

**O-305-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3157343 BY  
JOHNSON'S LONDON LTD  
TO REGISTER:**



**AS A TRADE MARK IN CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 407109 BY FARZANA ZAFFAR**

## BACKGROUND & PLEADINGS

1. On 31 March 2016, Johnson's London Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 17 below. The application was published for opposition purposes on 6 May 2016.

2. On 5 August 2016, the application was opposed by Farzana Zaffar ("the opponent") under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent is the owner of the following United Kingdom and European Union Trade Marks ("EUTM"):

UK No. 2414525 for the trade mark: **BENNY'S** which was applied for on 21 February 2006 and entered in the register on 25 August 2006. The opponent relies upon the goods and services shown in paragraph 17 below.

EUTM No. 8905994 for the trade mark: **BENNYS** which was applied for on 24 February 2010 and entered in the register on 13 July 2010. The opponent relies upon the same goods and services as those in UK No. 2414525.

3. The applicant filed a counterstatement (subsequently amended) in which the basis of the opposition is denied. As these are the only comments I have from the applicant, they are reproduced below verbatim:

"...I would like to deny the claim made by the opponent. I completely disagree with the claims that they have made against us as our mark "Benny's" is used in conjunction with other words to complete the name of our brand "Benny's beans artisan coffee". Also, the name Benny's is a very commonly used name, so I completely disagree that the likelihood of confusion occurring will be so strong that we have had this opposition made against us."

4. In these proceedings, the opponent is represented by The Trade Marks Bureau; the applicant has represented itself. Only the opponent filed evidence. Neither party asked to be heard nor did they elect to file written submissions in lieu of attendance.

## **DECISION**

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As both of these earlier trade marks had been registered for more than five years at the date when the application was published, both are, in principle, subject to proof of use, as per section 6A of the Act.

8. In her amended Notice of opposition, the opponent indicated (in box 2 of the Form TM7) that both of her earlier trade marks were subject to proof of use and (in boxes 3 and 3a), that they had been used for the goods and services upon which she relied. In the first version of its counterstatement filed on 27 September 2016, the applicant indicated that it wanted the opponent to make good this claim. In box 7 of the Form TM8, the applicant wrote: “\*How our logo is affecting their business.”

9. On 6 October 2016, the tribunal wrote to the applicant. That letter included, inter alia, the following paragraphs:

**“PROOF OF USE**

It has been noted that, for question 7 of your Form TM8 and counterstatement, you have requested the opponent provide proof of use when they file evidence.

However, as the opponent has not claimed statement of use in their notice of opposition (i.e. their earlier right has been registered for less than five years), your request is not applicable.”

10. On 13 October 2016, the applicant provided an amended Form TM8 in which it reacted to the above by ticking the box indicating that it did not want the opponent to provide proof of use. In an official letter to the applicant dated 1 November 2016 (in which further queries were raised), the tribunal stated:

“Your amended Form TM8 now correctly advises the Registry that the opponent does not have to provide proof of use when filing its evidence, however, the amended counterstatement you have filed requires amendment.”

On 2 November 2016, the applicant provided a further amended Form TM8 in which the box relating to proof of use was unchanged. It is upon the basis of this version of the Form TM8 that the proceedings continued.

11. As a consequence of the series of events I have outlined in paragraphs 9 and 10 above, the proceedings continued on the basis that it was not necessary for the opponent to make good her claim to having used the earlier trade marks upon which she relied.

12. However, as the earlier trade marks upon which the opponent relies are, in principle at least, subject to proof of use, the approach adopted by the tribunal in relation to the applicant’s request for the opponent to provide such proof (contained in the first version of its Form TM8), was clearly an error. In an official letter dated 22 May 2017, the tribunal noted this error and, inter alia, stated:

“A deadline of 14 days from the date of this letter, which is up to and including **5 June 2017**, is now given for the applicant to confirm whether they wish for the opponent to provide ‘proof of use’ evidence. If this is the case, the applicant is to file an amended Form TM8 and counterstatement.

...

Should the applicant not file an amended Form TM8 in the time period given above, the proceedings will continue to a final decision.”

13. The applicant did not respond to that invitation in the timeframe allowed nor has any response been received from it prior to issuing this decision. In those circumstances, I must proceed on the basis that it no longer requires the opponent to provide proof of

use of her earlier trade marks. As a consequence, the opponent may rely upon all of the goods and services she has identified.

### **The opponent's evidence**

14. This consists of a witness statement (and submissions) from the opponent's professional representative, Matthew Gardner. I will refer to Mr Gardner's statement later in this decision.

### **Section 5(2)(b) – case law**

15. The following principles are gleaned from the decisions of the courts of the European Union 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.

### **The principles:**

(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.

### **My approach to the comparison – the opponent’s strongest case**

16. The opponent is relying upon the two trade marks shown above; the specifications relied upon are identical. The applicant’s trade mark contains, inter alia, the word “Benny’s”. As the opponent’s UK trade mark consists of the word “BENNY’S” (i.e. also with an apostrophe “S”), it is this trade mark which, in my view, offers the opponent its strongest case in these proceedings. If the opponent does not succeed on the basis of this trade mark, it will, in my view, be in no better position in relation to the other trade mark upon which it relies i.e. BENNYS (in which the word is presented without an apostrophe).

### **Comparison of goods and services**

17. The competing goods and services are as follows:

<b>The opponent’s goods and services</b>	<b>The applicant’s goods</b>
<b>Class 30</b> – Coffee.	<b>Class 30</b> - Coffee-based beverages.
<b>Class 43</b> – Provision of food and drink.	

18. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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.

19. In her submissions, the opponent states that “coffee” in class 30 of her specification is “identical and similar” to the applicant’s “coffee based beverages” and that “provision of food and drink” in her specification in class 43 is “similar” to the applicant’s goods. She provides further arguments and three exhibits (consisting of extracts obtained after the material date from [starbucks.co.uk](http://starbucks.co.uk), [caffenero.co.uk](http://caffenero.co.uk) and [costa.co.uk](http://costa.co.uk)) in support of the latter.

20. Collinsdictionary.com defines “coffee” as a variable noun meaning “a hot drink made with water and ground or powdered coffee beans” and “the roasted beans or powder from which the drink is made.” That accords with my own understanding of the word and, more importantly will, in my view, accord with that of the average consumer. Proceeding on that basis, the applicant’s goods are, in my view, to be regarded as identical to the opponent’s goods in class 30. However, even if I am wrong in that

regard, when one considers the degree of overlap in the users, nature, intended purpose, method of use and trade channels of the competing goods, if not identical, they are, self-evidently, similar to the highest degree. Having reached that conclusion, there is no need for me to also conduct a comparison with the opponent's services.

### **The average consumer and the nature of the purchasing act**

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

22. In her submissions, the opponent states:

“12. The average consumer of coffee and services relating to the provision of food and drink which are usually restaurants, cafes, bars, public houses, tea rooms, caterers etc. will be a member of the general public. The goods and services are low cost, frequent purchases which are likely to be primarily visual, though there may be an aural element where the consumer consults a salesperson prior to purchase. A number of factors may be taken into account such as the particular origins or blend of coffee or ingredients in a food product,

as well as in store point of sale information about a particular drink or snack available. Subsequently, the level of attention paid to the purchase will be around average.”

23. I agree that in relation to the goods in class 30 the average consumer is a member of the general public. I also agree that such goods are low cost, frequent purchases which will be selected by primarily visual means from, for example, the shelves of a supermarket or the pages of a website. Like the opponent, I agree that aural considerations may also play a part. As to the degree of care that will be displayed when selecting such goods, the opponent pitches this at “around average”; while I am content to proceed on that basis, I will return to this point when I consider the likelihood of confusion.


### **Comparison of trade marks**

24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

25. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give

due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark – strongest case	Applicant's trade mark
BENNY'S	

26. In her submissions, the opponent states:

“6...The opposed mark contains a stylised device of a coffee bean together with the term “Benny’s Beans” in large lettering with the term –artisan coffee underneath in smaller size lettering.

7. Subsequently, the term “Benny’s” is a dominant and distinctive element of the opposed mark as the device of a coffee bean, the word “beans” and the term “artisan coffee” are all descriptive and non-distinctive of the goods.”

27. The opponent’s trade mark consists of a single word presented in block capital letters. That is the overall impression it will convey and where its distinctiveness lies.

28. The applicant’s trade mark consists of a number of components. The first is a green rectangle which acts as a background upon which the other components in the trade mark are presented. Although it will contribute to the overall impression conveyed, it has very little (if any) distinctive character. The opponent refers to the second component as a “stylised device of a coffee bean”. Presented in the colour off-white, I agree that is how the average consumer is likely to construe this device. However, it also contains

within it a stylised letter “B” presented in a cursive script in the same colour green as the background. Considered as a totality, it is not, as the opponent suggests, “descriptive and non-distinctive” and, given its size and positioning will, in my view, make a reasonable contribution to the trade mark’s distinctiveness and the overall impression it conveys. The third component, also presented in the colour off-white, appears below the device component and consists of the words “Benny’s Beans” presented in title case in a slightly stylised but unremarkable font. These words form a unit with the presence of the apostrophe “s” indicating that the “Beans” which are used in, for example, the applicant’s “artisan coffee”, originate from a person whose forename or surname is “Benny”; the word “Beans” is, of course, descriptive. Given its size in the context of the trade mark as a whole, this unit and in particular the word “Benny’s” will make a considerable contribution to both the overall impression the trade mark conveys and its distinctiveness. The final component (also presented in the colour off-white) appears below and is in much smaller text than the unit described above. It consists of the words “artisan coffee” presented in the colour off-white in lower case letters and is accompanied by two short horizontal lines appearing to the left of the initial letter “a” and the right of the final letter “e”. Given both its size and obvious descriptive credentials, it will make little or no contribution to the overall impression conveyed and no contribution to the trade mark’s distinctiveness.

29. I now turn to the visual, aural and conceptual comparison with the above conclusions in mind. The word “BENNY’S”/“Benny’s” is common to both parties’ trade marks. It is the only component in the opponent’s trade mark and the first word in a unit in the applicant’s trade mark which I have concluded will make a considerable contribution to the overall impression conveyed and its distinctiveness. Bearing that in mind but reminding myself of my conclusions in relation to the other components in the applicant’s trade mark (in particular the stylised device of a coffee bean), still results in an above average degree of visual similarity between the competing trade marks.

30. In relation to the aural comparison, it is well established that, when a trade mark consists of a combination of words and figurative components, the average consumer is

most likely to refer to the trade mark by the word component. Given their obvious descriptive nature, I see absolutely no reason why the average consumer would articulate the words “artisan coffee” when referring to the applicant’s trade mark. I reach a similar conclusion in relation to the letter “B” which appears in the bean device. Proceeding on that basis, the fact that “BENNY’S” is the only word in the opponent’s trade mark and the first word in the unit which the average consumer will articulate when referring to the applicant’s trade mark, results in a high degree of aural similarity between the competing trade marks. However, even if I am wrong and the average consumer does articulate the letter “B” (resulting in an aural comparison between “BENNY’S” and “B Benny’s Beans”), there remains, in my view, a fairly high degree of aural similarity.

31. Finally, the conceptual comparison. As I mentioned earlier, the word “BENNY”/“Benny” may operate as either a forename or a surname. As the word “Beans” in the applicant’s trade mark is descriptive, it does not alter the conceptual meaning that the word “Benny’s” will convey. The competing trade marks are, if not conceptually identical, conceptually similar to a high degree.

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

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

33. As the opponent has not filed any evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its counterstatement, the applicant submits that “Benny’s is a very commonly used name.” It has, however, provided no evidence in support of this submission. Whilst I accept that is not uncommon for, inter alia, those providing services relating to food and drink to use both forenames and surnames as indicators of origin, in my experience, the word “Benny” is a fairly well-known if not terribly common male forename and an even less common surname. Absent evidence to the contrary, I find that particularly when considered in relation to the goods upon which the opponent relies, her trade mark is, absent use, possessed of an average degree of inherent distinctive character.

### **Likelihood of confusion**

34. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are either identical or similar to the highest degree;
- the average consumer is a member of the general public who will select the goods at issue by predominately visual means, displaying an “around average” degree of attention during the selection process;

- the overall impression conveyed by the opponent's trade mark and its distinctiveness lie in the word of which it is composed;
- while the device component will make a contribution to the trade mark's distinctiveness and the overall impression it conveys, so too will the unit created by the words "Benny's Beans" and, given the descriptive nature of the word "Beans", in particular, the word "Benny's";
- the competing trade marks are visually similar to an above average degree, aurally similar to at least a fairly high degree and conceptually similar to at least a high degree;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

35. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

36. In reaching a conclusion on the likelihood of confusion, I remind myself that the degree of care the average consumer will display when selecting the goods at issue is a relevant factor. The higher the degree of care paid during the selection process, the less prone the average consumer will be to the effects of imperfect recollection. In her submissions, the opponent described the degree of care as "around average" and earlier in this decision I indicated I was content to proceed on this basis. I have adopted this approach because while in reality I think the degree of care paid by the average consumer during the selection process will be lower than average, pitching it as "average" is more favourable to the applicant. If the applicant does not succeed on this basis, it will be in an even worse position if the degree of care is assessed as below average.



37. Weighing all of the above factors, there is, in my view, a likelihood of confusion even if an “average” degree of attention is paid by the average consumer during the selection process. Given the importance the distinctive unit “Benny’s Beans” (and in particular the word “Benny’s”) plays in the overall impression conveyed by the applicant’s trade mark and the similarity of this unit to the opponent’s trade mark, confusion is, in my view, likely to be direct. However, even if the combination of the other components in the applicant’s trade mark and, in particular, the stylised bean/letter component is considered sufficient to avoid direct confusion, the importance of the word “BENNY’S”/“Benny’s” in the competing trade marks will, in my view, lead to indirect confusion. The average consumer will, in my view, simply assume that the applicant’s trade mark is a variant form/updated version of the trade mark of the opponent.

### **Overall conclusion**

**38. The opposition has been successful and, subject to any successful appeal, the application will be refused.**

### **Costs**

39. As the opponent has been successful, she is entitled to a contribution towards her costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using the TPN mentioned as a guide but making no award to the opponent in respect of her evidence (which played no part in the proceedings), I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Written submissions:	£200

Official fee: £100

**Total: £500**

40. I order Johnson's london ltd to pay to Farzana Zaffar the sum of £500. This sum is to 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 4th day of July 2017**

**C J BOWEN**

**For the Registrar**