

O-393-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2592242
BY BIG LICKS ICE CREAM LIMITED TO REGISTER THE TRADE MARK**

BIG LICKS

IN CLASSES 29, 30 AND 43

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 102796
BY LICK LTD**

BACKGROUND AND PLEADINGS

1) On 22 August 2011, Big Licks Ice Cream Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the word mark BIG LICKS in respect of the following lists of goods and services:

Class 29: *Ice cream from milk*

Class 30: *Ice cream, ice lollies, milkshakes*

Class 43: *Ice Cream parlour services*

2) The application was published in the Trade Marks Journal on 23 September 2011 and on 21 December 2011, Lick Ltd (“the opponent”) filed notice of opposition to the application. The single ground of opposition is that the application offends against Section 5(2)(b) of the Act because it is in respect of a similar mark and identical or similar goods and services to an earlier mark in the name of the opponent. The relevant details of its earlier mark are:

2484752

The logo consists of the word "Lick" written in a bold, cursive script. A thick horizontal line is drawn underneath the word, starting from the left and ending with a small loop under the letter 'k'.

Filing date: 12 April 2008

Registration date: 26 September 2008

Class 29: *Yoghurt.*

Class 30: *Frozen yoghurt, ice cream.*

Class 43: *Cafe, catering, restaurant and food preparation services; all included in Class 43.*

3) This mark qualifies as an “earlier trade mark” as defined in section 6 of the Act because its date of application is earlier than that of the contested application. As this earlier mark completed its registration procedure less than five years before the publication of the contested application, it is not subject to the proof of use conditions set out in Section 6A of the Act. Consequently, the opponent is not required to provide proof of use and it can rely on its earlier mark for its full list of goods and services.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard and I make my decision after careful consideration of the papers on file.

Opponent's Evidence

6) This takes the form of a witness statement by Ky Peter Morgan Wright, director of the opponent company. He states that the opponent's mark has been used since 2008 when it opened, what Mr Wright claims, was the UK's first frozen yoghurt store in Brighton. Mr Wright provides turnover figures for the years 2008 to 2011 inclusive. These illustrate a growing business with turnover rising from £95,000 to £138,000.

7) Mr Wright explains that since 2008/9, the opponent's products have been distributed across the South of England and he exhibits a letter (Exhibit KW6) from the opponent's distributor, Consort Frozen Foods Ltd., stating that it has been "storing, selling and distributing" the opponent's goods since 2010 and has delivered products across the south east of England.

DECISION

Section 5(2)(b)

8) Section 5(2)(b) reads:

"(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."

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) 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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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 (LIMONCELLO)*

Comparison of goods and services

10) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

11) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

12) Finally, I also keep in mind the following guidance of the General Court (GC) in *Gérard Meric v OHIM, T-133/05 (MERIC)*:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more

general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

13) The respective goods and services to be considered are:

The opponent’s goods and services	The applicant’s goods and services
Class 29: <i>Yoghurt.</i>	Class 29: <i>Ice cream from milk</i>
Class 30: <i>Frozen yoghurt, ice cream.</i>	Class 30: <i>Ice cream, ice lollies, milkshakes</i>
Class 43: <i>Cafe, catering, restaurant and food preparation services; all included in Class 43.</i>	Class 43: <i>Ice Cream parlour services</i>

14) In considering the applicant’s *ice cream from milk* listed in Class 29, it is clear what is intended by the term, however, the publication *International Classification of Goods and Services*, tenth edition (World Intellectual Property Organization or “WIPO”) lists *ice cream* as proper to Class 30. It is not obvious to me that there is any distinction between *ice cream* (listed in the applicant’s Class 30 specification and includes *ice cream from milk*) and the applicant’s *ice cream from milk* listed in Class 29. Whilst it is permissible to take into account the class number specified by the applicant when assessing the meaning of the descriptions of goods *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA), I do not see how doing so in this case can lead to a conclusion that the goods listed in Class 29 are different to *ice cream* in Class 30.

15) In light of my finding in the paragraph above, it follows that when applying the guidance provided by the GC in *MERIC*, the applicant’s Class 29 goods are identical to the opponent’s *ice cream* in its Class 30 specification. Even if I am wrong and the class heading serves to identify some difference between the goods, they will remain very highly similar.

16) It follows from my findings above that the identical term *ice cream* that appears in both parties’ Class 30 specifications are identical.

17) The applicant’s *ice lollies* include goods that are made wholly or partly from ice cream and, consequently, may be covered by the broad term *ice cream* in the opponent’s Class 30 specification. As a result, I conclude that these respective terms include identical goods. Even if I am wrong, and the term *ice lollies* does not include goods made from ice cream, they still share a high level of similarity because they are both frozen confections that are likely to be available from the same part (the freezer section) of a shop. Further, they are often in competition with each other where the consumer is offered a choice between a traditional ice

cream (served in a cone, for example) or an ice lolly. Finally, it is common for ice cream products to be presented on a stick, in the same way an ice lolly is. Therefore, they are also very similar in nature.

18) The applicant's *milkshakes* are a milk based product and, as such, share the same main ingredient as *yoghurt* and *frozen yoghurt*. Yoghurts are sometimes presented as "drinking yoghurts", consequently, they may be a competitor to *milkshakes* with them both being chilled, dairy based drinks. Further, they may be displayed on the same or closely located shelves in a shop. Consequently, their respective natures, intended purpose and trade channels are likely to be the same. Taking all of this into account, I conclude that they share a reasonably high level of similarity.

19) Finally, in respect of the applicant's *ice cream parlour services*, such services are regularly provided together with *café services* and, consequently, there is a close association in terms of sharing trade channels. As both types of service involve preparing and serving food for the public, there is also similarity of nature and purpose. Further, as the consumer may make a choice between having an ice cream or having a cake or other sweet treat, the respective services may also be in competition with each other. Taking all of this into account, I find that *ice cream parlour services* share a reasonably high level of similarity with the opponent's *café services*. Further, the opponent's *food preparation services* may include the preparation of ice cream products. There is also a high level of similarity with these services.

The average consumer


20) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who 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 and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

21) The average consumer of the respective goods and services is reasonably observant, paying a reasonable degree of attention. The goods are generally of a relatively low cost and purchased in a retail environment, café or specialist ice cream parlour. The purchase will be a combination of visual and aural, with labels and other marks often being visible at the point of purchase. In respect of the services, ice cream parlours and cafés are generally at the lower end of the costs spectrum in the field of the provision of food to the consumer and as such, the purchasing act will involve the same or similar level of attention as the goods.

22) Restaurant services occupy a wider range in terms of cost and may involve a correspondingly wider range of attention on the part of the consumer when selecting such services.

Comparison of marks

23) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
	BIG LICKS

24) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). The opponent's mark consists of a stylised version of the word LICK together with a device that forms a line under the word with an additional circular element below, and to the right, of the line. This device, when seen with the word LICK, is reminiscent of a tongue protruding from a mouth. This device element reinforces the meaning of the word element that is the dominant and distinctive element, being positioned above the device. It dominates, what is a very abstract and simple stylisation of a tongue and mouth, whose meaning may not be noticed without closer inspection and may merely be perceived as an underlining of the word element. The applicant's mark consists of the two words BIG and LICKS. The first word acts as an adjective relating to the second word, thus creating a single phrase. The distinctive character of the mark resides in the phrase in its totality.

25) Having identified the dominant and distinctive character of the respective marks, I now consider the similarities between the marks. From a visual perspective, the opponent's mark consists of the word LICK presented as if hand-written script that appears to be underlined by the same hand-written way. This underlining also has an added circular element below and to the right-hand side of the line. This device element together with the stylisation of the word element is absent in the applicant's mark that consists of the words BIG LICKS in ordinary typeface. The presence of the word BIG in the applicant's mark is also a point of difference. The marks share a similarity, namely that they both include the word LICK, the opponent's mark in the plural and the applicant's mark in the singular. Taking all of this into account, I find that the respective marks share a low level of visual similarity.

26) From an aural perspective, the opponent's mark will be pronounced as the single syllable LIC, whereas the applicant's mark will be pronounced as the two syllables BIG-LICX. The addition of the word BIG and the pluralisation of the word LICK will provide aural differences between the marks, but the occurrence of the syllable LIC in both marks is a point of similarity. Taking all of this into account, I find that the marks share a moderately high level of aural similarity.

27) Conceptually, both marks contain the word LICK or LICKS, meaning to "pass the tongue over (something) in order to taste" or "an act of licking something with the tongue"¹. This concept is modified in the applicant's mark by the addition of the adjective BIG and the pluralisation of the word LICKS so that it is a reference to large, multiple licks. Nevertheless, the core concept of the verb "to lick" remains prominent. Consequently, I conclude that the marks share a moderately high level of conceptual similarity.

28) Having found that the respective marks share a low level of visual similarity, a moderately high level of aural and conceptual similarity, this combines to result in a moderate level of similarity overall.

Distinctive character of the earlier trade mark

29) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods and services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). The word "lick" has a loose connection in respect of the relevant goods, namely, ice creams and frozen yoghurts may be consumed by licking the product. Nevertheless, this is a rather off-beat and tenuous connection with the word having a reasonable level of distinctive character. Further, the mark's distinctive character is enhanced by the stylisation present in the mark and the addition of a device element reminiscent of a mouth and tongue. Taking all of this into account, I conclude that the earlier mark is endowed with an average level of inherent distinctive character.

30) Mr Wright has provided information regarding the scale of use of the mark. It has been used for since 2008, being a maximum of less than three years before the relevant date (the filing date of the contested application) and with an annual turnover climbing to £138,000. There is no evidence to indicate how significant this use is in the context of the UK ice cream market. Whilst I note that the opponent's goods are distributed across the south east of England, the level of sales appears to me, to represent a very small proportion of what is a very large market. Further, the sales have been over a relatively short period of time prior to

¹ "lick". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 27 September 2012 <<http://oxforddictionaries.com/definition/english/lick>>.

the relevant date. Taking this into account, I conclude that the use is insufficient to illustrate that the mark's distinctive character has been enhanced through use.

Likelihood of confusion

31) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

32) I have found that the respective marks share a low level of visual similarity, a moderately high level of aural and conceptual similarity. I have also found that the respective goods (except *milkshakes*) are identical and that *milkshakes* share a reasonably high level of similarity to *yoghurts*. I have also found that the respective services share a reasonably high level of similarity and that the purchasing act is a combination of visual and aural and with the goods and services being at the lower end of the cost spectrum. Taking all of the above into account, whilst the visual differences providing some balance to the aural and conceptual similarities, on balance, I find that there is a likelihood of indirect confusion in respect of all of the applicant's goods and services. I find that the consumer, upon being exposed to one of the marks, when he/she encounters the other mark, he/she is likely to believe that the goods and services originate from the same or linked undertaking.

33) In summary, the opposition based upon Section 5(2)(b) of the Act is successful in its entirety.

COSTS

34) The opposition having been successful, Lick Ltd is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place. I award costs on the following basis:

Notice of Opposition (including official fee) and considering statement of case in reply	£500
Preparing and filing evidence	£500
TOTAL	£1000

35) I order Big Licks Ice Cream Limited to pay Lick Ltd the sum of £1000. This sum is to 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 11th day of October 2012

**Mark Bryant
For the Registrar,
the Comptroller-General**