

**O-615-16**

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTERS OF:**

**I) TRADE MARK APPLICATION 3106835  
BY JOSEPH DOBSON & SONS LIMITED  
TO REGISTER THE FOLLOWING MARK IN CLASS 30**

**YORKSHIRE MIXTURES**

**AND**

**OPPOSITION THERETO (NO. 404988) BY MAXONS LIMITED**

**&**

**II) TRADE MARK APPLICATION 3125974  
BY MAXONS LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 30**

**Maxons Yorkshire Mixture**

**AND**

**OPPOSITION THERETO (NO. 405762) BY JOSEPH DOBSON & SONS LIMITED**

## **Background and pleadings**

### *The first application*

1. The trade mark **YORKSHIRE MIXTURES** was filed by Joseph Dobson & Sons Limited (“Dobson”) on 1 May 2015. It was published for opposition purposes on 5 June 2015. Registration is sought for “boiled sweets” in class 30.
2. Maxons Limited (“Maxons”) opposes the registration of the mark. Its grounds for doing so are based on sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). The central theme of the grounds is that the term Yorkshire Mixtures has been used by a number of third parties for more than 60 years in respect of a mixture of boiled sweets, originally invented in Yorkshire and now predominantly manufactured in and around the county. The mark is said to be descriptive (3(1)(c)) and widely used (3(1)(d)) and, consequently, is devoid of distinctiveness (3(1)(b)).
3. Maxons also initially pleaded a ground under section 5(4)(a) based on its claimed use of the sign YORKSHIRE MIXTURES. However, this claim was withdrawn after the evidence rounds were complete.

### *The second application*

4. The trade mark **Maxons Yorkshire Mixture** was filed by Maxons on 8 September 2015. It was published for opposition purposes on 25 September 2015. Registration is sought for “confectionary; confectionary products; boiled sweets; non-medicated sweets. [sp]”
5. Dobson opposes the registration of the mark. Its grounds for doing so are based on sections 5(2)(b), 5(3) and 5(4)(a). It relies on the following marks/signs: UK trade mark 3106835 (the first application above) for the mark **YORKSHIRE MIXTURES**; European Union trade mark (“EUTM”) 014197271 for the mark **YORKSHIRE MIXTURES**; EUTM 14024211 for the mark **JOSEPH DOBSON YORKSHIRE MIXTURES**; and, finally, the sign **YORKSHIRE MIXTURES**, which is claimed to have been used since at least the 1920s. It should be noted that the EUTM for **YORKSHIRE**

**MIXTURES** has now been refused by the EUIPO following receipt of third party observations. In its written submissions, Maxons asks that the tribunal follow the decision of the EUIPO in refusing Dobson's mark. Whilst the decision is, of course noted, I must come to my own decision based upon the evidence and arguments before me - the matter cannot be resolved on a first past the post basis.

6. Both sets of proceedings were defended by the respective applicants. The proceedings were consolidated. Both sides filed evidence. Both sides have been professionally represented throughout the proceedings. Neither side requested a hearing, both opting to file written submissions instead.

### **The evidence**

#### **Maxons' evidence**

7. A witness statement was filed by Mr Christopher Pitchfork, a director of Maxons. He states that Maxons can trace its roots back to the 1840s in the field of manufacturing and wholesaling confectionery. In its current form, Maxons has been selling YORKSHIRE MIXTURE since the 1930s and Mr Pitchfork explains that in those days most other manufacturers had a Yorkshire Mixture, or something similar, as an effective way of disposing of extra bits of production. He adds that this created an attractive and changing selection of sweets as opposed to just a single product such as pear drops or humbugs.

8. It is stated that YORKSHIRE MIXTURE became popular in its own right so the make-up became formalised by each company, albeit in differing ways. Maxons' version (both branded and those made for other people) contained chopped rock and fish (a fish shaped sweet, not an actual fish). Mr Pitchfork states that other companies do not include these items due to an absence of production skills/moulds.

9. Exhibits 1 and 2 contain photographs from roughly the same period in the mid-1950s. They relate to the opening of a new showroom for a company called Ralph Pitchfork Ltd (an associate company of Maxons). They depict jars of sweets,

promotional material, the showroom and the warehouse; jars of Maxons Yorkshire Mixture are depicted.

10. Exhibit 3 contains price lists from the early 1960s for Maxons and, also, three other companies: F&M Dobson of County Durham (this company has nothing to do with Dobson), WA Palmer & Sons of Hull and NJ Harvey of Conisborough. The price lists all contain an entry for Yorkshire Mixture/s, alongside other typical descriptions of sweets. It should be noted that three of the price lists were missing from the evidence when first filed – this was highlighted by Dobson in its written submissions which led Maxons to subsequently provide the price lists. The tribunal notified the parties that the price lists could be taken into account, subject to Dobson being provided with an opportunity to make written submissions on their content. Dobson made such written submissions, but its primary position was that the price lists should not be admitted. It took this point to a case-management conference (“CMC”) before me on 15 December 2016. Maxons did not attend, but stated in writing that it relied on what it had already said about the missing price lists in its letter dated 1 November 2016. Whilst I agreed with the points made by Dobson at the CMC to the extent that it was not its responsibility to have highlighted the mistake earlier, nor was it the responsibility of the tribunal to do so, I nevertheless allowed the price lists to be admitted. I did so because, although the letter of 1 November 2016 does not give chapter and verse on how the mistake happened, it is implicit that this is all that this is. A simple mistake. Whilst mistakes are regrettable, they happen. I was satisfied that the mistake had been rectified as quickly as possible and that Dobson was not prejudiced in any way. The price lists will be considered. Dobson’s comments on their substance will likewise be taken into account.

11. Returning to the evidence, Mr Pitchfork states that over the intervening years a large number of small, family based sweet manufactures have either closed, or been absorbed into larger concerns. None of the companies in the preceding paragraph (other than Maxons) exist today. He states that there are just a handful of independent boiled sweet makers in existence, mostly based in the north, and most, Maxons, Dobson, Barnetts and Willetts, manufacture a Yorkshire Mixture. Mr Pitchfork states that two of these are not even based in Yorkshire, Barnetts being in Nottingham and Willetts in Chesterfield.

12. Mr Pitchfork states that by the 1970s, the increase in mechanisation meant that larger more mechanised companies stopped making mixtures as it became too expensive and fiddly. Nevertheless, Maxons was selling throughout the country, delivering with a fleet of vehicles which were covered in the artwork for the labels used on its sweet jars. Exhibit 4 shows a photograph of a delivery vehicle, but it is not clear whether the artwork on the side of the vehicle depicts Yorkshire Mixture or not.

13. It is stated that the number of manufacturers has declined since the heyday of the 1960s and 70s but there has been a similar (but not equal) rise in the volume and value of own labelling and contract manufacturing. Explanation is given by reference to supermarkets where as much product is sold under the supermarket name as there is under the branded and household name of the product. An example of what I assume is contract manufacturing is given with reference to the company J Bottomley & Sons of Keighley ("Bottomley"). Mr Pitchfork states that Bottomley has been manufacturing boiled sweets, including Yorkshire Mixture, since the middle of the 19<sup>th</sup> Century. The business moved out of family hands and eventually they ceased manufacturing. However, the business still wished to retain their brand name and the products they made. It is stated that Maxons began manufacturing for Bottomley. Exhibit 5 contains a copy of Bottomley's 1981 price list showing Yorkshire Mixture. Exhibit 6 contains a photograph of the manufacturing contract. Mr Pitchfork highlights the stipulation that the Yorkshire Mixture should be manufactured as near as possible to Bottomley's recipe and appearance and that the agreement included the sale of equipment to make Bottomley's Yorkshire Mixture. Mr Pitchfork states that to this day Bottomley's Yorkshire Mixture is markedly different to Maxons. It is now sold exclusively to FW Bishop & Sons of Bradford, who bought the Bottomley name (see Exhibit 7). The firm is now owned by M&M Value of North Shields.

14. Mr Pitchfork states that Yorkshire Mixture now accounts for 13.3% of annual turnover of Maxons, amounting to over £662k in the last five years (a breakdown of those five years is provided).

15. In addition to manufacturing Maxons' own version of Yorkshire Mixture, and that of Bottomley, manufacturing (of Yorkshire Mixture) has also been carried out under the Kingsway own brand of Hancock's Cash & Carry. This, and the product of Maxons,

has nationwide distribution. Exhibit 8 contains what Mr Pitchfork calls a testimonial from Hancock's. This comprises an email from a Mr Mark Robinson who states that Yorkshire Mixture is an important product sold across its depots (20 of them) nationally. They have been selling it under its own brand, Kingsway, for 30 years.

16. Reference is made to two other national cash and carry/wholesale chains – Booker and Batley's. Maxons has a national listing in Batley's for Yorkshire Mixture (Exhibit 8.1 contains invoices showing the sale of Yorkshire Mixture) and a listing in Bookers covering the north Midlands up to the Scottish borders. He adds that sales of Yorkshire Mixture is as strong in Lancashire as it is in Yorkshire.

17. Mr Pitchfork states that over the last 20 years the growth of Yorkshire Mixture was caused by two factors. First, its sale as an attractive own label product, second as a popular branded line, sold retail ready in multiple retailers. With regard to own label business, Maxons supplies a growing number of customers who appreciate its Yorkshire Mixture. Exhibit 9 contains three testimonials from some of its long term customers described as:

- i) Fosters Traditional Foods of Market Harborough, a leading distributor of quality foods who sell a number of their own brands including Fosters and the Fudge Tree. They also sell "a product that is personalised to the individual retailer". A letter is provided from them in which it is stated that Yorkshire Mixture is a generic product that it has bought from Maxons for around six years. They buy it in bulk then re-pack in house into smaller bags/jars, it is resold under the Yorkshire Mixture name.
- ii) Farrah's of Harrogate, who specialise in confectionery gifting. They supply Yorkshire Mixture under their own name, Farrah's, as well as under personalised branding and labelling for their many customers. For example, it might be sold as Lincoln Cathedral Yorkshire Mixture or House of Commons Yorkshire Mixture. A letter is provided which states that they have sold Maxons' Yorkshire Mixture to over 300 customers in many different market sectors. They have been buying from Maxons for over 15 years.

- iii) Sunshine Snacks of Rochdale who buy product in bulk from many suppliers for re-bagging and sale under their own name, Sunshine Snacks, which they supply up and down the country. A letter is provided in which it is stated that Yorkshire Mixture is just one of a number of generic products that it has in its stable which is successfully distributed around the UK. The letter writer states that the composition and quality [of Yorkshire Mixture] varies by manufacturer. At one point they tried to market Lancashire Mixture but this failed as people wanted Yorkshire Mixture.

18. In terms of retail ready packaging, Maxons has been supplying Asda and Tesco on a regional basis for 7 years, both directly and via a hub/consolidator called Locally Sourced Food Company. A letter from that business is provided in Exhibit 10 stating as much. I note that reference is made to the product being popular in the four counties of Yorkshire.

19. Maxons Yorkshire Mixture is also sold on the Internet, with Mr Pitchfork explaining that this is often carried out by small independent sweet shops. They have been selling on Amazon.co.uk for around 5 years. A breakdown of online sales is given, rising from just under £1k in 2011 to £12k in 2015. It is also stated that since 2012 Maxons has supplied 99p Store and Poundworld chains and has a listing in the Co-operative foods stores as part of its Yorkshire wide trial for regional foods. It also has national listings with Netto and One-Stop. All of the foregoing has been under the Maxons brand.

20. Exhibits 10 and 11 contains various prints as follows:

- A print from the website willetts-sweets.com showing a jar of sweets which uses the name Yorkshire Mixture. An accompanying description reads “A real Yorkshire Mixture made on the Yorks/Derb Border”.
- A print from the website barnettsconfectionersltd.co.uk showing pictures of sweets including Yorkshire Mixture (the others are sour apples, small pear drops, cola cubes etc).

- A print from the website [appletonsweets.co.uk](http://appletonsweets.co.uk) which depicts a jar of Barnett's Yorkshire Mixture. The accompanying description is headed Barnett's Yorkshire Mix and is described as a variety of Yorkshire themed boilings.
- A print from the website [foster-foods.co.uk](http://foster-foods.co.uk) showing a packet of sweets with the name Yorkshire Mixture. The accompanying description reads "Personalised Sweet Shop Yorkshire Mixture Bag" and another print from the same website showing "Fudge Tree Bags Yorkshire Mixture", although Yorkshire Mixture does not appear to be written on the packet itself.
- A print of a product description for SUNSHINE SNACKS YORKSHIRE MIX.
- A print from of a product range produced by Farrah's showing jars of various sweets including Yorkshire Mixture. The idea is that the label can be amended to add a retailer's own label.
- A print from the website [aquarterof.co.uk](http://aquarterof.co.uk) for a product identified as Yorkshire Mixture. The accompanying description reads "Yorkshire Mixture- just as its name suggests, this is a colourful mix of scrummy boiled sweets made in the very heart of Yorkshire Mixture Land...Yorkshire".
- A print from the website [thetraditionalsweetshop.co.uk](http://thetraditionalsweetshop.co.uk). The product being sold is identified as Yorkshire Mixture. The accompanying text reads "The Yorkshire Mixture is well known to us, being a traditional sweet shop in Yorkshire. You will find pear drops, fruits, humbugs and of course the fish".
- A print from the website [hancocks.co.uk](http://hancocks.co.uk) depicting Kingsway Yorkshire Mixture.
- A print from the website [thesweetiejar.co.uk](http://thesweetiejar.co.uk) for a product identified as Yorkshire Mixture. No jars or packets are shown.
- A print from the website [bestbritishsweets.co.uk](http://bestbritishsweets.co.uk) with an entry for Yorkshire Mixture described as a "wonderful mix of traditional boiled sweets...".



- A print from the website [thewhistlestopsweetshop.co.uk](http://thewhistlestopsweetshop.co.uk) for a product identified as YORKSHIRE MIXTURE with a description reading “Nothing is more traditional than the humble Yorkshire Mixture”.
- A print from the website [bahhumbugs.co.uk](http://bahhumbugs.co.uk) for a product identified as Yorkshire Mixture.
- A print from the website [grumpyssweetshop.co.uk](http://grumpyssweetshop.co.uk) for a product identified as Yorkshire Mix with a description reading “famous Yorkshire mix, an assortment of boiled sweets originating from the home of boiled sweets.”
- A print from [oldestsweetshop.co.uk](http://oldestsweetshop.co.uk) for a product identified as Yorkshire Mixture with a description reading “a classic selection of traditional boilings...”
- Two prints from [amazon.co.uk](http://amazon.co.uk) for a jar of sweets showing Maxons Yorkshire Mixture.

21. Exhibit 12 contains a photograph taken, apparently, on 13 November 2015 which is said to be of a sweet isle at an unidentified Tesco store. It apparently shows both Dobson’s and Maxons’ Yorkshire Mixture/s being sold, although, I cannot make this out in the print provided to the tribunal. Exhibit 12 also contains a print from the website [handycandy.co.uk](http://handycandy.co.uk) depicting Maxons Yorkshire Mixture, a print from [mysupermarket.co.uk](http://mysupermarket.co.uk) showing the same, and a print from [online-sweets.co.uk](http://online-sweets.co.uk) again showing the same.

22. Mr Pitchfork states that his evidence shows the industry wide use of the term. Although there may only be four manufacturers left, he states that it still exists in many forms and is sold under multiple brands.

23. Mr Pitchfork states that it is probably impossible to truly establish when the product and name came into being. He states that some of the stories are fanciful at best, often bearing a remarkable similarity to the accidental “invention” story of another confectionery mixture, liquorice allsorts. He says regardless of any claims made about the invention of the product, there were at least 8 manufacturers in the 1960s and perhaps more. He states that given that there were so many boiled sweet makers in

and around Yorkshire, the name probably just came from retailers describing a mixture of fruity sweets and describing them as a Yorkshire Mixture. He states that given the use of the name and it being in the public domain, it is not capable of functioning as a trade mark and, in any event, is a descriptive term.

24. A witness statement was also filed by a Mr Stewart Pitchfork, another director of Maxons, together with two exhibits. His evidence is about attending the Great Yorkshire Show in Harrogate (information about the show is provided in Exhibit 1) where Mr Pitchfork manned a stand organised by the Co-op. There is a picture of the stand (and Mr Pitchfork) in Exhibit 2. On this fairly small stand, there is a sign for Maxons, some bowls of sweets (one of which he says is Yorkshire Mixture) with a bag of the product also on the stand. Mr Pitchfork states that he was on the stand for around 2 hours. He says many people spotted the Yorkshire Mixture sign from some distance, but I find this hard to believe because the only Yorkshire Mixture sign is on the sweet packet which will be very difficult to see from distance. He states that around 20-30 people remarked (most of which he says were unprompted) upon the product. Remarks included, apparently, that it was great to see the proper Yorkshire Mixture (especially including the fish), that the rock was a sign of it being a proper Yorkshire Mixture and that no other Yorkshire Mixture matches up to Maxons. Mr Pitchfork states that he asked a few people whether they had tried Dobson's version and most said that they had not heard of them and didn't know they made Yorkshire mixture style sweets.

### **Dobson's evidence**

25. Two witnesses have given evidence on behalf of Dobson, Ms Miriam Walshaw and Mr Paul Brandon, both of whom filed two witness statements. I will deal first with the evidence of Ms Walshaw.

26. Ms Walshaw is a director at Dobson. She explains that it was incorporated in 1913, but its origins date to 1850 when the business was first set up by her great, great grandfather, Joseph Dobson. Prints from Dobson's website are provided setting out this history in Exhibit MEW1, which also shows two photographs of early jars of sweets, one containing humbugs, the other Yorkshire Mixtures. Whilst the Dobson's

name can be made out, I cannot make out humbug or Yorkshire Mixtures on the jars. She states that the Yorkshire Mixtures product was created by Thomas John Dobson, who was born in 1869 and died in 1941 (his birth and death certificates are provided in Exhibit MEW2). She states that the sweets/name were created by accident due to Thomas Dobson falling down the stairs and accidentally mixing sweets up. An extract from Dobson's website is provided in Exhibit MEW3 detailing this story. Exhibit MEW4 contains an extract from an unpublished book that was written 25 years ago, also recounting the story and that Thomas Dobson named his accidentally created mixture Yorkshire Mixtures. Another recounting of the story is given in Exhibit MEW5 from a book called A History of Elland, published in 1980. There is also reference to the story in Exhibit MEW6, a newspaper article from 1949 which includes the text "Mr Dobson claims that he originated Yorkshire Mixtures".

27. Ms Walshaw states that the sweets in Dobson's Yorkshire mixtures are specifically chosen in line with the assortment jumbled up by Thomas Dobson. It is not a way of disposing of extra bits of production. She states that the assortment has remained largely unchanged. Dobson was manufacturing rock at the time and also had (and still has) a large selection of roller die shapes to manufacture the sweets. She adds that if a different assortment were to be used then this would weaken the brand because customers recognise the various sweet types, therefore, "any change of variation would likely lead them to believe that they are purchasing/consuming another product, and not the original Yorkshire Mixtures created by Joseph Dobson. It is explained that Yorkshire Mixtures contain 18 types of sweet and have become "highly regarded as the "original" Yorkshire Mixtures, as it were".

28. Ms Walshaw "understands" that over the years other manufacturers have tried to copy Dobson's Yorkshire Mixtures but as they did not have a wide variety of dies, they started to add chopped rock. She states that this is not a reflection of Yorkshire mixtures but merely a copy of Dobson's original selection. She adds that all Yorkshire Mixtures made by Dobson are supplied and sold under our brand as being the original Yorkshire Mixtures.

29. An order form from the 1920s is provided in Exhibit MEW7 showing Yorkshire Mixtures alongside a host of what are well-known types of sweets (lemon drops,

humbugs etc), although, there are some products which are not obviously descriptive/generic (e.g. Alexandra Kisses). Various exhibits are then referred to:

- MEW8 is an extract from a Report of City & County Analysts from 1927 showing an entry for the name Crystallised Mixtures which is explained as an another early name for Yorkshire Mixtures.
- MEW9 are extracts from old order books for products identified as MIX or MIXTURES which was, apparently, used as an abbreviation for Yorkshire Mixtures – it is stated that the abbreviation is still used today at Dobson's factory.
- MEW10 contains letters sent to Dobson in the late 1940s early 1950s which refer to Yorkshire Mixtures or Mixtures.
- MEW11 contains a picture of some early packaging (similar to that referred to earlier) in which the main name on the tin is Dobson's. Yorkshire Mixtures is presented below this within a square with Yorkshire printed above Mixtures, Yorkshire being in smaller font.
- MEW12 shows more recent packaging, depicting a packet of sweets. The company name is used (in stylised script) below which are the words YORKSHIRE MIXTURES (one word above the other). The same appears on various jars.

30. Ms Walshaw states that the brand has grown significantly. Sales figures for Yorkshire Mixtures are provided between 2009 and 2015, with turnover ranging between £350k and £410k. The goods are said to be sold around the country in supermarkets and various other retail outlets. More exhibits are referred to as follows:

- MEW13 contains various invoices from over the years showing Yorkshire Mixtures. It is often the case that the invoices also list sweet names such as humbugs and sherbet pips.

- MEW14 contain further orders placed by Morrison's and Sainsbury's showing Yorkshire Mixtures. The name is alongside items such as mint imperials, but also voice tablets and Mintoes.
- MEW15 contains price lists from 1982 and 1985 showing Yorkshire Mixtures. Again, other names on the list include typical sweets (humbugs and pear drops) but also names like Mintoes and Tingle Tots.
- MEW16 contains delivery notes from 2016 for orders which include Yorkshire Mixtures.
- MEW17 contains an example of Dobson's product for sale on the Internet, specifically amazon.co.uk.

31. Ms Walshaw states that advertising campaigns and supermarket promotions have been carried out leading to Yorkshire Mixtures being known and recognised as a product belonging solely to Dobson's. Exhibit 18 contains a letter from the Confectionery Journal from 1954 asking for information from Dobson's regarding what entries are to be made in this trade publication. Amongst the requested information are the details of principal lines and details of BRANDED specialities. The response only provides information for the former not the latter. Yorkshire Mixtures is one of the principal lines mentioned, along with lozenges, mints and fruits drops.

32. Exhibit MEW19 contains an extract from the website of Maxons which Ms Walshaw highlights an entry indicating that they have only been manufacturing since the 1950s and that in this extract there is no mention of Yorkshire Mixtures.

33. Ms Walshaw states that Dobson has built a reputation and goodwill for over 120 years in respect of Yorkshire Mixtures. She states that is it not a descriptive term. An accurate description would be "sweet mixtures" or "boiled sweet mix". She states that Yorkshire Mixtures is distinctive particularly having regard to the history as to how it came about. Reference is made to the examination of the subject application and that it was accepted prima face (Exhibit MEW20 contains relevant extracts from the examination phase of the application).

34. In her second witness statement, some of the above information is repeated. She provides a print from Companies House showing that Maxons was not incorporated until 1975 and refers, again, to its history as per the evidence from Maxons' website. She states that Dobson has been selling Yorkshire Mixtures for far longer. She states that because Maxons' product does not contain the variety of different sweets devised by Thomas Dobson then they are not really Yorkshire Mixtures. She reiterates her understating that other manufacturers have sought to bring out versions of YORKSHIRE MIXTURES but they add rock (which Dobson never has) to increase colour etc. Unlike Maxons, Dobson does not manufacture for other companies, whereas Maxons appear happy to manufacture any mixture required to make up a Yorkshire Mixture selection of a customer's choice. However, "the original Yorkshire Mixtures product, belonging to Joseph Dobson & Sons Limited, have remained essentially unchanged and to this day contain the original selection".

35. In response to Mr Pitchfork's evidence about his attendance at the Yorkshire Show, Ms Walshaw states that she also attended the show and samples of Dobson's Yorkshire Mixtures product were given out. She recounts that a member of staff had overheard some comments from members of the public to the effect that Maxons' product was not the real Yorkshire Mixtures, "but let's hope that Dobson's will be coming too". She also refers to undertaking at supermarkets some promotional activities where samples were provided and where comments were, apparently, made along the lines of "your Yorkshire Mixtures are simply the best" and "why does the other company use the name YORKSHIRE MIXTURES when they put pieces of rock in which is not how we remember the original Yorkshire Mixtures".

36. Ms Walshaw states that when she made her first statement, Maxons had nothing on its website regarding Yorkshire Mixtures, but now it does. She highlights that Maxons product contains certain ever present items, but that the composition will change, thus, they are not in fact Yorkshire Mixtures. She states that Dobson's product has remained largely unchanged.

37. A number of emails/letters are provided in Exhibit MEW26, they date from 2007 to the present day. The writers have clearly enjoyed the Yorkshire Mixtures product that Dobson have provided. Some of the writers refer to the old-fashioned nature of

the product, reminding them of their childhood. One complains about other so-called Yorkshire Mixtures (presumably because they are not as good as those of Dobson) and another compares them to Maxons version, which the writer feels are not as good.

38. Mr Brandon is a trade mark attorney at Appleyard Lees. His evidence is to provide details of UK and EU trade marks which have been registered and which contain the word YORKSHIRE including: YORKSHIRE TEA, YORKSHIRE CRISPS, YORKSHIRE SAUCE, YORKSHIRE POPCORN, YORKSHIRE WATER CRACKERS, YORKSHIRE CRACKERS, YORKSHIRE BANK and YORKSHIRES. In his second witness statement he provides details of a mark consisting of the words SHROPSHIRE MIXTURE. I will come back to this evidence to the extent necessary.

### **Maxons' opposition to Dobson's application – sections 3(1)b), (c) and (d)**

39. These provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character”, “..consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services” or “consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.

40. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use.

41. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and

requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

42. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in*



*the Internal Market (Trade Marks and Designs) (OHIM) (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and Lego Juris v OHIM (C-48/09 P) , paragraph 43).*

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM (C-80/09 P)*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

and

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

43. In terms of section 3(1)(d), in *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case-law of the CJEU under the article 7(1)(d), the equivalent of section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly

refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

44. I also note that use by others as a brand name is not enough to engage section 3(1)(d). In *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch, Floyd J. stated that:

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using

the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

45. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case

C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

46. Before coming to the legal assessments, it is worthwhile setting out what I consider the evidence to show.

47. It is clear that both Maxons and Dobson have been selling a Yorkshire Mixture (Maxons) or Yorkshire Mixtures (Dobson) for a lengthy period of time. It is the name given to the mixture of boiled sweets that are contained within the jar or packet being sold. It is clear that the sweets contained in the respective mixes are not exactly the same. Different compositions are used and it is fair to say that Dobson's version has a more consistent composition whereas Maxons' version may have greater variance albeit it always contains some core sweets, including a fish. I should add that the evidence relating to the incorporation of Maxons only taking place in 1975 is noted, however, I nevertheless accept that earlier incarnations of the business have used the name. Given that Maxons is not claiming any proprietary rights in the name, I do not consider that anything turns on this. The primary point of longstanding use by the two parties (or predecessors) remains the same. On the basis of the figures provided in evidence, Dobson appears to sell more of its Yorkshire Mixtures than Maxons has sold of its Yorkshire Mixture; that being said, Maxons' sales are not insignificant.

48. In terms of who used the name first, whilst the exact historical context is not entirely clear, I am prepared to accept that Dobson (or a predecessor firm) used it first. Indeed, in its submissions Maxons does not dispute this. Whether the accidental

creation story that Dobson relies on is true or not, I accept that the story has been passed down and repeated over the years. However, I do not consider that much hinges on this, particularly given that the number of consumers who may know of the story is not known. In any event, even if the story is true, it does not follow that this nullifies Maxons' claims in terms of distinctiveness etc.

49. I accept that, over the years, other manufacturers have also produced their own version of Yorkshire Mixture. There is nothing in Dobson's evidence which counters this, indeed, as noted earlier, Ms Waltham "understands" that over the years other manufacturers have tried to copy Dobson's Yorkshire Mixtures. Dobson, in its further submissions, highlights that the missing price lists do not show current use, but they nevertheless add to this historic context. It is also argued that such use is simply copying, I will return to this point later.

50. I also accept that two other manufacturers, Barnetts and Willetts, now manufacture and sell a version of Yorkshire Mixture. In reaching this view I have guarded against the fact that the web prints showing the use of the name Yorkshire Mixture by these two manufacturers is not in archive form showing use before the relevant date (the application date). However, on the basis of Mr Pitchfork's commentary setting out what has happened in the trade over time, I am prepared to accept that the use by Barnetts and Willetts is not something that has occurred only after the relevant date. Again, there is nothing in Dobson's evidence to counter this. The scale of this use is not, however, clear.

51. I also accept that Maxons' has manufactured Yorkshire Mixture for other companies to re-badge and sell-on. These end products include those sold by Fosters, Sunshine Snacks, Farrah's and Kingsway. I also accept that unbranded Yorkshire Mixture has been sold by sweet sellers as per Mr Pitchfork's evidence, presumably supplied by Maxons. Examples can be seen in the web-prints of aquarterof, thetraditionalssweetshop, thesweetiejar, whistlestopssweetshop, bestbritishsweets, bahhumbugs, grumpysweets and oldestssweetshop. The point I have already made about the prints not being archive prints applies here also – it is highly unlikely that these companies only started buying and selling Yorkshire Mixture after the relevant date.

52. In its written submissions, Dobson highlights that the testimonies (consisting of letters and emails) from those in the trade who Maxons supply should be treated as hearsay evidence, the writers of these letters not having provided a witness statement. Whilst I accept the proposition that such evidence is hearsay, I will give it some weight, at least in terms of corroborating what Mr Pitchfork has explained about supplying such businesses.

53. I place little weight on the evidence about the comments made at the Great Yorkshire Show. This is the worst kind of hearsay. The full context of the conversations that took place is not clear and the witnesses will have no doubt just recounted the comments that suit their position the best. The same applies to the supermarket sample testing referred to in Dobson's evidence.

54. I also place little weight on the evidence of the earlier acceptances of marks which contain the word YORKSHIRE (and Shropshire). Although I understand Dobson's plea for consistency in its written submissions, as Maxons points out in its submissions, such precedents are largely irrelevant<sup>1</sup> and each case must be decided on its own merits. This is particularly so in a case such as this which contains evidence from both sides as to the merits of the opposition. I also add at this stage that Dobson's written submissions refer a number of times to the fact that the mark was accepted *prima facie* by the IPO examiner – this, again, has little weight.

### **Section 3(1)(d) of the Act**

55. Under section 3(1)(d), I must be satisfied that the sign YORKSHIRE MIXTURES is "...customary in the current language or in the *bona fide* and established practices of the trade". I set out some guidance from the case-law earlier. Further guidance can be seen in *Merz & Krell GmbH & Co* [2002] ETMR 21, where the ("CJEU") provided guidance on how this provision is to be interpreted:

"24 Accordingly, signs or indications that are not capable of fulfilling the essential function of a trade mark cannot enjoy the protection conferred by

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<sup>1</sup> As per the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281



registration. As is made clear by the tenth recital in the preamble to the Directive, the purpose of the protection afforded by the registered trade mark is in particular to guarantee that trade mark's function as an indication of origin.

25 Article 3(1)(d) of the Directive must be interpreted in the light of those considerations.

26 Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.

27 It is true that, unlike Paragraph 8(2)(3) of the Markengesetz, which refers to trade marks that consist exclusively of signs or indications which have become customary in the current language or trade practices “to designate the goods or services”, Article 3(1)(d) of the Directive contains no such qualification. It cannot, however, be concluded from that that, in order to assess the merits of an application for registration of a trade mark, account should not be taken of the connection between the signs or indications constituting the trade mark and the goods or services covered by that mark.

28 The purpose of Article 3(1)(d) of the Directive is to prevent the registration of signs or indications that are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and so do not satisfy the criterion laid down in Article 2 of the Directive.

29 The question whether particular signs or indications possess distinctive character cannot, however, be considered in the abstract and separately from the goods or services those signs or indications are intended to distinguish.

30 That finding is corroborated by Article 3(3) of the Directive. As the Court held at paragraph 44 of the judgment in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] E.C.R. I-2779*, it is through the use made of it that such a sign acquires the distinctive character which is a prerequisite for its registration under that provision. However, whether a sign does have the

capacity to distinguish as a result of the use made of it can only be assessed in relation to the goods or services covered by it.

31 It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.”

.....

41 It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

In *Stash Trade Mark* BL O/281/04, Prof Annand (sitting as the Appointed Person) provided further guidance, stating:

33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

56. I note that the examples of use relied upon by Maxons are mainly for the sign YORKSHIRE MIXTURE not YORKSHIRE MIXTURES (my emphasis), however, such

a difference is immaterial. Making a minor embellishment to a sign which would otherwise fall foul of the ground for refusal is unlikely to save the application - see, by analogy, *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc & Others* [2012] EWHC 1842 (Ch) and, also, *Micro Shaping Ltd v OHIM* – T-64/09.

57. I outlined earlier the *Nude* case and that use by others of a sign in a trade mark sense would not engage the ground of opposition. However, the manner of use here is not in that way. The manner of use will be perceived as the name of the sweets being sold. I accept the possibility that a sweet's name could be in a proprietary manner (for example, the evidence shows orders for the sale of a product named Mintoes), however, it remains the case here that a number of manufacturers/retailers use the name in question as an indication of the type of sweets and they also use it in the same manner as the name of other types of obviously generic types of sweets (pear drops etc).

58. Dobson argues that the name is exclusively associated with it, but that is difficult to reconcile (as Maxons say it in its written submissions) when it is clear that there are multiple users of the name. Dobson appears to have an understanding that use has been made by other traders (as per the comments made by Ms Walshaw), although, it considers such use to be an imitation of its product. I note that Dobson refers in its evidence to its product being “the original” Yorkshire Mixture/s. The use of the word “original” in this sense indicates an appreciation that there are others using the name, albeit that Dobson considers its version to be the original one. It also states that the Yorkshire Mixture produced by Maxons (and others) is not actually Yorkshire Mixture/s because it does not adhere to the composition first created by Thomas Dobson. Whilst I understand the point, it is clear from the evidence that over the years different manufacturers have produced Yorkshire Mixture/s with differing compositions so this does not impact upon my decision.

59. As to whether the amount of use presented is enough to constitute a customary/usual level of use, I answer this in the affirmative. Whilst Yorkshire Mixture/s may not be on a par with the likes of pear drops, cola cubes or dolly mixture, the level of use is sufficient to meet the customary test both in the current language

and practices of the trade to designate the goods of the application. **The ground of opposition under section 3(1)(d) succeeds.**

### **Section 3(1)(b) of the Act**

60. Given that the mark has fallen foul of section 3(1)(d), it follows that it also falls foul of section 3(1)(b). The customary use of the designation Yorkshire Mixture/s means that the mark will not perform the essential distinguishing function. I will, though, add one thing. If my finding under section 3(1)(d) is found to be wrong on appeal due to i) the difference created by Yorkshire Mixtures (as opposed to Yorkshire Mixture) immunises the mark from section 3(1)(d), and/or ii) the use is not customary enough, I would nevertheless still hold that the ground under section 3(1)(b) is made out. In terms of the difference between Yorkshire Mixture/Mixtures, such a difference is so small, and the nature of the difference a simple pluralisation, which means that the mark will still not function as a badge of trade origin. In relation to the customary point, the current level of use, together with the historic use over many years by multiple undertakings, a type of use which could well be remembered from childhood, is enough for me to conclude, again, that the mark will not function as a badge of trade origin as it will, instead, be seen as the name of a (non-proprietary) type of sweet. **The ground under section 3(1)(b) succeeds.**

### **Section 3(1)(c) of the Act**

61. The question here is whether the combination of words YORKSHIRE MIXTURES is simply a direct description of the goods or some characteristic(s) of them. There can be no doubt that the word MIXTURES is directly descriptive of sweets. It simply describes that the sweets are composed of a mixture of different ones. There can also be no doubt that the word YORKSHIRE is also directly descriptive. It simply describes the geographical origin of the goods, i.e. that the goods have been made or sourced from the geographical region of Yorkshire. Yorkshire is a large region of the UK, comprised of four counties. Even without Mr Pitchfork's evidence suggesting that Yorkshire is known (or at least has been known) as the centre of the boiled sweet industry in the UK, my view would be that the consumer will see a clear and direct descriptive message in the word YORKSHIRE. Much of Dobson's submissions

relating to the word Yorkshire are based upon the judgment of the CJEU in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97 from which it is highlighted that there must be an association (or possible future association) between the geographical name and the goods. This case is of course noted, but one of the tests outlined by the CJEU was whether it is "...reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods..". Given the size of the region and the nature of the goods I consider that the test must be answered positively.

62. My decision must, though, be based upon the combination of words. However, combining words does not necessarily provide them with a distinctive character under section 3(1)(c). In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the CJEU stated that:

"39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within

the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

63. Dobson submits that the mark as a whole is fanciful. I disagree. In my view, the mark is not more than the sum of its parts. As a whole, the mark will still be perceived as a descriptive combination, indicating that the goods are a mixture of boiled sweets which have been made or are sourced from the region of Yorkshire. That there may be other more apt terms does not make the combination inapt. Therefore, whilst my finding is academic (due to success already under the other two grounds of opposition), **the opposition additionally succeeds under section 3(1)(c).**

### **Distinctiveness through use**

64. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97 about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark,

it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

65. It is difficult to envisage a situation where a mark is debarred from registration under section 3(1)(d) yet nevertheless it is able to acquire a distinctive character through use. This is because to qualify for distinctive character through use, the use of the mark must identify the goods as originating from a particular undertaking. Whilst I accept that Dobson has used the mark, its use, along with others in the trade for many years, means that the mark will not signify trade origin in Dobson, it simply signifies that it is selling its version of Yorkshire Mixtures, regardless of whether or not it is regarded as the original version. The point can be further exemplified by considering the Case C-215/14, *Société des Produits Nestlé SA v Cadbury Uk Ltd*, where the CJEU considered a preliminary reference from the High Court which sought guidance about the legal test for showing that a trade mark had acquired a distinctive character. The CJEU understood the question as follows:

“By its first question the referring court asks, in essence, whether an applicant to register a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95 must prove that the relevant class of persons perceive the goods or services designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company, or whether it is sufficient for that applicant to prove that a significant proportion of

the relevant class of persons recognise that mark and associate it with the applicant's goods.”

The CJEU answered the question in these terms:

“In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company.”

In the High Court, Arnold J. stated that he understood this to mean that:

“...in order to demonstrate that a sign has acquired distinctive character, the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking *because of* the sign in question (as opposed to any other trade mark which may also be present).”

Additionally, that:

“...it is legitimate for the competent authority, when assessing whether the applicant has proved that a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question, to consider whether such persons would rely upon the sign as denoting the origin of the goods if it were used on its own.”

66. It is clear that the sign YORKSHIRE MIXTURES would not be relied upon alone to denote the trade origin of the goods. I also note Maxons' submissions based upon



the decision of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where he highlighted the “..unspoken and illogical assumption that “use” equals distinctiveness”. This is another case in point. **The use provision cannot be relied upon. The grounds succeed and Dobson’s application is to be refused.**

**Dobson’s opposition to Maxons’ application – sections 5(2)(b), 5(3) and 5(4)(a) of the Act**

67. 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.”

68. 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 greater 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.

69. Given that I have upheld Maxons' opposition to the registration of the mark YORKSHIRE MIXTURES, and given that its EUTM (which Dobson does not refer to in its submissions) has been refused by the EUIPO, I have only the earlier mark **JOSEPH DOBSON YORKSHIRE MIXTURES** to consider.

### **Average consumer and the purchasing act**

70. 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.”

71. The goods are not specialist products and should be regarded as general consumer goods aimed at the general public. It is likely that they will be selected more by the eye (from supermarket shelves etc) than by the ear. They will be selected in a relatively casual manner given their low cost and that they are bought fairly often.

## **Distinctive character of the earlier mark**

72. 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).”

73. Whilst the earlier mark as a whole, JOSEPH DOBSON YORKSHIRE MIXTURES, is at least reasonably distinctive, my findings under section 3 of the Act mean that such distinctiveness comes from the inclusion of the name JOSEPH DOBSON. In terms of whether the distinctiveness of the mark increases the likelihood of confusion, it is the distinctiveness of the common element which is key. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person, pointed out that

the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

74. Thus, for the purpose of assessing this factor, the common element YORKSHIRE MIXTURE/S is regarded as lacking distinctiveness.

### **Comparison of marks**

75. 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.”

76. 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.

77. The marks to be compared are:

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78. In terms of overall impressions, given what I have said about the distinctiveness of the words YORKSHIRE MIXTURES/Yorkshire Mixture, and given that the other elements of the marks stand at the beginnings of the overall impressions, I consider that it is the words JOSEPH DOBSON and Maxons, respectively, which constitute the dominant (and distinctive) element of the marks. The YORKSHIRE MIXTURES/Yorkshire Mixture elements are not of course negligible and must be taken into account in deciding what level of visual, aural and conceptual similarity exists between them.

79. Both visually and aurally, the common presence of YORKSHIRE MIXTURES/Yorkshire Mixture creates a degree of similarity. However, this must be tempered by my assessment of the overall impression of the marks, together with the fact that there are key differences (the different names) at the beginning of the marks which look and sound very different. The marks are visually and aurally similar to only a low degree.

80. Conceptually, both marks contain an element which indicates that the goods comprise a mixture of sweets from the area of Yorkshire. There is, though, a difference

on account of the very different surnames which are used. Whilst conceptual similarity exists, this is on the basis of a non-distinctive concept.

### **Comparison of goods**

81. The goods of the application read:

“Confectionary; confectionary products; boiled sweets; non-medicated sweets.  
[sp]”

82. The goods of the earlier mark read:

“Confectionery; non-medicated confectionery; sweets [candy]; non-medicated sweets; boiled sweets; flavoured sweets.”

83. There can be no doubt that the goods are identical.

### **Likelihood of confusion**

84. 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. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

85. Even taking into account the casual nature of the selection process and that this may increase the effects of imperfect recollection, the stark differences in the names used at the beginnings of the marks mean that the average consumer will not directly confuse the marks. In terms of indirect confusion, the fact that the common element is not strikingly distinctive, indeed I have found it to be non-distinctive, means that the average consumer will not see the goods as coming from the same or related



undertaking. Indeed, they will see what appears to be happening in the marketplace, two different traders each selling their own version of Yorkshire Mixture/s. There is no likelihood of confusion.

### **Section 5(4)(a)**

86. I will deal with this ground briefly, as the findings I have made thus far impact on the assessment. In summary, the ground under section 5(4)(a) fails for the following reasons:

- i) Although Dobson has a goodwill associated with its business in the field of confectionery, and although it might be recognised that it offers Yorkshire Mixtures for sale, such use, as found earlier, is not for the purpose of distinguishing trade origin. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods and must be distinctive of the claimant. See by analogy *Wild Child Trade Mark* [1998] RPC 455 P) and *Oertli v Bowman* [1957] RPC 388.
- ii) Given that the public will see Yorkshire Mixture in the applied for mark as a type of sweet, there will be no misrepresentation or damage.
- iii) It is clear that Maxons have used the name YORKSHIRE MIXTURE for a long period of time, so even if I am wrong on everything else, and even if Dobson is the senior user, it would no longer be equitable for it to be able to prevent the continued use by Maxons.

**87. The ground under section 5(4)(a) fails.**

### **Section 5(3) of the Act**

88. I will also deal with this ground briefly. In summary, the ground under section 5(3) fails for the following reasons:

- i) Even if the earlier mark has a reputation as a whole and is brought to mind, it will do so only in the sense that the respective marks are both supplying Yorkshire Mixture/s.
- ii) There will be no unfair advantage (or economic effect) as all Maxons is doing is making use of a term used in the trade and, indeed, one that it has been making use of for some time.
- iii) There will be no dilution (or economic effect) because the distinctive character of the mark as a whole is not altered.
- iv) There will be no tarnishing (or economic effect) as no negative impact will be made on the earlier mark.
- v) Maxons have been using the mark for some time and this will represent a due cause – it represents fair competition, something that has gone on for some time.

### **Outcome**

89. Dobson's application (no 3106835) for the mark **YORKSHIRE MIXTURES** is refused.

90. The opposition to the registration of Maxons' application (no 3125974) for the mark **Maxons Yorkshire Mixture** is dismissed and the mark may, subject to appeal, proceed to registration.

### **Costs**

91. Maxons has succeeded in both sets of proceedings and is, therefore, entitled to a contribution towards its costs. I take account that some costs will have been saved due to the consolidated nature of the proceedings. Dobson highlights in its submissions that Maxons withdrew its section 5(4)(a) claim very late in the day. This is true, however, I do not sense that an earlier withdrawal would have disposed of the

proceedings or in any material way changed the nature of the evidence that was filed. I therefore make no deduction from Maxons' costs in respect of this. There is also the issue of the missing evidence. Dobson considered (and made submissions at the CMC) that it was entitled to costs in respect of dealing with this. I agree that Maxons' mistake will have led to some costs being incurred by Dobson in having to deal with this issue and providing submissions about the price lists. However, I do not agree that it is entitled to costs in continuing to pursue the matter after the tribunal indicated that the price lists should be admitted or for taking the matter to a CMC where it lost the point. I will therefore award Dobson £100 towards its costs on this matter, which will be deducted from the costs awarded against it.

92. My assessment is set out below:

*Preparing a statement of case and considering the counterstatement in Maxons' opposition - £300*

*Opposition fee - £200*

*Preparing a counterstatement and considering the other side's statement of case in Dobson's opposition - £200*

*Filing and considering evidence - £1000*

Written submissions - £500

*Deduction - -£100*

**Total - £2100**

93. I order Joseph Dobson & Sons Limited to pay Maxons Limited the sum of £2100 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 22ND day of December 2016**

A handwritten signature in black ink, appearing to be 'O. Morris', written in a cursive style.

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**