

0-146-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2577122
BY GREYLEG INVESTMENT LIMITED TO REGISTER THE TRADE MARK**

HOKEY POKEY

IN CLASS 30

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 102551
BY BR IP HOLDER LLC**

BACKGROUND AND PLEADINGS

1) On 31 March 2011, Greyleg Investment Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark HOKEY POKEY in respect of *ice cream frozen yoghurt* in Class 30. There are two potential interpretations of this specification. It can be interpreted as a frozen yoghurt with ice cream properties, or alternatively, as the two distinct terms *ice cream* and *frozen yoghurt*. Neither interpretation will materially affect the outcome of the proceedings; consequently, I will not comment further on the issue.

2) On 22 July 2011, the application was published in the Trade Marks Journal and on 21 October 2011, BR IP Holder LLC (“the opponent”) filed notice of opposition to the application. The grounds of opposition were in summary:

- The application offends under Sections 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act, 1994 (“the Act”) on the basis that the mark has been widely used for many years to denote a flavour of ice cream.
- The application offends under Section 5(4)(a) of the Act because the opponent claims a substantial goodwill since 1997 in the mark and that use of the mark by the applicant would lead to misrepresentation and cause damage to that goodwill.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims. In particular it denies that the opponent had passing off rights either at the time of application or at the time of registration of an earlier mark (2229658 HOKEY POKEY in respect of *confectionary* in Class 30) also in the name of the applicant, registered in the year 2000. It puts the opponent to proof of use of its claimed goodwill. It claims that in the 11 years since the applicant commenced use of its mark there has not been one instance of confusion.

4) The applicant also points out that goodwill is inseparable from the underlying business and that the opponent has not owned any business in the UK. Consequently, it cannot be the correct opponent. It is put to proof of continued ownership “as Baskin Robbins has been owned by at least three owners since 1997”. It also claims that BRIP LLC is the owner of the earlier mark and thus not the correct opponent for the purposes of Section 5(4)(a).

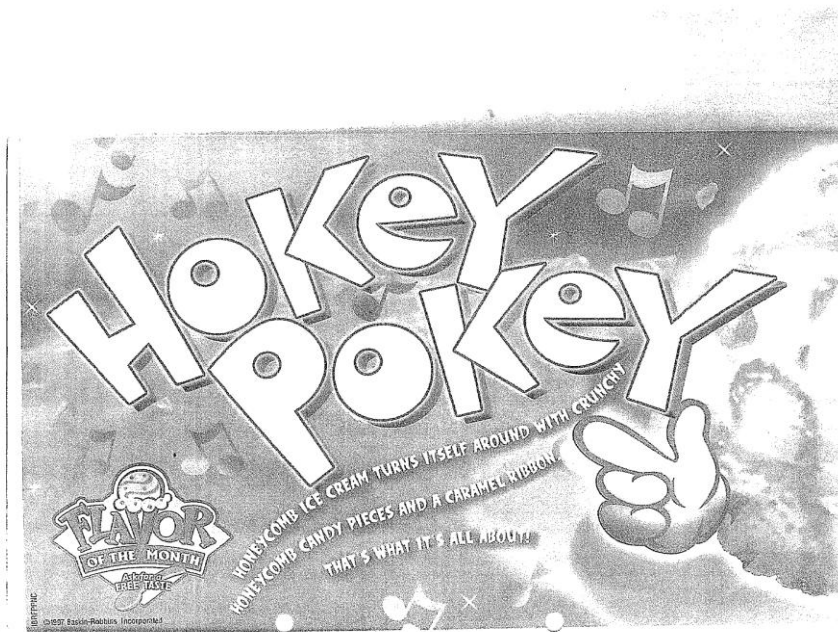
5) The opponent subsequently dropped its claim based upon Section 3(1) of the Act.

6) Both sides filed evidence and written submissions in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 26 February 2014 when the opponent was represented by Mr Chris McLeod for Squire Sanders (UK) LLP and the applicant represented by Mr David Garnsworthy and Mrs Deidre Garnsworthy.

Opponent's Evidence

7) This consists of an affidavit and two witness statements. The affidavit is by Mr Jeff Weaire, a franchisee of B-R International Co., whom he describes as “an affiliate” of Dunkin’ Brands Inc. and the opponent company. As a franchisee, he operates a Baskin-Robbins store in Ruislip, Middlesex. His store has been open since 1990 and is still in operation. As a franchisee, he is authorised to sell the Baskin Robbins company’s ice cream, ice cream cakes and other products.

8) Mr Weaire explains that his store offers numerous flavours of ice cream, some of which are permanently available, while others are seasonal or rotating flavours. He states that the HOKEY POKEY flavour is permanently available and consists of white chocolate ice cream with crunchy honeycomb candy pieces and a caramel ribbon. He also states that he first sold HOKEY POKEY flavoured ice cream in 1997. At Exhibit 1 he provides copies of two invoices dated 12 December 1997 and 13 March 1998 that he says are shown in pounds sterling (but no currency designation is present). Both list “Baskin Robbins Hokey Pokey” under a long list of flavours. Quantities are recorded as “1” and “2” respectively and with unit price recorded as “22.00” and “22.70” respectively. Since this time, Mr Weaire states that he has routinely ordered HOKEY POKEY ice cream and offered it for sale every year since 1998. Mr Weaire was provided with a decal to place in his store’s freezer windows. A copy of this is provided at Exhibit 2 and shown below:



9) The first of the witness statements is by Mr Chris Gray, Country Manager of Dunkin’ Brands, Inc. based in Massachusetts, USA. He states that the opponent company is an affiliate of his company. He states that the first Baskin-Robbins

opened its first store in the UK in 1983. A gradual increase in UK stores is shown and by March 2011 there were 14. These are spread across the UK from Aberdeen in the north, Swansea in the west, Essex in the east and a number in London and Middlesex. Sales of Baskin-Robbins ice creams have also been made in the UK through three third party retailers: *Warner Village Cinemas* (35 UK locations) between March 2000 and June 2009; *Millie's Cookies* (65 UK locations) since September 1999; *Cineworld Cinemas* (15 UK locations) since August 2000.









10) Mr Gray states that in 1997, the company introduced a new rotating flavour named HOKEY POKEY. Mr Gray provides, at Exhibit 1, an internally created flavour list from the sales period October 1999 to December 2000. Under the heading "Canada/Offshore", HOKEY POKEY is listed as a rotating flavour between May to July 2000. Mr Gray explains that "offshore" is a reference to locations outside the USA.

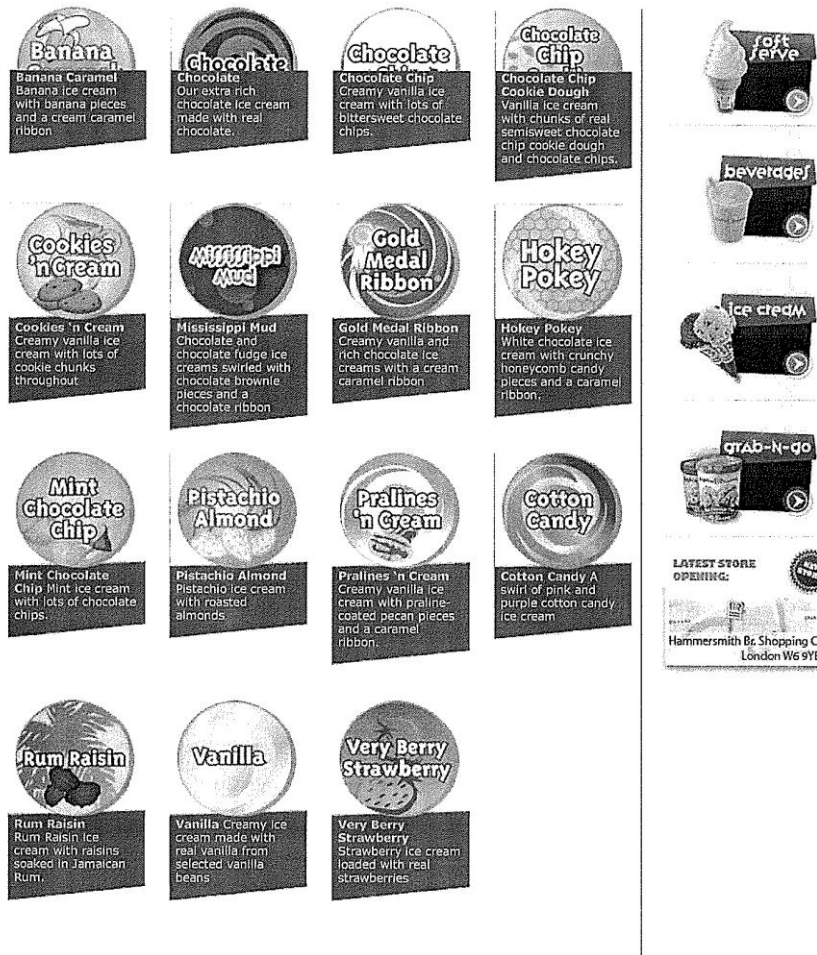
11) Mr Gray explains that over the years, HOKEY POKEY has become a permanent flavour appearing consistently in the company's UK stores and listed on the company's website, www.baskinrobbins.co.uk. Pages, dated 3 February 2012, from the website are shown at Exhibit 2. Fifteen "classic flavours" are shown, one of which is HOKEY POKEY. It is also listed under its list of "Grab 'n' Go" 500ml tubs together with a representation of the tub. Both pages in this exhibit are shown below:

CURRENT FLAVOUR LIST

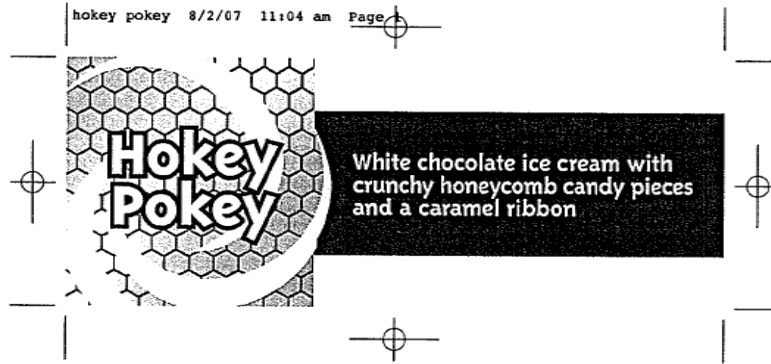
Baskin-Robbins Grab 'n' Go tubs are now available in eleven fantastic flavours across our 500ml and 125ml ranges. If you are interested in stocking these please contact us.

500ml Flavours:

 <p>Hokey Pokey White chocolate flavour ice cream with crunchy honeycomb candy pieces and a caramel ribbon</p>	 <p>Jamoca Almond Fudge Rich coffee ice cream swirled with chocolate sauce and roasted almonds</p>	 <p>Pralines 'n Cream Vanilla ice cream with praline-coated pecan pieces and a caramel ribbon</p>	 <p>Mint Chocolate Chip Mint ice cream with rich dark chocolate chips</p>
 <p>Strawberry Cheesecake Creamy cheesecake ice cream swirled with strawberry sauce & biscuit</p>	 <p>Mango Tango Luscious mango ice cream dancing with a tangy mango ribbon</p>	 <p>Chocolate Mousse Royale Chocolate mousse ice cream with chocolate chips</p>	 <p>Cookies 'n Cream Vanilla ice cream with crushed chocolate sandwich biscuits</p>



12) Mr Gray explains that the opponent's ice cream is promoted through provision of labels for freezer cases (see copy shown at paragraph 7, above), supplied to its franchisees and authorised dealers. Mr Gray provides, at Exhibit 3, example freezer strip labels for HOKEY POKEY ice cream used in the UK since August 2007. These appear to be internal mock-ups of labels. A product information sheet for HOKEY POKEY ice cream, dated 7 September 2007 is also provided at Exhibit 4. Mr Gray explains that this was provided to franchisees and authorised retailers in the UK. One of the two freezer labels is shown below:



13) Mr Gray explains the difficulty he has encountered attempting to obtain sales data for HOKEY POKEY ice cream. For the period 1997 to 2005 sales data was on a minicomputer system with data backed up onto tape weekly and annually. A tape recovery business was engaged to obtain the relevant information and to produce a summary of sales figures for HOKEY POKEY ice cream in the UK prior to 2006. Exhibit 5 is a report that has been created to show the quantity of HOKEY POKEY ice cream sold to UK franchisees between October 1997 and December 2005. This report indicates that the following approximate scales of sales were made (measured in “tubs” that Mr Gray states contain 11.36 litres of ice cream):

Year	No. Of Tubs
1997	350
1998	1,469
2000	1,797
2003	1,960
2005	6,094

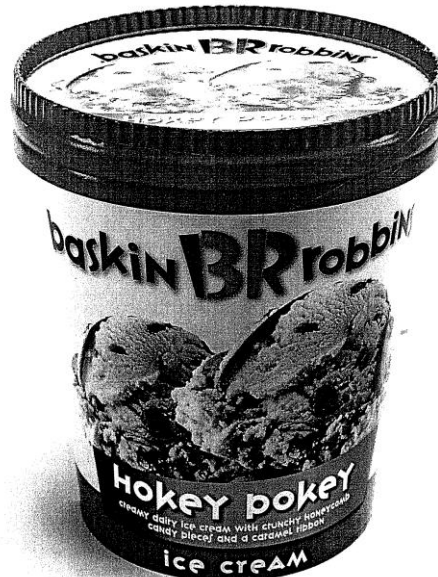
14) After 2005, the company partnered with Silver Pail Dairy in Ireland to manufacture its ice cream. This ice cream was distributed by another affiliate company, DB (UK) Franchising LLC. Mr Gray provides, at Exhibit 6, what he describes as a “representative example” of invoices to franchised stores and authorised retailers in the UK between April 2006 and February 2011. There is in the region of 100 pages of invoices and all carry the stylised mark BR BASKIN ROBBINS at the top and are addressed to retailers such as Millies Cookies and Vue Cinemas or to Baskin Robbins outlets. HOOKEY POKEY is listed in these invoices as one amongst numerous flavours such as vanilla, pralines n’ cream, mint chocolate chip, very berry strawberry, chocolate and cookies n’ cream.

15) Mr Gray states that the quantities of HOKEY POKEY ice cream shipped to the UK stores and authorised retailers between 1997 and 2010 were as follows:

Year	Units (bulkans)	Total litres
1997	350 tubs	3976
1998	1469 tubs	16,687
1999	919 tubs	10,439
2000	1797 tubs	20,413
2001	420 tubs	4,771
2002	1920 tubs	21,811
2003	1960 tubs	22,265
2004	2530 tubs	28,740
2005	6094 tubs	69,227
2006	3488 bulkans	39,623
2007	3367 bulkans	38,249
2008	3147 bulkans	35,749
2009	2451 bulkans	27,843
2010	2304 bulkans 411 cases, each 8 x 500ml 48,796 cases, each 4 x 500ml	125,409

16) Mr Gray explains that ice cream is sold to franchisees and authorised retailers by subsidiaries, distributors and affiliates and for that reason, invoices do not bear Baskin Robbins name or address.

17) Mr Gray explains that in 2010 sales of pre-packaged 4 x 500ml containers began to *Morrisons* supermarkets. Exhibit 7 is an internal document showing the production history of HOKEY POKEY ice cream for the UK. This shows production of these pre-packaged cases began in May 2010 and totalled 48,796 cases in the three months between May and July 2010. Exhibit 9 is a copy of photograph of one of the 500ml tubs supplied to *Morrisons*. This is shown below:



18) The same tub is shown in a *Morrisons* advert referring to offers valid between 24 July to 1 August 2010, a copy of which is provided at Exhibit 10.

19) The second witness statement is by Mr Christopher James McLeod, Director of Trade Marks of Squires Sanders (UK), the opponent's representatives in these proceedings. At Exhibit CJM1, Mr McLeod provides extracts from the website www.dunkinbrands.com showing the company's history. This includes a claim that it is one of the world's largest quick service restaurant companies. It also provides historical information about its Baskin-Robbins brand. The web page carries a notice that includes "...Baskin-Robbins trademarks, trade names, designs, logos, service marks, and related marks are registered trade marks of ... BR IP Holder LLC...".

Applicant's Evidence

20) This takes the form of four witness statements. The first of these is by Mr David Garnsworthy, a retired chartered accountant. He does not state his relationship to the applicant.

21) Mr Garnsworthy provides very detailed critiques of the opponent's evidence that I will not detail here, but will summarise later in the decision. He also provides evidence of the applicant's own use of the mark since 1998 on goods such as confectionery and ice cream. It is not necessary for me to provide further details of this use, for reasons that will become obvious.

22) Another witness statement is by Mrs Deidre Marion Mary Garnsworthy, a retired Chartered Accountant. She states she has applied her skills as an auditor to an analysis of the opponent's evidence. I will not detail these criticisms here, but I will keep them in mind.

Opponent's Evidence in reply

23) This takes the form of a witness statement by Ms Gabrielle Roth, a partner at Dickstein Shapiro LLP of Washington DC, USA. Ms Roth provides evidence in response to the applicant's criticisms that the opponent has failed to illustrate that it has goodwill identified by the sign HOKEY POKEY.

24) Ms Roth provides, at Exhibit GR1, extracts from Internet forums digitalspy.co.uk and thestudentroom.co.uk where users discuss their ice cream preferences. Dated April 2008, the first contains the post "Baskin Robbins Pralines and cream are my all time fave tho!", and the response "Saw this in Morrisons today, only £1.99, special offer. Got myself some Hokey Pokey, can't wait to try it". The second is from March 2009 and states in response to the question "Whats your favourite make of ice-cream?": "Baskin Robbins Hokey Pokey. My dad found it in Morrisons I think..."

25) Exhibit GR2 consists of extracts from Baskin and Robbins website promoting its “Grab-n-go” products. It is obtained from the Internet archive, *Wakbackmachine* and dated 7 Feb 2010. HOKEY POKEY as one of eight flavours available in its “Grap-n-Go” tubs.

26) Exhibit GR3 is a copy of a news item published on 7 June 2010 detailing the launch of Baskin-Robbins ice cream at *Morrisons* supermarkets. HOKEY POKEY is listed as one of “four variants” offered together with “cookies & cream”, “mint choc chip” and “praline & cream”. Exhibit GR6 is an extract of a Facebook discussion thread where the writer states, under the heading “Baskin Robbins” that “Hokey Pokey is my favourite. Please open a Baskin Robbins in Coventry so I don’t have to go all the way to Birmingham lol”. Exhibit GR7 provides a further story relating to the launch into *Morrisons*. It is also dated 7 June 2010 and appeared on *marketingmagazine.co.uk*.

27) Exhibit GR5 consists of a copy of a review of the Baskins-Robbins outlet in Aberdeen, dated 25 July 2008. It appears on the website *travel.ciao.co.uk*. Following a detailed review of the various flavours, the reviewer states “Other flavours Baskin Robbins do, which I haven’t tried are: Rocky Road, English Toffee, Hokey Pokey, Pist[*text missing*] Pecan Butter, Coconut, ...”

Opponent’s Further Evidence

28) This takes the form of two further witness statements. These were provided in response to my directions regarding perceived irregularities in the opponent’s evidence identified by the applicant. The first of these is a further statement from Mr Gray. This is in response to allegations raised by the applicant regarding inconsistencies in some of the customer numbers on the invoices submitted with Mr Weaire’s evidence. He states that Mr Weaire and his former wife, Mrs Amita Weaire are franchisees of the Baskin-Robbins store in Ruislip, Middlesex. He explains further that Mrs Weaire’s family operate four other Baskin-Robbins stores in the UK and that all five stores are considered one group of stores by the company. This, he states, explains why five customer numbers appear on the invoices.

29) Mr Gray also states that, to the best of his knowledge, the prices quoted on the same invoices are correct and ranged between £22 per tub in 1997 to £26.30 in 2011. The applicant had questioned why there was very little change, over time, in the unit price.

30) Mr Gray answers the criticism that the invoice numbers suggested an unrealistic number of invoices being issued. He explains that when the invoices in question were issued (1997/98) the group of companies associated with the opponent were owned by Allied Domecq PLC. It is suggested that it is likely that the same invoice regime was used for Allied Domecq’s non-USA operations as these were overseen by a single company set up by Allied Domecq.

31) Mr Gray concedes that during the extraction of data by the third party, some data was inadvertently duplicated. In particular he refers to two duplicated invoices (numbered 79841 and 77858) shown at Exhibit 5 of his original statement.

32) In response to an alleged uncertainty in the opponent's evidence created by the use of the terms "Balkans" and "tubs", Mr Gray explains that the terms were used interchangeably to describe 11.36 litre containers. The term "cases" is sometimes used in the invoices related to cases of items such as cups, lids, cones and spoons, but the heading of "cases" did not only include items that were technically "cases" and sometimes numbers of Balkans or tubs were listed under the heading, depending on what the goods in issue were. Sometimes 500ml tubs were sold, but these are marked in the invoices as such.

33) To explain why the opponent's UK distributor is a Delaware limited company, Mr Gray confirms that this company is based in London and resells/distributes ice cream to Baskin-Robbins franchisees and retailers in the UK.

34) Finally, in an attempt to address the perceived tension in the evidence regarding whether HOKEY POKEY was a rotating or permanent flavour, Mr Gray explains that due to its popularity, franchisees bought it in large quantities and sold it throughout the year.

35) Mr Weaire also provided an additional witness statement. At Exhibit A, he provides the original copies of the two invoices provided with his first affidavit to counter the applicant's allegation that they have been amended.

36) At Exhibit B he provides copies of other invoices dated in 1997/98 to demonstrate that these too appear on the same type of paper, the same heading information and same stylisation as the invoices at Exhibit A.

37) Exhibit C consists of photocopies of credit notes and remittance advice statements also from 1997/98. These too contain the same heading information and stylisation as the invoices at Exhibit A.

Applicant's further evidence

38) This takes the form of a further witness statement by Mrs Garnsworthy. She claims that there is no evidence of sales of HOKEY POKEY other than the information provided by Mr Gray and Mr Weaire. Such sales cannot be verified without access to the underlying accounting books and records. Mrs Garnsworthy also provides another detailed and rather forensic critique of the opponent's additional evidence. I will not detail this here, but I will keep it in mind.

DECISION

39) Section 5(4) (a) reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

40) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

The Relevant Date

41) The relevant date for determining the opponent’s claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115), that is to say 31 March 2011. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The position at an earlier date may also be relevant. It could be establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed as the parties have

a concurrent goodwill (*Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42).

Goodwill

42) In order to make an assessment of whether or not the opponent has goodwill in a business conducted under the HOKEY POKEY mark, I must be possessed of sufficient information to reach an informed conclusion. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 Pumfrey J said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

43) In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J commented directly upon *South Cone* in the following terms:

“8 Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

44) The applicant has attempted to cast doubt on the opponent's case in a number of ways:

- Submitting that the opponent's evidence shows use of the sign HOKEY POKEY in a descriptive way only;
- Submitting that the veracity of the evidence is in doubt and cannot be relied upon;
- Submitting that the chain of ownership of the goodwill is unclear and undefined;
- That the opponent has not addressed "the important effects" of the applicant's mark 2229658 for HOKEY POKEY in respect of confectionary that has been registered since April 2000;
- That the opponent has acquiesced to the applicant's mark.

45) In addition, the applicant claims it has a concurrent goodwill in respect of ice cream.

46) In respect of the first of these points, Mr Garnsworthy in his witness statement, submitted that sales made by the opponent are made with the dominant mark "Baskin Robbins" with the sign HOKEY POKEY only been used as a description of a flavour and never on its own. He argues that, consequently, there is no proof that the sign has "the identifying function" or that the opponent's customers "are aware of the significance of the sign hokey pokey to the opponent's business".

47) Mr Garnsworthy acknowledges that, at the filing date of 31 March 2011, the opponent had eleven franchised stores in the UK (see Exhibit DG(A), page 6). However, he submits that there is an absence of advertising and promotion of the HOKEY POKEY sign and the lack of independent proof, that use of "the flavour indicator" would never be more than very local. In respect to this last comment, whilst goodwill must be more than trivial (*Hart v Relentless Records* [2003] FSR 36 (HC)), it does not need to be extensive (*Stacey v 2020 Communications* [1991] FSR 49 (HC)). Consequently, the scale of use shown in the evidence is not such that would exclude the opponent from developing the requisite goodwill.

48) Mr Garnsworthy also submits (see page 7 of Exhibit DG(A)) that the evidence fails to show that the flavour is actually sold to the public. I do not accept this argument. For example, the opponent has provided a copy of a *Morrisons* supermarket promotion that included the opponent's HOKEY POKEY flavoured ice cream together with details of volumes of HOKEY POKEY ice cream produced for its UK franchisees. There is also the testimonies of Mr Weaire and Mr Gray who both attest to the flavour being sold in UK franchised outlets. Taking

all of this together, whilst the opponent's evidence is not particularly well marshalled, I am content that the opponent has traded in a HOKEY POKEY flavoured ice cream under its Baskin-Robbins brand. Further, it is not a requirement that there has been sales to the public (see for example: *Ewing v Buttercup Margarine Limited* (1917) 34 RPC 232 Warrington L.J.).

49) However, this is not the end of the matter and, as I have already mentioned, Mr Garnsworthy claims that the opponent's use is descriptive. He relies upon a number of cases when claiming the effects of descriptive use. He cites *South Cone Inc v Jack Bessant Domininc Greensmith Kenwyn and Gary Stinger* (SOUTH CONE) [2002] RPC 19 and *Reckitt & Coleman v Borden (JIF LEMON)* [1990] RPC 340 HL to support his view that in order to be able to rely upon a sign for the purposes of passing off, it must be considered as a badge of goodwill, that associates the goods with the opponent in the mind of the public. He submits that it does not identify the goodwill claimed by the opponent. Of course, as the judgment in the *JIF LEMON* case went on to observe, even a sign that is *prima facie* descriptive can acquire secondary meaning. In other words, it can acquire the meaning of identifying a company's goodwill.

50) In order to assess this issue, it is necessary to consider, in detail, what the opponent's exhibits illustrate in respect of its use of the sign HOKEY POKEY. The relevant evidence can be summarised as follows:

- Two invoices from 1997 and 1998 where "BASKIN ROBBINS HOKEY POKEY" is listed as one of numerous other products such as "BASKIN ROBBINS VANILLA", "BASKIN ROBBINS ENGLISH TOFFEE" and "BASKIN ROBBINS OLD FASHIONED BUTTER PECAN" (Mr Weaire's Exhibit 1);
- A decal for store freezer windows, carrying a copyright notice with the date 1997 (shown at paragraph 7, above);
- Two extract from the opponent's UK website, undated but printed on 3/2/2012, showing a "current flavour list". Under a sub-heading "Classis Flavours", HOKEY POKEY is listed (see representations shown at paragraph 10, above);
- What are described by Mr Gray as "freezer strip labels". These appear to be mock ups carrying a date of 8/2/07. The first prominently show the words HOKEY POKEY together with a description of the ice cream in smaller text. The second shows HOKEY POKEY appearing in front of a honeycomb background (see representation at paragraph 11, above);
- A product information sheet provided for "Hokey Pokey Ice Cream" and lists a description and ingredients. At the top of the page is a prominent "Baskin 31 Robbins" mark;

- Numerous invoices bearing the mark “BR baskin robbins” where “Hokey Pokey” listed as one of numerous flavours (see Mr Gray’s Exhibit 6);
- Proof of delivery documents from between February 2004 to February 2012. These all list “Hokey Pokey” as one of numerous flavours (see Exhibit 8 of Mr Gray’s statement);
- A photograph of a tub of Hokey Pokey ice cream as sold by *Morrisons* in 2010. This is at Exhibit 9 of Mr Gray’s witness statement and is shown at paragraph 16, above;
- Online discussion board called *digital spy*, dated December 2008, where one of the contributors writes, in response to a comment regarding favourite ice creams: "Baskin Robbins Pralines are my all time fave tho!!", responded by saying "Saw this in Morrisons today, only £1.99, special offer. Got myself some Hokey Pokey, can't wait to try it." (Ms Roth's Exhibit GR1);
- A discussion thread on the website www.thestudentroom.co.uk from September 2010, where in response to the question "What's your favourite make of ice-cream?", one of the contributors stated "Baskin Robbins Hokey Pokey. My dad found it in Morrisons I think...";
- A discussion thread from *Facebook*, dated May 2009, where the writer states under the heading "Baskin Robbins"; "Hokey Pokey is my favourite..." (Ms Roth's Exhibit GR6);
- At Ms Roth's Exhibit GR2, an extract from the Baskin Robbins website, dated 7 February 2010, carries a description of its Hokey Pokey ice cream. This states "White chocolate flavour ice cream with crunchy honeycomb candy pieces and a caramel ribbon";
- A review, from July 2008, of Baskin Robbins’ Aberdeen outlet where the reviewer stated that “other flavours Baskin Robbins do, which I haven’t tried are: Rocky Road, English Toffee, Hokey Pokey,... Pecan Butter, Coconut, ...”

51) Mr Garnsworthy submits that the opponent has not provided evidence from either the independent public or the independent trade to support the existence of the necessary reputation. He relies on the guidance in *SOUTH CONE* to support the claim that evidence from the independent trade is required. The opponent’s evidence does contain some sparse evidence from the public in the form of extracts from online discussion forums. Little can be gleaned from these, but if anything, they would appear to support Mr Garnsworthy’s submission that HOKEY POKEY is perceived by the consumer as a description of a flavour.

52) In addition to the *JIF LEMON* case, when considering the impact of descriptive use upon a consideration of passing off, I keep in mind the well established principle (see for example *Reddaway v Banham* 13 RPC 218 (HOL) and *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA)) that if a trader uses a sign which is descriptive of its products, the trader must show that the public understands that the products come from him when they see the mark so that the mark has in this way acquired a 'secondary meaning'. I also keep in mind the similar guidance on this point in *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 19.

53) However, the current case is not on "all fours" with the circumstances in these earlier cases. There is no evidence that the sign HOKEY POKEY is descriptive, even if it is used in a manner that suggests it is so. On the evidence before me, it is not clear what the consumer's level of understanding is of the term HOKEY POKEY. In its original statement of case, the opponent relied upon a Section 3(1) objection, but subsequently removed this pleading. The result of this is that I have no evidence on the point from the opponent. The applicant has provided no evidence beyond assertion that other traders are using it descriptively.

54) On the face of it, HOKEY POKEY appears to be a distinctive mark. However, how the opponent used the sign can be important. Use can be such that a sign will only be perceived as indicating the product (see *Jeryl Lynn* [1999] FSR 491) and the consumer can be educated to see a distinctive mark as descriptive. The earlier use by the opponent must relate to the use of the sign for the purposes of distinguishing goods or services (*WILD CHILD*). This does not appear to be the case here. Use, going back to the late 1990s, has been consistently as a flavour designation. Such long use in this manner will have the effect of dispelling any distinctive meaning that may have been attributed to the mark. There is no evidence to suggest that either the consumer or the opponent's franchisees perceive the sign as anything other than indicating a flavour of ice cream.

55) Certainly, the evidence of use of the sign by the opponent itself appears to support this. It consistently states that HOKEY POKEY is a flavour of one of its ice creams. It appears on invoices alongside other flavours, on freezer strip labels indicating to the public the flavour of the ice cream, references to it under "flavour lists" and photographs of packaging where the sign HOKEY POKEY appears with BASKIN ROBBINS. In the latter example, the packaging in the form of tubs, appears in a consistent format where the flavour is identified at the bottom and the Baskin Robbins mark appearing at the top (see, for example, the representation at paragraph 17).

56) Taking all of the above into account, I conclude that the goodwill vested in the opponent company and its affiliates is not identified by the sign HOKEY POKEY.

57) In the absence of goodwill, there can be no misrepresentation or damage. As a result of this finding, the opponent cannot rely upon its use of HOKEY POKEY to identify its goodwill and its case against the applicant must fail.

58) This finding is fatal to the opponent's case and, consequently, it is not necessary for me to consider the other defences put forward by the applicant.

COSTS

58) The applicant has been successful and is therefore entitled to a contribution towards its costs. In making a costs award I take into account that the applicant was not professionally represented. I therefore need to take into account the comments of Simon Thorley Q.C. sitting as the Appointed Person on appeal, in *Adrenalin Trade Mark*, BL O/040/02; he observed that:

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

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

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

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

...

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

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

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

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

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

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

36. In my judgment the approach which should be adopted when the Registrar is asked to make an award of costs in favour of a litigant in person is as follows. The hearing officer should direct the litigant in person pursuant to r. 57 of the 2000 Rules to file a brief schedule or statement setting out (i) any disbursements which the litigant claimed he has incurred, (ii) any other financial losses claimed by the litigant and (iii) a statement of the time spent by the litigant in dealing with the proceedings.

The hearing officer should then make an assessment of the costs to be awarded applying by analogy the principles applicable under r. 48.6, but with a fairly broad brush. The objective should be to ensure that litigants in person are neither disadvantaged nor overcompensated by comparison with professionally represented litigants.

37. In the present case I directed the applicant to provide such a schedule. The applicant duly filed a schedule claiming in respect of the proceedings at first instance disbursements of £20 together with mileage of 310 miles. No specific mileage rate was claimed so I propose to apply a rate of 25p per mile, giving a figure of £77.50, making total disbursements of £97.50. The applicant also estimated that it had spent a total of 83 hours dealing with the first instance proceedings. While this seems quite a lot by professional standards, it is appropriate to allow a litigant in person more time for a particular task than a professional advisor would be allowed: *Mealing McLeod v Common Professional Examination Board* [2000] 2 Costs L.R. 223. At the rate of £9.25 [now £18] an hour, 83 hours comes to £767.75. Accordingly, I shall set aside the hearing officer's costs order and substitute an order that the opponent pay the applicant the sum of £865.25 in respect of the first instance proceedings.

38. So far as the appeal is concerned, the applicant again claimed disbursements of £20 and mileage of 310 miles. It also estimated that it had spent 21 hours dealing with the appeal. Accordingly I shall order the opponent to pay the applicant the sum of £291.75 in respect of the appeal, making a total of £1157."

60) The case is an unremarkable one, involving issues that are before the tribunal on a regular basis. Despite this, it is evident that the detailed approach to analysing the opponent's evidence and the detailed way that its own evidence and submissions have been prepared, has resulted in the applicant spending a significant amount of time preparing the case. Nevertheless, taking account of the nature of the issues in the case, it is my decision that the costs award should be according to the published scale.

61) It is clear to me that any schedule of costs would demonstrate that actual costs will exceed scale costs. Therefore, by applying the scale, there is little likelihood of making an award that exceeds actual costs. Under these circumstances, I see little point in putting the applicant to the cost and time of preparing a schedule of costs.

62) With this in mind, I make a costs order based on the published scale of costs but also recognise that the applicant did not have the additional costs associated with legal representation. I note Mr Garnsworthy's request for me to take account that the applicant had to respond to a Section 3 claims in its counterstatement before the grounds were removed. I also note that the applicant's largest costs

are associated with its extremely detailed evidence and submissions and that the cost burden of attending the hearing was light. I take all of this into account in making the following award:

Considering Notice of Opposition and preparing counterstatement:	£250
Preparing and filing evidence and submissions and considering other side's evidence:	£900
Preparing for and attending hearing:	£270
TOTAL	£1420

63) I order BR IP Holder LLC to pay Greyleg Investment Limited the sum of £1420. 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 4th day of April 2014

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