

BL O/136/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3155613 BY
MUHAMMAD AWAIS AND ISHTIAQ AHMAD

TO REGISTER THE TRADE MARK




IN CLASS 35
AND
THE OPPOSITION THERETO
UNDER NO 406956
BY
WHOLE FOODS MARKET IP, L.P.

BACKGROUND

1. On 18 March 2016, Muhammad Awais and Ishtiaq Ahmad (“the applicants”) applied to register the above trade mark for, ‘retail services in relation to foodstuffs’ in class 35 under the Nice Classification system¹.

2. The application was published on 8 April 2016, following which Whole Foods Market IP, L.P. (“the opponent”) filed a notice of opposition against the application. The opposition is brought in respect of all of the applicants’ services.

3. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following UK Trade Mark (TM) registration in respect of its opposition under sections 5(2)(b) and 5(3) of the Act:

| Mark details and relevant dates | Services relied upon |
|--|--|
| <p>EUTM: 4974994</p> <p>Mark:</p>  <p>Filed: 22 March 2006</p> <p>Registered: 31 January 2008</p> | <p>Class 35</p> <p>Retail services in respect of food, beverages, grocery meats and produce; retail services of a supermarket or convenience store in respect of food, beverages, grocery, meats, produce; the bringing together, for the benefit of others, of a variety of goods, namely food, beverages, grocery, meats and produce.</p> |

4. In its statement of grounds, with regard to section 5(2)(b), the opponent submits that the parties’ respective marks are highly similar and the applicants’ services are identical or similar to the opponent’s services in the same class. It concludes:

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).*

“Given the similarity of the marks and the identity/similarity of the services in question, there exists a likelihood of confusion in the marketplace, not least because the similarity of the marks may lead consumers to unknowingly [make] use of the applicant’s services in place of those of the opponent.”

5. With regard to the opposition under section 5(3) the opponent submits that the parties’ marks are highly similar and the respective services are identical or similar. In addition, it claims that its mark benefits from enhanced distinctive character and has acquired a reputation in the Community including the UK. Consequently, it identifies the following heads of damage:

(a) By diluting or diminishing the ability of the Opponent’s mark to identify the services for which it is registered as coming from the Opponent;



(b) By tarnishing the repute of the Opponent’s mark in connection with its services, thereby damaging or reducing its power of attraction, by reason of the fact that the Applicant’s services may be of inferior quality to the Opponent’s well respected services, and that this will have a negative impact on the image of the Opponent’s mark;

(c) By free-riding on the coattails of the Opponent’s trade mark and its reputation in order to generate interest in the Applicant’s services, thereby saving on investment in the promotion and publicity of those services, and potentially leading to increased sales;

(d) By transferring to the Applicant’s mark and services the benefit, goodwill and reputation associated with the Opponent’s mark with the result that the marketing of the Applicant’s services will be made correspondingly easier.

6. Under section 5(4)(a) of the Act the opponent relies on the following signs:

| The opponent’s sign | Date of first use in the UK |
|----------------------------|------------------------------------|
| WHOLE FOODS MARKET | 1 January 2007 |
| WHOLE FOODS | 1 January 2007 |

| | |
|---|------------------|
|  | 9 September 2009 |
|  | 29 December 2015 |

7. It states that these signs have been used for ‘retail services in respect of food, beverages, grocery, meats and produce; retail services of a supermarket or convenience store in respect of food, beverages, grocery, meats, produce; the bringing together, for the benefit of others, of a variety of goods, namely food, beverages, grocery, meats and produce.’ It concludes:

“The opponent’s services and business have acquired goodwill and reputation symbolised by its mark. The use of the applicant’s mark by virtue of its high similarity to the opponent’s marks and the identical and/or similar nature of the applicant’s services to those of the opponent will constitute misrepresentation likely to lead the public to believe the applicant’s services are those of the opponent, or are linked to or endorsed by the opponent. The opponent is likely to suffer damage as a result.”

8. The applicants filed a counterstatement in which they deny all of the grounds of opposition and request that the opponent provide proof of genuine use of its trade mark in respect of the services for which it is registered.

9. The opponent filed evidence, the applicants filed written submissions during the written procedure. Both parties filed skeleton arguments. A hearing subsequently took place before me, by video conference, at which the applicants were represented by Mr Andrew Bridle of Bridle Intellectual Property Limited. The opponent was represented by Mr Jonathan Moss of Counsel instructed by Gill Jennings & Every LLP.

Preliminary issue

10. In its skeleton argument and at the hearing the applicants queried the relationship between the opponent and the other 'Whole Food Market companies'. I directed that, following the hearing, the opponent should provide an explanation of the company relationships and relevant licensees. This was provided on 24 August 2017 and reads as follows:

“Whole Foods Market, Inc. (“WFMI”) is, and at all times relevant to this proceeding has been, a holding company and the corporate parent of other companies in the Whole Foods Market family, including Fresh & Wild Limited (UK) which operates the WHOLE FOODS MARKET stores in the UK. The WFM brand and logos, and related registrations, are owned by Whole Foods Market IP, L.P. (WFM IP, L.P.) - a subsidiary of WFMI - and are licensed by WFM IP, L.P. to the affiliated corporate entities, including Fresh & Wild Limited (UK). Pursuant to these licenses, the goodwill arising from this licensed use of the WFM trademarks inures to the benefit of WFM IP, L.P.”.

11. Having considered the papers before me, I am satisfied that the opponent benefits from any goodwill generated by the trade marks relied on in this case and has the necessary standing to bring these proceedings.

EVIDENCE

The opponent's evidence

Witness statement of Roberta L Lang and Exhibits RL2-RL6 and RL8-RL10

12. Lang is the President of the opponent and has been employed by it since 2000. Her witness statement is dated 16 December 2016. The salient points from her evidence are as follows:

- The first store was opened in Austin, Texas in 1980.
- The opponent company expanded throughout the 1980s, 1990s and 2000s by

opening new stores and acquiring other natural food chains in the US, Canada and the UK.

- The opponent sells a wide range of natural and organic food products.
- The opponent currently employs approximately 87,000 people.
- Its sales in the fiscal year 2015 amounted to \$15.4 billion US dollars.
- An intrinsic part of the opponent's branding, since the 1980s, has been its house brand WHOLE FOODS MARKET.

13. Ms Lang submits that the following mark was first used in the UK on 6 June 2007 when the opponent opened its store in Kensington, London.



14. Ms Lang says of this mark:

"[It] has been used and continues to play a huge role in our branding today. Our mark therefore features very prominently in everything we do in the UK, from our marketing and business materials, to our website, our adverts (including on social media), on product packaging, shopping bags, shop frontages, and their internal fittings and so on..."

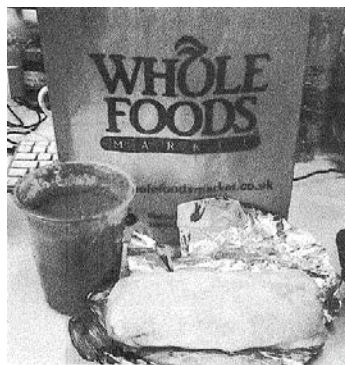
15. The opponent currently operates nine stores in the UK. Their locations and opening dates are as follows:

| Store location: | Opening date: |
|------------------------|----------------------|
| Kensington | June 2007 |
| Camden | January 2008 |
| Stoke Newington | January 2008 |
| Clapham Junction | January 2008 |
| Giffnock (Scotland) | November 2011 |
| Piccadilly Circus | May 2012 |
| Cheltenham | November 2012 |
| Richmond | October 2013 |
| Fulham | April 2014 |

16. REDACTED

17. Examples are provided of the opponent's mark used in a number of its stores, outside its stores and on jute bags and product labels.² The photographs appear to be taken from social media pages, some of which are dated. The first page is dated 7 June 2007 and shows the mark prominently displayed on the back wall of the opponent's Kensington Store.

18. A page dated 25 November 2008 shows the same mark displayed on an illuminated hanging sign outside the same store. A page dated April 2012 shows the same mark outside the opponent's Piccadilly store. Paper food bags featuring the mark are shown at page 33 of the exhibit.



19. A photograph taken in the Cheltenham store dated November 2012 shows the store interior branding and bags hanging at the end of the checkouts, all of which feature the opponent's mark. The following photograph is taken from Twitter and is dated 23 June 2012. It shows customers with branded bags, following the opening of the opponent's store in Piccadilly:

² See exhibit RL2



20. A print from Twitter shows the interior signage at the Giffnock store in Scotland. It is dated 21 June 2015 and shows the same mark.

21. The opponent's evidence includes ten prints from the opponent's website taken from waybackmachine.³ They are dated between 7 June 2007 and 7 March 2016 and include links to recipes, interviews, store information and competitions.

22. The first two pages dated 7 June 2007 and 14 March 2008 show the following mark at the top of each web page:



23. Four of the pages dated between 29 June 2009 and 20 February 2012 show the following sign, with the words, 'SELLING THE HIGHEST QUALITY NATURAL AND ORGANIC PRODUCTS' displayed below it:

24. The remaining pages, the earliest being dated 28 October 2014, show the following:

³ See exhibit RL5



25. Ms Lang states that the opponent's advertising and marketing uses various channels, including:

"16...direct mailings, circulars, in-store displays, advertisements in newspapers and magazines, flyers, newsletters, press releases, website advertising, social media, product packaging and labels, shelf-talkers, in-store events and participation in and sponsorship of community events."

26. Examples of advertising provided by the opponent⁴ include, inter alia, a number of social media pages announcing particular store openings, an advert for the opponent company on the back of a bus⁵ and a billboard advertisement at Kensington tube station to promote the opponent's Kensington store.⁶ The mark shown in each case is:



27. In-store magazines feature the following:



⁴ See exhibit RL9

⁵ See page 225

⁶ See page 229

28. The earliest of these is dated 'Winter 2009' and is a Christmas magazine.⁷

29. Ms Lang states that the mark and logos relied on by the opponent have been and continue to be 'prominently displayed on its social media platforms'. The opponent had, at the time Ms Lang wrote her statement, 88,000 followers on *Facebook*, 58,100 followers on *Instagram* and 49,550 followers on *Twitter*.

30. At paragraph 17 of her statement, Ms Lang refers to a number of awards won by the opponent which include the Good Egg Award [2007], the Good Pig Award [2007], and the Good Chicken Award [2015]. In the UK the opponent has won:

- Cool Brand Award [2008]
- Kings of Camden Award [2014]
- Time Out People's Choice Award [2016]⁸

31. In addition, the opponent has been named 'Retailer of the Year' by The World Retail Congress in 2013; ranked 18th on Fortune Magazine's 'World's Most Admired Companies' list in 2015⁹ (receiving the highest ranking in the food and drugstore segment) and Best Brand on Pinterest in 2014 at the 6th Annual Shorty Industry Awards.

32. The opponent is a member of The Organic Trade Board, The British Retail Consortium and The Soil Association in the UK.

Witness statement of Rowena Price and Exhibits RGP1 and RGP2

33. Ms Price is a trade mark attorney at the opponent's instructing firm. Her witness statement is dated 30 December 2016 and refers to a trade mark application and ex-parte trade mark hearing report relating to a matter of registration under section 3 of the Act. It does not relate to a trade mark relied on in these proceedings and I will say no more about it.

⁷ See exhibit RL9, page 202

⁸ See exhibit RL10

⁹ See exhibit RL10

34. This concludes my summary of the evidence to the extent that it is necessary. The applicants filed submissions during the period allowed for filing its evidence to which I will refer as necessary below.

DECISION

35. This opposition has been brought on a number of grounds. I will deal first with the claim under section 5(4)(a).

The law

36. Section 5(4) of the Act 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...

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

37. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) 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 preferred 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 or as if the words used by the House constitute an exhaustive, literal 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."

38. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

The relevant date

39. Whether there has been passing off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

“165. ...Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

40. The above related to a community trade mark, however, the same principle applies to a UK national trade mark.

41. The filing date of the subject trade mark is 18 March 2016. There is no evidence or claim by the applicants that they have used their mark prior to this. Accordingly, the matter need only be assessed as of 18 March 2016.

Goodwill

42. The first hurdle for the opponent is to show that they had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

43. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

44. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

45. The opponent's evidence shows that its business was established in the US and first entered the UK market in 2007 when it opened its first store in Kensington. This is supported by social media pages dated 7 June 2007 relating to that store opening¹⁰ as well as advertising relating to that store.¹¹ The opponent's UK business was initially confined to London and Greater London with seven stores in that area. In 2011 it opened a store in the suburbs of Glasgow and in 2012 it opened another in Cheltenham. Figures have been provided for the UK in respect of sales and advertising and are clearly not insignificant. FINAL SENTENCE OF THIS PARAGRAPH REDACTED.

46. The evidence in its totality shows that the opponent's business model is to provide a range of natural and organic food products and this is supported by a number of industry awards (though not all of these relate to the UK), photographs of in store displays and advertising. By way of example, a photograph of the inside of the Kensington store which shows the registered trade mark on the wall of the store, shows a chalk board in the fresh fruit and vegetable area which is titled, 'ORGANIC ITEMS' with the number '141' chalked below it.¹² A print from *facebook* shows the 'Organic September' calendar for the Camden store, it is dated 1 September 2011. It includes a competition to win an organic hamper and a number of 'organic' events happening in-store during the month. It clearly shows the trade mark presented in white on a darker background.

47. The opponent has provided examples of some of the types of goods available in its stores. For example, photographs provided at RL2 show a range of goods on display which one would typically expect to find in such a store, including, inter alia, a cheese department, a range of own brand seasonings, own branded drinks and breakfast pots,¹³ wine and champagne, delicatessen counters and a salad bar, an in-store café, a display of eggs and a number of examples of fresh fruit and vegetable departments in a number of the opponent's stores.¹⁴

48. In its totality, the evidence provided by the opponent is sufficient to show it had a protectable goodwill at the relevant date, namely 18 March 2016.

¹⁰ See exhibit RL2

¹¹ See exhibit RL9

¹² Page 12 of exhibit RL2

¹³ See exhibit RL4

¹⁴ See exhibits RL2 and RL4

Location of the opponent's goodwill

49. The opponent submits that its business 'has now extended throughout the rest of the UK' and that the opponent has traded through its website which allows consumers to pick up their orders from UK stores. It suggests that this provides evidence of its business having a presence throughout the UK.

50. At paragraph 15 of its skeleton argument the opponent states:

"Furthermore, even localised use is enough to establish goodwill capable of stopping a trade mark being registered, as no geographical restriction has been offered by the applicant".

51. I conclude from its various submissions that the opponent's position is that it has the necessary goodwill throughout the UK, but if that is found not to be the case, its localised goodwill is nonetheless sufficient.

52. Other than the seven stores it has in the London area, the opponent has one store in the suburbs of Glasgow at Giffnock and one in Cheltenham. In my view, the opponent's grocery stores are local in nature and I find it unlikely that a customer would buy groceries online and drive a considerable distance to collect them. Nor do I find it likely that a grocery store would deliver groceries beyond a reasonable distance. I find support for this in the opponent's evidence. For example, at exhibit RL9 the opponent provides one of the adverts for its Kensington Store. The bottom of the page reads:

"KENSINGTON HIGH STREET NOW DELIVERING TO W2, W6, W8, W9, W11, W14, SW3, SW5, SW7, SW10, NW8."

53. This clearly indicates that delivery is available within the local area. It is also clear from the opponent's evidence that promotion of its stores often takes place in the local area, for example, the advert at Kensington Tube station promoting the opponent's Kensington store.¹⁵

¹⁵ See exhibit RL9, page 229.

54. The pattern of advertising shown in the evidence is that the opponent's posters, in-store magazines and billboard adverts often refer either to the store where they are made available or the store nearest to where the promotional material is displayed. In addition the exhibits showing the opponent's presence on social media also largely relates to particular individual stores, with separate pages being used for each of them.¹⁶

55. In my experience it would be usual for consumers to buy the majority of their groceries within a reasonable distance of where they live, whether for collection, delivery or in-store purchase.

56. The situation here is on all fours with the type of goodwill established in *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another*¹⁷ where it was held that the plaintiff had a strong reputation and goodwill in certain parts of the UK. The case concerned an injunction but the geographic principles identified by Dillon L.J. are analogous to the situation before me. He concluded:

“If it be assumed, for the sake of argument, that the injunction were confined to the three proposed restricted areas, it also has to be assumed that there is a live possibility, perhaps amounting to a probability, that the defendants with their large resources and wide chain of existing shops, would soon be using the name ‘Chelsea Man’ in trading in towns close to the borders of some or all of those areas.

I do not propose to embark on a further examination of the evidence of which counsel on both sides have given us a careful and helpful analysis. In my judgment, it clearly shows that the use by the defendants of this name or mark even outside such areas would be likely to cause substantial confusion between the plaintiffs' and defendants' respective businesses, and thus to cause damage to the plaintiffs' business within those areas...”

57. In this case, having considered all of the material before me, I find that the opponent's goodwill, whilst concentrated in particular areas of the UK is sufficient to

¹⁶ See, for example, exhibit RL9 pages 185 and 187 relating to Richmond and Fulham Broadway stores.

¹⁷ [1987] RPC 189 (CA)

amount to a protectable goodwill in the UK for the purposes of its claim under section 5(4)(a) of the Act.

58. A fair characterisation of its business is that of a supermarket or convenience store with particular emphasis on natural and organic products.

The signs in which the opponent's goodwill rests

59. I note that in its skeleton argument the opponent submits:

40...It is important to note that this goodwill is not limited to a trade mark per se, but is more amorphous – and therefore includes the opponent simply being known by the name 'Whole Foods'."

WHOLE FOODS

60. The opponent claims to have goodwill in the plain words WHOLE FOODS, due to the use made of those words since 1 January 2007. I do not find that the evidence supports such a conclusion. The only references to the opponent as 'Whole Foods' are in press articles where it would be normal practice to use the words rather than a stylised mark in a section of text. In some of the examples provided at exhibit RL8 the article is accompanied by a picture of the store¹⁸ or a photograph of the opponent's primary mark¹⁹ and in the others it is clear from the introductory paragraph which particular business the article is referring to.

61. In the evidence provided by the opponent the only references by the opponent to itself as 'Whole Foods' in plain words is in twitter tags on social media pages²⁰ and as keywords on its social media pages. In each case the text relates to profile pictures and posts which show variations of the opponent's stylised mark. I cannot find any evidence of the opponent attempting to create a market for its services using simply the plain words 'Whole Foods'. The evidence supports my view that the words are used as matter of convenience with other signs providing the origin message.

¹⁸ See, for example, exhibit RL8, page 127 from *The London Evening Standard*, 'Whole Foods set to open second London branch', dated 4 November 2010.

¹⁹ See, for example, exhibit RL8, page 98 from *The Herald Scotland*, 'US stars' food store heads to Scotland', dated 5 November 2010.

²⁰ See, for example pages 25, 30 and 37 of exhibit RL2

The stylised mark/signs

62. Signage inside and outside the opponent's stores is primarily in the form of the sign shown below (the opponent's registered trade mark). It is sometimes presented with white lettering on a dark background and sometimes dark lettering on a lighter background:



63. Evidence of in-store magazines and archived pages from the opponent's website provide examples of the mark used on a circular background. The first of these, where the word 'MARKET' is presented on a lozenge shaped background, can be seen on a page printed from *facebook* dated 9 September 2009.²¹ The sign is shown at the bottom of a poster titled, 'Meet Our Butcher'.²² It takes the following form:



64. Both of these stylised signs (including the registered trade mark) are shown on, inter alia, bags sold within the store for customer use, bags and labels used to package items, staff uniforms, own branded food and drink products, social media pages and advertisements (including in-store advertisements) and the front cover of in-store magazines from a number of different stores.

65. The opponent claims use of the second round sign since 29 December 2015, which is the date that it is first shown in the evidence on its *facebook* page promoting a 'Health Fair'. It is shown as below:

²¹ See exhibit RL3, page 43.

²² The profile picture used by the opponent on that page is the second of these signs, but that does not mean that the opponent was using that sign as its profile picture in 2009. Facebook will have displayed the profile picture used by the opponent when the page was printed, namely, 12 September 2016.



66. The evidence shows that this sign is the opponent's current *facebook* profile, though I cannot be sure from what date it has been used in this way. This particular version of the opponent's sign would appear, given the dates claimed and the pattern of use shown in the evidence, to be a development of the earlier version of its sign (which presented the word MARKET on a lozenge background). In my view it would be seen as such by the relevant public, if the difference between the two were even noticed.

67. Taking all of the evidence into account, I find that the opponent had acquired goodwill under its earlier signs, including the words WHOLE FOODS MARKET alone, at the relevant date. The goodwill rests in supermarket or convenience store services with particular emphasis on natural and organic (or 'wholefood') products.

Misrepresentation

68. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is:

'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?'

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to ‘more than *de minimis*’ and ‘above a trivial level’ are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

69. In considering whether or not there will be misrepresentation in this case, I turn first to the nature of the opponent’s mark. Throughout the proceedings and at the hearing, the applicants have made reference to what, in their view, is the descriptive nature of the opponent's signs. The applicants did not file evidence in support of their submissions and the opponent submits that the point should not be considered. In their skeleton argument the applicants submitted the following, reproduced as written:²³

“The term WHOLE FOODS have been used for over 50 years (evidence: Wikipedia; not contradicted or challenged by the opponent). The words therefore form a commonly used term which describes ‘foods that are unprocessed and unrefined, or processed and refined as little as possible before being consumed’

The word MARKET is a commonly used word that is used to describe a retail channel for the goods.

Accordingly, when taken as a whole, the term WHOLE FOODS MARKET is entirely descriptive of a retail channel for foods that are unprocessed and unrefined, or processed and refined as little as possible before being consumed.”

70. The opponent submits:

²³ The paragraphs are not numbered but the extract provided is from the sixth paragraph on the first page.

“8. The Applicant has failed to put forward any evidence. Their submissions make comments on the descriptive nature of the word ‘whole foods’ and rely on certain websites to that end – but that is submission, not evidence.”

71. Whilst it is the case that the applicants have not filed evidence in support of this submission, this is not the end of the matter. I bear in mind the comments of Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*,²⁴ in which he stated that:

“The role of the court, including this court, was emphasised by Lord Diplock in *GE Trade Mark*²⁵ at page 321 where he said:

‘...where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the

²⁴ [1996] RPC 473

²⁵ [1973] R.P.C. 297

evidence of witnesses called at the trial is well established by decisions of this House itself.”

72. Whilst the case cited above dealt with goods the situation is analogous to services where those services are used by the general public and the nature of confusion or deception is a ‘jury question’. That is clearly the case here where the services are supermarket/convenience store services and the relevant public is the general public.

73. With this in mind, I note the comments of Mr Hobbs QC sitting as the Appointed Person²⁶ when he stated:

“15. In relation to the issue identified in paragraphs 20 and 21 of his decision, it was open to the Hearing Officer to look at appropriate works of reference for the purpose of supplementing his understanding of the meaning(s) that the word **FOREX** could properly be taken to possess in accordance with ordinary English language usage in this country. In *The Coca-Cola Co. of Canada Ltd v. Pepsi-Cola Co. of Canada Ltd*²⁷ Lord Russell of Killowen stated:

While questions may sometimes arise as to the extent to which a court may inform itself by reference to dictionaries, there can, their Lordships think, be no doubt that dictionaries may properly be referred to in order to ascertain not only the meaning of a word, but also the use to which the thing (if it be a thing) denoted by the word is commonly put.

There are numerous instances of dictionaries and other works of reference being considered in decisions issued by the Community Trade Marks Office and the supervising courts in Luxembourg in inter partes proceedings under the Community Trade Mark Regulation.²⁸

16. If the Hearing Officer had checked the normality of his own understanding of the word **FOREX** by comparing it with the meaning(s) indicated in appropriate

²⁶ *BL O/100/09*

²⁷ [1942] 59 RPC 127 (PC) at 133.

²⁸ Merely by way of example, see *Beiersdorf AG’s Trade Mark* [2001] ETMR 19, p.187 at paras 11, 12 (OHIM First Cancellation Division); *Case T-237/01 Alcon Inc. v. OHIM* [2003] ECR-411 at paras. 43 to 46; *Case T-91/03 Consorzio per la tutela del formaggio Grana Padano v. OHIM* [2008] ETMR 57 at paras. 67, 71 and 85.

works of reference, he would have been using generally accessible information to help him identify the ordinary meaning(s) of the word in the English language as written and spoken in this country. This is not normally regarded as evidence gathering. In *Baldwin & Francis Ltd v. Patents Appeal Tribunal*²⁹ Lord Reid said:

A judge is supposed to know the law, the English language and such facts as are common knowledge. If he refers to authorities or dictionaries or other works dealing with these matters he can safely do so because his general knowledge enables him to check and appreciate them.

and Lord Denning said:³⁰

And no one ever calls the author of a dictionary to give evidence. All that happens is that the court is equipping itself for its task by taking judicial notice of all such things as it ought to know in order to do its work properly.

It thus appears to me that the failure of the parties to adduce evidence in the present proceedings could neither prevent the Hearing Officer from checking his understanding in the way I have indicated nor compel him to assume without deciding that the word **FOREX** was likely to be perceived as an independent distinctive element in the marks in issue.”

74. With these cases in mind, following the hearing I wrote to the parties, enclosing the following dictionary definition, taken from the Oxford Dictionary of English:³¹

“Wholefood

noun

[mass noun] (also wholefoods) British. food that has been processed or refined as little as possible and is free from additives or other artificial substances.”

75. The applicants responded in the following terms:

²⁹ [1959] AC 663 (HL) at p.684.

³⁰ *Ibid*, at p. 691.

³¹ Ed. Stevenson, A. (2015, 3rd Edition) *Oxford Dictionary of English*, Oxford University Press.

“We note that the Hearing Officer intends to rely upon the dictionary definition of the term “Wholefoods” as set out in the Oxford Dictionary of English. We also note the legal basis and precedent for the use of the dictionary definition in this case.

Furthermore, we note that the definition given for this term in the Dictionary corresponds with the definition relied upon by the Applicant.

In the light of the dictionary definition of the term “wholefoods”, the Applicant maintains its position, as stated previously, that the term “wholefoods market” is entirely descriptive of a sales channel for food products that have been processed or refined as little as possible.

Accordingly, as previously stated, the rights owned by the Opponent in the WHOLEFOODS MARKET marks upon which they rely in their opposition to the subject application are limited to the specific stylisation of the marks in question.”

76. The opponent responded as follows:

“Firstly, we do not dispute the dictionary definition provided by the Office (i.e. “food that has been processed or refined as little as possible and is free from additives or other artificial substances”). Nonetheless, we submit that the Opponent has acquired distinctive character and goodwill in the term “Whole Foods”, this being composed of two words as opposed to one and containing a capitalised “W” and “F”. While it is not disputed that “wholefoods” describes certain foodstuffs, it is important to note that the goodwill in the term “Whole Foods” is in respect of retail services.

Secondly, the Office needs to take into account the fact that the opposition is based on other registered and unregistered rights of the Opponent, all of which have been substantiated during proceedings.”

77. Further guidance on this issue can be found in ‘The Law of Passing-Off, Unfair Competition by Misrepresentation’,³² the relevant paragraph of which reads as follows:

³² Wadlow, Christopher, Sweet & Maxwell, Third Edition, 2004, page 633.

8-73

A descriptive term may be sufficiently distinctive to be protected against precise copying, but may still not enjoy protection of such wide scope as a term which is wholly arbitrary. Other traders are free to use similar descriptive expressions as their own trade names or marks, and smaller differences will suffice to distinguish them than in a case of fancy words. This may be expressed in terms of 'the idea of the mark'. When an arbitrary mark is in use by the claimant, deception can occur by the defendant adopting a mark which incorporates the same predominant idea even if the expression differs. If, however, the only idea which can be identified is wholly descriptive then such distinctiveness as exists can only lie in the precise form of words used, or something even more specific, such as the manner in which they are written.³³ As may be seen in the Office Cleaning case,³⁴ there is an element of public policy here, in that a degree of confusion is held to be an acceptable price for keeping descriptive terms open to fair use by all.

'Foremost I put the fact that the Appellants chose to adopt as part of their title the words 'Office Cleaning' which are English words in common use, apt and more apt than any other words to describe the service they render...'

78. Having reminded their Lordships of the close relationship between trade name and trade mark cases,³⁵ Lord Simonds continued:

'So it is that, just as in the case of a trade mark the use of descriptive words is jealously safeguarded, so in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. It is otherwise when a fancy word has been chosen as part of the name...

³³ *Weingarten Bros v Bayer & Co* [1904-07] All ER 877; (1903) 22 RPC 341, HL.

³⁴ *Per Lord Simonds in Office Cleaning Services Ltd v Westminster Office Cleaning Association* [1946] 1 All ER

³⁵ *See Aerators v Tollit* [1902] 2 Ch 319; 19 RPC 418 (*Farewell J*) and *British Vacuum Cleaner Co Ltd v New Vacuum Cleaner CO Ltd* [1907] 2 Ch 312; 24 RPC 641 (*Parker J*).

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.'

79. Three points arise from the opponent's response to the dictionary definition for the term 'wholefoods'.

1. The Opponent submits that it has acquired distinctive character and goodwill in the term 'Whole Foods', this being composed of two words as opposed to one and containing a capitalised "W" and "F".

80. Wholefoods clearly has a natural break between the words 'whole' and 'foods' both being well-known English words. The space between the words and the capitalisation of the letters W and F in the opponent's sign do nothing to alter the dictionary meaning of this term.

2. The opponent submits that *"...it is not disputed that "wholefoods" describes certain foodstuffs, it is important to note that the goodwill in the term "Whole Foods" is in respect of retail services"*.

81. The opponent's sign comprises the words 'Whole Foods Market'. Self-evidently, a shop (market) which sells whole foods is a retail establishment selling whole foods. This submission does not assist the opponent.

3. *The opponent says: "the Office needs to take into account the fact that the opposition is based on other registered and unregistered rights of the Opponent, all of which have been substantiated during proceedings"*.

82. In conclusion, with regard to the nature of the opponent's sign, the dictionary definition I sent to the parties supports my own experience that it is not uncommon to

see areas of both online stores and bricks and mortar stores that describe some of their produce as whole foods and that this term refers to goods which are raw or unprocessed/refined.³⁶ Nothing in the submissions from the parties has altered my view on this matter and I find that the idea which can be identified within the opponent's sign is descriptive of its services which are those of a supermarket or convenience store, with particular emphasis on wholefood products.

83. The application is made and opposed in respect of retail services relating to foodstuffs. The parties' respective fields of activity are identical.

84. The opponent's goodwill is associated with the sign WHOLE FOODS MARKET, often used with the words presented one above the other, in a minimally stylised font with an additional element above the letter 'O' (which gives the impression of a leaf). Although it often uses those words in stylised form, I consider that the manner of overall use means that the goodwill is also associated with the words per se. The applicant's mark is as follows:



85. The applicants' sign comprises the words WHOLE FOOD EARTH, presented one above the other on a green circular background in capital letters. The text is fairly standard and has a handwritten appearance. The green circular background has a rough edge and is presented on top of a black square background. Between and below the two letters 'O' in the word food is a curved line which the applicants say creates a smiling face.

86. Visually, the marks share the words 'WHOLE FOOD' or 'WHOLE FOODS' (the additional 'S' in the opponent's sign does not make a material difference and is likely to

³⁶ *In the absence of my own understanding of these services I would still have reached the same conclusion based upon the evidence, submissions and the dictionary definition I provided to the parties.*

go unnoticed). The opponent's sign contains the additional word 'MARKET'. The applicants' mark contains the additional word EARTH. Visually, the opponent's stylised sign where the words are presented above each other on a circular background (with or without the word MARKET presented in a lozenge shape) is the most visually similar to the applicant's mark, being similar to a fairly high degree. However, the plain words WHOLE FOODS MARKET are still similar to a medium degree. Aurally, the respective marks are made up of words which will be well known to members of the relevant public, the first word of each mark being the same, WHOLE. The second word in each is FOOD or FOODS. The third word in the opponent's sign is MARKET, the third word in the application is EARTH, meaning that the earlier sign is a syllable longer than the application. The marks are aurally similar to a medium degree. Conceptually, both parties' marks clearly relate to whole food/s. However, the overall concept of the earlier sign is that of a market selling whole food, whereas the conceptual message conveyed by the application is more nebulous, giving the impression of soil for growing whole food or a whole food planet. The marks are conceptually similar to a medium degree.

87. In making a finding on the issue of misrepresentation, I bear in mind that it is the applicants' customers or potential customers who must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*,³⁷ Morritt L.J. stated that:

"This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill."

88. There is a difference between mere confusion and deception in passing-off cases. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*,³⁸ Mr Iain Purvis QC, as a Recorder of the Court stated that:

"54. Mr Aikens stressed in his argument the difference between 'mere wondering' on the part of a consumer as to a trade connection and an actual

³⁷ [1996] RPC 473

³⁸ [2013] EWPCC 18 (PCC)

assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.

89. In *Harrods Limited v Harrodian School Limited*³⁹ [1996] RPC 697 (CA), Millet L.J. stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services.”

90. That is the case here: there is clearly coincidence of the words ‘WHOLE FOOD/S’ in both parties’ signs at issue. However, the words WHOLE FOODS in the opponent’s sign are entirely descriptive of the type of goods being sold. Consequently, a greater degree of discrimination than usual will be needed on the part of the public and I find that the difference between WHOLE FOOD MARKET (stylised or in plain word form) and the applicant's mark is sufficient to avoid misrepresentation through deception.

The remaining grounds

91. For the purposes of 5(2)(b) and 5(3), the opponent relies upon EUTM 4974994:



³⁹ [1996] RPC 697 (CA)

92. Having looked at the opponent's evidence in detail, I am not convinced that the use of this mark shown in London, Cheltenham and Giffnock, (in the suburbs of Glasgow) is sufficient to establish the use or necessary reputation of the opponent's EU trade mark. The figures given in evidence are not insignificant but in terms of the size of the supermarket retail business across the EU, they must represent a small percentage. The opponent's evidence indicates a pattern of fairly localised marketing and a fairly local customer base for its stores. That said, I do not intend to engage in a detailed analysis here for reasons which will become apparent below and I will assume the necessary use and reputation to initiate the 5(2)(b) and 5(3) grounds.

The opposition under 5(2)(b)

93. Section 5(2)(b) of the Act 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.

94. 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.

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

95. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*,⁴⁰ Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd*⁴¹), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

96. Having found that a substantial number of the relevant public will not be deceived, it is highly unlikely that the average consumer would be, all things being equal. For the sake of completeness I will briefly consider this ground.

97. I have assumed proof of use was made out for the same services for which I found goodwill to exist in the opponent’s unregistered signs. The average consumer is a member of the general public and the nature of the purchase is frequent, fairly low cost and primarily visual, leading to an average level of attention being paid to the purchase, to the extent necessary to ensure, inter alia, the preferred ingredients, variety and nutritional requirements. The earlier mark lacks the circular background present in the unregistered sign which does lead to a slightly lower level of visual similarity, namely medium. The aural and conceptual considerations are the same as I have identified

⁴⁰ [2012] EWCA (Civ) 1501

⁴¹ [2004] RPC 40

above. The distinctive character of earlier mark rests in its particular presentation and not in the words WHOLE FOOD, which simply describe the subject of the services.

98. With regard to the types of confusion, I bear in mind *L.A. Sugar Limited v By Back Beat Inc*,⁴² in which Mr Iain Purvis Q.C. sitting as the Appointed Person stated the following:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’”

99. In this case, the visual and conceptual differences are sufficient to avoid direct confusion. With regard to indirect confusion, the primary point of similarity rests in a non-distinctive term which the average consumer will recognise. The average consumer is unlikely to conclude that the common presence of such a term as ‘WHOLE FOOD/S’ is as a result of the undertakings responsible for the marks being the same or being related. They will instead put the commonality down to a simple co-incidental (and unsurprising) use of descriptive language within the context of two different trade marks.

100. The opposition under section 5(2)(b) of the act fails.

⁴² Case BL-O/375/10

The opposition under 5(3)

101. Section 5(3) of the Act states:

“5...

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

102. Having assumed the necessary reputation a link must be made between the trade mark applied for and the earlier mark. In *Adidas-Salomon*,⁴³ the CJEU stated:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 General Motors [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, SABEL, paragraph 22, and Marca Mode, paragraph 40).”

103. In *Intel*⁴⁴ the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

⁴³ Case C-408/01

⁴⁴ Case 252/07, [2009] ETMR 13

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

104. In my view, a member of the relevant public encountering the applicants’ mark will not bring the earlier mark to mind. The marks contain visual differences as well as a degree of conceptual difference and the only real common element is a descriptor. I see no basis why the applicants’ mark would create a link (to the earlier mark) in the mind of the relevant person.

105. Even if there was a link, I find it difficult to see how any of the heads of damage would arise. The distinctiveness of the earlier mark depends, at the least, on the combination of the words WHOLE FOODS and MARKET. The opponent cannot claim an exclusive right to the words WHOLE FOOD as such, any more than it could claim an exclusive right to the words ORGANIC FOOD for the retailing of organic food. There can be no unfair advantage when the applicants are simply using the same descriptive term as part of their mark, nor would the distinctiveness of the earlier mark be diluted. Any argument on tarnishing is purely hypothetical. Further, the use of a descriptive term within a mark appears to represent a due cause, equivalent to an aspect of fair competition. The ground under section 5(3) is dismissed for all these reasons.

Conclusion

106. The opposition fails and, subject to appeal, the applicants' mark may proceed to registration.

Costs

107. The applicants have been successful and are entitled to a contribution towards their costs. I have borne in mind the applicants' late challenge to the status of the opponent's company, which led to additional documentation being filed subsequent to the hearing. My assessment is as follows:

| | |
|---|-------|
| Considering the statement of case and preparing the counterstatement: | £400 |
| Considering evidence and preparing submissions: | £400 |
| Attending the hearing: | £500 |
| Total: | £1300 |

108. I order Whole Foods Market IP LP to pay Muhammad Awais and Ishtiaq Ahmad the sum of £2100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of March 2018

Ms Al Skilton

For the Registrar,

The Comptroller-General

BL O/136/18

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3155613 BY
MUHAMMAD AWAIS AND ISHTIAQ AHMAD

TO REGISTER THE TRADE MARK



IN CLASS 35
AND
THE OPPOSITION THERETO
UNDER NO 406956
BY
WHOLE FOODS MARKET IP, L.P.

1. On 5 March 2018 a decision was issued in respect of these UK proceedings.

2. The applicant was successful and an award of costs was made, as follows:

“107. The applicants have been successful and are entitled to a contribution towards their costs. I have borne in mind the applicants’ late challenge to the status of the opponent’s company, which led to additional documentation being filed subsequent to the hearing. My assessment is as follows:

| | |
|---|------|
| Considering the statement of case and preparing the counterstatement: | £400 |
|---|------|

| | |
|---|------|
| Considering evidence and preparing submissions: | £400 |
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| | |
|------------------------|------|
| Attending the hearing: | £500 |
|------------------------|------|

| | |
|--------|-------|
| Total: | £1300 |
|--------|-------|

108. I order Whole Foods Market IP LP to pay Muhammad Awais and Ishtiaq Ahmad the sum of £2100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.”

3. Paragraph 108 of that decision should have read:

“108. I order Whole Foods Market IP LP to pay Muhammad Awais and Ishtiaq Ahmad the sum of £1300. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.”

4. The appeal period is not affected by this correction.

5. The sum of £1300 is to be paid by Whole Foods Market IP LP to Muhammad Awais and Ishtiaq Ahmad within fourteen days of this supplementary decision.

Dated this 6th day of June 2018

**Ms Al Skilton
For the Registrar**