

O-455-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3045888
BY JOLLY FOX LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 29, 30 & 43:**

Jolly Fox

AND

**AN OPPOSITION THERETO (NO. 402458) BY
NORTHERN FOODS GROCERY GROUP LIMITED**

Background and pleadings

1. This dispute concerns whether the trade mark **Jolly Fox** should be registered for the following goods:

Class 29: Bean curd;Burgers;Butter substitutes;Frozen vegetables;Fruit desserts;Fruit jams;Fruit jellies;Fruit paste;Fruit-based snack food;Hummus;Hummus chick pea paste;Hummus [chickpea paste];Jams;Jellies;Jellies for food;Jellies, jams, compotes;Margarine substitutes;Meat substitutes;Pates;Potato salad;Prepared salads;Salads (Fruit -);Salads (Vegetable -);Snack food (Fruit-based -);Soup cubes;Soup pastes;Soup powders;Soup (Preparations for making -);Soup preparations (Vegetable -);Soya bean curd;Soya milk;Soya milk [milk substitute];Soya [prepared];Soy-based snack foods;Tofu;Vegetable burgers;Vegetable pate;Vegetable salads;Vegetable soup preparations;Vegetables, cooked;Vegetables, dried;Vegetables, preserved;Vegetables, tinned [canned (Am.)];Vegetarian sausages;Yoghurt;Yoghurt desserts.

Class 30: Aerated beverages [with coffee, cocoa or chocolate base];Aerated chocolate;Aerated drinks [with coffee, cocoa or chocolate base];Alimentary pasta;Alimentary seasonings;Bakery desserts;Bakery goods;Barbecue sauce;Beverages based on chocolate;Beverages based on coffee;Beverages based on tea;Beverages (chocolate-based-);Beverages (Chocolate-based -);Beverages (cocoa-based-);Beverages (Cocoa-based -);Beverages (coffee-based-);Beverages (Coffee-based -);Beverages consisting principally of chocolate;Beverages consisting principally of cocoa;Beverages consisting principally of coffee;Beverages containing chocolate;Beverages (Flavorings [flavourings], other than essential oils, for -);Beverages (flavorings [flavourings], other than essential oils, for-);Beverages made from chocolate;Beverages made from cocoa;Beverages made from chocolate;Beverages (tea-based-);Beverages (Tea-based -);Beverages with a chocolate base;Beverages with a cocoa base;Beverages with coffee base;Beverages with tea base;Biscuits;Biscuits [sweet or savoury];Canned pasta foods;Canned sauces;Cheeseburgers [sandwiches];Cheesecake;Cheesecakes;Chicken sandwiches;Chilled desserts;Chilled pizzas;Chocolate;Chocolate based beverages;Chocolate based drinks;Chocolate based fillings;Chocolate based products;Chocolate cake;Chutney;Chutneys;Chutneys [condiments];Coffee;Coffee based beverages;Coffee based drinks;Concentrated sauce;Condiments;Condiments in powder form;Cookies;Cooking sauces;Crackers [edible];Cream (ice-);Cream (Ice -);Curried food pastes;Curry mixes;Curry paste;Curry pastes;Curry powders;Curry sauces;Dessert puddings;Desserts;Dips;Dips [foodstuffs];Dressings for food;Dressings for salad;Dressings (salad-);Dry and liquid ready-to-serve meals, mainly consisting of pasta;Dry and liquid ready-to-serve meals, mainly consisting of rice;Filled pasta;Filled rolls;Filled sandwiches;Flavorings [other than essential oils];Food condiment consisting primarily of ketchup and salsa;Food dressings [sauces];Food pastes;Foods with a cocoa base;Foodstuffs in the form of snack foods;Foodstuffs made from soya;Foodstuffs made from soybean;Foodstuffs prepared in the form of savory snackfoods;Fresh pies;Frozen pizzas;Frozen yoghurt [confectionery

ices];Frozen yoghurts;Fruit ice;Fruit ice cream;Fruit ices;Horseradish [relishes];Hot sauce;Ice cream;Ice cream desserts;Ice lollies;Iced coffee;Imitation chocolate;Imitation custard;Imitation ice cream;Imitation mayonnaise;Ketchup;Ketchup [sauce];Ketchups;Marinades containing herbs;Marinades containing seasonings;Marinades containing spices;Mayonnaise;Meals consisting primarily of pasta;Meals consisting primarily of rice;Mousses;Mousses (Chocolate -);Mousses (Dessert -) [confectionery];Non-dairy ice cream;Non-meat pies;Noodle-based prepared meals;Oat-based food;Oat-based food for human consumption;Oat-based foods;Pasta products;Pasta salad;Paste (Soya bean -) [condiment];Pastes (Farinaceous food -);Pesto sauce;Pies containing vegetables;Pizza;Pizzas [prepared];Prepared desserts;Prepared foodstuffs in the form of sauces;Prepared meals containing [principally] pasta;Prepared meals containing [principally] rice;Prepared meals in the form of pizzas;Prepared pasta dishes;Prepared pasta meals;Prepared pizza meals;Prepared rice dishes;Ravioli;Ravioli [prepared];Ready-made baking mixtures;Ready-made dishes containing pasta;Ready-made sauces;Ready-to-eat puddings;Relishes;Relishes [condiments];Rice;Rice based dishes;Rice-based pudding dessert;Rice-based snack food;Rice-based snack foods;Salad dressing;Salad (dressing for-);Salad dressings;Salad dressings containing cream;Salad sauces;Salsas;Sandwiches;Sauces;Sauces [condiments];Sauces for food;Snack bars consisting of chocolate;Snack bars containing a mixture of grains, nuts and dried fruit [confectionery];Snack bars containing dried fruits [confectionery];Snack bars containing grains [confectionery];Snack bars containing nuts [confectionery];Snack food (Cereal-based -);Snack food products consisting of cereal products;Snack food products made from cereal flour;Snack food products made from cereal starch;Snack food products made from cereals;Snack food products made from maize flour;Snack food products made from potato flour;Snack food products made from rice;Snack food products made from rice flour;Snack food products made from rusk flour;Snack food products made from soya flour;Snack food (Rice-based -);Snack foods consisting principally of bread;Snack foods consisting principally of confectionery;Snack foods consisting principally of extruded cereals;Snack foods consisting principally of grain;Snack foods consisting principally of pasta;Snack foods consisting principally of rice;Snack foods made from cereals;Snack foods made from corn;Snack foods made from corn and in the form of puffs;Snack foods made from corn and in the form of rings;Snack foods made from wheat;Snack foods made of wheat;Snack foods made of whole wheat;Snack foods prepared from maize;Snack foods prepared from potato flour;Snack products made of cereals;Snacks manufactured from cereals;Snacks manufactured from muesli;Sorbet;Sorbetes;Sorbetes [ices];Soya based ice cream products;Soya bean paste [condiment];Soy-based ice cream substitute;Substitutes (chocolate-);Tabbouleh;Tartar sauce;Tartare sauce;Tomato based sauces;Tomato ketchup;Vegetable pulps [sauces - food];Yoghurt (Frozen -) [confectionery ices];Yoghurt (frozen-) [confectionery ices];Yogurt (Frozen -) [confectionery ices];Yogurt (frozen-) [confectionery ices].

Class 43: Bar services;Bars;Cafe services;Cafés;Catering for the provision of food and beverages;Catering of food and drinks;Catering services;Catering

services for the provision of food;Catering services for the provision of food and drink;Club services for the provision of food and drink;Cocktail lounge services;Coffee shop services;Delicatessens [restaurants];Fast food restaurant services;Fast-food restaurants;Food cooking services;Food preparation;Food preparation services;Hotel accommodation services;Hotel catering services;Hotel reservation services;Hotels;Night club services [provision of food];Preparation of meals;Public house services;Pubs;Resort hotels;Restaurant reservation services;Restaurant services;Restaurants;Restaurants (Self-service -);Salad bars;Self-service restaurants;Services for providing food and drink;Snack bar services;Snackbars;Travel agency services for making hotel reservations;Wine bars.

2. The mark was filed by Jolly Fox Limited (the applicant) on 9 March 2014 and was published for opposition purposes on 4 April 2014. The above specifications are the result of an amendment during the course of the proceedings. At one point it appeared that the dispute was to be settled, but that did not materialise.

3. Registration of the mark is opposed by Northern Foods Grocery Group Limited (the opponent). Its grounds are under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade mark registrations:

i) UK registration 887518 for the mark **FOX'S** which was filed on 27 November 1965, completing its registration process shortly thereafter. The mark is registered in class 30 for "biscuits (other than biscuits for animals)".

ii) UK registration 2465173 for the series of marks:



The marks were filed on 24 August 2007 and the registration process completed on 22 February 2008. The registration covers the following class 30 goods:

"Biscuits; crackers; shortbread; bread and bakery products; cakes; preparations made from cereals and from flour; snack foods and prepared meals consisting primarily of the aforesaid goods."

iii) Community trade mark (CTM) registration 8271017 for the mark **FOX'S** which was filed on 30 April 2009, completing its registration process on 11 December 2009. The mark is registered for the following class 30 goods:

Cakes, bread other than croutons, pizzas, sweet snack foods but not including non-medicated sugar confectionery; muffins, preparations made from cereals; pastry, biscuits, crackers, chocolate and coated biscuits, biscuit confectionery, chocolate confectionery, chocolate sugar confectionery, chocolate products, flour confectionery; wafers, ice creams and edible ices; ice cream products; crisp breads other than croutons, crisps; rice based snacks; flour based snacks; breakfast cereals.

4. The above three marks are relied upon under section 5(2)(b). Only marks i) and iii) are relied upon under section 5(3). Marks i) and ii) completed their respective registration procedures more than five years prior to the publication of the applicant's mark. Consequently they are subject to the proof of use provisions contained in section 6A of the Act. In this regard the opponent made a statement of use in relation to all of the goods for which the marks are registered. Mark iii) was registered more recently and is not subject to the proof of use provisions. Therefore, this mark may be relied upon in these proceedings for its specification as registered without having to prove genuine use.

5. Under section 5(4)(a) the opponent relies on the use, since approximately 1864, of the sign **FOX'S** in relation to biscuits and confectionary.

6. The applicant filed a counterstatement denying the grounds of opposition. The applicant did not put the opponent to proof of use in relation to marks i) and ii). Consequently, these may also be relied upon for their specifications as registered. The main points raised in the applicant's counterstatement are:

- a) The applicant is a vegan food company.
- b) The applicant does not use the word FOX'S (with an apostrophe and/or full stop).
- c) The opponent does not have a trade mark for the singular word FOX.
- d) There are other food companies that use the word FOX/FOX'S.
- e) The applicant's goods do not include biscuits.

7. The opponent is represented by Walker Morris LLP. The applicant is self-represented. Only the opponent filed evidence. Neither side requested a hearing or filed written submissions. At the end of the proceedings the opponent indicated that it considered its best case under section 5(2)(b) to lie with CTM 8271017.

The evidence

8. The opponent's evidence was filed by Ms Helen Thomas-Peter, a trade mark attorney at Walker Morris, the opponent's representatives in this matter. She states that the mark FOX'S has been used:

“extensively throughout the United Kingdom in relation to biscuits and chocolate covered confectionary since 1853. As such we consider that it is a household name with a recognised trading goodwill and a reputation”.

Attached as Exhibit HTP1 are copies of “independent articles” about the brand, as follows:

- a) A print from the website www.confectionerynews.com. It is headed “Fox’s Biscuits eyes premiumization to halt sales declines”. Depicted is a tin of biscuits showing i) the word FOX’S (similar in style to earlier mark 2465173), ii) images of biscuits, and iii) a panda. There is also a picture of a chocolate covered biscuit bar called FOX’S ROCKY BIG EAT. The context of the article is that Fox’s is to adjust its brand image to make it more attractive in the premium market. The article notes that for the year ending 17 May 2014 its sales fell 2.7% to £117million. The article is dated 23 June 2014.
- b) A print from the website Wikipedia about Fox’s Biscuits. It includes information about the long history of the brand (starting in 1853). There is a list of its biscuit products. There is a paragraph about Vinnie, a character that plays a role in the marketing of Fox’s biscuits. Vinnie is, apparently, a “danda”, a cross between a dog and a panda, although from the picture on the tin of biscuits described above, he is more panda than dog.
- c) A print from the website biscuitpeople.com. It is headed “Biscuit market in UK making a packet”. As the title suggests, it is about the UK biscuit market generally. Part of the article reads “Fox’s Biscuits has grown from a tiny Victorian bakery in northern England over 160 years ago, to become one of the UK’s leading biscuit brands with three manufacturing sites in Bately in West Yorkshire, Kirkham near Blackpool and Uttoxeter in Staffordshire. The company offers, under the Fox’s label, crunchy creams in a variety of flavours, chunky cookies, Viennese treats and several other types of biscuits”. The article is from December 2014.
- d) A print from www.fdin.org.uk, the website of The Food & Drink Innovation Network. It is dated 2 March 2012 and is headed “Fox’s launches new indulgent biscuit range”. The article is about the continued expansion of Fox’s “special treat” products. Some of the new products it is to launch are depicted (the stylised mark is used). The biscuits depicted are chocolate covered ones sold in a fairly typical biscuit packet. The article notes that Fox’s Biscuits owns a 27% share of the special treats segment. I also note that in the “related posts” part of the page, a link is provided to an article headed “Fox’s launches new biscuit bars.”
- e) A copy of an article that was published in Food Trade Review on 1 January 2013. It is headed Fox’s Biscuits sees improved quality. It is about improved machinery used in its plant. It begins with the words “One of the UK’s leading biscuits manufactures...”.
- f) Two website articles are provided which Ms Thomas-Pater accepts post-date the relevant date, however, she considers that the £10million investment

mentioned in the articles shows that the brand's position in the market was sufficient enough to justify expenditure of this level.

9. Ms Thomas-Peter states that in view of the extensive evidence of use and reputation "we trust that the Registrar will be in a position to take judicial notice of the fact without further evidence being filed".

10. Ms Thomas-Peter's trust is misplaced in this instance. It would not be appropriate to take on judicial notice the extent and nature of the opponent's reputation/goodwill. Judicial notice is reserved for what are often termed notorious facts, facts that are so well known that to require a party to prove them through evidence would be disproportionate. The use that has been made of Fox's does not fall into this category. The claim to goodwill/reputation must, therefore, rest and fall on the evidence that has been presented.

11. The evidence presented is somewhat sparse. There is no evidence from the company records as to turnover, marketing expenditure etc. However, the independent articles all show that Fox's is one of the leading biscuit brands in the UK, a longstanding brand going back to Victorian times. I may touch on some of the evidence in more detail later, but for now, I am prepared to accept that the opponent's mark will be reasonably well-known to UK average consumers, albeit, I can only make that finding in so far as sweet biscuits (including chocolate covered biscuits) are concerned.

Section 5(2)(b)

12. Section 5(2)(b) of the Act states that:

"5.(2) A trade mark shall not be registered if because – ..

(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."

13. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

14. When making the comparison, all relevant factors relating to the goods and services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“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.”

15. 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;
- (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.”

16. 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 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).”

17. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is

neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

18. When making the comparison, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – “Meric”*) even if there are other goods within the broader term that are not identical.

19. The opponent’s (best) earlier mark is registered for the following goods:

Class 30: Cakes, bread other than croutons, pizzas, sweet snack foods but not including non-medicated sugar confectionery; muffins, preparations made from cereals; pastry, biscuits, crackers, chocolate and coated biscuits, biscuit confectionery, chocolate confectionery, chocolate sugar confectionery, chocolate products, flour confectionery; wafers, ice creams and edible ices; ice cream products; crisp breads other than croutons, crisps; rice based snacks; flour based snacks; breakfast cereals.

20. The goods sought by the applicant are many and varied. I will go through them in turn, but grouping them when it is reasonable to do so. I will compare each term (or group of terms) with the opponent’s goods as above. I will focus on what I consider to be the opponent’s most similar goods but I have, of course, borne all the opponent’s goods in mind. In every case, even when there are closer goods, I will also compare the applied for goods with the opponent’s biscuits. This is because of the claimed reputation for such goods which may increase the likelihood of confusion.

Class 29

Bean curd; Soya bean curd; Tofu; Meat substitutes

21. Such goods are used as component parts of meals in vegetarian cooking. Beyond the fact that the goods in comparison are food products, I see no real similarity with the goods of the earlier mark (including biscuits). **The goods are not similar.**

Burgers; Vegetable burgers; Vegetarian sausages

22. The closest goods I can see here are pizzas. All of the goods could be eaten as a quick and easy fast food type meal. However, the nature is different and there is nothing to suggest that the goods will be located close to each other in, for example, a supermarket. The goods are not complementary. There may be some competition. **I consider the above goods to have a low degree of similarity with pizza. There is no similarity with biscuits.**

Butter substitutes; Margarine substitutes

23. Such goods could be used as ingredients in many of the goods of the earlier mark. However, this alone does not make them similar. The nature is different, the purpose is different, they will not be located close to each other in a supermarket and they are not competitive. Although the use of butter/margarine (or in this case their substitutes) may be important in the creation of some of the class 30 goods, they are not complementary in the sense described by the case-law, a relationship which requires that “customers may think that responsibility for the goods lies with the same undertaking”. **The goods are not similar to those of the earlier mark, including biscuits.**

Frozen vegetables; Vegetables, cooked; Vegetables, dried; Vegetables, preserved; Vegetables, tinned [canned (Am.)]

24. The closest one gets here is that vegetables could be used to top a pizza or could be used as a filling for flour based snacks. However, for the same reasons as I discussed with regard to butter substitutes, **the goods are not similar to those of the earlier mark, including biscuits.**

Fruit desserts

25. There are a number of dessert type products in the opponent’s specification including cakes, muffins, confectionary and biscuits. The nature of the competing goods is different on account of the fruit base of the applied for goods. However, there is some similarity in purpose as they could all being eaten as a sweet treat at the end of a meal. There is nothing to suggest that the goods will be located in close proximity to each other. The goods are not complementary but there may be a degree of competition. Cakes and muffins are typical desserts. Confectionary and biscuits may be eaten as a dessert but are eaten more often as a snack between meals. **I consider there to be a moderate degree of similarity with cakes and muffins but only a low degree of similarity with confectionary and biscuits.**

Fruit-based snack food; Snack food (Fruit-based -)

26. The goods of the earlier mark include flour based snacks and, also, other products (such as biscuits) which could be eaten as snacks. The nature of the goods is likely to be different as are the areas of a store in which they are sold. The goods are not complementary. There may be a degree of competition, but given the quite different natures of the products I doubt that they are highly competitive. **I consider there to be a low degree of similarity with the snack type goods (including biscuits) of the earlier mark.**

Hummus; Hummus chick pea paste; Hummus [chickpea paste]; Pates; Vegetable pate

27. The closest one gets here is that such goods are traditionally eaten with bread or crackers, both of which are listed in the goods of the earlier mark. The nature of the goods is different, the purpose is different and they are unlikely to be located in close proximity. The goods do not compete. There could be a complementary

relationship but in my view it is not of the type where “customers may think that responsibility for the goods lies with the same undertaking”. **The goods are not similar to those of the earlier mark, including biscuits.**

Fruit jams; Fruit jellies; Jams; Jellies; Jellies for food; Jellies, jams, compotes

28. Jams and jellies may be eaten on bread and/or may be ingredients in certain of the opponent’s goods. However, the nature will be quite different, they will be located in different parts of a store and they do not compete. There could be a complementary relationship but in my view it is not of the type where “customers may think that responsibility for the goods lies with the same undertaking”. **The goods are not similar to those of the earlier mark, including biscuits.**

Fruit paste

29. Fruit paste is a form of concentrated fruit product used, for example, as an accompaniment, similar in a way to jams and jellies. As such, I come to the same finding as above. **The goods are not similar to those of the earlier mark, including biscuits.**

Salads (Fruit -)

30. As fruit salad could be eaten as a dessert, this means that there may be a degree of similarity with the opponent’s dessert type products as assessed earlier (see paragraph 25). However, I consider the difference in nature with the class 30 goods to be even stronger here. **I consider there to be a low degree of similarity with cakes and muffins but only a very low degree of similarity with confectionary and biscuits.**

Salads (Vegetable -); Vegetable salads; Potato salad

31. Beyond the very superficial fact that all of the goods are foods, the only point of similarity that I can see is that the applied for goods may be eaten as an accompaniment to certain goods of the earlier mark (such as pizza). However, the nature is different, the purpose (other than being food) is different and they will be located in different parts of a store. There is no meaningful degree of competition and the goods are not complementary in the sense described by the case law. **There is only a very low degree of similarity with goods such as pizza, but no similarity with biscuits.**

Prepared salads

32. The applied for term covers both fruit and vegetable based salads, **my findings as above are therefore applicable.**

Soup cubes; Soup pastes; Soup powders; Soup (Preparations for making -);Soup preparations (Vegetable -); Vegetable soup preparations

33. I see no real similarity with any of the goods of the earlier mark. Bread is often eaten with soup, but any complementarity on this basis is not of the type where

“customers may think that responsibility for the goods lies with the same undertaking”. Pizza can be eaten as meal as can soups, but the nature is quite different as are their locations in a store and they do not strike me as meaningfully competitive. **I find that there is, at best, a very low degree of similarity with pizza, but no similarity with anything else (including biscuits).**

Soya milk; Soya milk [milk substitute]

34. I see no obvious similarity here. The position is somewhat similar to the assessment made with regard to butter and margarine substitutes. I adopt the same finding. **The goods are not similar to those of the earlier mark, including biscuits.**

Soya [prepared]

35. I see no real similarity with any of the goods of the earlier mark. **The goods are not similar to those of the earlier mark, including biscuits.**

Soy-based snack foods

36. The position is similar to the fruit based snack products assessed at paragraph 26. There is no reason to assume a greater degree of similarity. **I consider there to be a low degree of similarity with the snack type goods (including biscuits) of the earlier mark.**

Yoghurt; Yoghurt desserts

37. Yoghurt in class 29 does not cover frozen yogurt (which falls in class 30) so the link with ice-cream (which must be very similar to frozen yogurt) is not in play. The goods are a step removed. One is consequently left with similarity on the basis that certain goods are dessert type products. However, the nature of yogurt and yogurt desserts will be very different to the opponent’s goods. **I consider there to be a low degree of similarity with cakes and muffins but only a very low degree of similarity with confectionary and biscuits.**

Class 30

Aerated beverages [with coffee, cocoa or chocolate base]; Aerated drinks [with coffee, cocoa or chocolate base]; Beverages based on chocolate; Beverages based on coffee; Beverages based on tea; Beverages (chocolate-based-); Beverages (Chocolate-based-); Beverages (cocoa-based-); Beverages (Cocoa-based -); Beverages (coffee-based-); Beverages (Coffee-based -); Beverages consisting principally of chocolate; Beverages consisting principally of cocoa; Beverages consisting principally of coffee; Beverages containing chocolate; Beverages (Flavorings [flavourings], other than essential oils, for -); Beverages (flavorings [flavourings], other than essential oils, for-); Beverages made from chocolate; Beverages made from cocoa; Beverages made from chocolate; Beverages (tea-based-); Beverages (Tea-based -); Beverages with a chocolate base; Beverages with a cocoa base; Beverages with coffee base; Beverages with tea base; Biscuits; Biscuits [sweet or savoury]; Chocolate based

beverages;Chocolate based drinks; Coffee;Coffee based beverages;Coffee based drinks; Iced coffee.

38. None of the opponent's goods are specifically identified as beverages. However, the opponent's goods do cover "chocolate products" which, on a fair reading of that term, covers chocolate based beverages. **Accordingly, to the extent that any of the above beverages are chocolate (or cocoa) based the goods must be considered as identical.** In relation to the other types of beverages, a coffee/tea based beverage must have a degree of similarity to chocolate based beverages (which are covered by the opponent's chocolate products). **They have a medium degree of similarity.** In comparison to biscuits, the beverages are not similar in nature, they have different purposes and will be sold in different areas of a store. The goods do not compete and any complementary relationship (the link between beverages and biscuits) is not the type of one where "customers may think that responsibility for the goods lies with the same undertaking". **The goods have a low degree of similarity at best.**

Bakery desserts; Bakery goods

39. The opponent's goods cover various bakery products (bread, biscuits, flour snacks etc) and desserts (cakes, muffins etc). **The goods must be considered as identical. The opponent's biscuits also fall within the applied for terms so are also considered identical.**

Biscuits; Biscuits [sweet or savoury]; Cookies

40. The opponent's goods include biscuits per se (which covers both sweet and savoury biscuits). A cookie is a type of biscuit. Consequently all of these goods fall within the ambit of terms in the earlier mark. **The goods are identical.**

Cheeseburgers [sandwiches]

41. In paragraph 22 I assessed the position with regard to goods such as burgers. Although to fall in class 30 a cheeseburger is one encompassed by a bread roll, I do not consider that this materially increases the degree of similarity with a pizza even though a pizza has a bread base. **I consider the above goods to have a low degree of similarity with pizza. There is no similarity with biscuits.**

Cheesecake; Cheesecakes

42. Cheesecake is a type of cake which, consequently, falls within the ambit of the opponent's cakes. **The goods are identical.** In relation to biscuits, that the goods could be eaten as a sweet treat at the end of a meal is a point of similarity, although perhaps not the strongest. **I consider there to be a low degree of similarity with biscuits.**

Chicken sandwiches; Filled rolls; Filled sandwiches; Sandwiches

43. The closest one gets is pizza as all the goods could be eaten as a quick snack product and both are bread based. However, the exact nature is quite different as

are the locations in which they are sold. There is no complementarity and the degree of completion does not strike me as high. **I consider there to be only a low degree of similarity with pizza, but no similarity with biscuits.**

Chilled desserts; Dessert puddings; Desserts

44. The opponent's goods include desserts such as cakes and muffins. The goods must therefore be considered identical. In relation to biscuits, as they could all be eaten as a sweet treat after a meal, this creates a point of similarity. However, considering the exact nature of the goods, I consider any similarity to be low.

Mousses; Mousses (Chocolate); Mousses (Dessert -) [confectionery]; Ready-to-eat puddings; Prepared desserts

45. On the basis that these could all be chocolate products, **the goods fall within the opponent's term and so are identical. In comparison to biscuits, consistent with earlier findings, I consider there to be a low degree of similarity.**

Rice-based pudding dessert

46. Such a product could be classed as a snack so would fall within the opponent's "rice based snacks". The goods are identical. **There would only be a low degree of similarity with biscuits.**

Chocolate; Aerated chocolate

47. The earlier mark covers chocolate products. **As such the goods must be considered identical.** In relation to biscuits, chocolate may be eaten as a sweet treat at any time of the day as can biscuits. Whilst they may not be located next to each other, in my experience, the chocolate and the biscuit isles are not that far from each other. The goods are not complementary, but there is a reasonable degree of competition. **I consider there to be a medium degree of similarity between chocolate and biscuits.**

Substitutes (chocolate-); Imitation chocolate

48. The assessment is similar here, notwithstanding that one is talking about chocolate substitutes or imitation chocolate. Chocolate substitutes and **imitation chocolate is highly similar to the opponent's chocolate products and there is a medium degree of similarity with biscuits.**

Chocolate based fillings; Chocolate based products; Snack bars consisting of chocolate; Chocolate cake; Foods with a cocoa base

49. **All of the goods fall within the opponent's chocolate products so must be considered identical.** In comparison to biscuits, the fillings would have only a low degree of similarity, the "chocolate based products" identical (because the applied for term would cover biscuits), the snack bars would have a very high degree of similarity (because the nature, purpose and channels of trade are very similar) and foods with a cocoa base identical (because such a term would encompass biscuits).

Alimentary seasonings; Barbecue sauce; Canned sauces; Chutney; Chutneys; Chutneys [condiments]; Concentrated sauce; Condiments; Condiments in powder form; Cooking sauces; Curried food pastes; Curry mixes; Curry paste; Curry pastes; Curry powders; Curry sauces; Food condiment consisting primarily of ketchup and salsa; Food dressings [sauces]; Horseradish [relishes]; Hot sauce; Imitation mayonnaise; Ketchup; Ketchup [sauce];Ketchups; Mayonnaise; Paste (Soya bean -) [condiment]; Pesto sauce; Prepared foodstuffs in the form of sauces; Ready-made sauces; Salad dressing; Salad (dressing for-);Salad dressings; Salad dressings containing cream; Salad sauces; Sauces; Sauces [condiments];Sauces for food; Tartar sauce; Tartare sauce; Tomato based sauces; Tomato ketchup; Vegetable pulps [sauces - food]; Dressings for food; Dressings for salad; Dressings (salad-); Marinades containing herbs; Marinades containing seasonings; Marinades containing spices; Flavorings [other than essential oils]; Relishes; Relishes [condiments]; Salsas; Food pastes; Pastes (Farinaceous food -); Soya bean paste [condiment];

50. The above goods are all various condiments, sauces, seasonings etc. None of the terms of the earlier mark cover such goods. Whilst some of the applied for terms may be ingredients in some of the goods of the earlier mark, as per my findings in paragraph 23, this does not make the goods similar. **The goods are not similar to those of the earlier mark, including biscuits.**

Crackers [edible]

51. A cracker is, essentially, a savoury biscuit. **The goods of the earlier mark include biscuits per se so must be consider identical.**

Cream (ice-);Cream (Ice -); Frozen yoghurt [confectionery ices];frozen yoghurts; fruit ice; Fruit ice cream; Fruit ices; Ice cream; Ice cream desserts; Ice lollies; Imitation ice cream; Non-dairy ice cream; Sorbet; Sorbets; Sorbets [ices];Soya based ice cream products; Soy-based ice cream substitute; Yoghurt (Frozen -) [confectionery ices]; Yoghurt (frozen-) [confectionery ices];Yogurt (Frozen -) [confectionery ices];Yogurt (frozen-) [confectionery ices]

52. The goods of the earlier mark include ice cream and edible ices. **The goods are either identical (for the ice-cream, sorbets etc) or similar to the highest degree (frozen yoghurt). In comparison to biscuits there is only a low degree of similarity.**

Dips; Dips [foodstuffs]

53. Dips could be chocolate in nature so would **fall within the opponent's chocolate products and must be considered identical. In comparison to biscuits there is only a low degree of similarity.**

Alimentary pasta; Canned pasta foods; Dry and liquid ready-to-serve meals, mainly consisting of pasta; Filled pasta; Meals consisting primarily of pasta; Prepared meals containing [principally] pasta; Prepared pasta dishes; Prepared pasta meals; Ravioli; Ravioli [prepared]; Pasta products; Pasta salad; Ready-made dishes containing pasta; snack foods consisting principally of pasta

54. I see none of the opponent's broad terms as covering pasta products/meals. There could be a degree of similarity with pizzas, as they are all Italian style meals, although, given the precise nature of the goods **there would be a moderate degree of similarity at best. In comparison to biscuits, the goods are simply not similar.**

Dry and liquid ready- to-serve meals, mainly consisting of rice; Meals consisting primarily of rice; Prepared meals containing [principally] rice; Prepared rice dishes; Rice; Rice based dishes

55. The opponent's goods cover rice based snacks. Although there may be a difference between a snack and a meal, the line between them could be quite narrow. **I consider there to be a reasonably high degree of similarity. However, in comparison to biscuits, the goods are not similar.**

Foodstuffs in the form of snack foods; Foodstuffs prepared in the form of savoury snack foods

56. The opponent's goods cover various forms of snack food and must, therefore, **be considered identical. Further, as biscuits are a typical snack then identity exists here also.**

Foodstuffs made from soya; Foodstuffs made from soybean

57. There is nothing in the opponent's specification that would specifically cover foodstuffs of this nature. The resulting foodstuff may, though, have some similarity with the various snack foods covered by the opponent's goods, **but without knowing more, the degree of similarity should be pitched as low at best. In relation to biscuits, I see no similarity.**

Fresh pies; Non-meat pies; Pies containing vegetables

58. None of the opponent's terms cover, in my view, pies. I think the assessment is similar to the ones made in relation to goods such as cheeseburgers and sandwiches. **I consider there to be only a low degree of similarity with pizza, but no similarity with biscuits.**

Chilled pizzas; Frozen pizzas; Pizza; Pizzas [prepared]; Prepared meals in the form of pizzas; Prepared pizza meals

59. The opponent's specification covers pizza, **the goods are therefore identical. There is, though, no similarity with biscuits.**

Imitation custard

60. None of the opponent's terms cover, in my view, imitation custard. **There may be a low degree of similarity with the opponent's dessert type products and its biscuits.**

Noodle-based prepared meals

61. None of the opponent's terms cover, in my view, noodle-based meals. I think the assessment is similar to the ones made in relation to goods such as cheeseburgers and sandwiches. **I consider there to be only a low degree of similarity with pizza, but no similarity with biscuits.**

Oat-based food; Oat-based food for human consumption; Oat-based foods

62. Oats are a type of cereal. The opponent's specification covers breakfast cereals and, also preparations made from cereals. **The goods must be considered identical. In relation to biscuits, these could be oat based so should also be considered identical.**

Ready-made baking mixtures

63. Baking mixtures can be used to produce a variety of products including goods covered by the opponent's mark such as cakes, muffins and biscuits. This creates a clear aspect of similarity, the nature is not the same, but the purpose is related. **I consider there to be a reasonably high degree of similarity with such goods (including biscuits).**

Rice-based snack food; Rice-based snack foods; Snack foods consisting principally of rice

64. The opponent's specification covers rice based snacks **so the goods are identical. In relation to biscuits, I see no real similarity.**

Snack bars containing a mixture of grains, nuts and dried fruit [confectionery];Snack bars containing dried fruits [confectionery];Snack bars containing grains [confectionery];Snack bars containing nuts [confectionery]

65. The opponent's goods cover sweet snack foods, which the above would fall within. **The goods must be considered identical.** In comparison to biscuits, I consider that there would be a strong degree of competition, a similar purpose and the goods could be located fairly close to each other. **There is a reasonable degree of similarity with biscuits.**

Snack food (Cereal-based -);Snack food products consisting of cereal products; Snack food products made from cereal flour; Snack food products made from cereal starch; Snack food products made from cereals; Snack food products made from maize flour; Snack food products made from potato flour; Snack food products made from rice; Snack food products made from rice flour; Snack food products made from rusk flour; Snack food products made from soya flour; snack food (Rice-based -);Snack foods consisting principally of bread; Snack foods made from cereals; Snack foods made from corn; Snack foods made from corn and in the form of puffs; Snack foods made from corn and in the form of rings; Snack foods made from wheat; Snack foods made of wheat; Snack foods made of whole wheat; Snack foods prepared from maize; Snack foods prepared from potato flour; Snack products made of cereals; Snacks manufactured from cereals; Snacks manufactured from muesli;

Snack foods consisting principally of extruded cereals; Snack foods consisting principally of grain

66. The opponent's cereal preparations would encompass all of the above so must be considered identical. The applied for snacks from cereals would also include biscuits which are also identical. In relation to the other snacks such as puffs, rings, those made from potato flour, muesli, wheat etc, I see less similarity with biscuits, but there is still some. **I consider there to be a moderate level of similarity.**

Snack foods consisting principally of confectionery

67. The opponent's goods include various confectionery products that could be eaten as snacks. **The goods are, therefore identical. I also consider this term to be broad enough to cover biscuits so the goods are identical to biscuits also.**

Tabbouleh

68. Tabbouleh is a dish primarily based on bulgur wheat, albeit with a number of other ingredients to produce the end dish. The end product is often described as a tabbouleh salad. Although the opponent's specification covers preparations made from cereals, I do not consider that such a term would cover tabbouleh per se as too much is done to it for it to be classed as a preparation of that product. **Nevertheless, there may be a medium degree of similarity to rice based snacks because this could be in the form of a rice type salad. There is, though, no similarity between tabbouleh and biscuits.**

Class 43:

Cafe services; Cafés; Coffee shop services; Snack bar services; Snack bars; Delicatessens [restaurants]; Fast food restaurant services; Fast-food restaurants; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (Self-service -); Salad bars; Self-service restaurants

69. The opponent's mark is not registered for any services, but it would not be unusual for those providing food services to offer branded products in supermarkets. Furthermore, the average consumer may choose to either purchase food products from a shop and cook them at home, or, alternatively, to go out for such food. There is, of course, an inherent difference between the nature of any good and the nature of a service (which also impacts on the method of use), but the purpose is similar in terms of both the goods and the services relating to the consumption of food. The link between services and the goods has the potential for similarity, but the matter must still be assessed on the basis of the exact terms in the competing specifications. There would be greater potential for similarity if the goods of the earlier mark were identified as prepared meals, but this is not the case here. However, I still consider that a cafe could specialise in goods such as cakes and or pizza and there would be a low degree of similarity with the above services. Any similarity with biscuits is less, if there is any similarity then it must be very low.

Bar services; Bars; Cocktail lounge services; Public house services; Pubs; Wine bars; Club services for the provision of food and drink; Night club services [provision of food]

70. All of these services could provide food in addition to drink. The link may not, though, be as strong (with food products) as establishments specifically set up as restaurants, **so any similarity with any of the goods is low at best. In relation to biscuits it is very low.**

Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Food cooking services; Food preparation; Food preparation services; Hotel catering services; Preparation of meals

71. These are more catering services (for events etc) and the link is, in my view, not as strong, **so any similarity with any of the goods is low at best. In relation to biscuits it is very low.**

Hotel accommodation services; Hotel reservation services; Hotels; Resort hotels

72. Whilst a hotel may have a restaurant, the primary purpose of a hotel is for the provision of accommodation. The complementary relationship described above is, therefore, not really in play. **There is no similarity to any of the goods of the earlier mark.**

Services for providing food and drink

73. This term encompasses the various services identified in paragraphs 69 (food) and 70 (drink) above, so **the findings I made there apply.**

Travel agency services for making hotel reservations

74. **These services have no similarity whatsoever with food products.**

Average consumer and the purchasing act

75. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

76. The average consumer is a member of the general public. The various goods will be selected with no more than an average level of care and consideration through primarily visual means, with the goods most often being selected from supermarket shelves (or the online equivalents). I believe the same applies to the applied for services, the average consumer being a member of the public who will select the services from perusal of websites, leaflets, signage on the high street. The only service that has potential for any difference is catering services. These could be used by members of the public and the trade and may involve more consideration if the service is being used to cater for a wedding or a particular event etc.

Comparison of marks

77. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

78. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Jolly Fox v FOX’S

79. The opponent’s mark is comprised of the possessive form of the word FOX. FOX’S is the only element in its overall impression. The applicant’s mark consists of the two words, Jolly and Fox. As opposed to functioning as two separate elements, the words blend together as a unit, indicating a jolly (or happy) fox.

80. Conceptually, I begin by observing that the word FOX has two primary significances. One is as surname, the other the name of an animal. However, which of these meanings the average consumer will perceive will depend on what context the word is put in. For example, a reference to the lair of a fox will be taken as a reference to the lair of the animal as opposed to the lair of a person whose surname is Fox. In relation to “Jolly Fox”, I come to the view that the average consumer will

perceive that mark as a reference to the animal, or in this case a jolly one. Without anything else to signify that the Fox in question is a person, it would be strain of the language to reach the opposite view. In relation to "FOX'S" I come to the opposite view. The possessive form is something often used with a surname to indicate something owned or coming from that person. In the context of the mark being used in relation to the goods for which it is registered, it will be seen as a reference that the goods come from someone with the surname Fox. This means that the marks are conceptual different.

81. Before leaving the conceptual comparison I note that the perception of the average consumer may not necessarily be a binary question. I must leave room, therefore, for the possibility that some average consumers may see the marks differently. In *JW Spear & Sons Ltd & Others v Zynga Inc* [2015] EWCA Civ 290 the Court of Appeal stated:

"36. Mr Silverleaf also referred us to the discussion of the attributes of the average consumer in *Interflora Inc and another v Marks & Spencer plc* [2014] EWCA Civ 1403 at [107] to [130]. In that case it was argued on behalf of the defendant that the judge had been wrong to ask himself whether a "significant proportion of members of the public" would be confused. The average consumer, it was suggested, was either confused or he was not. In the course of dealing with that question the court approved the following propositions of materiality here:

i) the average consumer in any context is a hypothetical person or "legal construct": a person who has been created to strike the right balance between various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market, and also to provide a standard, defined in EU law, which national courts may then apply.

ii) the average consumer test is not a statistical test. The national court must exercise its own judgment, in accordance with the principle of proportionality and the principles explained by the Court of Justice, to determine the perceptions of the average consumer in any given case in light of all the relevant circumstances.

iii) in a case concerning ordinary goods or services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up his or her own mind about the particular issue he or she has to decide in the absence of evidence and using his or her own common sense and experience of the world.

37. In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* identified the following propositions:

i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.

ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.

iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.

iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.

38. The court went on to emphasise (at [128]) that the average consumer was not "some form of mathematical average".

82. In view of the above, the potential for an alternative view as to the perception of the marks may be relevant if a sufficiently significant number of average consumers take that alternate view [and are also then confused]. However, whilst recognising this, I come to the view that it is highly unlikely that any significant numbers of people will see Jolly Fox as a reference to a person with the surname Fox. I come to the same view as to average consumers that would see "FOX'S" as a reference to the animal. It is therefore not likely that the alternative perceptions will lead to confusion that is sufficiently significant.

83. Visually, both marks contain the letters FOX/Fox, albeit as the second word in Jolly Fox and the first part of FOX'S. This creates an obvious aspect of visual similarity. However, there are also some differences, most notably the addition/absence of the word Jolly, but, also, the "s" in the opponent's mark. I consider this equates to a medium level of visual similarity. I consider the same analysis to run through the aural assessment with, again, a medium level of aural similarity.

Distinctiveness character of the earlier marks

84. 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 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of

other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

85. From an inherent perspective, the primary significance of FOX’S is, as already stated, a surname. Whilst surnames do not make for trade marks with the highest degree of inherent distinctiveness, there is no reason to accord them a low level either. I consider the earlier mark to have an average degree of inherent distinctive character.

86. I made some factual findings earlier with regard to the opponent’s evidence, including that the mark was likely to be reasonably well known by average consumers in the UK. Consequently, I consider that the earlier mark will have an enhanced (high) degree of distinctive character but only in relation to (sweet) biscuits.

Likelihood of confusion

87. 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.

88. Where there is no similarity between the goods/services then the opposition must be rejected¹. However, what remains are various goods/services with greater or lesser degrees of similarity. In some cases the goods are identical. To facilitate the understanding of my decision I will firstly pick out two scenarios. The first will be in relation to pizza as the goods are identical, but the opponent’s reputation is not relevant in that assessment. The second is in relation to biscuits where, again, the goods are identical, but the opponent’s reputation is relevant.

89. In relation to pizza, the fact that the goods are identical is important because this has the capacity to offset a lower degree of similarity between the marks. There will be an average level of attention paid to the purchasing process and the earlier mark

¹ See, for example, *Waterford Wedgwood plc v OHIM* (Case C-398/07).

is averagely distinctive for pizza. I must take into account imperfect recollection, however, even after weighing all these factors, I do not consider that the marks will be confused. The different conceptual messages that the marks send is sufficient to enable the average consumer to distinguish between them. Whilst I accept that a conceptual difference does not always counteract visual and aural similarities², in this case I consider it to be sufficient to counteract the medium degree of visual and aural similarity that exists. This conceptual counteraction assists to rule out both direct and indirect confusion.

90. In relation to biscuits, the added ingredient is the opponent's reputation. The principle is that the more distinctive the earlier mark (either inherently, or in this case through use) the greater the likelihood of confusion. I have fully borne this factor in mind, but come to the view that the added factor is not sufficient to lead to a likelihood of confusion in these proceedings. The conceptual difference still exists. Therefore, notwithstanding the high degree of distinctiveness the earlier mark has in relation to biscuits, I do not consider that the average consumer is likely to be confused – they will still distinguish between the marks for the reasons I have already given.

91. Given the above findings, the opposition under section 5(2)(b) fails in relation to pizza and biscuits and, by extension, fails in relation to all of the goods and services applied for.

92. For sake of completeness I add two points:

- i) I have fully considered the alternate concepts identified in paragraph 80 above and my summary of the case-law relating thereto in the subsequent paragraph. Even if I am wrong on the degree to which the alternative concepts will be perceived, I still consider that the level of perception will be relatively low and that the numbers of such people who will then go on to be confused will be even lower (due to the other differences between the marks) such that I am not satisfied that there will be a significantly sufficient level of confusion.
- ii) Even if I am wrong in relation to biscuits and the opposition should have succeeded, such a success would be extremely narrow, limited, in my view, to sweet biscuits.

Section 5(4)(a)

93. Section 5(4)(a) of the Act reads:

“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

² See, for example, *Nokia Oyj v OHIM* (Case T-460/07).

(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.”

94. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s 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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

95. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

96. Whether there has been passing-off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

“165. There is a further complication, however. Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into

account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

97. The above related to a community trade mark, however, the same applies, *mutatis mutandis*, to a UK national trade mark. The filing date of the subject trade mark is 9 March 2014. There is no evidence of any pre-filing use so, the matter need only be assessed as of 9 March 2014.

Misrepresentation

98. Given the findings I have already made with regard to the opponent’s evidence, I accept that at the relevant date the opponent had a strong goodwill associated with the sign FOX’S in relation to (sweet) biscuits. The relevant test for misrepresentation was outlined by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’[product]”

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol.48 *Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden’s Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

99. In comparison to section 5(2)(b) of the Act, the test still requires consumers to believe that the goods come from the same (or related) sources. Albeit, the test is now one-directional, in that those consumers must believe that the goods of the applicant are the responsibility of the opponent (or that there is an economic connection). I accept that there is a difference in the relevant tests in that under section 5(2)(b) one is making the assessment from the perspective of the average consumer whereas under passing-off one is concerned with a “substantial number of members of the public”. However, without debating how different these tests actually are, I consider that whatever way one looks at it, the opponent has not established that a substantial number of persons would be deceived. For similar reasons to that

already expressed, I consider that notwithstanding the opponent's strong goodwill in the field of sweet biscuits, the differences between the marks and their conceptual significances means that even if the applied for mark were used in relation to biscuits, there would be no assumption that the goods are those of the FOX'S brand. **The opposition fails under section 5(4)(a).**

Section 5(3)

100. Section 5(3)³ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Reputation

101. The earlier mark⁴ must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

102. Consistent with my earlier findings, I consider that the earlier mark meets the requirement for a reputation, albeit in relation to sweet biscuits, even bearing in mind that the relevant test for a CTM is to establish a reputation in a substantial part of the territory of the EU⁵

The required link

103. In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes

³ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01).

⁴ As per section 5(2), I will focus on the opponent's CTM.

⁵ See, for example, *Pago International* (case C-301/07)

a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 General Motors [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, SABEL, paragraph 22, and Marca Mode, paragraph 40).”

104. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

Similarity of marks

105. The marks are similar to a medium degree from a visual and aural perspective, but are conceptually different.

The goods and services

106. Many of the goods and services are similar, albeit to varying degrees as assessed earlier. Some of the goods are identical.

Reputation and distinctive character

107. The earlier mark has an average level of inherent distinctness. There is a strong reputation in the field of sweet biscuits.

Likelihood of confusion

108. There is no likelihood of confusion.

Link or not?

109. In my view there will be no link. Even measured from the perspective of the biscuits in the application, the conceptual message of Jolly Fox will not bring the opponent's FOX'S branded biscuits to mind. The position is even stronger for the other goods.

The heads of damage

110. In case of appeal I will, nevertheless, give my views on the heads of damage. On the assumption, against my above finding, that a link will be made, I come to the view that it will only be made in relation to biscuits. There are three potential heads of damage under section 5(3) to consider. They are often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07), *L'Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”

Tarnishing

111. I see no reason why the use of Jolly Fox on biscuits would tarnish the opponent's image. There is no need to say any more about this.

Free-riding

112. I see no reason why the use of Jolly Fox would gain any leg-up or unfair advantage. If consumers do not confuse the marks, then I see no reason why the job of marketing Jolly Fox biscuits is made any easier.

Dilution

113. I do not see how the use of the applied for mark will make the opponent's mark any less capable of distinguishing the goods for which it has a reputation or making it any less distinctive.

Conclusion

114. All the grounds of opposition have failed. The opposition is rejected.

Costs

115. The applicant has succeeded and is entitled to a contribution towards its costs. I bear in mind, though, that the applicant represented itself (so would not have incurred legal costs) and, furthermore, it played a limited part in the proceedings beyond filing its counterstatement. My assessment is as follows:

Preparing a statement and considering the other side's statement - £150

Considering evidence - £150

Total - £300

116. I therefore order Northern Foods Grocery Group Limited to pay Jolly Fox Limited the sum of £300. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of September 2015

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