

O/550/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3179942
BY FRANCO ICES LIMITED FOR THE TRADE MARK**

DOUBLE BUBBLE BLUE

IN CLASS 30

AND

**THE OPPOSITION THERETO UNDER NO. 408165
BY TOOTSIE ROLL OF CANADA ULC**

Background and pleadings

1. Franco Ices Limited (the applicant) applied to register the trade mark “DOUBLE BUBBLE BLUE” in the UK on 11 August 2016. It was accepted and published in the Trade Marks Journal on 30 September 2016 in respect of the following goods and services in Class 30:

Ices; ice cream; ice creams; ice lollies; lollies; sorbets; water ices; ice; frozen confectionery; ice cream confectionery; ice cream desserts; frozen desserts; frozen yoghurt (confectionery ices); ice cream cones; ice cream bars; ice cream stick bars; ice cream sandwiches; ice cream sundaes.

2. Tootsie Roll of Canada ULC (the opponent) opposes the trade mark under section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of two earlier European Union (formerly Community) Trade Marks.
3. The first of the opposing marks is EU004481479: DUBBLE BUBBLE. This mark was registered on 30 June 2006. The following goods in Class 30 are relied upon in this opposition:

Candy; confectionery; chewing gum and bubble gum; preparations made from confectionery.

4. The second is EU008756512:



The mark was registered on 20 May 2010. The following goods in Class 30 are relied upon in this opposition:

Candy; gum; preparations made from confectionery.

5. The opponent argues that the respective goods are identical or similar and that the marks are similar. It claims that the likelihood of confusion is greater, as its earlier marks have enhanced distinctiveness in the UK market.
6. The applicant requested a cooling-off period, which was due to expire on 9 October 2017. This period came to an end on 27 September 2017 when the applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its earlier marks. The applicant states that there is only a very low degree of similarity between the marks and that the opponent's marks, especially the word mark, have "a particularly low degree of distinctiveness".
7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
8. Both sides filed written submissions in lieu of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision, which has been taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by Keltie LLP and the applicant is represented by Franks & Co (South) Limited.

Relevant Dates

10. The opponent's earlier marks had been registered for more than five years on the date on which the contested application was published. They are, therefore, subject to proof of use provisions under section 6A of the Act, and the applicant has, as I have already noted, requested such proof. The opponent has made a statement that it has made genuine use of the marks in the EU, including the UK, in the relevant period for the goods upon which it is relying. The relevant period

for these purposes is the five years prior to and ending on the date of publication of the contested application: 1 October 2011 to 30 September 2016. The relevant date for the purposes of section 5(2)(b) is the date the application was filed: 11 August 2016.

EVIDENCE

Opponent's Evidence

11. The opponent's evidence comes from Barry Bowen, Treasurer of Tootsie Roll of Canada ULC since 1 January 1991. His witness statement is dated 28 November 2017. There is also a witness statement from Benjamin Britter, Chartered Trade Mark Attorney at Keltie LLP. This is dated 29 November 2017.

12. In 1928, Walter Diemer, an accountant from Philadelphia, invented bubble gum. He called it "DUBBLE BUBBLE". The brand was purchased by the opponent in 2003. Mr Bowen states that "DUBBLE BUBBLE" has been used in Europe for confectionery since at least the 1960s. Ex-works sales figures¹ (in US\$) of confectionery products bearing the opponent's marks in selected EU markets are as follows:

	2010	2011	2012	2013	2014	2015	2016
UK	312,000	135,000	224,000	100,000	195,000	81,000	111,000
Germany	98,000	159,000	174,000	116,000	116,000	58,000	58,000
Benelux	0	133,000	73,000	68,000	70,000	71,000	66,000
Sweden	0	37,000	37,000	35,000	80,000	37,000	37,000
Spain	853,200	1,067,773	847,990	601,306	613,588	724,828	768,337
Total	1,263,200	1,531,773	1,355,990	920,306	1,074,588	971,828	1,040,337

I note that these figures do not distinguish between the opponent's two marks.

13. Exhibit 1 to Mr Bowen's witness statement consists of a series of photographs of the goods on sale in UK stores. Some of these photographs are undated, while others fall outside the relevant period (those dated 2010 and possibly some of those dated 2011). Most of the photographs are unclear and it is hard to make

¹ "Ex-works sales" are ones where the seller makes the goods available at a specified location (such as their factory), and the buyers are responsible for arranging transportation.

out the marks on the products. Following comments from the applicant, the opponent submitted a further witness statement, dated 28 March 2018 and a clearer set of images on 3 April 2018. In this statement, the opponent said that the undated images were taken from a UK Market Retail Check dated June 2016, and that all the products shown in Exhibit 1 were on sale in that same month. The packaging bears the device mark in several variations:

- sometimes the crown contains only the word “ORIGINAL”, not the phrase “AMERICA’S ORIGINAL”; and
- sometimes the circle is overlapped with an elongated bubble containing the words “BUBBLE GUM” or “GUMBALLS”.

14. In its written submissions in lieu of a hearing (dated 8 May 2018), the applicant raises an objection to this further Exhibit:

“In any case, the Opponent’s second evidence round is reserved for new evidence to be provide in reply to the Applicant’s evidence, where the Applicant’s evidence has raised new issues. Evidence of Use of a mark is to be provided as part of the Opponent’s Evidence in Chief, and the Evidence in Reply is not the place to try to correct defective Evidence of Use. We ask that this evidence is rejected as inadmissible.”

15. The images submitted by the opponent on 3 April 2018 are not new ones. Rather, they are colour and blown-up copies of the original images that were submitted by the opponent as Exhibits to the first witness statement. In my view it is reasonable to admit clearer versions of the same photographs, in response to the comments of the applicant in its own witness statement. The applicant has, in any case, had ample opportunity to raise an objection before filing its written submissions in lieu of a hearing.

16. Exhibit 2 contains two images of products from the Spanish company, Fleer Española, which is one of two factories in Europe making the product line. This exhibit is headed “DUBBLE BUBBLE in Spain 2011”. The first image shows the

device mark with the word “ORIGINAL” in the crown and an elongated bubble containing the words “BUBBLE GUM”. Pictures of the packaging appear to show the same mark, although it is not easy to see at this size. The second image also contains the device mark as represented in the first image, and smaller pictures of the packaging and the quantities in which the products can be bought, presumably by a retailer.

17. Exhibit 3 comprises two images of a lorry and is headed “DUBBLE BUBBLE in Sweden 2006”. The photographs are tagged with a 2006 date. The images show both sides of a lorry and the mark shown on the vehicle is the device mark as registered.
18. Mr Britter’s evidence concerns the availability of ice cream and ice lolly products containing confectionery. Attached to his witness statement are four exhibits:

Exhibit 1: printouts from the websites of UK supermarkets, ice cream and frozen yogurt bars showing products “comprised of, containing or flavoured by other confectionery products”. Not all of these are dated, but those that are were printed on 28 or 29 November 2017.

Exhibit 2: printouts from the websites of UK supermarkets showing ice cream products containing bubble gum (known as “screwballs”). Again, these bear the date of 28 or 29 November 2017.

Exhibit 3: printouts from three specialist ice cream supply websites that sell bubble gum for use in ice cream products. These are all undated.

Exhibit 4: a catalogue from Fler Española showing images of products. There are no prices and the catalogue is undated. Mr Britter states that it is from 2017.

Applicant's Evidence

19. The applicant's evidence comes from Pasquale Tanzarella, Managing Director of Franco Ices Limited. He has been a director of the company since its incorporation in 2003. His witness statement is dated 29 January 2018. In addition, there is a witness statement from Jonathan Banford, Director at Franks & Co (South) Limited. This is also dated 29 January 2018.
20. Mr Tanzarella explains the origin of "Double Bubble Blue" in the applicant's desire to offer a competitor to an ice cream product sold under the name "Smarties". This earlier product comprises vanilla ice cream containing broken-up "Smarties" sugar-coated chocolate confectionery and attached to a hollow handle filled with whole "Smarties". Exhibit 1 contains screenshots from the website of a firm called R&R (formerly Richmond Ice Cream) which makes ice cream products sold under confectionery brand names such as "Smarties". Mr Tanzarella states that "As far as I am aware, R&R manufactures and sells the branded ice-cream products itself, and the confectionery brand owner is not involved". The screenshots are undated.
21. The applicant decided to produce a variation on its "Clown" product, which Mr Tanzarella states has been sold since 2001. A screenshot from the applicant's website showing the product is provided in Exhibit 2. It is dated 29 January 2018.



22. "Double Bubble Blue" is made from two flavours of ice cream: vanilla and bubble gum. The bubble gum-flavoured ice cream is blue. The product has a hollow handle, filled with blue sugar-coated chocolate beans. Mr Tanzarella states that:

“In the DOUBLE BUBBLE BLUE product, the bubble gum flavoured ice-cream is the first ‘BUBBLE’ and the round sugar-coated beans are the second ‘BUBBLE’. ... I chose DOUBLE BUBBLE BLUE because it has a better sound as a trade mark.”



23. Mr Tanzarella claims not to have heard of “DUBBLE BUBBLE” gum and notes that the applicant has produced a bubble gum-flavoured product since about 2008 under the registered trade mark “MR BUBBLE”. Exhibit 2 also contains an undated screenshot from the applicant’s website showing this product and details of the registered trade mark from the Intellectual Property Office website.



24. Mr Banford uses his witness statement to comment on the evidence provided by the opponent. Attached to the statement are four Exhibits:

Exhibit 1: printouts from the websites of Nestlé and MARS providing some data on UK consumption and production of the chocolate confectionery KitKats and Mars Bars respectively. The Nestlé press release is dated 11

October 2010 and claims that 1 billion KitKats are eaten every year in the UK. The promotional material from MARS has a copyright date of 2013 and says that 3 million Mars bars are produced every year in Slough. Mr Banford has performed some rough calculations in an attempt to demonstrate that the sales figures submitted by the opponent are relatively small. He acknowledges that these “might suffice to prove sufficient use of the marks”, but contends that they are insufficient to show reputation.

Exhibit 2: Reproductions of some of the images from Mr Bowen’s Exhibit 1. Mr Banford says that these are unclear and goes on to “suggest that except with the eye of faith, the words DUBBLE BUBBLE cannot be discerned”. As I have already mentioned in paragraph 13, the opponent submitted enlarged and clearer copies on 3 April 2018.

Exhibit 3: Excerpts from the *Concise Oxford Dictionary*, 12th edition, published in 2011, containing definitions of “bubble”, “bubblegum”, “candy”, “chocolate”, “confectionery”, “gum” and “sweet”.

Exhibit 4: Printout from www.statista.com of statistics for the global confectionery market in 2016. This provides a total figure, but also breaks down that total into three categories: chocolate, sugar, and gum. The chart indicates sales of confectionery in Western Europe were over \$50bn in 2016, with gum accounting for around \$4bn of this figure.

PROOF OF USE

25. Section 6A of the Act states that:

(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

(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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.

26. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J summarised the principles guiding the assessment of whether there has been genuine use of a trade mark. These principles are drawn from the following case law: *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01), *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02), *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-416/04 P), *Verein Radetzky-Orden v*

Bundesvereinigung Kameradschaft "Feldmarschall Radetzky" (C-442/07), *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07), *Leno Marken BV v Hagelkruis Beheer BV* (C-149/11), *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* (C-609/11), and *P Reber Holding & Co KG v OHIM* (C-141/13):

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the

mark: *Ansul* at [37-38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72-76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].
- (8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].²

27. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

² Paragraph 219.

If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

29. The opponent's trade marks are EU trade marks. In *Leno Merken BV v Hagelkruis Beheer BV*, C-149/11, the Court of Justice of the European Union (CJEU) noted that:

"It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors in determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."⁴

30. I have examined the evidence submitted by the opponent in support of its claim to have used the marks between 1 October 2011 and 30 September 2016. A good deal of what has been provided falls outside these dates, or appears to have no date at all. For ease, I have set out below the evidence that falls within the relevant period:

Mr Bowen's evidence

- Sales figures provided in the first witness statement and reproduced above in paragraph 12, except where these figures are not within the relevant period.
- Exhibit 1 to the first witness statement and Exhibit to the second witness statement. Some of these images fall within the relevant period.

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

⁴ Paragraph 36.

- Exhibit 2 is potentially within the relevant period. However, the marks shown in this exhibit are also used on products shown in Exhibit 1.

The exhibits attached to Mr Britter’s witness statement all fall outside the relevant period.

31. The sales data indicate that the marks have been used in at least five EU Member States, including the UK during the relevant period.⁵ Mr Banford claims that annual sales of around \$1-1.5 million are small when compared to a Western European market for gum of \$4.15 billion in 2016. However, I have to bear in mind that there is no *de minimis* level below which use is necessarily insufficient. I also recall that the applicant did not dispute that such a level of sales could demonstrate genuine use (see paragraph 24 above).

32. I will now consider what marks have been used. I have referred in paragraph 13 above to the variations observed in the marks shown in the evidence. In *Colloseum Holdings AG v Levi Strauss & Co.*, C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“32. ... the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

...

35. ... a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).”

33. One of the observed variations is the addition of a bubble containing “BUBBLE GUM” or “GUMBALLS”. In *Hypen GmbH v European Union Intellectual Property*

⁵ These are the UK, Germany, Sweden, Spain and the Benelux (Belgium, the Netherlands and/or Luxembourg).

Office (EUIPO), T-146/15, the General Court set out the following approach to the assessment of whether the addition of components is likely to alter the form of the registered mark to a material extent:

“29. ... account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM – Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:698, paragraph 33).

...

31. It must also be remembered that, in order for the second paragraph of Article 15(1)(a) of Regulation No. 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM – Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).”

34. The CJEU considered the impact of additions to the distinctive character of a mark in *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*, C-252/12:

“22. For a trade mark to possess distinctive character for the purposes of Regulation No. 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 32; Case C-304/06 P *Eurohypo v*

OHIM [2008] ECR I-3297, paragraph 66; and Case C-311/11 P *Smart Technologies v OHIM* [2012] ECR I-0000, paragraph 23).

23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 30).”

35. Taking into account this case law, I turn to an assessment of whether the opponent’s word mark is an acceptable variant of the registered device mark. I note that no evidence has been supplied showing use of just the word mark (EU004481479) within the relevant period. However, in line with the guidance in paragraph 32 of *Colloseum* (quoted above), I find that its use within the device mark represents use of the mark.
36. The registered device mark consists of a dark oval, surrounded by a thin white line which is, in turn, surrounded by a thinner dark line. The mark has been registered in grayscale, but it is clear that the thin line is darker than the colour of the oval. Inside the oval are the words “DUBBLE BUBBLE”, in white capital letters, one word above the other. The font is a standard one. Each letter is surrounded by a thin dark line which is, in turn, surrounded by a thin lighter line. Perched on top of the oval is a device that resembles a crown. It is darker than the oval, surrounded by a thin white line, then a thin dark line. Inside the crown are the words “AMERICA’S ORIGINAL”, in smaller white capital letters and a standard font and again one word above the other. The height of the letters increases towards the end of each word.
37. The addition of a coloured, elongated bubble containing the words “BUBBLE GUM” or “GUMBALLS” does not, to my mind, alter the distinctive character of the mark. The words merely describe the type of product. Furthermore, this

bubble is at the bottom of the device and is, in my view, less likely to attract the eye of the consumer than the centre or top of the mark.

38. I will now consider the words within the crown on the top of the device. These are, as I have already noted, smaller than the words within the oval. Subtracting the word “AMERICA’S” is, in my view, a minor alteration. The mark would still clearly signify to the relevant class of persons that it originates from the same undertaking as the registered device mark does. I find that the mark used is an acceptable variant of the registered mark.

39. Having found that this is an acceptable variant, I will now consider what use has been shown. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”⁶

40. The marks are registered for the following goods, which are relied upon in this opposition:

Word Mark	Device Mark
Class 30 Candy; confectionery; chewing gum and bubble gum; preparations made from confectionery	Class 30 Candy; gum; preparations made from confectionery

⁶ Paragraph 22

41. The opponent has demonstrated that it has used its marks on *gum* (which encompasses *chewing gum and bubble gum*), but has not shown any evidence of use on other products. I am required to consider whether the opponent has shown use on *candy, confectionery or preparations made from confectionery*. This turns on an assessment of whether any of these terms encompasses *gum*. I bear in mind the comments of Kitchin LJ in *Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220:

“56. ... On the one hand, a proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few of them. The mark should remain registered only in respect of those goods and services for which it has been used.

...

60. Conversely, however, a proprietor cannot reasonably be expected to use his mark in relation to all possible variations of the particular goods or services covered by the registration.

61. These competing considerations are to be resolved by taking into account the breadth of the categories of goods for which the mark is registered and the extent to which those categories are described in general terms. If these categories are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories. But if it is not possible to make a meaningful division of the particular category in relation to which use of the mark has been established then proof of use will suffice for the whole of that category.”

42. “*Candy*” is often used as a general word for sweets or confectionery, particularly in North America. This is confirmed by the dictionary definition that the applicant

has submitted in evidence. To my mind, gum is an identifiable sub-category within the broader term. Other sub-categories, for example, would be chocolate bars, jellies or boiled sweets. Unlike other confectionery, gum is intended to be chewed and not swallowed. Consequently, I find that the opponent has not demonstrated use of the marks for “*candy*” as a broad term. The same applies for “*confectionery*”.

43. Nor do I find that the opponent has demonstrated use of the marks for “*preparations made from confectionery*”. What would the average consumer understand by this term? In my view, they would see it as a product containing confectionery as an ingredient, or confectionery that has undergone some form of processing, perhaps for use in ice creams or desserts. I do not think they would see it as referring to confectionery on its own. Even if I am wrong on this point, the term is broader than “*gum*”, which describes the goods for which the opponent has demonstrated use.

44. The evidence that the opponent has submitted is not extensive. However, I consider that, taken as a whole, there is enough to demonstrate genuine use of an acceptable variant of the device mark, and of the word mark, for *gum*.

DECISION

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

“A trade mark shall not be registered if because –

...

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

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

Case law

46. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

- (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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

47. The opponent has claimed that the goods in the application are identical or similar to the goods of the earlier trade marks upon which it is relying in this opposition. The applicant denies this and believes that there is no more than a low degree of similarity between the goods.

48. As I have already found, the opponent has demonstrated use of the earlier marks for gum, but has not shown use on any other goods in the specification. I must therefore only compare “*gum*” with the goods listed in the applicant’s specification:

Ices; ice cream; ice creams; ice lollies; lollies; sorbets; water ices; ice; frozen confectionery; ice cream confectionery; ice cream desserts; frozen desserts; frozen yoghurt (confectionery ices); ice cream cones; ice cream bars; ice cream stick bars; ice cream sandwiches; ice cream sundaes.

49. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account, per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, C-397/97.

50. Guidance on this issue has come from Jacob J (as he was then) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281, where the following factors were highlighted as being relevant:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

51. In comparing the goods, I have also considered the meaning of the expressions used in the specifications, following the comments of Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158:

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47-49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

52. *Ice* is frozen water, often sold in cube form. It is used for cooling other products, such as drinks. While it has the same users as gum (the general public) and the same trading channels (supermarkets and convenience stores), it is not in competition with gum or complementary to it. I find that it is a dissimilar good.
53. I will now turn to the following goods: *Ices; ice cream; ice creams; ice lollies; lollies; sorbets; water ices; frozen confectionery; ice cream confectionery; frozen yoghurt (confectionery ices); ice cream cones; ice cream bars; ice cream stick bars; ice cream sandwiches*. These goods are snacks. This list does also contain some broader terms (*ices; ice cream; ice creams; sorbets; water ices*) that could also be desserts, but in my view these broader terms encompass the snack products too.
54. There is, to my mind, a degree of similarity between gum and snack ices. They have the same distribution channels and users. Their physical nature is very different and there is still a distinction between products that are intended for consumption, and those that are intended to be thrown away. However, I find that there are overlapping uses suggesting a degree of competition. Sometimes the temperature of the product will be important to the consumer. They will be seeking refreshment or cooling down on a warm day. At other times, the

consumer will be wanting a small treat and gum or an iced product could meet that need equally satisfactorily. It is, in my view, also possible that these products will be located closely together. A freezer containing these types of products may be near the shelves containing gum and confectionery, ready for an impulse purchase, although I accept the applicant's view that this is to a large extent dependent on the layout of the shop.

55. The opponent stated in its written submissions of 29 November 2017, that "it is common for ice cream and ice lolly products to contain elements of other types of confectionery such as candy, chocolate, sweets, chewing gum or bubble gum, indicating that they can be of a complementary nature too". In *Boston Scientific Ltd v OHIM*, T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

56. I do not consider that the opponent's goods are indispensable or important for the use of gum, or vice versa. Consequently, I find that there is a low degree of similarity between the goods listed in paragraph 53.

57. I must now deal with the remaining goods: *ice cream desserts; frozen desserts; ice cream sundaes*. The uses of these products are different, as they are intended to be consumed as part of a meal, rather than a snack. However, in my view, they would also be covered by the terms "*ice cream*" and "*ices*", so from hereon I will consider them alongside the goods listed in paragraph 53.

58. Consequently, I find there is similarity between all the goods listed in the applicant's specification, apart from "*Ice*". However, this at a low level.

Average Consumer and the Purchasing Act

59. Having compared the goods, I shall now consider the average consumer. In *Hearst Holdings and Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*,

The Partnership (Trading) Limited, U Wear Limited and J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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.”⁷

60. The average consumer will be a member of the general public who buys these goods as part of their weekly shop or as an impulse purchase. This could be child as much as an adult. Levels of attention are likely to be lower than average, particularly for the impulse purchasers. The goods are likely to be selected primarily by visual means. Even where there is an element of oral purchasing, such as at an ice cream van, the consumer can expect to see pictures of the available products.

Comparison of Marks

61. It is clear from *Sabel BV v Puma AG*, C-251/95 (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 by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, 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

⁷ Paragraph 60.

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.⁸

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

63. The respective marks are shown below:

Earlier marks	Contested mark
<p data-bbox="183 862 406 896">EU004481479:</p> <p data-bbox="183 969 454 1003">DUBBLE BUBBLE</p> <p data-bbox="183 1077 406 1111">EU008756512:</p> 	<p data-bbox="810 969 1173 1003">DOUBLE BUBBLE BLUE</p>

64. The applicant’s mark consists of the words “DOUBLE BUBBLE BLUE”. The phrase is in a standard font with no stylisation and is presented in capital letters.⁹ The opponent argues that the dominant and distinctive element of this mark is “DOUBLE BUBBLE” and that the word “BLUE” is descriptive of the goods. The applicant argues that there is no dominant or distinctive element and the mark

⁸ Paragraph 34

⁹ Registration of a trade mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

should be assessed as a whole. In my view, “DOUBLE BUBBLE” may be given more significance in the overall impression and this is supported by its placing at the beginning of the mark. That said, “BLUE” still makes a contribution, particularly through the alliteration and the visual impact of the repetition of letters that have already occurred in the mark.

65. The opponent’s word mark consists of the words “DUBBLE BUBBLE”. The phrase is in a standard font with no stylisation and is presented in capital letters. The first word is likely to be interpreted as a misspelling of “DOUBLE”.
66. I have described the opponent’s device mark in paragraph 36 above. In my view, the whiteness and size of the letters of “DUBBLE BUBBLE” make this the dominant element of the mark. The misspelling is noticeable. However, the crown also makes a contribution to the overall impression of the device. Depending on its size, the text in the crown may be too small to attract the attention of the average consumer, who, I have found, will be paying below average levels of attention. In any case, the eye is likely to be more drawn to the larger letters.
67. The opponent argues that the applicant’s mark is visually highly similar to the device mark. The dominant words in the applicant’s mark are the same length as those in the dominant element of the opponent’s mark (the words “DUBBLE BUBBLE”). The final word “BLUE”, as I have noted above, uses the same letters found in those words. However, the crown and the oval of the opponent’s mark would not go unnoticed and the misspelling is unusual. I find the marks visually similar to a moderate degree. There is a greater degree of visual similarity between the applicant’s mark and the opponent’s word mark. In my view, these are highly similar, on account of the identical length of the first two words, the identity between the second words of the mark, and the near identity between the first two words.
68. Aurally, the applicant’s mark is highly similar to the opponent’s marks. As I have noted above, the first two words of the applicant’s mark are likely to be more significant and these words sound identical to the dominant element of the

opponent's device mark as well as the word mark. They will both be articulated "DUB-BEL BUB-BEL".

69. The opponent argues that conceptually the applicant's mark is highly similar to its own marks. The word "BUBBLE" will, in my view, be associated by the average consumer with the bubble gum flavour of the applicant's product and the very nature of the opponent's product. "DOUBLE" will be taken to mean twice as big or twice as many bubbles. In addition, the applicant's mark will be understood as indicating the colour of the bubbles. The "DUBBLE" in the opponent's marks will be interpreted by the average consumer as a misspelling of "DOUBLE". I find that there is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

70. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer v Klijsen Handel BV*, C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, that national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1990] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the

amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

71. The opponent claims that its marks have enhanced distinctiveness in the UK market. I consider that the opponent has not submitted sufficient evidence relating to use within the UK, such as the market share and promotional activities. Nor is there sufficient evidence of how long-standing and intensive use of the marks has been in the UK. I am consequently unable to find that the marks have enhanced distinctiveness and will therefore consider only the question of inherent distinctiveness.

72. In doing so, I take account of the comments of Mr Iain Purvis QC, sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13:

“It is always important to bear in mind what it is about the earlier mark which gives it a distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”¹⁰

73. The applicant contends that the distinctiveness of the opponent’s marks is low and refers to the DOUBLEMINT case *OHIM v Wm Wrigley Jr Company C-191/01 P*). Here the applicant is referring to the word mark, but states in its written submissions that the same also applies for the device mark, if it is held that the dominant and distinctive element of that mark is “DUBBLE BUBBLE”:

“If the Word Mark has been DOUBLE BUBBLE, then by very close analogy with DOUBLEMINT, the element DOUBLE should have been declared descriptive or laudatory, and the element BUBBLE declared descriptive of a

¹⁰ Paragraph 39.

major feature of property of the gum – it can be blown into bubbles. The combination DOUBLE BUBBLE would still have the descriptive meanings ‘twice as many bubbles’, ‘twice the bubble size’ or ‘twice the quality of bubbles’. Therefore, following DOUBLEMINT, the mark DOUBLE BUBBLE should be unregistrable ... In the absence of any acquired distinctiveness (in the UK and EU anyway), the only trace of distinctiveness in the Word Mark has to be the misspelling of DOUBLE as DUBBLE.”

74. As the applicant notes, I must presume that the mark has been validly registered and has some level of distinctiveness: see the judgment of the General Court in *Formula One Licensing BV v OHIM*, T-10/09.

75. It is my opinion that, even with the misspelling, the inherent distinctiveness of this mark is low. The words used are not simply random, but allude to the goods sold under the mark. I note again that I have not been shown evidence of the mark being used on any product other than gum.

Conclusions on Likelihood of Confusion

76. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now must look at the question from a global perspective. As the CJEU stated in *Canon Kabushiki Kaisha*:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity

between the mark and the sign and between the goods or services identified.”¹¹

77. As noted in paragraph 23 above, Mr Tanzarella states that the applicant has been selling a product under the UK registered trade mark “MR BUBBLE” since 2008 “with no objections”. The absence of any objections to an earlier trade mark, however, is not evidence to support a claim that there is no likelihood of confusion: see *Zero Industry Srl v OHIM*, particularly paragraph 71. In any case, it is my view that there is a lesser degree of similarity between this mark and the opponent’s marks than there is with the contested mark.

78. The weak distinctive character of an earlier trade mark does not preclude a likelihood of confusion, as stated by the CJEU in *L’Oréal SA v Office of Harmonisation in the Internal Market (OHIM)*, C-235/05 P:

“The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variations in the nature of the products or stemmed from marketing considerations and not that the difference denoted goods from different traders.”¹²

¹¹ Paragraph 17.

¹² Paragraph 45

79. In making an assessment of the likelihood of confusion, it is important to keep in mind the circumstances in which the average consumer will encounter the marks. These are goods that will for the most part be self-selected, by a consumer that is paying lower than average levels of attention. The visual element will therefore be the most important: see *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03, particularly paragraph 49.
80. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’¹³

81. As the average consumer will be paying low levels of attention, it is unlikely that they will – even subconsciously – be conducting the kind of mental process outlined by Mr Purvis. This, after all, is pretty much the proverbial “bag of sweets” case.
82. The average consumer will not have a perfect recollection of the opponent’s mark. The goods may not be highly similar but “DOUBLE BUBBLE BLUE” and “DUBBLE BUBBLE” could easily be confused if the consumer does not see the

¹³ Paragraph 16

products together and, as I have found, the different storage requirements mean that the goods will not sit side-by-side on a shelf. Generally, more attention tends to be paid to the start of a mark than the end (*El Corte Inglés SA v OHIM*, Joined Cases T-183/02 and T-184/02).

83. Consequently, I find that it likely that the average consumer will confuse the applicant's mark with the opponent's marks for all the specified goods, except ice.

Conclusion

84. The opposition has been partially successful. The application will be refused in respect of the following goods in Class 30:

Ices; ice cream; ice creams; ice lollies; lollies; sorbets; water ices; frozen confectionery; ice cream confectionery; ice cream desserts; frozen desserts; frozen yoghurt (confectionery ices); ice cream cones; ice cream bars; ice cream stick bars; ice cream sandwiches; ice cream sundaes.

85. It can proceed to registration in respect of the following goods in Class 30:

Ice

Costs

86. The opponent has achieved a greater measure of success in these proceedings. In the circumstances I make an award to the opponent of £1100 as a contribution towards its costs. This award has been calculated as follows:

Official fee - £100

Preparing a statement and considering the other side's statement - £275

Preparing evidence and considering the other side's evidence - £450

Preparation of submissions - £275

Total: £1100

87. I therefore order Franco Ices Limited to pay Tootsie Roll of Canada ULC the sum of £1100. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 4th day of September 2018

**Clare Boucher
For the Registrar,
Comptroller-General**