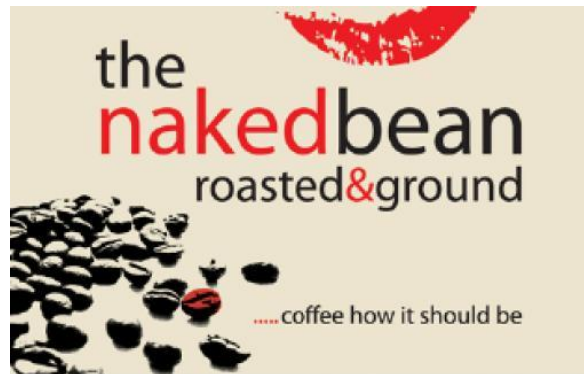


O-028-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2590810
BY THE NAKED RANGE T/A THE NAKED BEAN TO REGISTER THE
FOLLOWING TRADE MARK IN CLASSES 30 & 43:**

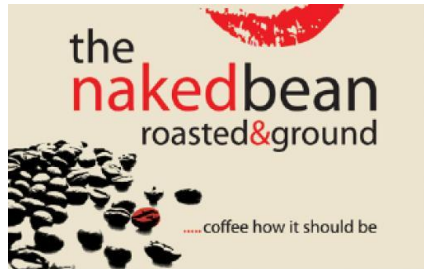


AND

OPPOSITION THERETO (NO 102850) BY RELISH (YORK) LIMITED

The background and the pleadings

1) Application 2590810 was filed by The Naked Range t/a The Naked Bean (“Range”) on 9 August 2011 and it was published in the Trade Marks Journal on 11 November 2011. The mark and the goods/services for which registration is sought are:



Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

2) Relish (York) Limited (“Relish”) opposes the registration of the above mark. Its opposition was filed on 5 January 2012 and is based on a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Relish claims that there is a likelihood of confusion with its UK trade mark registration 2585556 which was filed on 23 June 2011 and which completed its registration procedure on 16 December 2011; the mark and the goods/services for which it is registered are:



Class 29: Meat, fish, poultry and game; meat extracts; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and

confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 35: Provision of assistance (business) in the operation of franchises.

Class 42: Designing of restaurants, establishments and facilities, engaged in providing food and drink prepared for consumption.

Class 43: Restaurants, cafes, cafeterias, snack bars and coffee bars; preparation of take-away foods.

3) Relish's mark was filed before that of Range, there are no priority dates that affect the position. Given this, Relish's mark qualifies as an earlier mark as defined by section 6 of the Act. Further, given the date on which Relish's mark completed its registration procedure, there is no requirement to prove that it has been used (section 6A of the Act refers), consequently, the earlier mark may be considered in these proceedings in respect of the goods and services for which it stands as registered.

4) Range filed a counterstatement denying the grounds of opposition. It makes various arguments, including:

- That Range's trade is solely business to business;
- That any aural similarity is less significant because self-service selection (a visual act) predominates in the business to business field;
- That the marks are not visually similar (various reasons are given which I will come back to);
- That the marks are not conceptually similar in that although NAKED BEAN is an industry term (said to mean "raw" or unroasted coffee) the average consumer would not be familiar with this term;
- That although the "classes" are the same/similar, reference is again made to Range's business to business trade.

5) Neither side filed evidence. Neither side requested a hearing and neither side filed written submissions.

Section 5(2)(b)

6) Section 5(2)(b) of the Act 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.”

7) There are a number of factors which need to be carefully assessed in determining whether there is a likelihood of confusion. Guidance on how to deal with matters such as this has been provided by the Court of Justice of the European Union (“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, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is

permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

8) 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 and services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The goods and services in question are ones ordinarily provided to the general public. In relation to the goods in class 30 and the food/drink related services in class 43, although cost can vary, they will not be selected with a heightened degree of care and attention. Most will be selected with a reasonable (no higher or lower than the norm) degree of care. There are some exceptions to this. For example, Range's services include retirement home services and crèche services. Both of these services are likely to be selected with a higher degree of care and consideration than the norm. In

contrast, goods such as confectionery will be selected quite casually. In most cases, the goods/services will be selected more by the eye (for example, by way of self-selection or inspection of brochures/the Internet) than by the ear. Aural similarity will not be ignored completely though, particularly in the case of some of the services concerned which may be booked over the telephone (although I still consider the visual aspects of the marks to be more significant).

Comparison of goods/services

9) When making the comparison, all relevant factors relating to the goods/services in the respective specifications should be taken into account. In terms of how to assess whether goods/services are similar, the CJEU stated in paragraph 23 of its judgment in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*:

“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.”

10) Guidance can also be found in the judgment of Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are 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.”

11) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was 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).”

12) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I will go through the applied for goods/services class by class.

Class 30

13) The respective goods in class 30 are worded in exactly the same manner. **The goods are identical.** It does not matter that Range’s goods are sold in the business to business field. This is because it is the inherent characteristics of the goods with which the tribunal is concerned. Furthermore, there is no limit to the goods of the earlier mark which could, therefore, be sold business to business or direct to consumers.

Class 43

14) Although Relish’s earlier mark is registered for goods and services, its most likely prospect for a finding of similarity lies in its services in class 43 which are:

Restaurants, cafes, cafeterias, snack bars and coffee bars; preparation of take-away foods.

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

15) Range seeks registration for various services. I will firstly consider:

Services for providing food; restaurant and catering services.

16) Although the services are not worded using the same terminology, they nevertheless cover the same type of services. **The services are identical, or at the very least they are highly similar.**

17) I next consider:

Services for providing drink; bar services.

18) Food and drink go hand in hand, the purposes are similar. Restaurants will have bars and bars will very often provide food, so there is similarity in terms of trade channels. A consumer may choose between going to a bar for food or going to a restaurant, so there is a competitive relationship. The visiting of premises to sit down to eat or drink creates a similarity in the methods of use. **The services are highly similar.**

19) I next consider:

Temporary accommodation; provision of holiday accommodation.

20) Such services will include things such as hotel services within their ambit. A hotel service has a key function of providing rooms for overnight stays (or longer) (and other facilities), but they also have other key functions including the provision of food and drink in a hotel restaurant. Restaurants often form a very important aspect of a hotel. Some consumers will choose to go to a restaurant in a hotel as opposed to a standalone restaurant even if they are not resident in the hotel. This creates a similarity in purpose, method of use, and in the channels of trade. **The services are reasonably similar.** I must bear in mind that the above terms cover other temporary accommodation/holiday accommodation services which are not hotels and which may not be similar to Relish's foods services in class 43. For example, the provision of self catering holiday apartments would not be similar. If it becomes necessary, I will consider later in this decision whether I need to receive submissions from the parties on possible revised specifications.

21) I next consider:

Booking and reservation services for restaurants.

22) Simply phoning a restaurant to book a table does not constitute a booking/reservation service. Such a service is likely, instead, to be provided by a third party to a restaurant, with the consumer then phoning the service provider to make a booking which will be taken on the restaurant's behalf. The consumer will

nevertheless see some similarity in purpose as the services are being used with the end result of dining in a restaurant. The methods of use differ. There is no competition but a degree of complementarity. **There is a moderate degree of similarity.**

23) I next consider:

Booking and reservation services for holiday accommodation.

Approached on the same basis as above, these services are more distant as the user is likely to be booking the accommodation aspect rather than a restaurant in the accommodation. **The services are not similar.**

24) I next consider:

Retirement home services.

25) The purpose and method of use of a retirement home is very different from the purpose of the services of the earlier mark. There is no competitive or complementary relationship. Although food is consumed in a retirement home, this does not create any meaningful similarity with a restaurant or any other food related service covered by the earlier mark. As far as I am aware, retirement homes would not ordinarily incorporate a restaurant or other food service (there is no evidence to suggest the contrary), it is simply that the residents are fed; consequently there is no overlap in trade channels. **The services are not similar.**

26) I finally consider:

Creche services.

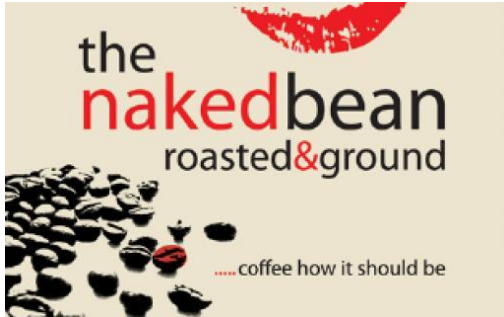
27) The purpose and method of use of a crèche is very different from the purpose of the services of the earlier mark. There is no competitive or complementary relationship. There is no evidence as to whether there is an overlap in trade channels, there is no obvious overlap that I am aware of. **The services are not similar.** I have borne in mind that the earlier mark is registered for other goods and services, but these are further away from the services I have assessed as not being similar; these comments also apply to my conclusions in paragraph 23) and 25).

Comparison of the marks

28) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall

impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Range's mark



Relish's mark



29) Both marks are made up of multiple components. However, the dominant and distinctive elements of the respective marks are the words “the naked bean”/”NAKED BEAN” respectively. In Relish’s mark these words dominate the overall impression very strongly. In Range’s mark, whilst the words are still the dominant and distinctive element, the words dominate less strongly due to the various other elements of which the mark consists. In neither of the marks are the additional elements negligible, so the comparison must be based on the totality of the competing marks.

30) From a visual perspective, the sharing of a very similar dominant and distinctive element creates an inevitable degree of similarity. There are, though, a number of differences, as highlighted by Range in its counterstatement: the additional wording, coffee beans, and lipstick print in its mark, and the additional leaf in Relish’s mark. There are also different colour aspects to the marks. These differences contribute to a different look and feel. **Weighing these matters up, I conclude that the differences do not outweigh the similarities and that the similarity based on “the naked bean”/”NAKED BEAN” creates a reasonable degree of visual similarity.**

31) From an aural perspective, I consider that the average consumer will only articulate “the naked bean” element in Range’s mark. NAKED BEAN is the only verbal element in Relish’s mark, so the only difference between the two likely articulations is the addition of the definite article. **From an aural perspective, the marks are highly similar.**

32) In terms of concept, Relish stated in its statement of case that the average consumer will see the words NAKED BEAN as a reference to beans which are unadorned/untreated. Range states in its counterstatement that although the phrase may be a standard industry term (although no evidence has been provided to this effect) such a meaning will not be known by the average consumer. My view of this is that the average consumer will see an allusive reference (but not a recognised trade description) to beans which are plain,

having nothing added to them, and the average consumer will thus conceptualise the words by reference to beans which are “naked”. In Range’s mark the bean in question will be perceived as a coffee bean, whereas in Relish’s mark the beans in question may be other than coffee beans. **The concepts are still, though, highly similar.**

The distinctiveness of the earlier mark

33) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In these proceedings I have only the inherent properties of the mark to consider as no evidence of use has been filed. I have already stated that there are some allusive characteristics in the words NAKED BEAN. However, there is no evidence that this is term commonly encountered by the average consumer and I consider the allusiveness to be mild. **I consider the earlier mark to be of an average degree of distinctiveness.**

Likelihood of confusion

34) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), 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.

35) It must be borne in mind that confusion can be direct (effectively mistaking one mark for the other) or indirect (when despite the differences being noticed, the similarities will be put down to the undertakings responsible for the goods/services being the same or related). I must also bear in mind the concept of imperfect recollection. I come to the view in this case that the sharing of a very similar dominant and distinctive element, the very thing that will attract most attention and recollection, will lead the average consumer to believe that the identical/highly similar goods/services provided under the marks are the responsibility of the same or an economically linked undertaking. The different look and feel (and other differences) of the marks may be noticed to a degree, but this is not enough, particularly given the average level of distinctiveness of the words NAKED BEAN, to point the average consumer to an opposite view. **There is a likelihood of confusion in relation to the goods and services I found to be identical/highly similar.**

36) In relation to “temporary accommodation; provision of holiday accommodation” and “booking and reservation services for restaurants” I **consider that the relationship between hotels and restaurants, and**

restaurants and booking services for restaurants, to be sufficient, when all the other factors are borne in mind, for there also to be a likelihood of confusion.

37) In relation to “booking and reservation services for holiday accommodation; retirement home services; creche services” I found these services not to be similar to anything covered by the earlier mark. For there to be a likelihood of confusion there must be some similarity between the goods/services in question (see, for example, the CJEU’s judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*). Accordingly there is no likelihood of confusion. Even if I am wrong on my assessment that there is no similarity in goods/services, any similarity must be at the lower end of the scale and the competing factors would not have persuaded me that there was a likelihood of confusion. **The opposition fails in relation to these services.**

Summary of conclusions

38) Subject to the comments in paragraph 40 below, the opposition succeeds in relation to:

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants.

39) The opposition fails (and the mark should be registered) in respect of:

Class 43: Retirement home services; creche services; booking and reservation services for holiday accommodation.

Revised specification

40) In the above conclusions, I have upheld the opposition against “temporary accommodation; provision of holiday accommodation” on the basis that such terms include things such as hotel services. However, if the terms were to be limited then it may be possible to register the mark for other forms of temporary accommodation/holiday accommodation. I gave an example of the provision of self-catering holiday apartments earlier in this decision. In view of this, Range is permitted 14 days to put forward any revised terms that:

- i) Fall within the ambit of “temporary accommodation; provision of holiday accommodation” in class 43;
- ii) Do not have restaurants/other food and/or drink related services which form a key component.

41) Relish will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If Range puts forward no revised terms then I will issue a supplementary decision confirming the outcome as it stands in paragraphs (38)- (39) above. In the supplementary decision I will also issue my decision on costs. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision.

Dated this 21st day of January 2013

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