milk Choc & Hokey Pokey 50g Bar”.
- vi) Further invoices (approximately 70) from various dates in 2007. The designations already referred to are used, but no additional ones.
- vii) Further invoices (approximately 53) from various dates in 2008. It is noted that the company issuing them is called The Chocolate Partnership Ltd. The Chocolate Society is used on the bottom of the invoices. The designations already referred to are used, but no additional ones.
- viii) Further invoices (approximately 62) (again from The Chocolate Partnership Ltd) from various dates in 2009. The designations already

referred to are used, additional designations include “Hokey Pokey Milk/Dark”, “Hokey Pokey F & M – Wicked/Original” and “Hokey Pokey – Original Bulk”.

- ix) Further invoices from various dates in 2010. The invoices are now from The Chocolate Society. In view of the relevant period being considered, only those issued before 28 July 2010 are relevant. Only 17 fall in this category. The designations include: “Hokey Pokey”, “Milkey Hokey Pokey” and “Wicked Hokey Pokey”.
- x) Documents relating to sales history are provided. They cover, primarily, the designations set out above. The total sales of the various HOKEY POKEY products between 2004 and 2009 were approximately £224k. Other than a dip in 2007, sales increased year on year. This does not, though, include sales made from The Chocolate Society’s shops. The sales figures therefore relate to wholesale orders only. The wholesale figures for ice-cream can be ascertained from a summary sheet; this shows figures for “HP ice cream 4kg” with sales of £345 (a quantity of 14) in 2008 and £42 (a quantity of 5) in 2009. It is, though, highlighted that most of the ice-cream sales were made through the shops rather than wholesale.
- xi) Some internal documents which refer to: a) the hokey pokey room, presumably where the products are made, b) another reference to the hokey pokey room which discusses the hot honeycomb that is made therein and a reference to only authorized personnel being able to assist in honeycomb production; the documents are dated 2000 and 2002 respectively.
- xii) Mail order price lists from 2004 and 2005 showing various Hokey Pokey products (but not ice-cream). Further documents from 2006 (product information sheets, inventory control information, stock transfer note) referring to various Hokey Pokey products (but not ice-cream); similar documents from 2007 with similar references (but not ice-cream) – one refers to “Crunchy Nut, Hokey Pokey & Morello Cherries Chocolate”; similar documents from 2009 are provided.
- xiii) Photographs of Hokey Pokey products. I attach a scan below:



This above is said to be from 2003, as is a further photograph showing a similar product as part of a hamper offered by The Chocolate Society, as is a photograph of the shop interior with what appears to be the above products on a shelf. There is also a website print from 2007 showing the same products as above. There are further prints from the website from 2006 and 2007 showing “HOKEY POKEY (HONEYCOMB)” text, and, also, prints showing text (but not the packaged product) using names such as HOKEY POKEY ORIGINAL/WICKED/MILKEY etc. Current prints from the website showing similar packaging and use in text are also provided.

- xiv) Information relating to the sale of ice-cream is provided. Various documents are provided showing that the business owned ice-cream machines. An income report for a period in 2008 refers to ice-cream sales of around £4k (but Hokey Pokey is not specifically mentioned). A further “nominal view” report from 2005 shows ice-cream sales (not Hokey Pokey ice cream); HOKEY POKEY is listed separately. Sales history and stock movement sheets are provided, however, most are undated. They could be duplicating the figures mentioned earlier. They at least refer to Hokey Pokey ice cream albeit in very small amounts. Some fliers are provided but these do not mention Hokey Pokey. Prints from the shops’ menu from 2007; Hokey Pokey is one of the available ice-creams for purchase (the others are just descriptions, e.g. vanilla). Another similar menu refers to milkshakes under the same designations. There is an internal email from 2006 referring to ice-cream having sold well. Two internal emails (one undated, the other from 2007) referring to the shops need to restock “h.pokey. ice cream”. Examples of promotional material relating to The Chocolate Society

are provided, said to be from 2007-2010, which includes the words "...or even our Hokey Pokey ice-cream by our friendly staff". A master order form from 2008 & 2009 where HOKEY POKEY ice-cream is listed. Another order form (Mr Garnsworthy states that it is "probably from 2009") which lists various Hokey Pokey products such as "Choc Soc Own label", and later lists "Hokey Pokey ice cream".

xv) Marketing material is provided, but as this is mainly before the relevant period I will not detail it all. Much of it refers to trade shows etc. I note one extract, from shortly before the relevant period, consisting of a retailers' price list from January 2005 which, under the heading of a particular Hokey Pokey product, it is described as "Our special recipe honeycomb...". Further website documents are also provided showing Hokey Pokey products being sold from within the relevant period. Some show use in relation to Easter eggs. I also note the "Our special recipe honeycomb..." message is repeated in the way in which the product is marketed⁴.

xvi) Evidence relating to other retailers selling the products is provided. This includes an example of a Fortnum & Mason hamper containing the packaged product, but this is from after the relevant period; an undated extract from the website of The Little Favour Box Company, showing a picture of the product; extracts said to be from the 2009, 2008, 2007 & 2006 website of Gorvett & Stone selling Hokey Pokey and Milkey/Wicked Hokey Pokey (the 2006 extract shows the packaging); an extract (either of a website or a brochure) from 2008 from Merrose & Morgan referring to Chocolate Society Hokey Pokey (and depicting it); an extract from a Fortnum and Mason Afternoon Tea menu listing the Original and Wicked Hokey Pokey product; 2008 & 2009 extracts from the website of Berry Bros & Rudd for Wicked Hokey Pokey.

8) A witness statement is filed by Duncan Charles Garnsworthy. He says that he purchased the trade mark from its previous owners Norwood House Chocolate Ltd on 31 March 2010. He explains that some Hokey Pokey stock was purchased from the administrators and that great value was placed on the trade mark. The stock was sold to the public from the premises of The Chocolate Society in a 10 day period (the exact period is not given). The rest of his evidence relates to subsequent developments which are outside the relevant period so I need not detail them.

9) A witness statement is filed by Alasdair Garnsworthy (presumably the "Al" Garnsworthy mentioned earlier in the evidence). He explains that Greyleg was established by him and his brother Duncan. He explains that they bought two companies: Norwood House Chocolate Ltd and Fraiche (1987) Ltd and that part

⁴ See, by way of example, page 136 of Mr Garnsworthy's evidence.

of this purchase included the HOKEY POKEY trade mark. He repeats Duncan Garnsworthy's evidence about the sale of left over stock. He provides an extract from a chocolate weblog that refers to the sale of Hokey Pokey in April 2010. Reference is made to the selling of further stock both wholesale and retail. He refers to action taken to stop others from using the trade mark.

10) A witness statement is filed by Deidre Garnsworthy. Her evidence corroborates much of what has already been set out in the evidence. It is unnecessary to detail it further.

11) A witness statement is made by Howard Carr. He is a former director and shareholder of The Chocolate Partnership Limited. He explains that Norwood House Limited was the principle trading business with Fraiche (1987) holding the lease to one of the shops. From the context of his evidence, The Chocolate Society seems to be a trade name/mark of Fraiche (1987). He says that a principle part of the business was the trade in Hokey Pokey in the form of honeycomb and chocolate coated honeycomb products. The goods were sold retail, wholesale, via the Internet and in department stores. In relation to ice-cream, it is explained that sales were less in volume and were concentrated over the summer months. Hokey Pokey ice-cream was sold from its shops in Shepton Mallet and Elizabeth Street in London. It was made at a plant in Acton and transported in tubs where it was scooped for sale or sold in tubs for home freezer use. He says that under previous ownership, the ice-cream was made in the shop using honeycomb made in the Norwood House Factory in Yorkshire. He says under the previous ownership the company made both confectionery and ice-cream Hokey Pokey for several years.

Evidence relating to the term HOKEY POKEY

12) A witness statement is made by Ms Zelica Carr (on behalf of Irma), who is the Chief Executive Officer of The Ice Cream Alliance, which she describes as the trade association for the artisan ice-cream manufacturing industry. Ms Carr states that Hokey Pokey is a phrase that has been used in the ice-cream industry for over 100 years, originally as a term describing ice-cream sold from street vending carts. She adds that, more recently, in the last 20 years, it has been used in the artisan ice-cream industry to describe honeycomb ice-cream. She says that Roskilly's and Ryeburn were both using it from 1991 and 1998 respectively. She says that amongst the artisan ice-cream manufacturing fraternity, the term is commonly understood to describe honeycomb ice-cream.

13) A witness statement is provided by Mr Charles Mezger, director and shareholder of Irma. In terms of the historical origins of the phrase, he says that this stems from street traders (as referred to by Ms Carr) and provides supporting exhibits from the Oxford English and The Oxford Concise Dictionaries to this effect. Further evidence of this meaning comes from a publication called ICES - THE DEFINITIVE GUIDE (copyright 1995) and an extract from the educational

part of the BBC website (it is not possible to date this). Also provided are extracts from a website called Edmund Forte & Related Families (it is not possible to date this), from Rights and wrongs.co.uk (which seems to have been published on 5 February 2011) and from thepotteries.org (it is not possible to date this), which all also refer to this historical meaning. There is also a CD from 1975 which features HOKEY POKEY as part of a song name.

14) Mr Mezger provides a copy of an article in *Farmlife* from 1991 about ice-cream produced by the Roskilly family of St Keverne. The extract states :”Lovers’ delight, Crusoe’s Paradise, hokey pokey, chocolate chaser – the Roskilly Family... have no trouble thinking up names for their homemade ice-creams”. The hokey pokey ice-cream is made of crushed up “cinder toffee”. Also provided is an extract dated 5 November 1998 from the *Gazette & Herald* relating to ice-cream produced by a North Yorkshire company called Ryeburn. It states that “The range of unusual flavours includes Hokey Pokey (cinder toffee), Bubble Gum, Strawberry Cheesecake..”. Also provided is an extract from a book called *Street Food* which was first published in the UK in 1999 which contains a recipe for hokey pokey which is then described as Honeycomb toffee ice-cream. The recipe is in the Australia and New Zealand section. The writer provides a commentary about the product being from New Zealand, although reference is made to the use of the name hokey pokey in the distant past. Reference is then made to what Mr Mezger identifies as 24 commercial outfits that have been producing hokey pokey ice-cream. These are:

- i) Judes, who have produced handmade ice-cream since 2002. They list a number of flavours: Hokey Pokey, Strawberry Tease, Very Vanilla, Double Choc (the website has a copyright date of 2011);
- ii) Callestick Farm, who offer a “Honeycomb (Hokey Pokey) ice cream (it is not possible to date this);
- iii) Ryeburn, who offer a Hokey Pokey Ice Cream (it is not possible to date this);
- iv) Roskilly, a further copy of the 1991 newspaper article is provided;
- v) Baskin Robbins, who offer a Hokey Pokey Ice Cream (it is not possible to date this);
- vi) The Coach House at Lea, who have Hokey Pokey ice-Cream on its menu (it is not possible to date this);
- vii) Merryweather Ice Creams, who offer a Hokey Pokey (Honeycomb) ice-cream (the website has a copyright date of 2009);

- viii) Braemar Farm, who offer “Hokey Pokey: Dairy Ice Cream with Honeycomb” other flavours include Braemar Cream, Strawberry Field, Mint Sensation, Chocoholic, Rippled, Irish Cream, Cow Pat, Pannacotta and Wild Strawberry Coconut (it is not possible to date this);
- ix) Ronaldo’s Ice Cream who offer Honeycomb Hokey Pokey Ice-Cream (it is not possible to date this);
- x) Peak District Dairy who offer Hokey Pokey Ice-cream (winning a gold award at the Bakewell Show 2007);
- xi) Ice Cream Parlour at Manor Farm, who are renowned for wacky flavours including hokey pokey (“a lovely gooey honeycomb concoction”)⁵ (it is not possible to date this);
- xii) Daisy Grazing Ice-Cream (an ice-cream bike service) whose flavours include Honeycomb Hokey Pokey (“caramel ice cream with chunks of honeycomb) (it is not possible to date this);
- xiii) Gales of Llangollen who offer Hokey Pokey ice cream (it is not possible to date this);
- xiv) Lolas on Ice who offer a range of unusual ice creams (horseradish and gin & tonic) including Hokey pokey ice-cream (it is not possible to date this);
- xv) Dale Farm, whose webpage refers to Hokey Pokey as a traditional name for ice-cream (it is not possible to date this);
- xvi) Auchendean Lodge, whose most popular ice-cream is hokey pokey. A recipe is then provided. The honeycomb seems to be the Hokey Pokey which is then mixed into ice cream. It is referred to as New Zealand’s most popular flavour. The historical origin of the term is also mentioned. (it is not possible to date this);
- xvii) A reference on a website called dewintons.co.uk about a caterer called Jacqueline Cottrel who refers to an ice-cream station used at her events and that Hokey Pokey ice-cream is offered (it is not possible to date this);
- xviii) Hush, an eatery that offers Hokey Pokey Ice-Cream with Hot chocolate sauce;

⁵ The extract is from the *Bradford Telegraph and Argus*.

- xix) Huntley's, who produce ice-cream including Hokey Pokey (it is not possible to date this);
- xx) Euro Ice-cream, who produce ice-cream, but the picture of ice-cream which features the words HOKEY POKEY contain the words "ice-cream parlour" beneath it - it is therefore unclear what the sign relates to (it is not possible to date this);
- xxi) Cole & Sons, an ice cream seller who offers "Honeycomb (Hokey Pokey)" as a flavour (the website carries a copyright date of 2010);
- xxii) Jumping Jenny, another eatery to offer Hokey Pokey ice-cream (the print carries a date of January 2008);
- xxiii) The Modern Pantry, another eatery, the website contains a review from Lisa Thompson of *NZinspired*, "as each nugget of honeycomb in the homemade Hokey Pokey ice-cream..."(it is not possible to date this);
- xxiv) Severn Fish, another eatery that sells a Hokey Pokey ice-cream (it is not possible to date this).

15) Examples of the term HOKEY POKEY from the world of cookery in relation to honeycomb/cinder toffee are then provided, including:

- i) An extract from the book *Nigella Express* (by Nigella Lawson), the front cover of which states "more than one million copies sold". Hokey Pokey (a recipe in the body of the book) is said to be the Cornish term for honeycomb. A hard copy of the book is provided showing a copyright date of 2007;
- ii) An extract from *Simple Cakes* by Mary Berry. The recipe is for Hokey Pokey Coffee cake, a special cake from New Zealand (the book was first published in 2004, this version (paperback) was first published in 2006);
- iii) An extract from the Jamie Oliver website. It is a message board entry for someone who is looking for ideas for food gifts but who has never made anything other than hokey pokey (the message is dated November 2008);
- iv) An extract from the BBC website for honeycomb, which is also known as: "cinder toffee, yellowman, sponge toffee, puff candy and hokey pokey" (it is not possible to date this);
- v) A recipe from the website of foodnetwork.co.uk taken from its show *Nigella Express*, the content is similar to i) above. Also provided is a similar entry from Nigella.com. Statistics for the popularity of Nigella Lawson's

shows are provided from Wikipedia, around 3 million per episode is referred to (it is not possible to date this, another reference is made back to the book and its copyright date of 2007);

- vi) A screen print from the BBC Iplayer for the programme *The Great British menu*. The print shows a person with a wheeled food tray upon which the word HOKEY POKEY is written (it is not possible to date this);
- vii) A recipe from the website for the show *The Hairy Bikers Mums Knows Best* in respect of Hokey Pokey biscuits – these are apparently viewer recipes from the recipe “swap tent” (it is not possible to date this).

16) Examples of the term HOKEY POKEY in newspapers are provided, namely:

- i) An extract from the *Daily Mail* website for a “HOKEY POKEY CINDER TOFFEE” recipe (it is not possible to date this);
- ii) An extract from *The Times* website referring to the origins of the hokey cokey song, which includes a reference to Hokey Pokey in the historical sense (the article dates from 11 January 2009);
- iii) An extract from *The Guardian* (the extract is not a news article but part of a continuing fictional story) which refers to a person entering a sweetshop containing products including sweets such as Hokey Pokey (this seems to date from 2007, due to a blogged comment that follows the story);
- iv) An extract from spectator.co.uk which has a recipe for Brula Honeycomb. The extract begins “Like hokey pokey ice-cream” (it is not possible to date this);
- v) An extract from *The FT* similar to ii) above (the article is dated 12 January 2009);
- vi) An extract from news.scotsman.com which provides a recipe for butterscotch ice-cream with hokey-pokey. It says that hokey pokey is also called honeycomb or puff candy and is what New Zealanders use in their Hokey Pokey ice-cream. A supplier (Valvona & Crolla) of hokey pokey is detailed in Edinburgh (it is not possible to date this).

17) The final extracts provided by Mr Mezger are further internet uses in relation to ice-cream, honeycomb or honeycomb ice-cream:

- i) A print from a website called foodstuff.blogspot.com about a confection called CREDIT CRUNCH described as Dark hokey pokey fun. The writer of the article refers to cinder toffee being called hokey pokey by some (the print is dated 9 April 2009);

- ii) An extract from urbandictionary.com defining hokey pokey as hard golden sweet stuff found in hokey pokey ice-cream and used in Cadbury's Crunchie Bars (part of the posting relating to this definition comes from a user called Juanita and is dated 22 September 2005);
- iii) An extract (dating from 1996) from recipiesourse.com for Hokey-Pokey ice-cream;
- iv) An extract (dating from August 2010) from meemalee.com with a recipe for cinder toffee "aka puff candy, honeycomb toffee or hokey pokey";
- v) An extract (dating from 1999) from randomhouse.com referring to the historical usage;
- vi) An extract from gastronomydomine about Hokey pokey ice-cream (it is not possible to date this);
- vii) An extract from gustoandrelish.co.uk which, under their gifts and hampers, hokey pokey (chocolate dipped honeycomb) is available (the website carries a copyright date of 2008);
- viii) An extract (dated 21 December 2009) from yell.com referring to a recipe for Hokey Pokey Cinder Toffee;
- ix) An extract (dated 26 February 2011) from oowleer.blogspot.com which provides a recipe for hokey pokey coffee cupcakes, based on the recipe from Mary Berry;
- x) An undated print from Daisy Chain Cakes who sell a variety of cupcakes including one called HOKEY POKEY which contain pieces of *Crunchie* (a well-known brand of chocolate confectionary that contains honeycomb);
- xi) An extract (dated 4 November 2009) from *The List* relating to a café that has opened in the National Gallery of Scotland. Midway through the second page reference is made to Carina (who runs the café) and that the café contains a painting of her father's ice-cream parlour in Cockenzie – she refers to Hokey Pokey ice-cream as being part of her heritage;
- xii) An extract (from April 2008) from a message board of digitalspy.co.uk relating to a general topic of best ice-cream tasted. One user refers to Hokey Pokey;

xiii) A Google results page for the term **hokey pokey** in UK sites which brought back 212,000 results;

xiv) A Google results page for the term **hokey pokey ice cream** in UK sites which brought back 15,300 results.

18) To counter Mr Mezger's evidence, a witness statement is provided by Deirdre Garnsworthy. Mrs Garnsworthy provides evidence relating to the size of the ice-cream market (which I accept is large). She provides a Marketing Alliance list of 29 major ice-cream manufactures and then compiles her own list of 65 other small and medium sized manufactures. None use HOKEY POKEY. For ice-cream that contains honeycomb, the names are predominantly based on the word honeycomb; documents relating to the manufacturers' products are also provided. Mrs Garnsworthy also provides evidence in relation to the 24 ice-cream manufacturers identified by Mr Mezger. For reasons that will become apparent, I will not detail all of the evidence, but she highlights that Jude's Ice-cream are the predecessors in title to Irma and that they also supply a number of the other undertakings; it is highlighted that some no longer offer the product, some are merely retailers not manufactures, that some may no longer be in business, that some have been uncontactable, and that Roskillys have a short term licence from Greyleg. In relation to the Ice Cream Alliance, Mrs Garnsworthy says that they represent, in the main, small mobile ice-cream makers/vans. An article from 2008 in the Farming Monthly states that they have 650 members involved in the manufacturing, retail and catering of ice-cream and related products; it is stated that at their 2011 trade fair most of the exhibitors were equipment suppliers. Mrs Garnsworthy also undertook research against a cross selection of 53 artisan producers. Of those who produce honeycomb ice-cream, 31 use the expression honeycomb ice-cream, 1 (Jude's) use Hokey Pokey and another uses Honeycomb (Hokey Pokey). She also spoke to Mr Greg Barton, Sales Director at Ice Cream World (who she says is that largest UK ice-cream wholesaler), who had no idea what HOKEY POKEY was. Mrs Garnsworthy provides evidence as to Mr Mezger's intent; I see nothing in this evidence that assists with the questions that are now before the tribunal. She completes here evidence by providing recipes and website prints for products containing honeycomb which, invariably, and unsurprisingly, refer to honeycomb and not HOKEY POKEY.

19) Mr David Garnsworthy also provides counter evidence/submissions. It is long and detailed. The relevant points I note are that:

- The ice-cream industry is very large;
- That there is historical use of HOKEY POKEY in relation to ice-cream (the street vendor evidence) but this stopped some time ago;
- Greyleg has taken action to stop other traders from using the words HOKEY POKEY;

- That honeycomb is used in a variety of confectionery products but normally with reference to the word HONEYCOMB;
- That he could find no foundation for HOKEY POKEY being a Cornish term for honeycomb. Mr Garnsworthy cannot understand why Nigella Lawson says so. He highlights that Ms Lawson was a member of The Chocolate Society.

WHAT CAN BE TAKEN FROM THE EVIDENCE

20) In terms of Greyleg's use, I take forward that:

- a) During the relevant period Greyleg sold reasonably significant amounts of honeycomb and chocolate covered honeycomb confectionary, both retail and wholesale.
- b) The sign HOKEY POKEY has been used prominently in connection with such sales.
- c) During the relevant period Greyleg has also sold ice-cream with reference to the sign HOKEY POKEY. Wholesale sales are small, combined sales in 2008 and 2009 were less than £400. If wholesale sales are greater than this, the evidence does not support it. The availability of the product was, though, highlighted on order forms; how many customers were aware of this availability is not, however, clear.
- d) In terms of ice-cream sales via The Chocolate Society shops, the scale is not quantified. For a period of time in 2008 sales of ice-cream as a whole were around £4,000. HOKEY POKEY was, though, just one of the ice-creams beings sold. HOKEY POKEY featured on the ice-cream menu.

21) In terms of the meaning of the phrase HOKEY POKEY, I take forward that:

- e) There is a historical meaning behind the words HOKEY POKEY;
- f) The words HOKEY POKEY describe a type (honeycomb) of ice-cream in New Zealand;
- g) That some people may perceive HOKEY POKEY as an alternate name for honeycomb;
- h) That some manufactures/retailers use the words HOKEY POKEY in connection with honeycomb ice-cream;
- i) That some consumers will have encountered HOKEY POKEY ice-cream (other than that produced by Greyleg);

j) That the most popular descriptive designations for honeycomb ice-cream or confectionery make use of the word honeycomb;

k) That both the ice-cream industry and the confectionery industry are large.

22) I will make my proof of use analysis shortly. However, as it will assist with the whole scope of the decision, I will firstly assess the significance of the words HOKEY POKEY from the perspective of the UK average consumer (who must be assumed to be a member of the general public).

23) The meaning of HOKEY POKEY is not something which can be accepted as a notorious fact despite the dictionary definitions Mr Mezger provided. Caution needs to be exercised in deciding what an average consumer knows. This is illustrated by the decision of Ms Anna Carboni, sitting as the Appointed Person, when she expressed caution as to the degree of knowledge an average consumer may be assumed to possess; in those proceedings the word in question was CHEROKEE⁶. However, Mr Mezger has filed a significant amount of evidence in an attempt to show that the average consumer is aware of the phrase HOKEY POKEY. The question, though, remains, as to whether the average consumer can be taken to know the term. It does not matter that some members of the general public may know the phrase as a result of the use that Mr Mezger provides in his evidence. In terms of establishing whether there exists a likelihood of confusion, the fact that some people may not be confused because they regard the phrase as simply a descriptor (and hence will not believe that the goods sold under the respective marks are from the same undertaking) is not relevant. It is the average consumer's reaction that is important.

24) In terms of ice-cream, whilst there are a number of undertakings who offer/sell HOKEY POKEY ice-cream, this is watered down given that some relate to stockists of Irma's goods or that some have stopped using the designation as a result of action taking by Greyleg, or are licensed by Greyleg. There was a dispute between the parties as to how much watering down there was, but I do not consider this to be overly significant. This is because of two factors. Firstly, the question as to whether the use is particularly significant in the marketplace. Secondly, what will be perceived by consumers who do encounter such use. In terms of the first factor, there is no evidence of the significance in the market place (such as sales figures etc) or how much of the market the use put forward represents. Indeed, Greyleg's counter evidence suggests that the significance is low. This can be exemplified by the nature of the undertakings; many appear to be local rather than national undertakings. They include production on farms and sales in individual eateries. They include single catering companies. Whilst such companies could have a significant reputation within the market, there is no evidence to demonstrate this. There is, of course, the Baskin Robbins (which

⁶ See BL O-048-08

Irma highlight as a well-known national (even international producer)) use, but, again, I have no idea as to the scale or timing of this. Greyleg's counter evidence also casts doubt on the significance of Irma's evidence given that the majority of ice-cream manufacturers who offer honeycomb ice-cream appear to use designations other than HOKEY POKEY. The evidence of Ms Carr (of the Ice-Cream Alliance) does little to assist in terms of the perception of the average consumer. Her organisation represents those in the artisan field and there is no evidence to explain the degree to which the average consumer will have encountered goods produced by such undertakings and how many of these undertakings use the term HOKEY POKEY. Indeed, Greyleg researched a number of what they believed to be artisan ice-cream makers with few using the term HOKEY POKEY. In terms of the second factor, there is a question mark as to whether consumers who encounter the words in relation to ice-cream will automatically regard it simply as a description and nothing else. Whilst some consumers may regard any ice-cream which is listed, effectively, as a flavour, as simply a description (even if that name seems to be invented), others may, nevertheless, still perceive it as a trade mark of the company that has produced it. This will be more certain in respect of some uses than others. For example, the newspaper article about Roskilleys refers to them coming up with ice-cream "names" (the other names are not standard descriptions) and Braemar also sell a "cow pat" ice-cream which clearly is not a flavour per se. Even when this is not the case, some consumers are still likely to appreciate that non-standard names (particularly with no obvious clue to the type of ice-cream involved) can play a dual role, indicating, in a trade mark way, the flavour of ice-cream produced by one undertaking; the name performing, effectively, a dual proprietary role. Unless the consumer has encountered multiple examples of use from clearly different undertakings then this dual role message may not be disturbed. I should add that I do not regard the historical meaning of HOKEY POKEY to assist. Even though Ms Mezger provided a number of Internet extracts which make reference to this meaning, it is not safe to assume that the average person in the UK will have encountered them; some will, but in my view not in significant numbers. For a combination of these reasons it is not safe to infer that the average consumer in the UK will regard HOKEY POKEY as a type or flavour of ice-cream.

25) In terms of the use of HOKEY POKEY as an alternative to the word honeycomb, similar themes run through my analysis. Whilst there has been some use which, on the face of it, may seem significant, such use is not always telling. For example, the use in Nigella Lawson's million unit seller appears on page 281 of the book. Readers of books such as this may not even notice the recipe, let alone read and recall the fact that is given (HOKEY POKEY being the Cornish name for honeycomb). I note, as with ice-cream, some people clearly see the term as an alternative way of referring to honeycomb, but I am not persuaded that such knowledge is representative of the UK average consumer. Even when one adds all the evidence together, I am not persuaded that the average person in the UK will perceive HOKEY POKEY as an alternative way of referring to honeycomb.

26) It may be the case that the historical and/or New Zealand use may have crept into the vocabulary to a degree. However, I come to the view that whilst some members of the public will know of the phrase HOKEY POKEY as an alternative to honeycomb or will know of the phrase as a description of a type of ice-cream, such people will be in the minority. The average consumer of the respective goods will view the phrase as invented, perhaps being reminiscent of the song “the hokey cokey”.

PROOF OF USE ANALYSIS

27) Put simply, Greyleg’s earlier mark must have been genuinely used in the five year period which ended on the date on which it applied for its declaration of invalidity⁷. If this test fails then Greyleg is not entitled to rely on its earlier mark, with a consequence that its application for invalidation must fail. If genuine use has been made of the earlier mark, I must also determine a fair specification that reflects such use. The period relevant for my determination is 29 July 2005 to 28 July 2010. The onus is on Greyleg to show what use it has made of the mark, as per section 100 of the Act which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

28) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position⁸ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a 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].

⁷ Proper reasons for non-use may also be relied upon, but none are claimed by Greyleg.

⁸ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

(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]; *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].

(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].”

29) I also note the comments in *Laboratoire De La Mer Trade Mark* [2002] FSR 51 where Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

30) As can be seen from the preceding analysis of the evidence, the sign HOKEY POKEY has clearly been used on honeycomb and chocolate honeycomb type products. I will return to ice-cream shortly. The proof of use provisions require a mark to be used in accordance with the essential distinguishing function of a trade mark i.e. used as a trade mark. However, this is not an assessment of the inherent or factual capacity of the mark to distinguish. As mentioned earlier, these are not proceedings concerned with the validity of Greyleg's mark on the basis that it is descriptive or that it is a term commonly used in the relevant field or that it has become, since registration, generic or deceptive. I believe the correct test is whether the nature of the use is capable of being taken by the average consumer as a sign indicating trade origin – as it suggests in *Ansul*, whether the nature of the use is consistent with the essential function of a trade mark. Applying this test then the use presented is acceptable. The packaging features the words HOKEY POKEY as the name of the product, its use not being in the nature of simply describing what the goods are. Whilst the mark is sometimes (in lists of products for example) used alongside other descriptive names, other distinctive names are also used which, therefore, means that the capacity of it to be taken as a trade mark is not seriously undermined. It is also clear in the marketing that has taken place that the sign is promoted as a trade mark. **My finding is that there has been genuine use in respect of honeycomb and chocolate covered honeycomb and chocolate products containing honeycomb.**

31) I now turn to ice-cream. The sales of ice-cream to the wholesale market are incredibly small. Whilst not a strict qualitative assessment, the use must still be warranted in the economic sector concerned so that a market share/outlet is created or preserved. I also have the retail sales to consider, the whole picture of use needs to be considered. However, sales figures have not been provided. The only figure is that in a period in 2008 there was £4000 worth of sales for all ice-cream. HOKEY POKEY represents only a proportion of that given that a number of other ice-creams were available. Even if I were to attempt to estimate such sales then the figures are still small. The fact remains that there is little evidence before the tribunal to make an informed decision. Whilst Mr Carr confirms that sales were made, albeit concentrated in the summer months (Mr Bendelow also refers to the sale of ice-cream in an email), this takes me no further forward. The presence on order forms does not really assist as I do not know how many were issued. Even making the best of it I can, the most that can be inferred is that very small (unspecified) amounts of HOKEY POKEY ice-cream has been sold through a very small (perhaps just 2) number of shops (where the mark was placed on menus); I do not consider this to be sufficient to meet the genuine use test, particularly when the very large size of the ice-cream market is borne in mind (Greyleg itself says that this is very large market). **In relation to ice-cream, genuine use has not been demonstrated.**

32) It is necessary to consider how the relevant public would likely describe the goods⁹ for which genuine use has been demonstrated. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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 relating to which the goods or services for which the trade mark has actually been used actually 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

⁹ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

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.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

33) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. 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."

34) The earlier mark is registered for confectionery at large. This is a broad term covering a number of sub-categories of confectionery. Genuine use has been shown on honeycomb and chocolate products containing honeycomb. I cannot think of any way to sub-categorize honeycomb. In relation to the other products, they all have chocolate in common. There are a number of types of product sold ranging from chocolate covered chunks, chocolate bars containing honeycomb and even Easter eggs. I consider that the relevant public will regard this as chocolate confectionery, a term which reflects a fair and reasonable sub-category of the goods. **I consider a fair specification to be:**

"Honeycomb; chocolate confectionery"

35) The earlier mark will be considered upon the above basis.

SECTION 5(1)/5(2)(a) OF THE ACT

36) This section 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.”

37) Both grounds require identity between the trade marks in question. As both marks consist simply of the words HOKEY POKEY with no form of stylization then identity is present. Section 5(1) also requires identity between the goods. Irma’s mark is registered for:

“Ice cream and frozen yoghurt” in class 30

38) I have held that Greyleg’s mark should be considered solely in respect of:

“Honeycomb; chocolate confectionery”

39) Even if it contains it, honeycomb is not ice-cream/frozen yoghurt or vice versa. There is no identity here. In relation to the term “chocolate confectionery”, I do not consider the term chocolate confectionery to include within its ambit ice-cream or frozen yoghurt. The term includes a range of chocolate confectionary products such as bars of chocolate, chocolate covered sweets etc, but not ice-cream or frozen yoghurt. This means that there is no identity between this term and anything in Irma’s specification. **Without identity between the goods then the opposition under section 5(1) must fail. The ground is dismissed.**

40) In relation to section 5(2)(a), similarity between the goods is sufficient, so long as such similarity, when various other factors are considered, will lead to a likelihood of confusion. In terms of the assessment to be made, I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

41) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar (the marks in this case are identical), other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

The average consumer

42) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on the particular goods or services in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

43) The respective goods being considered are not specialist in any way. They are products purchased by the general public to be eaten. They are not particularly expensive. A fairly causal selection process is likely to be the norm.

Comparison of the goods

44) All relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

45) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(a) 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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

46) I will begin by comparing Irma’s ice-cream with the goods of the earlier mark (honeycomb and chocolate confectionary). Both products are for eating and both can be characterised as a sweet product. The physical nature is somewhat different, ice-cream between a frozen product which, if melted would be liquid in nature, whereas the goods of the earlier mark do not possess these characteristics. Both are eaten, although ice-cream with a spoon or eaten from a cone, whereas the goods of the earlier mark will either be bitten/broken from a larger piece or placed in the mouth whole if the pieces are small enough. There is a degree of competition as both may be eaten as a sweet snack. The goods are unlikely to be found next to each other or in particularly close proximity due to the requirement to keep ice-cream frozen. Whilst there are some clear differences, there are also some clear similarities. A further point to bear in mind is that a feature of ice-cream is that it often contains other products (the whole proceedings revolve around honeycomb ice-cream) which are added to ice-cream. All things considered, my finding is that the goods are similar to a reasonable (neither high nor low) degree. Similar considerations apply in relation to frozen yoghurt.

Distinctiveness of the earlier mark

47) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

48) From an inherent perspective the words HOKEY POKEY have no obvious relationship with the goods of Greyleg's mark. The claim relating to the average consumer knowing of the term has been dealt with already; I have found that the average consumer will possess no such knowledge. Given this, I come to the conclusion that the earlier mark must be regarded as having a high degree of distinctive character, consisting of an invented phrase. The use of a mark may enhance its distinctive character. Whilst I have found genuine use in relation to some of the goods, this does not equate to an increased distinctiveness. The scale of use involved is not sufficient to increase further the mark's degree of distinctiveness.

Conclusions under section 5(2)(b)

49) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

50) The marks are identical and there is a reasonable degree of similarity between the goods. The earlier mark is highly distinctive. For a likelihood of confusion to exist, it is not necessary to find that an average consumer would select HOKEY POKEY ice-cream/frozen yoghurt in the mistaken belief that it is HOKEY POKEY chocolate confectionery/honeycomb; this is unlikely to happen. It is sufficient for the average consumer to believe that HOKEY POKEY ice-cream/frozen yoghurt comes from the same undertaking responsible for the HOKEY POKEY chocolate confectionery/honeycomb. Given the various factors I have assessed, particularly bearing in mind that the marks are identical and that the earlier mark is highly distinctive from the view point of the average consumer (and that Irma's mark will also be perceived by the average consumer as indicating trade origin), then the use of the identical name will be put down by the average consumer as a result of the same or related company being responsible for both parties' goods. The average consumer will believe that the goods come from the same stable. **There is a likelihood of confusion. The application for invalidation succeeds.**

COSTS

51) Greyleg has been successful and is entitled to a contribution towards its costs¹⁰. Greyleg has not, though, incurred the costs of being represented by a legal professional. I therefore reduce by half (other than in relation to the fee for filing the application for invalidation) what I may otherwise have awarded. I hereby order Irma Management Limited to pay Greyleg Investments Ltd the sum of £1550.

Preparing a statement and considering the other side's statement - £250

Fee for filing application for invalidation – £200

Considering and filing evidence¹¹ - £800

Attending the hearing – £300

52) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 07 day of November 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹⁰ Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

¹¹ This includes the costs associated with having to file further evidence to meet late evidence filed by Irma.