

O-492-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3056218

BY

BOZENA AGNIESZKA MAZERANT

TO REGISTER THE TRADE MARK

WILD AND WOOD COFFEE HOUSE

IN CLASSES 30 and 43

AND

THE OPPOSITION THERETO

UNDER NO 402838

BY

TOOK US A LONG TIME LIMITED

BACKGROUND

1. On 19 May 2014, Bozena Agnieszka Mazerant (the applicant) applied to register the above trade mark in classes 30 and 43 of the Nice Classification system¹ as follows:

Class 30

Ground and whole bean coffee, coffee beverages, ready to drink coffee, espresso and espresso beverages.

Class 43

Preparation and provision of coffee for consumption in offices.

2. The application was published on 11 July 2014, following which Took Us A Long Time Limited (the opponent) filed notice of opposition against the application.

3. The opposition is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (the Act). The opponent relies upon the following marks in respect of the section 5(2)(b) and 5(3) grounds:

Mark details and relevant dates	Goods relied upon
<p>UK: 2208408</p> <p>WILDWOOD</p> <p>Filed: 10 September 1999</p> <p>Entered in the register: 3 March 2000</p>	<p>Class 43 Restaurant, pizza restaurant, café, bar, wine bar and catering establishment services; catering services</p>
<p>UK: 2492055</p> <p>WILDWOOD</p> <p>Filed: 8 July 2008</p> <p>Entered in the register: 28 November 2008</p>	<p>Class 43 Services for providing food and drink; restaurant services; cafe services; bar services; catering for the provision of food and drink; catering services; provision of food and drink; advisory services relating to catering; arranging for the provision of food and drink; bistro services; booking of catering services; booking of restaurant places; business catering services; cafeteria services; coffee shops; consultancy services relating to food; cooking services; food preparation; food cooking services; hospitality services (food and drink); preparation of food and drink; provision of information relating to restaurants; public house services relating to food; reservation of meals; restaurant reservation services; snack bars; tea room services.</p>

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

CTM: 12530382

WILDWOOD KITCHEN

Filed:

23 January 2014

Entered in the register:

16 June 2014

Class 29

Meat; fish; poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; dairy products and dairy substitutes; charcuterie; soups; seafood; lobsters, not live; oysters, not live; shellfish, not live; processed fruits, fungi and vegetables (including nuts and pulses); prepared meals, snacks and desserts (including soups and stocks) namely birds' nests, casseroles, condensed tomatoes, dips, fish crackers, pollen prepared as foodstuff, pork snacks, prepared soya, ready meals primarily with meat, fish, seafood or vegetables, snacks and side dishes of potatoes, soups and preparations therefor, stews, stocks and broths, yucca chips.

Class 30

Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; pasta; biscuits; buns; sushi; tarts; prepared foods; prepared meals; fruit sauces; convenience food and savoury snacks namely corn, cereal, flour and sesame based snacks, crackers, dumplings, pancakes, pasta, rice and cereal dishes, pies and pastry dishes, sandwiches and pizzas, spring and seaweed rolls, steamed buns, tortilla bread dishes; salts, seasonings, flavourings and condiments; baked goods, confectionery, chocolate and desserts; sugars, natural sweeteners, sweet coatings and fillings, bee products; ice, ice creams, frozen yogurts and sorbets; processed grains, starches, and goods made thereof, baking preparations and yeasts.

Class 43

Services for providing food and drink; restaurant services; food and drink take-away services; preparation of meals for consumption off the premises; café services; bar services; temporary accommodation; booking of temporary accommodation; hospitality services namely accommodation; hospitality services namely food; hotel and restaurant reservation services; cocktail lounge services; hotel information; providing hotel accommodation; resort hotels; motels; agency services for booking hotel accommodation; holiday lodgings; arranging and provision of holiday accommodation;

	arranging and providing meals for travellers; arranging and providing hotel reservation services; reservation services for booking meals; catering services for the provision of food and drink; and advice, consultancy and information for the aforesaid, included in the class.
--	--

4. The applicant filed a counterstatement on 14 November 2014. It denies the grounds on which the opposition is based and requests the opponent provide proof of use of its marks.² It has not specified for which mark(s) proof of use is requested.

5. Both parties filed evidence. A hearing took place on 13 August 2015, by video conference. The applicant represented herself. The opponent filed a skeleton argument and was represented by David Rose of King & Wood Mallesons LLP.

EVIDENCE

Opponent's evidence

6. The opponent's evidence comprises a witness statement by:

Daniel Jonathan Plant and exhibits DJP1-DJP10

Mr Plant is the Director of the opponent, which is a subsidiary of Tasty Plc. Mr Plant is also a Joint CEO of Tasty Plc. His statement is dated 12 February 2015.

7. The main points arising from Mr Plant's statement are as follows:

"9. The Opponent opened its first restaurant under the name WILDWOOD in September 2008 in Gerrards Cross, Buckinghamshire. Since that first opening, the Opponent has opened a number of WILDWOOD branded restaurants. By the Filing Date there were 20 outlets operating under the name WILDWOOD and 4 operating under the name WILDWOOD KITCHEN sites..."

8. Exhibit DJP1 comprises prints which Mr Plant states are taken from the opponent's website. They consist of photographs of 23 WILDWOOD restaurants. Seven of the photographs show the exterior of a restaurant on which WILDWOOD can be seen on a range of signs. The remaining images are interiors in which the name of the restaurant cannot be seen. None of the printed pages is dated. The final page of the exhibit is titled Wildwood Kitchen, has a print date of 2 December 2015 and lists seven locations for restaurants. Mr Plant says of the restaurants:

"10. The Opponent's WILDWOOD restaurants are focused on casual dining, and offer a range of dishes including quality grills, pizza and pasta dishes: in essence, WILDWOOD restaurants seek to blend traditional Italian with

² Because the earlier mark completed its registration process more than five years prior to the date of publication of the applied for mark then it is subject to the proof of use provisions set out in section 6A of the Act.

American steak-house styles. The units which operate under the name WILDWOOD KITCHEN maintain the essence of the main outlets but in a stripped back format, with a simplified menu and operated from smaller units. The opponent serves, and has served at all material times, quality coffee and similar beverages such as tea in all the restaurant[s] operated under the Wildwood Marks. Coffee products are a very significant element of the casual dining model of business and plays a significant role in the manner that a restaurant is perceived by the customers.”

9. In support of his statement, exhibit DJP2 is an article titled ‘Poor coffee ruins the restaurant experience, according to research’. It is taken from www.thecaterer.com and is dated 26 October 2012.

10. With regard to use of the marks WILDWOOD and WILDWOOD KITCHEN, Mr Plant states that the marks appear prominently on the fascia of each outlet as well as on menus and in promotional material. In support of this statement, DJP3 is described as a presentation showing the shop fronts of the restaurants. It is not clear to whom this presentation was made available and it is not dated. It shows the shop fronts of 27 restaurants. The first is Gerrards Cross which opened in September 2008, the last is Camberley, which opened in August 2014. The photographs show the words WILDWOOD or WILDWOOD KITCHEN (in a range of typefaces) on the front fascias of 24 of the restaurants. Three of the photographs are not clear and the signage cannot be made out.

11. DJP4 is sample menus from WILDWOOD, dated 1 December 2010 and from WILDWOOD KITCHEN, dated 8 January 2014. Mr Plant states that these are typical of how the marks have been used on menus. The marks are shown at the top of each menu in the following forms:



12. Exhibit DJP5 comprises examples of promotional material issued between 2010 and 2013. The first page of the exhibit is a poster advertising ‘Dine 2 for 1’ with a web address where a voucher can be printed. The bottom quarter of the poster shows the WILDWOOD mark I have reproduced above. There are five other examples of posters showing offers, each including the WILDWOOD mark prominently on the page. Also included is a loyalty card which enables customers to collect stamps and a children’s activity sheet, both of which show the WILDWOOD mark. In addition there is a discount coupon offering ‘2 4 1’ and showing WILDWOOD KITCHEN in the form I have depicted above. It is not clear

where the posters were displayed or how the flyers were made available.

13. Mr Plant states that since the opening of the first WILDWOOD restaurant, the opponent has generated a substantial reputation and extensive goodwill in its marks. Exhibit DJP6 comprises examples of reports in the specialist press such as 'The Caterer' and 'Bighospitality'. It also includes articles taken from local press publications referring to the opening of new restaurants under the WILDWOOD and WILDWOOD KITCHEN marks and directory entries for those restaurants. The articles focus on the opponent's expanding business and increased share prices as well as the nature of the casual dining industry.

14. At paragraph 14 of his witness statement, Mr Plant states:

"The Wildwood Marks are also reputed and well recognized within the hospitality industry and have been included in the top ten brands to watch in February 2012, March 2013 and November 2013 Ones to Watch surveys by foodservice analyst Horizons. Horizons' Ones to Watch survey is released biannually and tracks the emergence of new and expanding brands. To qualify for inclusion a brand must have between five and twenty five outlets and experience growth of 20% over the previous three years combined."

15. Mr Plant provides the following turnover figures which he describes as 'total revenue' figures:

Financial year	Revenue (£)
2009	1,733,000
2010	3,866,000
2011	5,187,000
2012	9,838,000
2013	14,086,000
2014	20,030,000

16. He comments on the figures at paragraph 15 of his statement in the following terms:

"As can be seen, total revenue figures since opening the first restaurant are £54,740,000, with the revenue increasing by almost £6,000,000 during the last year alone."

The applicant's evidence

17. The applicant's evidence comprises a witness statement by:

Ms Bozena Agnieszka Mazerant, the applicant, with 25 exhibits attached.

Ms Mazerant's statement is dated 9 April 2015.

18. The main points arising from the witness statement are as follows:

19. The trade mark Wild and Wood Coffee was first used in the UK in 2008 when Wild and Wood Coffee opened a coffee shop on 4 December 2008.

20. Wild and Wood Coffee has been voted Best Coffee Shop of the Year 2014 by London Lifestyle Awards.

21. By way of an explanation as to the naming of the business, the applicant states that the shop was named after the road in which her partner lived at the time the business was

established, Wildwood Road in North London.

22. Ms Mazerant is keen to show a distinction between Wild and Wood Coffee and the opponent's restaurants which, in her view, are not known for their coffee. In her statement she stresses that Wild and Wood Coffee House uses only organic Jersey Milk and Monmouth coffee and top quality suppliers who also supply to Harrods, Liberty and Selfridges.

23. In further support of this point, Exhibit BAM5 comprises newspaper articles and magazines which have featured articles about Wild & Wood Coffee. These are dated between 2010 and 2014. An example is an article from *the Independent* titled 'The 50 best coffee shops' by Victoria Stewart and published 3 May 2012. Wild & Wood is shown in the list.

24. Exhibit BAM7 comprises a number of prints from coffee blogs dated between 2010 and 2014. For example, at page 4 of the exhibit is a review from The Muesli Lover dated 15 January 2010, it is titled 'Best cafes: Wild and Wood, Holborn, London.

25. Exhibit BAM10 is a list of awards won by Wild and Wood Coffee. They are dated between 2010 and 2014. For example, the last page of the exhibit is a photograph of a sticker on a shop window, presumably the window of the coffee house owned by Ms Mazerant, though this is not clear from the statement. The sticker features a stylised London skyline with the words, LONDON LIFESTYLE AWARDS 2014, London Coffee Shop of the Year, WINNER, Wild & Wood.

26. BAM24 is a further collection of reviews of Wild and Wood Coffee. The first three are not dated. The fourth is a blog from www.quora.com. The entry naming Wild and Wood as a favourite place in London for coffee is dated 26 December 2011.

27. To support the applicant's view that there is no confusion between the parties' respective businesses Exhibit BAM23 is the result of a Google search which Ms Mazerant states shows that Wildwood Restaurant and Wild and Wood Coffee never appear next to each other in search results and that Wild and Wood Coffee is never returned when searching for Wildwood.

28. This completes my summary of the evidence.

The WILDWOOD KITCHEN mark

29. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A³ of the Act kick in), there is a prima facie presumption that it is valid in relation to all the goods/services for which it is registered (see s72 of the Act). Consequently, the opponent's earlier UK mark WILDWOOD KITCHEN can be relied on for each of the goods and services for which it is registered without the opponent needing to prove any use of its mark in relation to those goods and services. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the good or services listed in the register regardless of the goods or services on which it may have used its mark. This

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5 May 2004

concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*⁴ like this:

"22...It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

The WILDWOOD marks

30. The applicant's WILDWOOD marks completed their registration procedure in the UK on 3 March 2000 and 28 November 2008. The application was published on 11 July 2014. Consequently, the opponent's registrations in respect of WILDWOOD are subject to proof of use, as per Section 6A of the Act and the applicant has requested the opponent to prove its use.

31. Section 6A of the Act reads as follows:

"6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

⁴ [2004] RPC 41

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

32. The relevant period is the five year period ending on the date of publication of the application, namely 12 July 2009 to 11 July 2014. The onus is on the opponent, under section 100 of the Act, to show genuine use of its marks during this period in respect of those services relied on.

Approach

33. I will consider the opponent’s WILDWOOD KITCHEN mark first, in respect of the 5(2)(b) ground, as it is registered in the same classes as the application and is not subject to proof of use.

DECISION

34. Section 5(2)(b) which reads as follows:

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

(a)...

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

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

35. In its statement of grounds, with regard to section 5(2)(b), the opponent states:

“2.2 Due to the similarity of the Trade Mark and the Earlier Trade Marks, visually, aurally and conceptually, the relevant public within the United Kingdom is likely to consider that the goods and services at issue are provided by the same undertaking or by an economically linked undertaking.

2.3 The Opponent also relies on the enhanced distinctive character and extensive reputation of the Earlier Trade Marks as a result of which there will be an increased likelihood of confusion on the part of the relevant public between the Trade Mark and the Earlier Trade Marks.”

36. In its counterstatement the applicant states:

“There is no likelihood of confusion, mistake or deception because products, customers, delivery channels of Applicant’s mark and marks of Opposer are not confusingly similar.

Wild and Wood Coffee is a Small 20sm in total area. We are well established in the artisan coffee business. Featured in numerous coffee publications. Wild and Wood Coffee has been voted Best Coffee Shop of the Year 2014 by LONDON LIFESTYLE AWARDS...WILDWOOD RESTAURANT is a pizza and pasta place where people go for a meal and glass of wine.”

37. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 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.

The average consumer and the nature of the purchasing act

38. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which those services will be selected in the course of trade.

39. In its skeleton argument the opponent states:

“12.5 Here the average consumer is a consumer of coffee. Such consumers will exhibit certain features:

(a) They will represent a spectrum of customers with different backgrounds (whether in terms of age, gender, income bracket etc.) and who shop in different ways.

(b) They will enter into a range of transactions which will include the wholly functional (a cup of coffee to have with a lunchtime sandwich) to the more discerning (the purchasing of ground coffee for a coffee machine). Coupled with the fact that transactions will be of small or low value, the level of attention of the average consumer will be modest.

(c) They will interface with brands through a variety of sources and media – word of mouth, online, in store and will rarely have the chance to make direct comparisons between marks (instead of having to rely upon an imperfect picture of them).”

40. 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

41. Coffee and the provision of coffee are normal everyday goods and services available to members of the general public. The selection process for the goods and services is primarily visual, though I do not discount the fact that there may be an aural element given that word of mouth recommendation may play a part. The goods may be purchased on the high street, online or by mail order. The services are likely to be selected on the high street or in response to promotional material. In both cases, the level of attention paid will be average, the consumer paying the attention necessary to obtain, inter alia, the particular variety and/or strength of coffee, in a location convenient to them.

Comparison of goods and services

42. The goods and services to be compared in classes 30 and 43 are as follows:

The opponent’s goods and services	The applicant’s goods and services
<p>Class 30</p> <p>Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; pasta; biscuits; buns; sushi; tarts; prepared foods; prepared meals; fruit sauces; convenience food and savoury snacks namely corn, cereal, flour and sesame based snacks, crackers, dumplings, pancakes, pasta, rice and cereal dishes, pies and pastry dishes, sandwiches and pizzas, spring and seaweed rolls, steamed buns, tortilla bread dishes; salts, seasonings, flavourings and condiments; baked goods, confectionery, chocolate and desserts; sugars, natural sweeteners, sweet coatings and fillings, bee products; ice, ice creams, frozen yogurts and sorbets; processed grains, starches, and goods made thereof, baking preparations and yeasts.</p> <p>Class 43</p>	<p>Class 30</p> <p>Ground and whole bean coffee, coffee beverages, ready to drink coffee, espresso and espresso beverages.</p> <p>Class 43</p> <p>Preparation and provision of coffee for consumption in offices.</p>

The opponent's goods and services	The applicant's goods and services
Services for providing food and drink; restaurant services; food and drink take-away services; preparation of meals for consumption off the premises; café services; bar services; temporary accommodation; booking of temporary accommodation; hospitality services namely accommodation; hospitality services namely food; hotel and restaurant reservation services; cocktail lounge services; hotel information; providing hotel accommodation; resort hotels; motels; agency services for booking hotel accommodation; holiday lodgings; arranging and provision of holiday accommodation;	

43. So far as the applicant's use of its mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁵, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

44. Therefore differences between the goods and services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the specifications they have tendered for the purpose of the registration of their marks. Differences between the parties' marks or trading styles are also irrelevant, again except to the extent that these are apparent from the registered and applied-for marks.

45. In comparing the goods and services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

46. In class 30 the applicant's coffee goods are clearly included within the broad term 'coffee' in the opponent's specification. In class 43 the applicant's 'preparation and provision of coffee for consumption in offices' falls within, at least, 'services for providing food and drink' within the opponent's specification. In accordance with *Meric*, the applicant's goods and services are identical to the opponent's goods and services in the same classes. I need not consider the opponent's goods in class 29 since the goods in that class cannot put the opponent in any better position than the finding I have already made.

Comparison of marks

47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created

⁵ Case C-533/06

by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

49. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
WILDWOOD KITCHEN	WILD AND WOOD COFFEE HOUSE

50. With regard to the overall impression of the respective marks the opponent submits that 'kitchen' and 'coffee house' are descriptive in light of the goods and services. Consequently, the opponent concludes that the distinctive elements of the marks are WILDWOOD and WILD AND WOOD, differing only in the additional AND in the application.

51. The opponent's mark is made up of two words WILDWOOD KITCHEN. It is presented in upper case in a plain black font with no additional stylisation. The overall impression of the mark is dominated by the initial word WILDWOOD, the second word simply being seen by the average consumer as a description of the undertaking or the source of the goods.

52. The applicant's mark consists of the five words WILD AND WOOD COFFEE HOUSE in upper case, presented in a plain black font. The overall impression of the mark is dominated by the words WILD AND WOOD, the COFFEE HOUSE part of the mark simply being seen as a description of the undertaking providing the goods and services.

Visual similarities

53. Both marks begin with the four letters WILD. In the opponent's mark these are the first four letters of the eight letter word WILDWOOD. WILD is the first word of the application, with the word WOOD also appearing in it, albeit after the word AND. The applicant's mark is longer, comprising five words compared to the opponent's two. The application ends with the words COFFEE HOUSE while the opponent's ends KITCHEN. Taking all of these factors into account, I find the marks share a medium degree of visual similarity.

Aural similarities

54. The opponent's mark includes the word WILDWOOD. Whilst presented as a single word, it naturally breaks down to the two component words WILD-WOOD. The first word of the applicant's mark is WILD followed by AND WOOD. The words WILD and WOOD are present in both marks. Both are followed by common English words KITCHEN and COFFEE HOUSE, which are non-distinctive for the goods and services at issue and are unlikely to be articulated by the average consumer.

55. Where the marks are pronounced 'WILD-WOOD' and 'WILD AND WOOD' I find the parties' marks to be aurally similar to a fairly high degree. If the average consumer articulates the whole of both marks then the degree of similarity is at a medium level.

Conceptual similarity

56. With regard to conceptual similarity, at the hearing, Mr Rose submitted for the opponent that conceptually the parties' respective marks are the same as they are made up of the same words WILD and WOOD and they break in a natural and normal fashion. I disagree.

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁶ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁷

58. The opponent's mark WILDWOOD naturally breaks into the two words WILD and WOOD, however, the conceptual message rests in the mark in its totality which will be seen by the average consumer as overgrown or unruly woodland. The conceptual message provided by the application rests in the words WILD AND WOOD which will most likely be seen as a combination of surnames.

59. The remaining words of both marks, namely, KITCHEN and COFFEE HOUSE will simply be seen as referring to the nature of the parties' respective businesses. I find the marks to be conceptually distinct.

Distinctive character of the earlier mark

60. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services for which it is registered 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 and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

61. As I have concluded above, the mark will be seen as the word WILDWOOD, which creates the impression of a wild wood. The word KITCHEN describes the nature of the

⁶ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁷ See the comments of Anna Carboni sitting as the Appointed Person in the *Chorkee* case, BL O-048-08

undertaking/origin of the goods. The mark does not describe or allude to the goods and services in question. Accordingly, the mark has an average degree of inherent distinctive character of the kind possessed by a normal trade mark.

62. Throughout these proceedings and at the hearing the opponent sought to rely on enhanced distinctive character through the use of its marks. In its skeleton argument the opponent submits:

“12.6 As explained in Mr Plant’s witness statement, the Opponent has made significant use of the marks WILDWOOD (both on its own and as part of WILDWOOD KITCHEN) enjoying considerable commercial success in the process (and across a broad geography). For example revenue from the WILDWOOD and WILDWOOD KITCHEN brands was over £20M in 2014 alone. Such distinctiveness through use only serves to increase confusion.”

63. The evidence filed by the opponent relates to its ‘casual dining’ restaurant business. There is no evidence of sales of any goods bearing the mark WILDWOOD KITCHEN and no figures provided for the sales of such goods. I am unable to determine the opponent’s turnover with regard to any goods in class 30. Furthermore, with regard to the figures that have been put in evidence; no breakdown is provided to enable me to determine the nature of those sales or services supplied and they are not sufficiently detailed to enable me to reach a conclusion with regard to the extent the share of the relevant market that such sales and or supply of services may represent. Accordingly, whilst it is clear the opponent has used its mark, I am unable to conclude that the opponent has materially enhanced the distinctive character of its earlier mark due to the use made of it.

Likelihood of confusion

64. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁸ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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 services and vice versa.

65. I have concluded:

- The parties’ marks are visually similar to a medium degree.
- They are aurally similar to a fairly high degree if pronounced ‘WILD-WOOD’ and ‘WILD AND WOOD’ and are similar to a medium degree if both are articulated in full.
- The marks are conceptually distinct.
- The distinctive character of the earlier mark is average and has not been shown to have been materially enhanced through the use made of it.
- The parties’ goods and services are identical.

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

- The average consumer is a member of the general public, making a primarily visual purchase which requires an average degree of attention to be paid to the selection of goods and services.

66. The ends of both parties' marks are non-distinctive, the purchase is a primarily visual one which is low cost and fairly frequent. Given the visual and aural similarities of the marks and taking into account the concept of imperfect recollection, when encountering them the average consumer may misremember what the mark was that they had encountered previously, 'WILDWOOD' or 'WILD AND WOOD', giving rise to direct confusion.

67. In reaching such a conclusion I have considered the decision in *Nokia Oyj v OHIM*⁹, in which the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 *P Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

CONCLUSION

The opposition succeeds in full under section 5(2)(b) of the Act.

68. In its skeleton argument and at the hearing the opponent declined to pursue its 5(3) and 5(4)(b) claim in respect of WILDWOOD KITCHEN, so I need not consider these grounds any further in respect of this mark.

The remaining WILDWOOD marks

69. The opponent also relies on two WILDWOOD solus marks which I have described earlier in this decision. These are subject to proof of use and are narrower in scope than its WILDWOOD KITCHEN registration in that they are registered only in class 43 for a range of services. Put simply, the WILDWOOD marks put the opponent in no better position in light of my findings under the provisions of section 5(2)(b).

70. The opponent does, however, seek to pursue its opposition under 5(3) and 5(4) in respect of the WILDWOOD solus marks. However, use claimed for both marks is narrower than the registration I have already considered and only relates to services in class 43. Evidence filed in these proceedings showing use of the opponent's mark is not sufficient to establish a reputation of the kind envisaged by the CJEU in *General Motors Corp v Yplon SA*¹⁰ in respect of the goods at issue. Even if a reputation could be established for services which had sufficient reach to enable a finding in the opponent's favour, it would still be in no better position than it is under 5(2)(b) and I decline to consider it further. With regard to its 5(4) pleadings, the opponent relies on WILDWOOD KITCHEN used since 2012 and WILDWOOD used, it is said in its statement of grounds, since 2004 (2008 in the witness statements and exhibits). In either case, a finding in the opponent's favour would put it in no better position than I have already determined under section 5(2)(b) of the Act and I decline to consider it any further.

⁹ T 460/07

¹⁰ [1999] ETMR 950

The objection under 3(6) of the Act

71. Section 3(6) of the Act states:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

72. In respect of its claim under section 3(6) of the Act, the opponent states:

“The Applicant is involved in the operation of a coffee shop in New Oxford Street, London, W1 under the name WILD & COFFEE (‘the Café’). The shop was previously called WILD & WOOD. The name of the Café was changed following a claim for trade mark infringement and passing off asserted by the Opponent against the Applicant...”

73. In its skeleton argument and at the hearing, the opponent advanced the following in support of its case:

“43...What is not in dispute is that at the date of filing the Application, 19 May 2014... the following had occurred:

(a) March 2011 – The Opponent had challenged (by way of a cease and desist letter) the Applicant’s use of the name WILD & WOOD COFFEE.

(b) August 2011 – The Applicant agreed to a change of name.

(c) December 2011 – The Applicant confirmed that she would be changing the name to HYMAN & ROTH COFFEE. This offer was immediately accepted by the Opponent’s solicitors on the Opponent’s behalf.

(d) January 2012 – The Applicant said that it would now be changing the name to WILD & COFFEE.

(e) February 2012 – The Applicant assured the Opponent that she would be changing the signage and the website (according to the Applicant, more time was needed in relation to the website as ‘our web person is still away’).

(f) March 2012 – The Applicant changed the signage to WILD & COFFEE.

...

43.8 As the evidence shows, the Applicant and the Opponent reached an agreement over the change of name on 15 December 2011: the Applicant made an offer to change the name to HYMAN & ROTH COFFEE and the Opponent agreed unequivocally. Subsequently the Applicant revised its position and said it would change name to WILD & COFFEE (which the Opponent did not object to) and changed the signage in accordance with the agreement reached. However, simultaneously and unbeknownst to the Opponent, the Applicant had no intention of stopping use of WILD & WOOD other than on the Café’s external signage — she maintained the website (in spite of representations that the ‘web guy’ would make the required changes) and actively promoted the business as WILD & WOOD. Indeed the Applicant is brazenly open about the fact that she never intended to stop using WILD &

WOOD. For example at page 6 of her witness statement, the Applicant makes this telling admission:

‘After one year of harassment I remove word ‘wood’ from sign outside on 20 February 2012 to get some rest from letters and stressful phone calls. [I] Never change name with my suppliers and still up to today I am trading under Wild & Wood Coffee. I used this approach to force them into backing off’

74. The applicant states:

“Wildwood Restaurants threatened me over 2 years with phone calls, threatening me with high-powered lawyers and court costs that would send almost anyone under. With its deep pockets and limitless amount of time, Wildwood Restaurants can afford to wait out smaller players and drive them into the ground.

...

Wildwood Restaurant registered whole list of goods [services] in their list but coffee as a product is not there...But coffee is mine main product and Wild & Wood Coffee is there on London coffee map just on top of the list.

...

Finally I am taking this step to actually protect my brand as a registered trade mark as a demonstration to third parties of my commitment to the brand and that I regard it as my intellectual property right.”

75. The law in relation to section 3(6) of the Act was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*¹¹ in the following terms:

“131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd*

[2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

¹¹ [2012] EWHC 1929 (Ch)

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

'41...in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

76. In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, the CJEU stated that:

“46.....the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith”.

47. In such a case, the applicant’s sole aim in taking advantage of the rights conferred by a Community trade mark might be to compete unfairly with a competitor who is using the sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48. That said, it cannot be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective.

49. That may in particular be the case...where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.

50. Moreover...the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitor’s freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.

51. Furthermore, in order to determine whether the applicant is acting on bad faith, consideration may be given to the extent of the reputation enjoyed by the sign at the time when the application for registration as a Community trade mark is filed.

52. The extent of that reputation might justify the applicant’s interest in ensuring wider legal protection for his sign.”

77. Whether a trade mark was applied for in bad faith must be assessed at a particular point in time. As stated in the *Sun Mark* case, the relevant date is the application date or the opposed mark, namely 19 May 2014.

78. There is no dispute between the parties regarding the nature of the correspondence which passed between them. In fact they have both filed much of it in evidence to support their own cases.

79. There is no doubt that the applicant received correspondence from the opponent on 16 March 2011 which formally notified it of the opponent's WILDWOOD marks.¹² There is also no dispute regarding the fact that the applicant offered to change the name of its business. Its email to the opponent dated 3 August 2011 states:

"I will be changing the name at the end of august, but I have not come up with an alternative has (sic) yet."

80. There is also no dispute that two alternative names were suggested by the applicant and accepted by the opponent, or that the applicant altered its shop front in March 2012 but did not alter either its website, or its name in business dealings. As I indicated above, it filed its application to register the mark WILD AND WOOD COFFEE HOUSE on 19 May 2014.

81. I have no doubt in reaching a conclusion on the issue of bad faith that the applicant believes it has acted legitimately in pursuit of her business. However, as per point seven of the decision in *Red Bull* the applicant's own standards of honesty, or what the applicant considers to be acceptable commercial behavior, is irrelevant. What matters is whether the applicant's actions are such as would be judged by other honest men in business to be in bad faith.

82. The applicant had been in negotiation with the opponent and had agreed to change its name. In March 2012 the applicant changed its shop front to WILD AND COFFEE and had made an undertaking to the opponent that it would also change its website. The opponent could, at that point, have reasonably presumed that the matter had abated. By filing an application for the mark that she already agreed to stop using, (more than two years previously), the applicant has acted in a way that clearly will be viewed as falling below the standards of acceptable commercial behaviour and I find that she made the application in bad faith. **The ground under section 3(6) of the Act succeeds.**

CONCLUSION

83. The opposition succeeds under sections 5(2)(b) and 3(6) of the Act.

¹² The WILDWOOD KITCHEN mark was registered more than three years later than the date of this letter.

COSTS

84. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I make the award on the following basis:

Official fee:	£200
Preparing a statement and considering the other side's statement:	£300
Filing and considering evidence:	£700
Preparation for and attending a hearing:	£500
Total	£1700

85. I order Bozena Agnieszka Mazerant to pay Took Us A Long Time Ltd the sum of £1700. 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 21st day of October 2015

**Ms Al Skilton
For the Registrar,
The Comptroller-General**