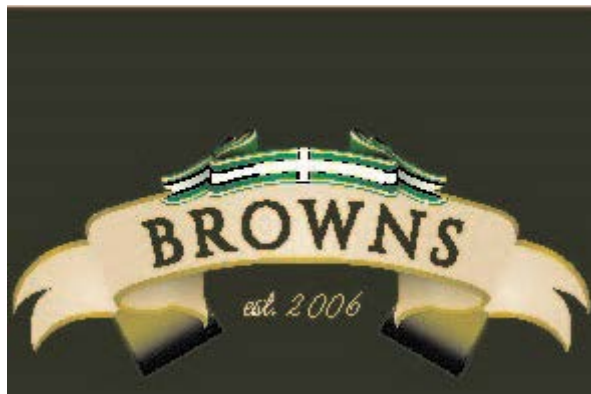


O-785-18

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3235366
IN THE NAME OF JOHN ANDREW BROWN
OF THE TRADE MARK



IN CLASS 30

AND

THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 501835
BY OLD KENTUCKY RESTAURANTS LIMITED

Background and pleadings

1. On 5 June 2017, John Andrew Brown (“the registered proprietor”) filed trade mark application number UK00003235366 for the mark detailed on the cover page of this decision, for *teas* in Class 30.
2. The application was published in the Trade Marks Journal on 23 June 2017. No opposition was received, and the mark was registered on 1 September 2017.
3. On 20 October 2017, Old Kentucky Restaurants Limited (“the applicant”) filed application number CA000501835 to have the protection of the registered proprietor’s mark declared invalid, relying upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
4. The applicant relies upon UK Trade mark series registration 3070781, shown below, which has a filing date of 2 September 2014 and a registration date of 9 January 2015. The applicant relies upon some of the goods covered by its earlier trade mark, namely *coffee, tea, cocoa* in Class 30.



BROWNS



BROWNS

5. The registered proprietor, in its counterstatement, requested the applicant provide proof of use of its earlier registered marks. However, as the applicant’s earlier marks completed their registration process less than five years prior to the date of the application for invalidation, they is not subject to the proof of use conditions, as per section 47(2A) of the Act. The consequence of this is that the applicant is entitled to rely upon all of the goods relied upon in its application (coffee, tea, cocoa).

6. The applicant, in its application, claims that the registered proprietor's mark is identical or similar to its earlier marks and is registered for identical or similar goods, leading to a likelihood of confusion.

7. The registered proprietor filed a counterstatement in which it denies that there exists a likelihood of confusion.

8. The registered proprietor filed evidence and written submissions in lieu of a hearing. The applicant filed written submissions at the evidence rounds. Neither party chose to be heard. The applicant is represented by Nucleus IP Limited, whereas the registered proprietor represents itself.

Preliminary issue

9. The applicant initially filed its application relying upon sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4). The section 5(3) and 5(4) grounds were subsequently dropped. Therefore, any submissions relating to those grounds are no longer relevant to these proceedings and will not assist me in making my decision.

Evidence summary

10. The registered proprietor's evidence takes the form of a witness statement and fourteen exhibits from John Andrew Brown, the registered proprietor. The evidence contains a mixture of submissions (which I will bear in mind when making my decision) and fact (relating to the registered proprietor's business). The registered proprietor is not required to prove use of its mark and, as such, it is not clear why the evidence was filed and why it assists in these proceedings. If the registered proprietor is claiming that it has used its mark before the applicant, then this is not a sustainable defence¹. Absent any clear impact on the proceedings, I will say no more about the registered proprietor's evidence of use.

¹ See Tribunal Practice Notice 4/2009 titled "*Trade mark opposition and invalidation proceedings – defences*"

The correct approach

11. The registered proprietor, in its written submissions and evidence, relies on a number of factors which it says will avoid any likelihood of confusion. Before going any further into the merits of this application for invalidation it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this application.

- i. The registered proprietor has made comparisons between its mark and what it refers to as the applicant's 'Brasserie & Bar logo'

What the registered proprietor has included at its exhibit JB3B as the applicant's mark is shown below.



This is not what the applicant relies upon for the purposes of this application. The applicant relies upon its marks as shown at paragraph 4, above, and so that is what I must compare the registered proprietor's mark to.

- ii. The registered proprietor makes comparisons between the types of tea that the parties provide (i.e. loose tea v tea bags)

Differences between the goods currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the list of goods they have tendered for the purpose of the registration of their marks. I am required to make a decision based on the goods included in the parties' respective specifications. Therefore, submissions regarding the specific

composition of the goods are irrelevant to the assessment I am required to make.

iii. The registered proprietor makes the following submissions:

“...the registered trade mark of the applicant [...] only entered the register on the 9th of January 2015 yet the logo used in advertisements apart from being completely different to the registered logo, bears the date 1973, in this way they are not subject to proof of use which seems a contradiction as they have been apparently serving tea since 1973 so there [surely] was use.

[...]

I asked the staff if they sold in any shape or form, tea loose or bagged to take away under the browns branding and was told that they only serve tea in the restaurants...”

As I have found at paragraph 5 above, the marks upon which the applicant relies for the purposes of these proceedings were registered less than five years prior to the date of the application for invalidation. As a result, the applicant is not required to prove use of its marks, in relation to the goods upon which it relies, or at all. In making my decision, I am only required to consider notional use of the marks and so submissions relating to their actual use are not relevant, and neither are submissions relating to any other mark in use by the applicant.

Relevant legislation

12. Section 47 of the Act provides for invalidity of a registration under the pleaded grounds and the immediately relevant parts of that section are set out below:

“(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.”

Decision

Section 5(1)

13. Section 5(1) of the Act is as follows:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

14. Firstly, I must consider whether the respective marks are identical, this is a prerequisite under section 5(1). In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*², the Court of Justice of the European Union (“CJEU”) held that:

“54. A sign is identical with the trade mark when it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. The marks share the word BROWNS but the registered proprietor’s mark is followed by ‘est. 2006’. The marks also differ in their stylisation and the registered proprietor’s mark contains a scroll-like figurative element. I find that these are differences which are not so insignificant that they would go unnoticed by the average consumer. The applicant’s case fails under section 5(1).

Section 5(2)(a)

16. Section 5(2)(a) of the Act is as follows:

“(2) A trade marks shall not be registered if because –

(a) it is identical with an earlier mark and is to be registered for goods or services 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.”

17. I have already found, under section 5(1), that the marks are not identical. Such identity is also a requirement of this ground. Therefore, the applicant’s case fails under section 5(2)(a).

² Case C-291/00

Section 5(2)(b)

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

“(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.”

The principles

19. 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 C3/03, *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 the mark as a whole and does not proceed to analyse its various details;

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) However, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) A lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) Mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) The reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) If the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

20. It is self-evident that *teas* in the registered proprietor's specification are identical to *tea* in the applicant's specification. As noted earlier, any differences in the tea actually supplied is not a relevant factor to consider here. The parties' goods are identical.

The average consumer and the nature of the purchasing act

21. It is necessary for me to determine who the average consumer is for the respective parties' goods. 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. 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 & Co GmbH v Klijsen Handel BV*³.

23. I am of the view that the average consumer of the parties' goods is a member of the general public. The goods are relatively inexpensive and purchased frequently, for example, during a weekly shop, when the consumer will self-select the goods from physical stores or websites. The purchase is likely to be predominantly visual. However, I do not completely discount an aural element to the purchase. Whilst the

³ Case C-342/97

average consumer may consider the variety/flavour of tea and perhaps whether it is decaffeinated or not, the average consumer is not going to pay any more than an average degree of attention to the purchase.

Comparison of marks

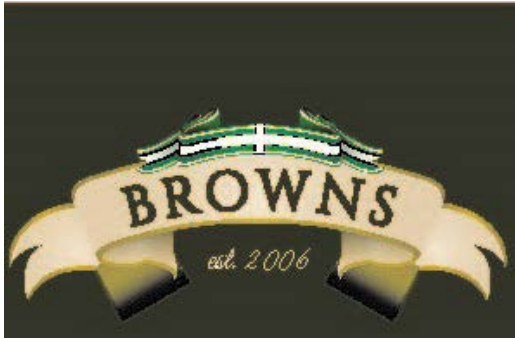
24. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁴, 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, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

26. The trade marks to be compared are as follows:

⁴ Case C-591/12P

Applicant's earlier marks	Registered proprietor's mark
<p data-bbox="280 315 687 398">BROWNS</p> <p data-bbox="285 501 695 584">BROWNS</p>	

Overall impression

27. The applicant's marks consist of the word BROWNS in a fairly standard typeface, presented in red (in the first mark of the series) and grey (in the second mark of the series). Whilst the 'R' and 'W' have slightly more stylisation than the other letters in the mark, it is the word itself which strongly dominates the overall impression of the mark. The stylisation is not though completely negligible, but nevertheless the relative weight of this aspect is limited.

28. The registered proprietor's mark consists of a number of elements. The word BROWNS is presented in a particular but unremarkable brown font. 'est. 2006' is presented below the word BROWNS in an italicised (but fairly standard) typeface in a cream-coloured font. The word BROWNS is presented on a cream-coloured scroll device, above which is a green flag with a white cross. All of the elements are on a brown rectangular background. I consider that the word BROWNS has the greatest impact in the overall impression, given its size and position. A lesser role is played by 'est. 2006' which, positioned beneath the word BROWNS and in a smaller typeface, is likely to be seen by the average consumer as the date the business was established. The scroll and flag devices play a weaker role (than BROWNS), though they are not negligible. The brown background is likely to be seen as little more than that; a background.

Visual comparison

29. The similarity lies in all six letters (B-R-O-W-N-S) of the more dominant component of the registered proprietor's mark, which are the same as the word BROWNS in the applicant's marks.

30. In terms of differences, the registered proprietor's mark contains the additional wording 'est. 2006' and the various figurative and stylistic elements described above. The applicant's marks also have a form of stylisation not shared by the registered proprietor's mark. The difference in colour also creates a difference, but, even in relation to the most contrasting colour to the registered proprietor's mark (the red version of the applicant's mark), this is not, in my view, overly significant.

31. Taking all of these factors into account and bearing in mind the overall impressions I have outlined, I consider the marks in question to be visually similar to at least a medium degree.

Aural comparison

32. In terms of aural similarity, it is unlikely that the registered proprietor's mark will be referred to in its entirety ('BROWNS est. 2006'). I find that it is more likely that this would be shortened to BROWNS. Given that BROWNS is the only word in the applicant's marks, I consider the marks to be aurally identical.

Conceptual comparison

33. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM*⁵. The assessment must be made from the point of view of the average consumer.

⁵ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

34. Whilst it is possible to see the word BROWNS as a plural of the colour brown, I am of the view that the average consumer will see the word, despite the lack of apostrophe between N and S, as a surname. In any event, given that the dominant element is the same in the respective marks, I find them to be conceptually identical.

Distinctive character of the earlier mark

35. Having compared the marks, it is necessary to determine the distinctive character of the earlier marks, in order to make an assessment of the likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* 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).”

36. As no evidence has been filed by the applicant, I have only the inherent distinctiveness of the earlier marks to consider. The most likely significance of the word Browns is a surnominal one. BROWNS does not allude to the goods at issue, beyond suggesting that someone with the name BROWN has some form of connection with the company. Names do not generally make for the most distinctive of marks, however, this is not reason to automatically accord them with a low degree of distinctiveness. I therefore conclude that the degree of distinctiveness is moderate (between low and medium).

Likelihood of confusion

37. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]) and I must make a global assessment of the competing factors (*Sabel BV v Puma AG* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

38. Earlier in this decision I found that:

- The average consumer is a member of the general public, who will select the goods primarily by visual means (though I do not discount an aural component) and who will pay an average degree of attention to their selection;
- The goods are identical;
- The marks are visually similar to a medium degree, aurally identical and conceptually identical;
- The applicant's marks are inherently distinctive to a moderate degree.

39. There are two types of confusion that I must consider: direct confusion and indirect confusion, the difference between the two was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*⁶:

“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 recognised 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’.

40. As I have found above, the most dominant element of the marks at issue here is BROWNS. It is the part by which the average consumer will refer to and remember the parties’ goods. Taking these factors into account, and bearing in mind the concept of imperfect recollection, I find that the average consumer having encountered the respective marks will be directly confused, simply believing them to be the same mark, mistaking one for the other.

41. Even if I am wrong in my finding and the average consumer does recognise the differences between the marks, there will still be a likelihood of indirect confusion. One mark will be seen as either an updated or more modern version of the other or a variant of the other mark, so that the consumer would believe the same or related undertaking to be responsible for both. With the marks being dominated by the single name BROWNS, and despite the distinctiveness of the element not being high, I do not consider that the average consumer will put this down to mere co-incidence. There is a likelihood of confusion.

⁶ BL O/375/10

Conclusion

42. There is a likelihood of confusion. The application for invalidation succeeds.

Costs

43. As the applicant has been successful, it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide I award costs to the applicant on the following basis:

Official fee: £200

Preparing a statement and
considering the other side’s statement: £200

Considering the other side’s evidence: £200⁷

Preparing written submissions: £200⁸

Total: £800

44. I order John Andrew Brown to pay Old Kentucky Restaurants Limited the sum of **£800**. This sum is to be paid within fourteen days of the expiry period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of December 2018

Emily Venables

For the Registrar,

The Comptroller-General

⁷ This amount is below the scale minima due to the applicant not preparing evidence

⁸ This amount is below the scale minima due to the applicant’s written submissions being of limited substance