

**O-107-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3086416  
BY NICK DAVID WILLOUGHBY  
TO REGISTER THE FOLLOWING MARK IN CLASSES 29, 30 & 43:**

**DIXIE UNION**

**AND**

**OPPOSITION THERETO (NO. 404099) BY  
SABT 1 LIMITED**

## **Background and pleadings**

1. These opposition proceedings concern whether the trade marks **DIXIE UNION** should be registered for various goods and services in classes 29, 30 & 43. The applicant is Nick David Willoughby, who filed the mark on 17 December 2014. The mark was published for opposition purposes on 9 January 2015.

2. The opponent is SBT1 Limited. Although pleaded more widely at the outset<sup>1</sup>, the opponent restricted its opposition to section 5(2)(b) of the Trade Marks Act 1994 (the Act), relying on the following two earlier marks:

- i) UK registration 2376091B for a series of two marks, which were filed on 19 October 2004 and registered on 17 October 2008:



**Class 29:** Chicken and chicken products.

**Class 30:** Coffee, teas, rice, condiments, spices.

**Class 43:** Restaurants; snack bars; cafes; canteens and fast food outlets; take-away food services; catering services; accommodation, hotel services and rental of temporary accommodation.

- ii) UK registration 2367430B which was filed on 5 July 2004 and registered on 15 February 2008:



**Class 29:** Chicken and chicken products; all included in Class 29.

**Class 30:** Coffee, tea, rice, condiments, spices; all included in Class 30.

**Class 43:** Services for providing food and drink; all included in Class 43

3. The goods and services on which the opponent relies are underlined in the above list. The opponent does not oppose all of the applied for goods and services. In its

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<sup>1</sup> It had additional grounds under section 5(3) and 5(4)(a) and, also, additional earlier marks. The scope of its opposition was restricted in comments in its written submissions dated September 2014.

statement of case the opponent identifies the following goods and services as being identical or similar to terms in its earlier marks:

**Class 29:** Meat, poultry; eggs; foodstuffs containing all the aforesaid goods; snacks and prepared foods, prepared meals.

**Class 30:** Sandwiches; filled sandwiches; snack foods, prepared meals.

**Class 43:** Restaurant services, snack bar services; catering services; preparation of food on trolleys; provision of food and drink; cafes, cafeterias, canteens, self-service and fast food restaurant services.

4. It should be noted, though, that the goods and services I have identified above as being the subject of the opposition relate to the claim stemming from earlier mark ii). The goods and services opposed on the basis of earlier mark i) are slightly narrower (it does not include a claim relating to “preparation of food on trolleys”). The opponent also states that it opposes registration of the mark in relation to “Rental of fast food restaurant services”. However, as such a term is not listed in the applied for specification, I need say no more about this. I should also add that in the opponent’s written submissions it compares a wider range of applied for goods and services than that listed above. This is not appropriate. The opponent must stand by the claims it made in its statement of case, no request to amend the pleadings having been made.

5. Both earlier marks were registered more than five years before the date on which the applicant’s mark was published. In accordance with section 6A of the Act, this means that the proof of use provisions are applicable. The opponent made a statement of use claiming that the marks have been used for the goods and services on which it relies. The opponent’s main points in its statement of case are that:

- i) The distinctive and dominant part of its marks is the word DIXY.
- ii) Its marks have a substantial reputation in the UK being “something of a household name”.
- iii) The use of the word DIXIE in the applied for mark clearly demonstrates similarities in a visual and phonetic context and the goods and services are also similar.
- iv) The public would believe that the goods and services offered under the applied for mark originate from the opponent.

6. The applicant filed a counterstatement. The main points in defence are that:

- i) Whilst the words DIXY and DIXIE are visually similar and phonetically identical, the marks as a whole are not similar, still less confusingly similar.
- ii) The applicant was unaware of the opponent’s mark when he adopted the name DIXIE UNION, which is the name of a place he came across in Georgia (in the US) and which reflects the “Dixie style” of food he produces.

7. In relation to proof of use, the applicant ticked the box to request proof of use, but added:

“Yes, but only to the extent necessary to make good the Opponent’s claim that its Dixy Chicken trade mark is a household name. Even on that point I only require proof if the claim to having a household name in some way materially strengthens the Opponent’s case.”

8. The consequence of the above is that the opponent has not been put to proof for the purposes of the proof of use provisions. The knock-on effect is that the opponent may rely on both its earlier marks for the goods and services it has identified. However, the applicant’s statement does put the opponent to proof of its reputation and whether such reputation will increase the likelihood of confusion.

9. The applicant is self-represented. The opponent is represented by Burges Salmon LLP. In addition to providing written submissions, the opponent compiled evidence of use, but it highlighted that this was not necessarily required for the purposes of section 5(2)(b) because the opponent, as noted above, was not put to proof of use. It was unclear whether the opponent wished to have its evidence considered by the tribunal, so it wrote to the opponent seeking clarification, albeit agreeing with it that no evidence was required in relation to the proof of use provisions. The opponent responded stating that its evidence was not to be entered into the proceedings. The evidence will not, therefore, be taken into account in my decision. The applicant did, however, file evidence, which I will duly consider. Neither side asked for a hearing or filed written submissions in lieu of attendance.

### **The applicant’s evidence**

10. This comes from the applicant, Mr Nick Willoughby. In general terms, Mr Willoughby’s evidence focuses on the differences between the parties services (or at least the services they offer in the marketplace) and evidence relating to the distinctiveness, or otherwise, of the word DIXIE and the use of that word by others. Rather than provide a self-standing evidence summary, I will, instead, refer to the evidence when it is relevant to the matters that need to be determined. The evidence also incorporates a large amount of submission, which I will take into account.

### **Section 5(2)(b)**

11. 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.”

12. 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.

## Comparison of goods and services

13. When making a comparison, all relevant factors relating to the goods/services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

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

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

17. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>2</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>. I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. It should also be noted that goods/services can be found to be identical if a term in one specification falls within the ambit of a broader term in the competing specification. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. Much of the applicant’s evidence and submissions relate to the respective services. In summary, the points made by the applicant are that DIXIE UNION is a food stall offering southern (US) style food. This includes pulled pork, but occasionally clam chowder, oysters and chicken wings “all in the Dixie style”. His kitchen (presumably where the food is prepared) is in a gastro pub in West Norwood, where the applicant is also responsible for the pub food. The stall is part of the Covent Garden Thursday food market, but, from time to time, he sets up stalls on an ad hoc basis at food festivals. The applicant describes his offering as “a street food “foodie” business” which is part of a niche market quite different from the niche market of the opponent, which he describes as catering for urban high street traffic in competition with the likes of KFC (whose main focus is on fried chicken). The applicant makes a number of comments about the “street food revolution” and provides some press articles about street food in general which he considers to be of a high quality, having moved on significantly from the sort of fare offered by burger vans. He considers there to be a gulf between this and the typical fried chicken outlet offered by the applicant.

20. Whilst noting the above, I observe that the points being made relate to the actual trade of the parties. This is not the correct test. It is necessary, instead, to consider the earlier mark on a notional basis, in relation to all the goods/services it relies on. To illustrate the point, earlier mark ii) includes services for providing food and drink. The term is not limited in any way. It is, therefore, necessary to take that term into account to the extent that it covers all types of services for the provision of food and drink. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

21. In making the comparison, I will do so with reference to the applied for goods and services, on a term-by-term basis, albeit grouping them together when it is reasonable to do so:

### Class 29

22. **Meat:** The goods of the earlier marks include chicken, which is a meat. Therefore, on the basis of the principle outlined in the *Meric* case, the goods of one fall within the ambit of the other and may, therefore, be considered identical. Even if the applicant limited its specification to meat that was not chicken (pork for example), and by doing so removed identity, the goods would still, nevertheless, be highly similar. The nature,



purpose and methods of use are all highly similar. There would be some competition and the channels of trade would be the same or highly similar.

23. **Poultry:** As per the above assessment, the same principles apply, chicken (covered by the earlier mark) being poultry. Again, even if the specification were limited to avoid chicken (duck or turkey for example) the goods would still be highly similar, indeed, given that they would still all be forms of poultry then the similarity would be extremely high.

24. **Eggs:** The opponent's submission is that eggs are identical to its "chicken products" because eggs "are, of course, a chicken product". I disagree. Whilst chickens produce eggs, that does not make them a "chicken product". I have set out the case-law earlier with regard to how specifications should be interpreted. It would, in my view, be straining the natural language to interpret "chicken products" as including eggs. The ordinary, understandable meaning would be that a chicken product is a product made from chicken. The goods are not identical. Irrespective of this, I must decide whether the goods are similar. The nature of an egg is quite different from chicken or chicken products. The methods of use are also different. In terms of purpose, both eggs and chicken (or chicken products) could be seen as a base ingredient used in the creation of food, however, such similarity would be of a very general nature. The users would be the same, but, again, this is a very general assessment because this would apply to a vast range of goods given that the average consumer (as I will come on to say) is a member of the general public. The channels of trade overlap to the extent that they will all be sold in the food areas of a supermarket (and similar stores), but there is nothing to show that the respective goods are located in close proximity to each other. If there is any similarity between eggs and chicken/chicken products then it must be of a very low degree. I see no greater degree of similarity with any of the other goods/services of the earlier marks.

25. **Foodstuffs containing all the aforesaid goods:** In relation to foodstuffs containing [meat and poultry], this must be taken to be identical to the opponent's term "chicken products", the products being foodstuffs. As per my finding at paragraphs 22 and 23 above, even if "the aforesaid goods" did not include chicken, the remaining foodstuffs containing meat/poultry would still be highly similar to chicken products. However, in relation to foodstuffs containing [eggs], this would, for similar reasons given in paragraph 24, be of only a very low degree of similarity to chicken products.

26. **Snacks and prepared foods, prepared meals:** All these terms could contain chicken and, thus, could be classed as chicken products. Therefore, on the *Merit* principle, the goods are identical. The applicant has not provided any fall-back specification for consideration to limit the type of snacks and prepared foods/meals to be offered. I note in the applicant's evidence that there is reference to pulled pork products, clam chowder, oysters and chicken wings. From this perspective, a limitation to chicken wings does not assist because these are chicken products. In terms of pulled pork products, whilst pork is clearly a different meat (to chicken), very similar products could be made from pulled chicken (a chicken product), consequently, the goods would still be highly similar. The same applies to clam chowder because chicken products would include chicken chowder – the goods are highly similar. The only product which has less similarity would be snacks and prepared food/meals based on oysters. However, whilst the primary ingredients may be different, the fact

remains that chicken products would include forms of snack and forms of prepared meals. This creates a similarity in purpose and method of use, and, also, competition. The nature may be different. The goods could, though, be located in fairly close proximity in the prepared meal/snack food area. I consider there to be a moderate (between low and medium) level of similarity. There is, also, potential similarity with the various restaurant/food services covered by the earlier marks. This is because food services are an alternative to buying food, particularly prepared foods and meals and, so, the purpose is similar and there is a degree of competition. The nature and method of use is different. The users are the same, but this is quite general. I consider the similarity to be of a medium level.

### Class 30:

**27. Sandwiches; filled sandwiches:** These goods fall in class 30 because they are encompassed in bread. However, the fillings for them could fall in class 29 (such as chicken). I consider that there is a medium degree of similarity between sandwiches in class 30 and chicken products in class 29 because the latter would include chicken sandwich fillings. There would also be a medium degree of similarity with chicken based snacks and prepared meals which would also be covered by chicken products. If, though, the sandwiches were limited to pulled pork sandwiches (one of the things the applicant mentions in his evidence), any similarity with a chicken product is very low. However, any type of sandwich (pulled pork or otherwise) would have a medium level of similarity with food services such as snack bars and takeaway food services which could (and often do) focus on sandwiches. The reasons for coming to this view are expressed in the previous paragraph.

**28. Snack foods, prepared meals:** To fall in class 30 the snacks and prepared meals will principally be composed of products that themselves fall in class 30 e.g. rice, pasta etc. However, whilst the primary ingredient may be different, the fact remains that chicken products in class 29 would include forms of snack and forms of prepared meals. This creates a similarity in purpose and method of use, and, also, competition. The nature may be different. The goods could, though, be located in fairly close proximity in the prepared meal/snack food area. I consider there to be a moderate (between low and medium) level of similarity.

### Class 43

**29. Restaurant services, self-service and fast food restaurant services:** Earlier mark i) covers the term “restaurants”. The term is not limited to any particular type. The services applied for fall within the ambit of the earlier mark. The services must be held to be identical. In terms of earlier mark ii), this covers “services for providing food and drink” which, in itself, also cover restaurants. Identity also exists here.

**30. Snack bar services:** Earlier mark i) covers “snack bars”. The services are, self-evidently, identical. Earlier mark ii) covers “services for providing food and drink” which, in itself, also covers snack bars. Identity also exists here.

**31. Catering services:** Earlier mark i) covers “catering services”. The services are identical. Earlier mark ii) covers “services for providing food and drink” which, in itself, also covers catering services. Identity also exists here.

**32. Preparation of food on trolleys:** The opponent has opposed this term in relation to mark ii) only which covers “services for providing food and drink” which, in itself, would cover preparation of food on trolleys. Identity exists here.

**33. Provision of food and drink:** Earlier mark ii) covers the provision of food and drink and, so, the terms are identical. Even for earlier mark i), the various terms it covers are all for the provision of food and drink and, on the *Merix* principle, would be identical. If it am wrong in relation to the provision of drink (because drink is not specifically listed in the services of earlier mark i), and that the services are not identical, then they are high in similarity.

**34. Cafes, cafeterias, canteens:** Earlier mark i) covers cafes (which is an equivalent term to cafeterias) and canteens. The services are identical. Earlier mark ii) covers “services for providing food and drink” which, in itself, would also cover cafes, cafeterias and canteens. Identity also exists here.

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

35. 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.”

36. The goods and services concerned are not specialist ones and will be purchased/used by members of the general public. They are not highly considered selections, even when the services in class 43 are being considered. No more than an average degree of consideration will be deployed by the average consumer when selecting the goods or a service provider. The selection process will be more by the eye than by oral request. The goods will most often be self-selected from a shelf or the online equivalents. In relation to the services, the mark will be encountered on signage, menus, websites etc. I will not, though, completely ignore the aural aspects of the marks because the goods could still be ordered by oral means and restaurant services booked by telephone etc.

37. As touched on earlier, the applicant makes much of the different types of actual service provided by the parties. However, this has limited pertinence given the notional test that I described earlier. For the most part the goods and services are identical, so it follows that the average consumer must also be identical.

## The average consumer's perception of the word DIXIE/DIXY

38. The applicant regards the word DIXIE to lack distinctiveness. The same view is taken of the misspelling of that word (DIXY) as it appears in the earlier mark. Various pieces of evidence are put forward by the applicant to support his proposition. Reliance is placed on various earlier marks on the trade marks register. In relation to what is often called "state of the register" evidence, I note that in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the CJEU found that:

"65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered."

39. Also, in *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

40. Such cases follow a well-trodden path which was aptly summarised by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where he stated:

"In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."

41. The marks the applicant points to are:

- CHICK 'N' DIXIE (CTM 48520 in class 29).
- Dixie (CTM 12544251 which includes class 43).
- DIXI (UK 2224390 in classes 29 & 30).
- DIXIE LEE (two series of two UK registrations (2497484 which also includes a device and 2497485) which cover services in class 43).
- Uncle Dixie & device (UK registration 2540717 in classes 29 & 30).
- Dixie Diner/DIXIE DINER (UK 2592078 and device and 2592079 word only) in classes 29 & 30.
- DIXIE (UK registration 2592080) in classes 29 & 30.
- DIXY ORIGINAL (UK registration 3002225) in class 43.
- MINI DIXI (IR 1221262) in classes 29 & 30.

42. In relation to the meaning of the word DIXIE, dictionary extracts are provided showing that one of the meanings is as a reference to the Southern US/US states. Also provided are a number of prints as follows:

- A print about a replica paddle steamer that operates on the Thames called the Dixie Queen.
- A print about The London Dixieland Jazz Band.
- A print about The Dixie Ticklers who, according to a review, have a “deep scholarly understanding of New Orleans and Dixieland jazz”.
- A print from the Facebook page of Dixie Kitchen (which appears to be based in Wales and the North West), which has “Original Southern Style”.
- Another print from Facebook of what appears to be a separate business (based in Yorkshire) called Dixie Kitchen, some of its imagery contains southern state signage, such as the confederate flag.

43. Mr Willoughby states that he does not know how relevant evidence from the marketplace is in these proceedings, but he goes on to provide examples of other food businesses using the word DIXIE. He says he can provide more, however, it is not, of course, for the tribunal to inform the applicant what may or may not help his case. The examples provided are:

- Three DIXIE CHICKEN shops (one in Southall, one in Hanwell and one in Bow). It is not clear whether the shops are related to each other or not.
- A shop called DIXIE GRILL in Peckham.
- DIXIE CHICKEN & PIZZA in Willesden.

44. Mr Willoughby states that Dixie is a style of cooking, but he has provided nothing to show this (such as a gastronome or cooking book). He has not provided evidence of, for examples, recipes that use Dixie as a description of a style in which food is cooked.

45. The other points I note from Mr Willoughby's evidence are his reference to two earlier decisions of this tribunal relating to marks incorporating the word Dixie/Dixy. In 2002 Mr John McGillivray (BL O/331/02) found that:

“Given the non-distinctive or descriptive nature of the words CHICKEN and RIBS, it seems to me that DIXY and DIXYLAND is the distinctive and dominant word element in the respective marks and in my view these words allude to “Dixie” or “Dixieland”, well known dictionary words for the southern states of the United States of America.”

46. Mr McGillivray was dealing with a ground under section 5(4)(a) and he went on to hold that there would be a misrepresentation (and damage) between marks whose dominant elements were DIXY and DIXELAND.

47. In 2011 Mr Mark Bryant (BL O/123/11) found that:

“32) I note Mr Khan’s argument that the word DIXIE or variants of that word is descriptive of the Southern United States. I am aware that Wikipedia is a user authored site and therefore the origin or veracity of the information it contains must be considered in this context. Nevertheless, the point at issue is supported by the Oxford online dictionary and I accept that the word DIXIE refers to the Southern States of the United States. There is, however, no evidence that the average consumer will understand the term in such a way. In this respect, I am mindful of the comments of Ms Anna Carboni, sitting as the Appointed Person, in *Chorkee v. Cherokee* (BL O-048-08):

“37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included),but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.

38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.

...

52. It will be clear from my review of the Hearing Officer’s assessment of conceptual similarity that I do not agree that it is appropriate to assume

that the relevant average consumer would think of the Cherokee Nation tribe when faced with the earlier trade marks. I stated at the hearing that I had expected to find some reference to Cherokee Jeeps, my own assumption being that many people would think of these vehicles in response to seeing the name CHEROKEE on clothing. Mr Groom rightly was not receptive to that suggestion. Like the Hearing Officer's assumption of the average consumer's awareness of the Cherokee Nation tribe, my assumption of their awareness of the Cherokee Jeep was not a fact of which I could take judicial notice in the absence of evidence."

33) Similarly to the considerations of Ms Carboni, I am not satisfied that the average consumer of *fast food and non-stop restaurant services* in the UK will be aware of the descriptive meaning of the word DIXIE. It appears to be a colloquial term used by Americans to identify part of America. The UK consumer may possibly understand the word as being some allusion to America without knowing its precise meaning, but I would not put recognition of the word as any higher than that. Of course, an additional factor in the current case is that the respective marks both use (different) misspellings of the word. My finding is not disturbed when considering the two earlier decisions by fellow hearing officers in respect of DIXY FRIED CHICKEN (BL O/144/03) and DIXYLAND CHICKEN & RIBS (BL O/331/02) that were referred to me at the hearing. In summary, I reject the argument that the variants of the word DIXIE will only serve a descriptive purpose within the respective marks.

48. After rejecting the adequacy of some evidence relating to the use of the word in relation to recipes, Mr Bryant concluded:

"35) Both marks also contain the stylized device of a chicken's head that reinforces the meaning of the word CHICKEN in the respective marks. Finally, I acknowledge the presence of the word PAK in Mr Khan's mark and that, if this is noticed by the consumer, it will not attract any obvious conceptual identity. There is no evidence before me that this word has any meaning.

36) Taking all of the above points into account, the term DIXI/DIXY CHICKEN is no more than a loose allusion to an American style chicken, but that this allusion is common to both marks. When considering the marks as a whole, I conclude that the respective marks share a high level of conceptual similarity."

49. Mr Bryant then went on to hold that there was a likelihood of confusion between two marks whose main elements were DIXY CHICKEN and DIXI CHICKEN.

50. Mr Willoughby advocates the findings of McGillivray (that DIXIE was a well-known word, even in 2002) as opposed to the less precise evocative understanding referred to by Mr Bryant. I must, of course, come to my own view, based upon the evidence filed in the present proceedings. The decisions of fellow hearing officers are neither binding on the law or on the facts. Indeed, any persuasive value they have is mild at best. The decision quoted by Mr Bryant (*Cherokee*) is important to bear in mind. Whilst one can consider meanings in dictionaries and other reference works, caution must be exercised in terms of what the average consumer will know.

51. As a matter of fact, I accept that DIXIE is a word which indicates the southern states of the US. However, in terms of the average consumer, it is difficult to quantify how well known the word is. It is not the type of word which, in my view, is obviously and unquestionably known. It is not the type of word likely to crop up in common parlance. Taking the evidence in the round, I think that some consumers will know of the word (with varying degrees of precision), but some will not. There is, therefore, no binary answer. In respect of how to deal with such a scenario, I note that in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. summed up the Court of Appeal's earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403 like this:

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

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

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

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

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

52. The impact of the above judgment is that the ground of opposition may succeed if a sufficiently significant percentage of relevant consumers are confused, but it is not necessary that the majority of consumers are misled.

53. I cannot, of course, say with precision what proportion of average consumers would or would not have knowledge of the word. I think it probable that more people will not know of the meaning than will know of it. Even if this is not correct, and the balance swings the other way, there is, at the very least, a very significant percentage of relevant consumers that will not know of the meaning of the word. None of what I have said means that there is automatically a likelihood of confusion, I will consider that matter later.

54. It is clear from his submissions that Mr Willoughby will not agree with my view that there will be some people who simply do not know the meaning at all. To explain why I come to this view, there is no evidence that consumers are readily exposed to the word. The evidence filed presents some uses, but not enough to demonstrate that



average consumers are all bound to be aware of it. There is no evidence to show that the word is used as the name of a type of food. I suspect that whether one has heard of the word at all, or for those that have the specificity of meaning, will depend on whether it has been encountered in the media, film, music etc. The evidence is not sufficiently compelling for me to conclude that the meaning is universally known.

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

55. 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).”

56. The opponent asked for its evidence not to be taken into account. Consequently, its pleaded claim to having a reputation need not be considered. In terms of the inherent characteristics of the earlier mark, the word DIXY that appears in the mark may be seen as a misspelling as DIXIE by some consumers. As I have already indicated some will know of the word (with precision or otherwise) others will not. For those that do not know of the word, the mark will have at least an average level of inherent distinctive character. The distinctiveness resides mainly in the word itself. The device element adds to the distinctiveness, but I must bear in mind that it is the distinctiveness of the common element that is important.

57. For those that know of the word and see DIXY as a misspelling of it, the distinctiveness will be less. It will have, in my view, a low to moderate level of distinctiveness. However, I should be clear on one point. The word DIXY in the earlier mark has some inherent distinctiveness, distinctiveness which is added to by the device element. There is no evidence that any consumers will understand the word

DIXIE (or DIXY) to be directly describing the type of foods or services – it is evocative/suggestive at worst.

### Comparison of marks

58. 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.”

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

Applicant's mark	Opponent's marks
<p><b>DIXIE UNION</b></p>	

60. In terms of the overall impression of the earlier marks, this is comprised of the word DIXY built into a stylised logo incorporating the head of a chicken. The word CHICKEN is also used in one of the earlier marks, albeit in smaller script than the word DIXY. I consider the word DIXY to play the more memorable and stronger role in the overall impression of the earlier marks. The figurative elements (including the chicken

head) still, though, play a role, given the visual impact they provide. The word CHICKEN has very little, if any, weight.

61. In terms of the overall impression of the applied for mark, it is comprised of the words DIXIE UNION, with neither of those words given greater emphasis than the other.

62. Conceptually speaking, for those that see no meaning in the words DIXIE/DIXY then the mark are conceptually neutral. The addition of UNION gives the applicant's mark no concrete meaning and the device of a chicken's head is not overly significant (conceptually) given the nature of the goods/services.

63. However, for those that know the word DIXIE as a reference to the southern states of the US, those people are likely to see a degree of conceptual similarity. The UNION element does not avoid this as it does not create a concrete (and different) meaning as a whole. Indeed, for such people the message of the Southern states may actually be re-enforced as the word UNION may also have a resonance for them given that it refers to the body (the "Union" is often used as a reference to the US as a whole) from which the Southern States wished to separate, although, I accept that it produces an imprecise whole.

64. Visually, the words DIXY and DIXIE have clear similarities (which the applicant has accepted). There are, though, some obvious points of difference including the addition of the word UNION and the absence of a figurative element and chicken head. I consider there to be a medium degree of visual similarity.

65. From an aural perspective, the DIXIE/DIXY elements will be articulated in an identical manner. However, the applicant's mark as a whole is longer given the addition of UNION and this creates a difference. I consider there to be a medium degree of aural similarity.

### **Likelihood of confusion**

66. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) but a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). 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.

67. Whilst both marks have DIXIE/DIXY within them, I consider the other differences between them to be sufficient to avoid the average consumer from directly confusing one for the other. However, there is also what is known as indirect confusion to consider. Indirect confusion 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).”

68. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion “tends” to fall in one of them. I think it also useful to highlight the guidance in relation to composite trade marks (of which the applicant’s mark is an example). In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

69. I will consider firstly the opposed services, all of which I have found to be identical to terms of the earlier mark(s). Much of the applicant’s submissions focus on the differences between the services, but for reasons already given I reject this submission. The differences between the marks are also referred to together with the point regarding the distinctiveness of the common element DIXY/DIXIE. However, from the perspective of average consumers who do not know the meaning of DIXIE, this latter point has no pertinence. One is then left with the differences between the marks. In my view, the difference between DIXY/DIXIE is something that could easily be lost through imperfect recollection. Furthermore, the stylisation and chicken head of the earlier mark does not greatly assist in distinguishing on a trade origin level, particularly bearing in mind the nature of the device. The word UNION must also be considered and the impact of this on this average consumer I am considering. I come to the view that the average consumer will still believe that the respective services are the origin of the same (or related) undertakings given its (at least) average level of inherent distinctiveness and given that UNION does not really create a new concept as a whole, with the word appearing more independent. The average consumer I am considering probably represents the majority of the relevant public, or at least a very significant proportion thereof. In view of this, I am satisfied that the ground for refusal should succeed.

70. In any event, even for average consumers who know of the meaning of DIXIE, at least a proportion of them would be confused in the same way. As I have said, the word is not directly descriptive and some (albeit weaker) distinctiveness is inherent in the word. Such people, taken together with the average consumer already assessed, is easily sufficient for the ground to be upheld.

71. In relation to the goods, I feel the same principles apply. Where the goods are identical (or highly similar as a fall-back) there is a likelihood of indirect confusion. In terms of the other goods, and considering firstly eggs, the degree of similarity in the goods is very low. Given the interdependency between the various factors, and given the differences between the marks, I consider the net effect to be that there is no likelihood of confusion. The same applies to foodstuffs containing eggs.

72. In relation to the various snack foods and prepared meals (including sandwiches), I consider that there is a likelihood of confusion. The relationship between the goods

and the goods/services of the earlier mark, means, in my view, that the same stable assumption would flow.

## **Conclusion**

73. Given the findings I have made, the opposition succeeds in relation to all of the opposed goods/services, except for:

**Class 29:** Eggs; foodstuffs containing the aforesaid goods.

74. The net effect of the opposition, bearing in mind that not all of the goods and services were the subject of the pleaded case, is that the application may proceed to registration for:

**Class 29:** Meat, fish, poultry and game; cheese, eggs, seafoods, pate; preserved, dried and cooked fruits and vegetables; eggs, milk and milk products; edible oils and fats; foodstuffs containing all the aforesaid goods; ~~snacks and prepared foods; prepared meals;~~ yoghurts; flavourings and constituents for all the aforesaid goods.

**Class 30:** ~~Sandwiches; filled sandwiches;~~ croissants, bread, pastry, pastries, preparations made from cereals; confectionery; ices; ~~snack foods, prepared meals;~~ desserts; flavourings and constituents for all the aforesaid goods.

**Class 43:** ~~Restaurant services, snack bar services; catering services; provision of food and drink; cafes, cafeterias, canteens, self-service and fast food restaurant services; self-service restaurants;~~ services for the provision of food or preparation of food on trolleys, carts or from caravans, boats and other mobile vehicles not including coffee bars.

75. It may seem somewhat incongruous that some of the terms that remain are subsets of a wider term that has been struck as a result of the (partially) successful opposition. However, as stated earlier, the opponent elected to proceed its opposition in relation to earlier marks which identified only some (not all) of the applied for goods and services as being the subject of the claim. The tribunal can only work on the basis of what has been pleaded. One can only assume that the opponent had no objection to the narrower terms that remain.

## **Costs**

76. The opponent has largely succeeded in relation to the goods and services the subject of the opposition and is entitled to a contribution towards its costs. My assessment is set out below:

*Official fee - £100<sup>4</sup>*

*Preparing a statement and considering the other side's statement - £300*

*Considering evidence and filing submissions<sup>5</sup> - £400*

*Total - £800*

77. I therefore order Nick David Willoughby to pay SABB1 Ltd the sum of £800. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3rd day of March 2016**

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

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<sup>4</sup> Although the official fee paid was £200, I have awarded only £100 as this is the fee applicable to grounds under 5(1)/5(2) only, i.e. upon which the opposition was ultimately based.

<sup>5</sup> Although evidence was compiled by the opponent, I have awarded nothing for it because it elected not to have it included.