

O-180-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2237024A
BY HYPERAMA PLC TO REGISTER A TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 52841 BY COLIN T LOFTUS & KEITH SKINKIS-LOFTUS
TRADING AS JAVA BAR EXPRESSO**

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No. 2237024A by Hyperama PLC to
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**IN THE MATTER OF Opposition thereto
Under No. 52841 by Colin T Loftus &
Keith Skinkis–Loftus trading as Java Bar Espresso**

BACKGROUND

1. On 23 June 2000 Hyperama PLC applied to register the trade mark JAVA EXPRESS in Class 42 of the register for a specification of “Restaurant services; café and bar services; catering for the provision of foods and drink.”
2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 13 July 2001 Colin T Loftus & Keith Skinkis-Loftus trading as Java Bar Espresso filed a Notice of Opposition. In summary the Notice (as amended) set out the following grounds:
 - (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier UK registered trade marks owned by the opponents which cover identical services and there exists a likelihood of confusion on the part of the public –

REGISTRATION NUMBER	MARK	REGISTRATION EFFECTIVE	SERVICES
21351111		5 June 1997	Class 42 – Provision of bar, restaurant and catering services.

2235987	 <p>(series of two) the applicant claims the colours purple and rust as an element in the first mark in the series,</p>	14 June 2000	Class 42- Provision of bar, restaurant and catering services.
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(ii) Under Sections 5(4)(a) of the Act by virtue of the law of passing off.

4. On 30 October 2001 the applicant filed a Counterstatement denying the grounds of opposition, stating that no single entity could claim rights to the word JAVA and drawing attention to a number of trade mark registrations containing the word JAVA.

5. Both sides filed evidence and asked for an award of costs in their favour. The matter came to be heard on 3 June 2003 when the applicant for registration was represented by Mr Tritton of Counsel instructed by RM Trademarks and the Opponents by Mr Keith Skinkis-Loftus.

Opponents' Evidence

6. This consists of a witness statement by Keith Skinkis-Loftus dated 27 March 2002.

7. Mr Skinkis-Loftus explains that he and his brother, Colin Loftus, are the proprietors of the business in Manchester known as JAVA, JAVA BAR EXPRESSO, JAVA BAR with outlets at 8a Oxford Road, 1-3 Station Approach, Oxford Road Railway Station, 95 Piccadilly M1, and Victoria Station.

8. Mr Skinkis-Loftus states that the trade marks JAVA BAR EXPRESSO and JAVA and associated logo were first adopted by the opponents in 1997 in relation to the provision of coffee bar services integral in which was the sale and promotion of a range of fresh coffees and snack foods eg pastries, danishes and cakes. He adds that the first outlet opened on Oxford Road, Station Approach on 3 March 1997.

9. Mr Skinkis-Loftus goes on to say that the approximate turnover in relation to the opponents business since March 1997 amounts to some £1.5 million and he provides the following annual breakdown:-

1997	-	£175,000
1998	-	£181,062
1999	-	£211,215
2000	-	£289,891
2001	-	£640,000

10. Mr Skinkis-Loftus states that the trade marks JAVA BAR EXPRESSO, JAVA BAR and JAVA have been used on a continuous basis since March 1997 in the provision of the business via advertisements, corporate literature and point of sales materials and advertising expenditure, adding that the total expenditure since March 1997 is in the region of £75,000. He confirms that the opponents now have four outlets in Manchester City centre.

11. At Exhibit 2 to his statement, Mr Skinkis-Loftus sets out information relating to the promotion/exposure of the JAVA, JAVA BAR EXPRESSO and JAVA BAR trade marks, which includes copy advertisements, award certificates, photographs and editorials in magazines eg GQ Active, City Life, The Manchester Resident, The Guardian Guide and The Virgin Train Passenger Magazine. Mr Skinkis-Loftus adds that the opponents are the beneficiaries of several accolades, which he summarises as follows:-

- a) Best Coffee Bar 1999 – City Life Magazine;
- b) Highly Commended for Contribution to Tourism and Leisure 1999 – Manchester Chamber of Commerce;
- c) Best Café 2000 North West – Theme Magazine;
- d) Best UK Independent Coffee-led Outlet 2001 – Café Society Coffee Forum.

12. Mr Skinkis-Loftus submits that the opponents trade marks are essentially JAVA marks and the word JAVA is the essential element of the mark in suit as the word EXPRESS comprises purely descriptive matter, signifying fast and efficient service etc. He adds that the word EXPRESS is used in many trade marks in relation to the provision of food and drink. At Exhibit 3 to his statement Mr Skinkis-Loftus provides a number of examples. Mr Skinkis-Loftus concludes that as both the opponents and applicant's marks are essentially JAVA trade marks, confusion is inevitable. He goes on to state that a JAVA EXPRESS outlet has opened up in Manchester city centre and that this has resulted in two instances of actual confusion involving third parties. The first of these involved a company named Mulmar who issued an invoice to the opponents dated 30 March 2001, for work carried out at the applicant's JAVA EXPRESS outlet. Copies of this original invoice and a subsequent credit note to the opponent are at Exhibit 4 to Mr Skinkis-Loftus statement. Next he turns to a company named ADT Fire and Security PLC who, he states, provided a quotation for JAVA EXPRESS in relation to fire alarms on their premises and these were also sent to the opponents. A copy is at Exhibit 5 and is dated 12 February 2001.

Applicant's Evidence

13. The applicant's evidence consists of three statutory declarations, two by Jeanette Wood dated 24 June 2002 and 25 September 2002 and one by Linda Carey dated 25 September 2002.

14. Ms Wood is a Director of RM Trademarks Limited, the applicant's professional advisors in these proceedings.

15. In her first declaration Mr Wood commences by submitting that the coffee bean device element present in the opponents' earlier marks is a dominant and important feature and she adds that the opponents and applicants marks are different overall. Ms Wood goes on to refer to Exhibit RM to her declaration which shows a number of UK registered trade marks which contain the word JAVA, including registration numbers : 2284437 (Java Minute) in Class 42; 2186734 (Java The Hut) in Class 30; 2280322 (Java Junction and device) in Class 42; 2194418 (Espresso Bar Café Java Joes) in Class 42; 2211205 (Java to the People) in Class 42. Ms Wood contends that the opponents have no monopoly in the word JAVA and that the evidence does not demonstrate that they possess rights in the word JAVA per se. She adds that a number of the opponents' exhibits are dated after 23 June 2000 (the relevant date for these proceedings).

16. Returning to the comparison of the applicant's and opponents' marks, Ms Wood states that the words EXPRESSO and EXPRESS have totally different meanings and she adds that Collins Dictionary 2001 contains no specific definition of the word EXPRESS in specific relation to the services of the applications.

17. In relation to the turnover figures supplied by the opponent Ms Wood states that they are not significant and that it is not clear exactly which registered trade marks (if any) the figures relate to. She points out that the turnover relates to the opponents' business overall which does not mean that it relates to sales under the registered trade marks. Going to the advertising expenditure claimed by the opponents, Ms Wood states that, once again, this relates to the business overall and also to JAVA Coffee shops. She adds that the opponents have no registration of the word JAVA solus.

18. Ms Wood states that it is apparent from the exhibits that the word JAVA has a connection with coffee. She refers to Exhibit 3 to 3d to her declaration which are excerpts from the opponents' evidence and Exhibit 3 states that "The name Java was adopted not only in recognition of the Indonesian area renowned for its coffee beans; but also because the word is American slang for coffee", whilst Exhibit 3b states "the Loftus boys honed their knowledge and came up with the Java concept – a name which has second meanings beyond the immediate coffee bean growing Indonesian nation, "Java" is an American slang word for coffee" and Exhibit 3c states "As the improvement gathers pace, the city's independent coffee bar chain Java – the name comes from US slang for coffee".

19. Ms Wood adds that, the authors of these articles also acknowledge that the word JAVA has a meaning in relation to coffee. Exhibit 3c in the Folder is a copy of an article by Jonathan Schofield entitled "Blending In" in this article he says, "I've drunk a lot of Java java". Additionally he makes reference to the types of coffee available in the Opponents' coffee bar and specifically refers to "Just Good Java, a simple cup of coffee". Exhibit 3d is a

copy of the Opponents' menu, which they submitted, which lists "JUST GOOD JAVA" as a coffee drink, which is for sale in their outlet.

20. Ms Wood goes on to refer to Exhibits 4 to 4r of her declaration which comprise copies from internet searches, dictionaries and articles from which, she states, it is apparent that JAVA is a blend of coffee and a term widely used in relation to coffee. Exhibit 4q is an excerpt taken from the tenth Concise Oxford Dictionary published in 2001, which gives the definition for JAVA as "informal coffee" but denotes "N.Amer" to show that it is not a UK term as such.

21. In her second declaration, Ms Wood refers to a number of visits she made to various supermarkets and internet searches made in relation to cafes and companies whose names include the word JAVA. In support she attaches a folder JW2 to her second declaration.

22. In relation to Ms Wood's submission that JAVA is a type of coffee, her comments are as follows:

- "(i) On 28 June 2002 I visited Tesco Supermarket, Old North Road, Royston, Herts SG8 5UA. I purchased two different makes of coffee, which use the word JAVA as part of their name. Exhibit 1 in JW2 is a copy of the packaging of Tesco's own brand JAVA SUMATRA ROAST & GROUND COFFEE. Exhibit 2 is the packaging for CONNOISSEUR JAVA made by Bewley's. The description of the coffee is "this Bewley's Connoisseur Java is a distinctive, strong and full bodied coffee". The use of the word JAVA in the context of this sentence would seem to be in place of the word coffee and the sentence could equally well read "this Bewley's Connoisseur coffee" and have exactly the same meaning. Exhibit 3 is a copy of the receipt for the purchase of these coffees.
- (ii) On 2 July 2002 I visited Whittard's outlet at 24 Petty Cury, Cambridge. I refer to Exhibit 4, which is a leaflet from Whittard's that details the types of coffees they sell. Included in this list are SANTOS AND JAVA and OLD BROWN JAVA. Exhibit 5 is an example of a sticker for these coffees, which Whittard's apply to the coffees when they are sold, which were given to me by staff in the Cambridge store. I draw attention to the list of Whittard stores on the back of the leaflet exhibited at 4, which shows that they sell coffee in 23 shops in London, 68 stores throughout the UK and also have 10 "Outlets and Stores" additionally listed, as well as three "opening soon". In addition it is possible to purchase Whittard Coffees by Mail Order and on 9 July 2002 I telephoned Whittard's on 0800 015 1755 and spoke to Leila on 9 July 2002. I asked whether I could purchase SANTOS AND JAVA and OLD BROWN JAVA by mail order. She told me I could and also I could purchase it online if I went to www.whittard.co.uk. Exhibit 6 is the temporary product listing sent to me by post by Whittard's following my telephone conversation with Leila. Pages 26 and 29 both list OLD BROWN JAVA, whilst page 26 includes SANTOS and JAVA.
- (iii) Also on 2 July 2002 I visited Marks and Spencer in Market Square, Cambridge. I purchased Marks & Spencer own brand of MOCHA JAVA, see Exhibits 7 and 8, which is the receipt for this product.

- (iv) I then went to Sainsbury's in Sydney Street, Cambridge. I purchased Sainsbury's own brand JAVAN, see Exhibit 9. I also bought a coffee by Taylor's of Harrogate, which lists other coffees they sell. Included in this is HOT LAVA JAVA, see Exhibits 10 and 11, which is the receipt for the purchase of these coffees.
- (v) I also exhibit at Exhibit 12 a printout of a website www.itchyoxford.co.uk about cafes in Oxford. This uses the word "java" to mean coffee in the general sense.
- (vi) I also exhibit at Exhibit 13 a printout from a website called Sophie's Tea & Coffee referring to Old Brown Java.
- (vii) I also exhibit at Exhibit 14 lyrics from the Ink Spots, an English pop group, where they use the word "java" as slang for coffee.
- (viii) I exhibit at Exhibit 15 a printout from the website of Van Lauren beverages which explains how the island of Java lent its name to the coffee trade and how coffee became known as java coffee beans. It appears clear from the above that there is sample evidence to conclude that as of the application date, java was a term in common usage as slang for coffee."

23. Ms Wood goes on to draw attention to cafes with JAVA in their name she states:

"1. On 8 July 2002 I conducted an Internet search of www.yell.com the search criteria being the word JAVA, in the UK. Exhibit 16 is the result of the search.

2. Exhibit 17 are the results of an Internet search conducted on 6 August 2002, I conducted an Internet search using the www.goggle.co.uk search engine using the search terms "java café coffee" and selecting only the option "pages from the UK". Exhibit 17 comprise printouts from the first six web pages of results from that search.

3. On 9 July 2002 I telephoned the numbers that were found in the www.yell.com search and asked each of the persons who answered the telephone about their activities and the results are as follows:

4. BAR JAVA, 48-52 Constitution Hill, Edinburgh, telephone 0131 554 1299. Bed and breakfast services as well as bar services are provided under the mark BAR JAVA. The gentleman who answered the telephone directed me to the website www.gobananas.co.uk where I found the information relating to BAR JAVA, which is exhibited at Exhibit 18 in the folder. He told me that BAR JAVA has been in existence for four years since 1998.

5. I spoke with Sharon at JAVA JUNCTION, 36 Station Street, Keswick, Cumbria CA12 5HF, Tel 017687 74053. She told me that JAVA JUNCTION is a café/coffee shop and that they sell food such as sandwiches. She told me that JAVA JUNCTION has been in existence for five years. They put me in touch with Head Office who confirmed that they operate a chain of outlets called JAVA JUNCTION and have done so for at least five years. Their company is called Coffee Partners Ltd incorporated on 20 October 1994, and their accounts show trading since 3 August

1998 – see Exhibit 18a. The lady I spoke to said that since the company started they have used JAVA JUNCTION.

6. JAVA THE HUT , British Rail Station, Amersham Hill, High Wycombe, Buckinghamshire, HP13 6NN, Tel 01494 527341. The person I spoke to informed me that they supply coffee by mail order and had been doing so since November 1999. They sent me a mail order catalogue, which I exhibit at Exhibit 19, which claims their trade mark is registered. Listed amongst the various coffee products is OILD BROWN JAVA and JAVA THE HUT SPECIAL BLEND. I draw attention to Exhibit 20 in JW1, which gives details of the trade mark registration for JAVA THE HUT, No 2186734 in the name of Mrs Georgina Hooker, of High Wycombe, Bucks. This is for the same trade mark as the one used on Exhibit 20. Exhibit 21 is an excerpt taken from the website www.javathehut.com. I was told that HAVA THE HUT has been round since November 1999.

7. BAR JAVA, 58 Westfield Street, St Helens, Merseyside WA10 1QJ, Tel 01744 23725. I spoke with Lara who informed me that they are a public house, selling food between 08.00 and 18.00 hours. Subsequently, she told me that it has been trading for three years.

8. JAVA 33 Ferryquay Street, Londonderry, County Londonderry BT48 6JB, Tel 028 7136 2100. The person I spoke with told me they have a snack menu, salads, baguettes, breakfast menu and they sell beers and wines. I was subsequently told that JAVA has been trading for three years.

9. JAVA DESIGN LTD, 72 Festival Village, Trafford Centre, Manchester, Lancashire M17 8FS. I spoke with the manager. She told me that they are a gift shop and they did receive enquiries asking for gifts comprising of coffee. She said this was because of their name, which includes the word JAVA and people think they sell coffee – which they don't.

10. JAVA MALAYAN RESTAURANT, 58-60 George Street, Hull, North Humberside HU2 3AB, Tel 01482 610959. I reached an answering machine that informed me the restaurant is open from 6.30 to 11.00.

11. JAVA INDONESIAN RESTAURANT, Wharf Street, Sowerby Bridge, Est Yorkshire HX6 2AF, Tel 01422 831654. I spoke with Mr Raja. He informed they had been using the name JAVA INDONESIAN RESTAURANT for 17 years. He sent me a menu, which I exhibit at Exhibit 22 and which says that THE JAVA RESTAURANT has been established in Sowerby Bridge for 17 years.

12. JAVA CAFÉ Ambassadors Hall rear of 236 High Street, Banfor, Gwynedd LL57 1PA, Tel 01248 361652. I spoke with Jim. He informed me that they had been trading as JAVA CAFÉ for three years and they were open 10-6 on Monday and Tuesday and 10-10 from Wednesday through to Saturday. They have an international menu including traditional foods, Eastern, Indian and Thai foods.

13. JAVA AND JAZZ Café, The Square, Lewes Road, Forest Row, East Sussex, Tel 1342 826699. I spoke with Laurie. He informed me that they had been trading under this name for 5 years and they provided food and drinks.

14. CLUB JAVA, 39 Commercial Street, Edinburgh, Midlothian EH6 6JD, Tel 0131 555 5622. There is also a BAR JAVA. I exhibit at Exhibit 23 a print out of a website relating to places to dine in Edinburgh. CLUB JAVA was established 29 November 1997.

15. HOUSE OF JAVA LTD 67-69 High Street, Tunbridge Wells, Kent TN1 1XX, Tel 01892 511121. I spoke with Marie Clare. They are a café, open between 07.30 and 18.00. They serve drinks all day and food at lunchtime . I was told that they have been in existence for five years.

16. CAFÉ JAVA, 7 Surrey Street, Norwich, Norfolk NR1 3NX, Tel 01603 666604. I spoke to Paul who told me they had been using the name CAFÉ JAVA for 2 years. They provide eat in and take-away services, selling food and drinks. They are a café.

17. LAVA JAVA COFFEE HOUSE, Harpers Court, Dingwall, Ross-Shire IV15 9HT, Tel 01349 866456. Angus told me they are a café, open between 09.00 and 17.00 hours and sell a range of goods and drinks. I was subsequently told that they have been in existence between one and two years.

18. JAVA JUNCTION, 95 South Street, St Andrews, Fife KY16 9QW, Tel 01344 471451. I spoke with Anna who told me they sell a range of food and drinks. I understood that they had been in existence since 28 March 02.

19. JAVA COFFEE HOUSE, 10 Picton Avenue, Swansea, West Glamorgan SA1 3BE, Tel 01792 458141. Shirley told me they sell a range of goods and drinks, including tea and coffee. They have been trading under this name for approximately 16 months.

20. The Opponents are claiming that they have outlets in or local to railway stations. Attention is drawn to JAVA THE HUT , British Rail Station, Amersham Hill, High Wycombe, Buckinghamshire, HP134 6NN, which is situated on the British Rail Station in high Wycombe.

21. There is a JAVA COFFEE house in Whitby, North Yorkshire Tel 01947 821 973. I exhibit at Exhibit 24 web pages from its website at www.java-online.co.uk. I was told that they had been in existence for five years since August 1997.

22. JAVA CAFÉ is listed for Stratford-upon-Avon Tel 01789 263 400. I exhibit at Exhibit 25 a printout of a guide to Internet cafes in Stratford upon Avon. I was told by the gentleman who answered the phone that they first used JAVA Café in May 1998.

23. I also exhibit at Exhibit 26 a print out from a website from a Roger Hart about the delights of java coffee.

24. I exhibit at Exhibit 27 a print out of the Knowhere Guide to Bradford which refers to a JAVA Café which would now appear to have closed down.

25. I exhibit at Exhibit 28 a print out from a website evidencing the fact that there used to be a café in Milton Keynes called “Café Java Internet Business Centre”. It would appear this has now closed down.

26. I exhibit at Exhibit 29 a print out from a guide to Brighton cafes which lists a Java Cafe, which would appear to have closed down.

27. I exhibit at Exhibit 30 a print out of a website of a cyber café called Java Junction in Rugby, which would appear to have closed down.

28. I exhibit at Exhibit 31 a print out of a guide to the Upper Craigs area of Stirling where it can be seen that there is a Java Café bar, which would appear to have closed down.

29. I exhibit at Exhibit 32 a website of “Java’s Internet Coffee House” in Chesterfield, Derbyshire which is situated at www.javas.co.uk which would appear to have closed down.”

24. Ms Wood goes on to comment on a search she conducted in relation to company names with JAVA in them and she states:

“I conducted a company names search using the Armadillo online system on 16 July 02. I searched for companies with the word JAVA in their title and Exhibit 33 is the result. I have highlighted the references to companies, which are most obviously/likely to be in the restaurant/café business, of which there are 45. The references to “Basic non-limited” companies are those companies, which may not have limited liability and have been included on Armadillo by virtue of reference to them in sources other than Companies House records, for example telephone directories and gazettes. Exhibit 34 comprises 32 addresses for the companies I refer to above and which would appear to be in the restaurant/café business.”

25. Ms Wood submits that JAVA was a slang name for coffee, and is also used to refer to a type of coffee and continues to be used as part of the names of cafes across the UK. She concludes that the opponents do not have sole rights in the word JAVA in relation to the services specified.

26. Linda Carey is a Trade Marks Assistant at TM Trade Marks Limited (the applicant’s professional advisors in this opposition).

27. Ms Carey explains that she has undertaken research into how the proprietors of company names that contain the word JAVA, arrived at that or selected their particular name and whether the word JAVA had a specific meaning which influenced their decision.

28. Ms Carey goes on to outline the results of her research. She contacted sixteen different businesses in various fields of activity. Of these, nine businesses referred to a link between the word JAVA and coffee. Ms Carey concludes that the opponents’ do not have sole rights in the word JAVA in relation to the services specified or in respect of coffee and coffee products.

29. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

30. Firstly I turn to the ground of opposition based upon Section 5(2) of the Act which reads as follows:

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

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

31. An earlier right is defined in Section 6, the relevant parts of which state:-

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

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

32. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;
- (g) account should be taken 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 was registered; *Lloyd*, paragraph 29;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, page 224;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

33. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponents have filed evidence relating to the reputation of its trade marks and this evidence shows that the opponents' registered trade marks have been in use since 1997 in Greater Manchester in relation to the provision of Coffee Bar Services and prior to the relevant date for these proceedings (23 June 2000) the opponents provided the services from four outlets in Manchester, had a turnover of £211,215 in 1999 and had won a number of accolades in relation to their services. However, in order to secure the enhancement of marks inherent attributes for the purposes of Section 5(2), the reputation and recognition of a mark by the public needs to be demonstrated on a comprehensive and national basis (given the registration provides national protection). On the basis of the evidence filed I do not consider the usage and reputation shown has been on a sufficient scale to further enhance the inherent attributes of the mark. In *DUONEBS* (BL O/048/01) a decision of Simon Thorley QC sitting as the Appointed Person, it was said:

“In my judgement, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

34. I do not believe the opponent can claim enhanced distinctive character for its marks in relation to Section 5(2).

35. In essence the test under Section 5(2) is whether there are similarities in marks and goods or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the services, the category of services in question and how they are marketed. I must assume normal and fair use of the marks across the full range of services included within the respective specifications and take account of any actual use of the marks.

36. Turning first to a consideration of the respective services covered by the specification for the application in suit and the opponents' earlier registrations, it is obvious that the services are identical. Furthermore the specific service for which the parties have used their marks ie coffee bar services, are the same although there is no evidence that the applicant used its mark prior to the relevant date.

37. I now go on to a comparison of the mark in suit with the opponent's earlier registrations.

38. Much of the applicant's evidence and Mr Tritton's submissions on behalf of the applicant at the hearing, go to the issue that JAVA is a non-distinctive element in relation to the services for which registration is sought and therefore, as a whole, the respective marks are sufficiently different.

39. In relation to the nature of the word JAVA the applicant's evidence considers the state of the trade marks register, those businesses which incorporate JAVA as part of their name, slang use of JAVA for coffee and descriptive use of JAVA in relation to coffee, and coffee bar services.

40. In my considerations on this issue I am not assisted by the state of the trade mark register in relation to marks containing the word JAVA and I am guided on this point by the comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held 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 eg *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

41. Furthermore, I believe the applicant's evidence relating to those businesses which incorporate the word JAVA in their names to be in a similar vein. However, the evidence

does go to show that the opponents have no de facto monopoly in the word JAVA in relation to the services at issue, a point conceded by Mr Skinkis-Loftus at the hearing.

42. Turning to the evidence of slang use of the word JAVA for coffee, it is my view that this clearly shows use in the USA of such slang. However, there is no evidence to show that in the UK, JAVA is commonly known or used as a slang alternative word for coffee by the customer for coffee or coffee bar services.

43. Next, I turn to the applicant's submissions that the word JAVA is descriptive in relation to coffee and thus coffee bar services. In this connection it is worth noting the Registrar's Practice in relation to the acceptability service mark applications for foreign geographical names which is set out in Chapter 4.9.14 of the Trade Marks Manual and reads as follows:-

“4.9.14 Foreign geographical names

Regardless of population size or type of service, these must be considered on the basis of whether the name of the location has a reputation for the service and whether other traders with a business in the UK are reasonably likely to wish to use the name to indicate the geographical origin or other characteristics of their own such services. In many cases the use of foreign geographic locations as trade marks for services would be fanciful, eg BOMBAY for “shoe repairs”; as would KANSAS FRIED CHICKEN for restaurant services. Prima facie objections would arise if the place name has a connection or reputation for the service claimed eg PARIS for “fashion design”, MAJORCA for “travel services” or MONGOLIAN for restaurant services (indicates type of goods served).”

44. The above guidance, which has no force of law as such, shows that objection arises if the place name has a connection or reputation for the service claimed or indicates a type or category of goods available through the service eg Mongolian food at a Mongolian restaurant.

45. The applicant's evidence relating to the use and descriptive nature of the word JAVA as a type of coffee and a source of coffee is comprehensive and in my view conclusive. The exhibits attached to Ms Wood's witness declarations contain numerous examples of such use – JAVA blends are sold by Tesco, Bewleys, Whittard, Marks & Spencer and Sainsbury's, amongst others. The ingredient shown on the back of the Sainsbury's pack is “Javan coffee (100%).” Numerous internet references also substantiate the applicant's case.

46. While I find it difficult to envisage that a coffee bar service would be offered for JAVA coffee only, it seems to me perfectly feasible for a coffee bar to specialise in Javan coffee(s) and I believe that Mr Tritton's submission that the word JAVA is a non-distinctive element within both the opponents' and applicant's trade marks, in relation to the relevant service, to be correct.

47. This, of course, is by no means the end of the matter as the respective marks must be considered in their totality and the comparisons made on the merits of the case in hand.

48. The opponents' prior registrations consist of two marks. Registration Number 2135111 comprises the words JAVA BAR ESPRESSO (JAVA being prominent through its size and location) and a stylised device of a coffee bean. I have already commented above in relation to the word JAVA and I would add that the words BAR and ESPRESSO are mere descriptors

in relation to the relevant services. Registration Number 22235987 consists of a series of two marks comprising the word java and a stylised device of a coffee bean, the second mark being limited as to colour. The mark in suit consists of the two words JAVA EXPRESS. The opponents submit that the word EXPRESS in relation to a service, including services for the provision of food and drink, is commonly used to denote a fast or quicker service. While the applicant's dispute this point, my own knowledge and experience tells me that EXPRESS in relation to services, including the services at issue, will be readily perceived as indicting fast or speedy service provision.

49. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison, reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

50. Firstly, I turn to a visual comparison of the respective marks. The similarity and differences are plain to see. The respective marks share a common element, the non-distinctive word JAVA. In addition, the mark in suit contains the non-distinctive word EXPRESS, whereas the opponents registrations contain a stylised coffee bean device and in the case of registration number 2135111 the additional non-distinctive words BAR and ESPRESSO. While the words EXPRESS and ESPRESSO may look superficially similar, they have their own strong and separate meanings in relation to coffee and coffee bar services. Accordingly, the visual interpretation will be affected by the identification of the different words. My considerations must be on the basis of overall impression but given the non-distinctive nature of the words within the marks it seems to me that in totality as the inherent distinctiveness of the respective marks is somewhat limited, the impact of the device element within the opponents' marks is likely to be enhanced and serves to differentiate the marks in a visual context.

51. In relation to aural use the opponents' position could be stronger in that the device element in the opponents' marks may not be referred to as, in composite marks, "words speak louder than devices". However, the different words appearing in the marks have an obviously differing aural impact given their obvious meanings. It also seems to me that the opponents' marks have a primarily visual identity given the non-distinctive nature of the word(s) contained within these marks. I would add that at the hearing it was common ground that in relation to the services at issue, the customers primary means of identification would be in a visual context as coffee bar services etc are visually experienced by the customer visiting the premises of the service supplier.

52. I now turn to a conceptual comparison of the marks. While the respective marks share the word JAVA this is not a novel or distinctive word in relation to coffee (goods provided under the service) and given this fact I do not believe that the JAVA concept is one which would be identified with any particular trader or service provider. While it is possible that some people encountering the applicant's mark may think it reminiscent of the opponents' marks, it does not follow that a likelihood of confusion exists.

53. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to a likelihood of confusion I must consider the average customer of the services.

At the hearing it was common ground that the customer for the relevant services was the public at large who would in the main enter the respective premises to purchase a drink, snack or meal. Accordingly, the customer is not a sophisticated or specialist consumer.

54. Before reaching my conclusions in relation to the Section 5(2)(b) ground I go on to consider the opponents' evidence in relation to actual confusion between the respective marks in the market place.

55. The opponents allege two instances of actual confusion but the evidence shows (see paragraph 12 of this decision) that the alleged confusion arose after the relevant date for these proceedings. Furthermore, in the Mulmar incident the invoice and credit note were correctly made out to the applicant and the delivery and installation details show the applicant's address. While the address is incorrectly stated on the invoice and credit note, being an address of the opponent, there could be a number of reasons for such an error and the fact remains that the applicant company was correctly identified as the customer of Mulmar. The second incident involved a faxed quotation for a fire and security system by a company named ADT Fire and Security for the applicant. Once again this quotation is correctly made out to the applicant, but the fax numbers on the document are those of the opponent which resulted in the facsimile being sent to the opponent company. However, once again it is the applicant company which is correctly identified as the customer of ADT.

56. On the evidence of confusion issue Mr Tritton drew my attention to the following comments of Lord Simons in the *Office Cleaning Services Ltd v Westminster Window & General Cleaners* [1946] 63 RPC 39 at 43:

“It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

57. While Lord Simons comments were obviously not made in the context of confusion under Section 5 of the 1994 Act, I agree with Mr Tritton that the sentiments expressed in that case are applicable and are consistent with the guidelines expressed in *Sabel BV v Puma AG* which are mentioned earlier in this decision. I have already found that in relation to coffee bar services the common element in the respective marks, the word JAVA, is non-distinctive. The fact that the respective marks contain this word as a major element within the marks may lead to an association between them, but it does not demonstrate confusion as to trade origin ie as to who is providing the particular service under the relevant mark.

58. On a global appreciation taking into account all the relevant factors I have come to the conclusion that while some people encountering the applicant's mark may think it reminiscent of the opponents' marks, it does not follow that a likelihood of confusion exists among the average customer for the services. While the respective specifications cover identical services, the overall differences in the marks (bearing in mind the non-distinctive nature of the word JAVA in respect of the relevant services) and the category of services, which are usually experienced by the customer in person at the service provider's premises,

means that the possibility of confusion amongst the relevant customers cannot be regarded as a likelihood.

59. The opposition under Section 5(2)(b) of the Act fails.

60. Next, the Section 5(4)(a) ground. Section 5(4)(a) states:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

61. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the ‘Appointed Person’, in *Wild Child* [1998] 14 RPC, 455:

“A helpful summary of the element of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been referred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition of ‘passing off’, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

62. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the courts will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the matter in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

63. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (23 June 2000) (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

64. At the hearing Mr Tritton, correctly in my view, conceded that the opponents had sufficient goodwill in its marks, as registered, to launch a passing off action. However, as the evidence shows that the marks used by the opponents are identical to the marks for which registration has been obtained ie registration numbers 2135111 and 2235987, the opponents are, in effect, in no stronger position under Section 5(4)(a) than Section 5(2)(b).

65. Earlier in this decision I found that the application in suit and the opponents' registered marks were not confusable. Accordingly it is my view that the necessary misrepresentation required by the tort of passing off will not occur and the Section 5(4)(a) ground must fail on this basis.

COSTS

66. The applicant is entitled to a contribution towards its costs and I therefore order the opponents to pay the applicant the sum of £1,750. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2003

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General