

O-056-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
REGISTRATION OF TRADE MARK No. 2514284  
STANDING IN THE NAME OF  
CHICKEN JOES LIMITED**

**AND**

**IN THE MATTER OF THE REQUEST FOR A DECLARATION  
OF INVALIDITY THERETO UNDER No. 83657  
BY AMANDA LIMITED**

## BACKGROUND

1) On 22 April 2009 Chicken Joes Limited (the registered proprietor) applied to register the following trade mark:



2) In respect of the following goods and services:

Class 16: Paper, cardboard and goods made from these materials, printed matter; photographs; stationery; printed publications.

Class 25: Clothing, footwear, headgear.

Class 29: Meat, fish, poultry and game, meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30: Flour and preparations made from cereals, bread, pastry, vinegar, sauces (condiments); spices, sandwiches, prepared meals, pizza, pies and pasta dishes.

Class 35: Advertising, business management, business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; data processing; provision of business information; retail services connected with the sale of chicken foodstuffs.

Class 39: Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services.

2) The application was examined and accepted. The trade mark was published for opposition purposes. No opposition was filed, and registration granted on 4 September 2009.

3) On 8 January 2010 Amanda Limited (the applicant) applied for invalidity under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The grounds are, in summary:

- a) The applicant has applied to register in OHIM trade mark No.7142367 **JO LOVES** in respect of:

Class 11: Apparatus for lighting, lamps, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; candle and storm lanterns.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones, watches, clocks.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; publications; periodicals; magazines; newsletters; pamphlets; brochures; books; booklets; calendars, photographs; stationery; adhesives for stationery or household purposes; artists` materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes).

Class 20: Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith) including cups, mugs, combs and sponges; graters, spatulas, spoons, whisks, bowls, bottle openers; kitchen and bathroom accessories, including soap and lotion dispensers, soap dishes, tumblers, toilet tissue holders, tooth brush holders, waste baskets, pitchers, and napkin rings not made of precious metal; dinnerware; beverage ware; bakeware; cookware, cleaning supplies, table accessories, brooms, brushes and dusters (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, vases and pitchers, porcelain and earthenware not included in other classes.

Class 25: Clothing, footwear, headgear; clothing accessories, belts, scarves.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; smoothies made from milk.

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

Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; smoothies made from fruit.

Class 33: Alcoholic beverages (except beers).

Class 35: Retail services in department stores, stand alone retail outlets, retail services via mail and telephone order and via websites on the internet, all for the following type of goods: lamps, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, candle and storm

lanterns, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, watches, clocks, paper, cardboard and goods made from these materials, printed matter, publications, periodicals, magazines, newsletters, pamphlets, brochures, books, booklets, calendars, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching materials (except apparatus), plastic materials for packaging, furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum, and substitutes for these materials or of plastics, household or kitchen utensils and containers including cups, mugs, combs and sponges, graters, spatulas, spoons, whisks, bowls, bottle openers, kitchen and bathroom accessories including soap and lotion dispensers, soap dishes, tumblers, toilet tissue holders, tooth brush holders, waste baskets, pitchers and napkin rings made of precious metal, dinnerware, beverage ware, bakeware, cookware, cleaning supplies, table accessories, brooms, brushes and dusters (except paint brushes), brush making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, vases and pitchers, porcelain and earthenware, clothing, footwear, headgear, clothing accessories, belts, scarves, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, smoothies made from milk, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice, ice-cream, ice-creams, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, smoothies made from fruit, alcoholic beverages.

Class 39: Transport; packaging and storage of goods; travel arrangement and delivery of goods.

Class 40: Treatment of materials, air freshening services.

Class 43: Services for providing food and drink; restaurant, cafe, bar and catering services, temporary accommodation.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

- b) As the marks and goods are similar there is a likelihood of confusion amongst the public and so the mark in suit should be declared invalid under Section 47(2)(b) of the Trade Marks Act 1994.

3) On 21 September 2009 the registered proprietor filed a counterstatement denying the ground of invalidity, stating “No admissions are made concerning the similarity or otherwise of the goods and services covered by Registration No. 2514282 and Application No. 7142387”.

4) Neither party filed evidence, although both filed written submissions which I will refer to as and when necessary in my decision. Both parties ask for an award of costs. The matter came to be heard on 25 January 2011 when the registered proprietor was represented by Ms Bowhill of

Counsel instructed by Messrs Charles Russell LLP and the applicant by Mr Pennant of Messrs D Young & Co.

## DECISION

5) The sole ground of opposition is under Section 5(2)(b) of the Trade Marks Act 1994 which reads as follows:

“5.-(2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

7) In these proceedings the applicant is relying upon an earlier mark which has a filing date of 7 August 2008 and is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

8) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

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

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

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

(i) 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;

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

9) In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the registered proprietor's mark and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods and services in their specifications.

10) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) is normally a factor, however the applicant has not filed any evidence of use and so cannot benefit from enhanced protection due to a reputation gained through use.

11) It was accepted at the hearing that the average consumer for the goods of both the parties must be considered to be the general public. The exception to this is the registered proprietor's services in Class 35, which would tend to be aimed at business users. The types of goods and services

offered to the general public would be purchased with a reasonable amount of care and attention. Although I must take into account the concept of imperfect recollection.

12) I next turn to consider the relevant goods and services of the two parties. Up until the hearing the registered proprietor's position was that overall there were only "partial similarities in the goods or services". This position was utterly absurd. It is clear to anyone who can read that the specifications in Classes 16, 25 and 43 are identical. The first clue to this is that the words used in the specifications are the same. The same is true of most of the two parties' specifications in classes 29, 30 and 43. However, once Counsel was involved common sense came to the fore and the registered proprietor's stance was that the goods in Classes 16, 25 and 43 are completely identical. Similarly, the goods in Classes 29, 30, 35 and 39 are identical save for identified items shown below which split into similar and dissimilar groups.

Class	Similar	Dissimilar
29	Prepared meals; soups and potato crisps.	n/a
30	Prepared meals, pizza, pies and pasta dishes.	n/a
35	Retail services connected with the sale of chicken foodstuffs.	Advertising, business management, business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; data processing; provision of business information;
39	Travel information.	Distribution of electricity; provision of car parking facilities.

13) The applicant contended that advertising is for the advertisement in relation to the retail of goods and services. This is nonsense, as otherwise any product or service which is advertised would be considered identical to the provision of advertising services.

14) In relation to Class 39 the applicant contended that a specification of goods which quotes the class heading automatically covers all the goods or services in that class. I was referred to a case which is going before the ECJ shortly. However, I prefer to deal with the matter using settled law rather than speculate on what may or may not occur in a case which has yet to be heard. The current test was set out very well by Jacob J. in *Avnet Incorporated v Isoact Ltd* 1998 FSR 16 where he said:

"In my view specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

15) Bearing these comments in mind regarding Class 39, I do not accept that the "provision of car parking facilities" or "distribution of electricity" is similar to anything in the applicant's specification.

16) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Registered Proprietor's Trade Marks
JO LOVES	

17) Clearly, the registered proprietor's mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components.

18) The applicant contends that the dominant elements of the registered proprietor's mark are the two words LOVE JOES. They state that the fact that JOE is traditionally associated with the male, being a shortened version of Joseph, whilst JO is seen as female might lead to one being viewed as a sub-brand or variant with one targeting the male and the other the female consumer. The applicant also contends that the words "a food service you'll just love!" are trivial elements in the mark as a whole and are descriptive in relation to the goods and services covered by the registration. The applicant also states that as the average consumer reads from left to right the registered proprietor's mark will be seen as JOES LOVE.

19) The applicant further contends that the mere inversion of the first two words of its mark by the registered proprietor cannot allow a conclusion that the marks are visually or phonetically different. They refer me to the General Court decision in *MIP Metro Group Intellectual Property GmbH & Co. KG v OHIM*.

20) I agree that the most dominant aspects of the registered proprietor's mark are the two words LOVE JOES. Whilst the eye is initially drawn to the word JOES simply because of its size the average consumer will then discern that the word above it is LOVE and that grammatically it must precede the word JOES. This is made more obvious by its positioning, which, although it starts further across the page than the word JOES, is not that much further across starting just above the letter "E" in JOES. The natural manner of reading will therefore provide the result which is also grammatically correct "Love Joes". Clearly, the mark is a statement that the purchaser will "love Joes" goods or services. The answer to the "what" question is supplied just underneath by the words "a food service you'll just love". I do not agree that the qualifying statement "a food service you'll just love" can be regarded as trivial or descriptive of many of the goods and services covered by the registration.

21) Nor do I agree that the average consumer would view them as connected simply because one uses the female form of JO and the other the male form JOE. To my mind the applicant's mark "JO LOVES" will be seen in two ways. Some will view it as a statement that a female called JO loves something although there is no clue as to what. Alternatively they may see it as the forename and surname of a lady called JO LOVES. Usually a trade mark identifies the origin of goods or services, and I believe that at least some will see the applicant's mark as simply a name indicating the origin of the goods or services on which it is used.



22) With the registered proprietor's mark this mistake cannot occur. The forename JOE is common, but not JOES. Therefore, the mark will always be seen as LOVE JOES. Further, the words are not simply inverted as claimed but there is a significant difference in the possessive case of the registered proprietor's mark as well as the use of male and female forenames which whilst having a degree of similarity also have significant differences.

23) Considering the marks as wholes and acknowledging that there are some visual and phonetic similarities I must also recognise that there are very significant differences, visually, phonetically and conceptually.

24) I take all of the above into account when considering the marks globally. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. The differences in the marks are such that even when used on goods which are identical, I believe that there is no likelihood of consumers being confused into believing that the goods provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them, such as by way of a license. The invalidity action under Section 5(2) (b) therefore fails in relation to the whole of the specification which was registered.

## **COSTS**

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£0
Preparing for and attending a hearing	£300
Expenses	£0
<b>TOTAL</b>	<b>£500</b>

25) As the registered proprietor has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the registered proprietor the sum of £500. In calculating this sum I have taken into account the additional work the registered proprietor's unjustifiable stance regarding the goods and services caused to the applicant, even though this was slightly rectified once Counsel had been instructed. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17 day of February 2011**

**G W Salthouse  
For the Registrar  
the Comptroller-General**