

O/737/18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003255479 BY
LONDON FLAVOURS INTERNATIONAL LIMITED
TO REGISTER THE FOLLOWING SERIES OF SIX MARKS IN CLASSES 29 AND
30:



AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 411158 BY
AP BRANDS LTD

BACKGROUND AND PLEADINGS

1. On 8 September 2017, London Flavours International Limited (“the applicant”) applied to register the series of six marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 September 2017. The applicant seeks to register its mark for the following goods:

Class 29 Crisps; Crisps (Potato -); Vegetable crisps; Potato crisps; Low-fat potato crisps; Potato crisps in the form of snack foods; Potato snack foods; Chips (Potato -).

Class 30 Whole-wheat crisps; Crisps made of cereals; Cheese balls [snacks]; Cheese curls [snacks]; Puffed cheese balls [corn snacks]; Cheese flavoured puffed corn snacks; Cereal snack foods flavoured with cheese; Cheese puffs; Savoury snack foods; puffed and extruded snacks; Snack food products made from maize flour; Extruded snacks containing maize; Extruded corn snacks; Extruded wheat snacks; Puffed corn snacks; Snack foods prepared from maize; Snack foods made from wheat; Snack foods made from corn; Tortilla chips; Corn chips; Popcorn; Flavoured popcorn; Popped popcorn; Processed popcorn; Seasoned popcorn; Glazed popcorn; Kettle corn [popcorn].

2. The application was opposed by AP Brands Limited (“the opponent”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies on the following earlier EU Trade Mark registration no. 15341944 for its opposition under sections 5(2)(b) and 5(3):



4. The opponent's mark has an application date of 14 April 2016 and a registration date of 4 August 2016. The opponent relies on (and claims it has a reputation in respect of) all goods for which the earlier mark is registered, namely:

Class 29 Crisps.

5. Under section 5(2)(b), the opponent claims there is a likelihood of confusion because the respective goods are identical or similar and the marks are similar.

6. Under section 5(3), the opponent claims that the earlier mark has a reputation in respect of the goods for which it is registered and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark.

7. The opponent further relies on section 5(4)(a) of the Act and claims that the same sign as shown in paragraph 3 above has been used throughout the UK since June 2015 in respect of the following goods:

Crisps and snack foods.

8. The applicant has filed a counterstatement denying the grounds of opposition.

9. The opponent is represented by CMS Cameron McKenna Nabarro Olswang LLP and the applicant is represented by Osborne Clarke LLP. The opponent filed evidence in chief in the form of the first witness statement of Thomas Oliver Lock dated 23 May 2018. The applicant filed evidence in the form of the witness statement of Robert Busst dated 10 July 2018. The opponent filed evidence in reply in the form of the second witness statement of Thomas Oliver Lock dated 13 September 2018. No hearing was requested and both parties filed written submission in lieu, both dated 30 October 2018. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent's Evidence

10. As noted above, the opponent's evidence in chief consists of the first witness statement of Thomas Oliver Lock dated 13 September 2018, with five exhibits. Mr Lock founded the opponent in September 2013.

11. Mr Lock states:

“5. Since 2015, we have made sales of over £998,000 (over 3.1 million bags) in the UK, in relation to crisps products under the London Crisp Marks. We have also spent over £145,000 to date on advertising and promoting those products in the UK. The celebrity football star and Hollywood actor, Vinnie Jones, is now the global ambassador for the London Crisp brand. As a result of this promotional activity and the extensive coverage of our products, London Crisp has acquired a substantial reputation in our London Crisp Marks in the UK.”

12. The following overview of the turnover figures for the opponent is provided by Mr Lock:

	2017-2018 Turnover (to date) (£)	2016-2017 Turnover (£)	2015-2016 Turnover (£)
UK	289,352	389,941	319,140

13. The following overview of the opponent's marketing and advertising spend in the UK is also provided by Mr Lock:

	2017 Spend (to date) (£)	2016 Spend (£)	2015 Spend (£)
UK	£44,000	£55,000	£46,000

14. Mr Lock states that the opponent's goods are available in over 300 outlets including pubs, restaurants and coffee shops. The opponent's goods are sold through supermarkets, independent retailers and wholesalers. Mr Lock confirms that their goods are sold by ASDA, Waitrose and Tesco as well as 10 UK wholesalers. There is also growth in the opponent's online business, with its goods being sold on the Amazon UK website. The opponent also sells its goods to catering services and food service operators.

15. The opponent has sought to promote itself by attending a variety of events, shows and fairs (such as the International Food Exhibition) and maintaining an active social media presence.

16. Exhibit TL1 to Mr Lock's statement provides a more detailed breakdown of the opponent's turnover figures. The sales per year are broken down by month and product, although the only information provided on products sold is 40g cases, 40g bags, 150g cases and 150g bags. No explanation is provided as to the difference between cases and bags. The turnover figures broken down by month show that approximately £248,000 of the total turnover figures referred to above relate to the period from October 2017 to April 2018.

17. Exhibit TL2 to Mr Lock's statement provides examples of brochures which display the opponent's mark. Mr Lock states that the first example was used by the opponent's clients to promote its products to distributors, retailers and food service outlets. The second example is a brochure being used by DDC Foods to promote its products. The first page displays the opponent's mark and shows examples of the opponent's goods – both crisps and popcorn – offered in a range of flavours. It is undated, save for the print date of 22 May 2018. The second and third pages are very similar and display the opponent's mark alongside pictures of its products offered in different flavours and "inspired" by different areas of London. DDC Foods' brochure displays pictures of the opponent's different products and offers them for sale. Again, it is undated. The final page of the exhibit is a duplicate of the first.

18. Exhibit TL3 to Mr Lock's statement provides examples of the packaging used for the opponent's products. Five examples are provided.

19. Exhibit TL4 to Mr Lock's statement consists of examples taken from the opponent's social media accounts. The first print out is taken from the opponent's Twitter account and confirms that the opponent has 13,600 followers. However, the Twitter account is for The London Snack Co. The post is undated. The second print out is taken from the opponent's Facebook account and confirms that the opponent has 1,481 followers and 1,509 'likes'. Again, the account is for The London Snack Co. However, the account has posted various pictures which display the earlier mark. It shows various posts made by the opponent dated from 20 April to 17 May. It is not specified what year these posts relate to. However, as the pages were printed on 22 May 2018, the lack of year appearing on the social media site suggests that they are taken from the same year in which they were printed – 2018. The third print out is taken from the opponent's Instagram account and confirms that it has 347 followers. Again, this is called The London Snack Co. It shows various posts made by the opponent all displaying the earlier mark, which are not themselves dated, although one states: "Wishing you an amazing 2016!".

20. Exhibit TL5 to Mr Lock's statement consists of examples of the opponent being referenced on websites and in press publications. These are dated between 2 September 2015 and 21 February 2017 (although some examples are undated). They do not all display the earlier mark, but most do refer to the London Crisp Company. However, some make reference to the London Popcorn Company.

Applicant's Evidence

21. The applicant's evidence consists of the witness statement of Robert Busst dated 10 July 2018, with six exhibits. Mr Busst is the sole director of the applicant and founded the business in 2015.

22. Exhibit RB1 to Mr Busst's statement is a printout from the applicant's website, which Mr Busst states is accessible from the UK. It promotes the applicant's crisps and popcorn.

23. Exhibit RB2 to Mr Busst's statement is a printout from the website www.seedrs.com. This appears to be offering an opportunity to invest in the opponent.

This is used by Mr Busst as an example of the opponent describing itself as the “only London-named crisp brand”. Mr Busst states that contrary to this claim there are various other businesses which offer food products using the word “London” in their branding. At Exhibit RB3 Mr Busst provides examples of 35 UK, EU and international marks designating the UK or EU which all use “London” and have crisp products or related services in their specifications. Exhibit RB3 lists both parties’ marks.

24. Exhibit RB4 to Mr Busst’s statement consists of printouts from the websites www.waitrose.com and www.chipsandcrisps.com. These are provided by Mr Busst to counter the opponent’s claim that it is known for high quality products. The printouts display reviews of the opponent’s products which contain some negative feedback. The posts are undated save for their print dates of 5 July 2018 and 20 June 2018.

25. The first print out in Exhibit RB5 to Mr Busst’s statement is taken from the MySupermarket website and shows the results of what appears to be a price comparison search for the opponent’s Prawn Cocktail crisps. The results state that they are “unavailable in Tesco” and provide no prices for various other retail outlets such as ASDA, Waitrose and Amazon. The second printout in Exhibit RB5 is taken from the ASDA website and shows that the opponent’s Prawn Cocktail crisps are unavailable. The third, fourth, fifth and sixth print outs are taken from the Waitrose website and show that the opponent’s Sea Salt, Prawn Cocktail, Cheese and Onion and Sea Salt and Malt Vinegar crisps are unavailable. No date is provided for these searches other than the print out date of 9 July 2018. In addition to these examples, Mr Busst states that he understands the opponent’s listing with Fuller’s pubs “have now been terminated”.

26. Exhibit RB6 to Mr Busst’s statement is a letter from the applicant’s representatives to the opponent’s representatives dated 6 July 2018. This encloses a copy of the opponent’s accounts and a report dated 4 July 2018 and requests an undertaking for the applicant’s costs in the event they are successful. In the alternative, the applicant’s representatives state that they will consider making an application for security for costs.

27. The applicant's evidence was accompanied by written submissions dated 11 July 2018. The applicant also filed written submissions in lieu of a hearing dated 30 October 2018. Whilst I do not propose to summarise these submissions here, I have taken them all into account and will refer to them below as appropriate.

Opponent's Evidence in Reply

28. The opponent's evidence in reply consists of the second witness statement of Mr Lock dated 13 September 2018, with eight exhibits.

29. Exhibit TL1 to Mr Lock's statement is a print out from the opponent's website which shows an example of the opponent's product packaging.

30. Mr Lock states that there have been instances of third parties confusing the opponent and the applicant. The first example given is that Sourced Market (a small chain store in London) were approached by the applicant's agency who provided them with samples. Exhibit TL2 to Mr Lock's statement contains an email chain from Sourced Market in March 2018 stating that they had already received samples from the opponent. There is no query from the opponent in the email chain provided regarding this statement or challenging that it was in fact their crisps that had been received. However, Mr Lock states that these samples were in fact the samples provided by the applicant's agency. On 19 March 2018, Sourced Market stated: "a brand mix up it seems – very close names!". As the opponent does not appear to have challenged the statement made by Sourced Market, it is not clear in what context this second statement was made.

31. The second example of confusion provided by the opponent is that a business customer of the opponent contacted Mr Lock personally on the messaging application 'Whatsapp' to ask whether the applicant's website www.londonflavours.com belonged to the opponent. The conversation appears to have taken place on 13 September 2018, although it is not clear if this is a print date only. Exhibit TL3 shows the following conversation:

<http://londonflavours.co.uk/> 19:22

Hi Tom. Did you know about this?
Its yours? 19:23

Yes we know. It is a copy cat brand.
We are taking legal action. Did they
approach you? 19:24 ✓

No. I have sharef because we saw
them and its to similar 19:25

We didn't knew if you were creating
a different concept 19:25

32. Exhibit TL4 consists of a duplicate of the search results shown at Exhibit RB3 to Mr Busst's statement. Mr Lock states that some of the marks shown in the results have not been registered in the same classification as the opponent's goods and one was registered after the opponent's mark. Mr Lock also notes that the results include the parties' marks. Exhibit TL4 also consists of print outs of the opponent's marks, including those not relied upon in these proceedings.

33. Mr Lock states that the negative reviews provided by the opponent have been "cherry-picked" and that they have received various positive reviews. Exhibit TL5 consists of five examples of emails from customers giving the opponent positive feedback. These are dated between 14 November 2015 and 7 December 2017.

34. Mr Lock states that the printouts from websites which show its products as unavailable are "misleading". He states that its products are supplied on a weekly basis to supermarkets including ASDA, Waitrose and Tesco. Mr Lock states that an agreement has been secured to supply Ocado starting in October 2018. Mr Lock has also provided various purchase orders at Exhibit TL6, specifically:

- a) Five orders from John Lewis dated 2 August 2018, 9 August 2018, 23 August 2018, 30 August 2018 and 6 September 2018 for 250 (in total) of the opponent's crisps;

b) Two orders from Tesco dated 1 August 2018 and 2 August 2018 for 100 (in total) of the opponent's crisps;

c) Two orders from ASDA dated 1 August 2018 and 6 August 2018 for 120 (in total) of the opponent's crisps.

35. Mr Lock states that the applicant is incorrect in its claim that the opponent no longer supplies Fuller's pubs. Exhibit TL7 contains recent purchase orders which Mr Lock states relate to Fuller's pubs (although they are in the name of Brakesgroup). These are dated 14 August 2018, 16 August 2018 and 27 August 2018. They relate to 1,190 units of various flavours of crisps.

36. Exhibit TL8 to Mr Lock's statement is a letter dated 17 July 2018 from the opponent's representatives to the applicant's representatives in response to their letter dated 6 July 2018 (exhibit RB6 above). It denies that the opponent is in financial difficulty and states that no undertakings regarding costs will be given. A copy of the opponent's up-to-date accounts are also included in Exhibit TL8.

37. The opponent filed written submissions in lieu of a hearing dated 30 October 2018. Whilst I do not propose to summarise those submissions here, I have taken them all into account and will refer to them below as appropriate.

PRELIMINARY ISSUES

38. The applicant has made various references to other trade marks which are already on the register and which contain the word 'LONDON', specifically those that relate to the goods which are in issue in these proceedings. For the avoidance of doubt, the existence of other trade marks on the register is not relevant to the decision I must make¹.

39. In its Notice of Opposition, the opponent states:

¹ *Zero Industry Srl v OHIM*, Case T-400/06

“The Applicant’s mark consists of the elements LONDON and FLAVOURS. The four pronged motif is the more dominant, memorable and distinctive element, and that first and dominant element is similar to the Opponent’s earlier trade mark. Further, the common device element is situated in a prominent position at the beginning of the mark applied for and therefore constitutes a dominant element of the mark as a whole and is representative of the mark as a whole.”

40. However, the applicant’s mark as applied for contains no “four pronged motif”. It is, therefore, not clear to what motif the opponent makes reference here, and no further clarification has been provided by the opponent in its written submissions. For the avoidance of doubt, it is the marks as applied for/registered which are relevant to this decision.

41. In its written submissions dated 30 October 2018, the applicant states that in addition to the sign shown at paragraph 3 above, the opponent also relies on the word mark THE LONDON CRISP CO. for the purposes of its opposition under section 5(4)(a). I assume that the applicant is referring to the opponent’s answer to question 4 in Section C of its Notice of Opposition in which it states:

“The Opponent has used the trade mark “The London Crisp Co.” on its own and with a range of colours throughout the UK since June 2015 and has, as a result, gained significant goodwill and reputation under the name “The London Crisp Co.”...”

42. However, when asked to state the signs upon which the opponent relies under section 5(4)(a) for the purposes of its opposition it has listed only the sign shown at paragraph 3 above. The opponent is, therefore, only able to rely on that sign pleaded and not on the word only mark to which the applicant refers.

43. Finally, in his witness statement, Mr Lock makes reference to other trade marks owned by the opponent. Further, in its written submissions dated 30 October 2018, the opponent states:

“33. As indicated at Paragraph 25 above, the Opponent owns a family of marks for snack foods where “LONDON” is the central and dominant component. Contrary to the Applicant’s claim that this evidence is irrelevant, the Opponent’s evidence at Exhibit TL-2 and TL-4 of the Opponent’s Statement shows that the Opponent also uses the marks THE LONDON SNACK CO., and THE LONDON POPCORN CO., which increases the likelihood of confusion between the Applicant’s Sign and the Opponent’s Mark.

44. The only mark relied upon by the opponent under section 5(2)(a) and 5(3) in these proceedings is EUTM registration no. 15341944. This mark is the same as the sign upon which the opponent relies for its opposition under section 5(4)(a). It is not acceptable for the opponent to wait until its written submissions in lieu of a hearing to seek to rely on a ‘family of marks’ argument, when no mention of any such argument has previously been made and the applicant has, consequently, had no opportunity to respond. In any event, the opponent has not relied upon any of the other marks which it claims form part of the ‘family of marks’ in these proceedings. This argument cannot, therefore, succeed and I will disregard the opponent’s ‘family of marks’ argument in reaching my decision.

DECISION

45. 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.”

46. 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 a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

47. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

48. The opponent’s mark qualifies as an earlier trade mark under the above provisions.

49. Section 5(4)(a) 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, or

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”.

Section 5(2)(b)

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

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

51. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="204 528 336 562"><u>Class 29</u></p> <p data-bbox="204 580 308 613">Crisps.</p>	<p data-bbox="809 528 941 562"><u>Class 29</u></p> <p data-bbox="809 580 1391 837">Crisps; Crisps (Potato -); Vegetable crisps; Potato crisps; Low-fat potato crisps; Potato crisps in the form of snack foods; Potato snack foods; Chips (Potato -).</p> <p data-bbox="809 913 941 947"><u>Class 30</u></p> <p data-bbox="809 965 1391 1939">Whole-wheat crisps; Crisps made of cereals; Cheese balls [snacks]; Cheese curls [snacks]; Puffed cheese balls [corn snacks]; Cheese flavoured puffed corn snacks; Cereal snack foods flavoured with cheese; Cheese puffs; Savoury snack foods; puffed and extruded snacks; Snack food products made from maize flour; Extruded snacks containing maize; Extruded corn snacks; Extruded wheat snacks; Puffed corn snacks; Snack foods prepared from maize; Snack foods made from wheat; Snack foods made from corn; Tortilla chips; Corn chips; Popcorn; Flavoured popcorn; Popped popcorn; Processed popcorn; Seasoned popcorn; Glazed popcorn; Kettle corn [popcorn].</p>

52. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

53. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

54. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

55. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

56. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

57. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be

assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

58. In its written submissions in lieu the opponent states:

“12. These goods are identical in that both cover the identical product category namely, crisps. At worst, they are highly similar since they have the same purpose (crisps and snack foods) and the same nature. They are provided by identical channels and to the same relevant consumers.”

59. In its written submissions in lieu, the applicant states:

“25. The Applicant admits that the goods are similar, insofar as both the Applicant’s Trade Mark and the Opponent’s Trade Mark cover “crisps”...”

Class 29

60. “Crisps” appear in both the opponent’s specification and the applicant’s specification. These goods are plainly identical. “Crisps (Potato -)”, “Vegetable crisps”, “Potato crisps”, “Low-fat potato crisps” and “Potato crisps in the form of snack foods” in the applicant’s specification all fall within the broader category of “Crisps” in the opponent’s specification. These goods can be considered identical on the principle outlined in *Meric*.

61. That leaves “chips (potato -)” in the applicant’s specification. What is meant by this description is open to some interpretation. Chips, in the UK, is commonly used to describe potatoes (or other vegetables) that have been cut into oblong slices and fried (or in some cases oven baked) which are normally served as an accompaniment to a main meal and may be referred to as “French fried potatoes” or “French fries”. This is a different meaning to “crisps” which are very thinly sliced potatoes (or other vegetables) which have been fried to create a crunchy snack product. However, I am aware that “potato chips” is a term sometimes used to describe crisps and not chips in the sense described above. I will proceed on the basis that the latter interpretation

is correct in light of the rest of the applicant's specification. Consequently, these goods will be identical to "crisps" in the opponent's specification.

Class 30

62. "Whole-wheat crisps" and "crisps made of cereals" in the applicant's specification fall within the broader category of "crisps" in the opponent's specification. Similarly, "crisps" in the opponent's specification falls within the broader category of "savoury snack foods" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

63. The rest of the goods in class 30 are all equivalent snack goods that might be eaten as an alternative to more traditional crisps. They will have the same users, uses and methods of use as crisps. They are likely to be sold in the same area of a supermarket and there will be competition between them. I consider these goods to be highly similar.

The average consumer and the nature of the purchasing act

64. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

65. I have no submissions from either party on the identity of the average consumer or the purchasing process for the goods in issue. The average consumer for the goods will be a member of the general public. The level of attention paid by the average consumer is likely to be average. These purchases are likely to be fairly frequent and of low cost.

66. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online equivalent. This might include shops and food outlets. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant or word-of-mouth recommendations may be made.



Comparison of trade marks

67. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

69. The applicant's series of marks are all identical save for the colour of the background. As the opponent's mark is registered in black and white, I will use only the black and white version of the applicant's mark as this represents the closest comparison with the opponent's mark. The respective trade marks are shown below:

Applicant's trade mark	Opponent's Trade Mark
	

70. I have lengthy submissions from both parties on the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

71. The applicant's mark consists of the words LONDON FLAVOURS presented on a black rectangular background. The word LONDON is presented in larger font than the word FLAVOURS. The wording used plays a greater role in the overall impression of the mark, with the background playing a lesser role. The word LONDON plays a marginally greater role than the word FLAVOURS due to the size of the font used. The opponent's mark consists of the words THE LONDON CRISP. CO. presented in three black arrows. The first arrow is pointing to the right and contains the word THE. The second arrow, presented beneath it, is pointing to the left and contains the word LONDON. The third arrow, beneath the second, is pointing to the right and contains the words CRISP. CO. The "O" in CO. is underlined. The wording in the opponent's mark is all approximately the same size, although the start or ends of some words appear larger to accommodate the size of the arrows. The overall impression of the mark is contained in the combination of the wording and the arrows, with the wording playing a marginally greater role.

72. Visually, the wording of both marks is presented in uppercase fonts. The font used in the word LONDON in the applicant's mark is elongated to create a rectangular impression. Both marks contain the word LONDON. However, differences are created between the marks by the addition of the word FLAVOURS to the applicant's mark and the words THE and CRISP. CO. to the opponent's marks. Further differences are created by the use of a plain rectangular background in the applicant's mark and the three arrows in the opponent's mark. I, therefore, consider the marks to share a low degree of visual similarity.

73. Aurally, the words LONDON FLAVOURS in the applicant's mark will be given their ordinary English pronunciation. I disagree with the opponent that the word FLAVOURS will be omitted from the pronunciation of the applicant's mark. The opponent's mark will be pronounced either THE LONDON CRISP CO. or THE LONDON CRISP COMPANY. In either case, the only common element between the two marks is the word LONDON which will be pronounced identically in each. I, therefore, consider the marks to share a low degree of aural similarity.

74. Conceptually, the words in the applicant's mark come together to create the impression of flavours of London. That is, flavours that are inspired by or originate, in some way, in London. The opponent's mark creates the conceptual image of a business entity in which is based in London and produces crisps. The only similarity between the two marks is that they are in some way linked to the city of London. I consider there to be a low degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

75. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case 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, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

76. Registered trade marks possess varying degrees of inherent distinctive character ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

77. I must consider the inherent distinctive character of the earlier mark as a whole. The opponent’s mark consists of the words THE LONDON CRISP.CO. These words are purely descriptive of the goods provided by the opponent and the location in which the business originated. The use of the arrow background as described above does help to add a degree of distinctiveness to the opponent’s mark. However, even with this, I consider the inherent distinctiveness of the opponent’s mark to be no more than average.

78. The opponent has filed evidence to show that its mark has enhanced its distinctiveness through use. Whilst the evidence shows that the mark has been used and has been referenced in some articles it does, in my view, fall short of demonstrating that the distinctiveness of the mark has been enhanced through use.

Likelihood of confusion

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

80. Exhibit TL2 and TL3 to Mr Lock's second statement are provided by the opponent to support the suggestion that there is a likelihood of confusion. The first issue with Exhibit TL2 is that limited information is provided as to why Sourced Food thought they had received samples of the opponent's crisps. An agency was the point of contact for them and we do not know what discussions took place, the explanation given as to the origin of the crisps or whether Sourced Food was actually exposed to the applicant's mark in any way. Further, having said that they had received a sample of the opponent's crisps, there is no email attempting to clarify or correct this assumption sent by the opponent. The opponent has provided Sourced Media's response saying: "a brand mix up it seems" but it is not clear what discussion led to this statement being made. Exhibit TL3 is described as being communications from a "business customer" of the opponent. No explanation is provided as to the nature of the relationship between the businesses. Clearly, the contact recognised the difference between the two marks because the first question asked is: "did you know about this?". It is not clear what caused the contact to consider that there may be some connection between the parties and whether this was caused by viewing the marks alone or by some other

factor (for example the reference made by the opponent to the “four-pronged motif” which does not actually appear in the applied for mark may mean that something else was in play which is not present in the application). In any event, even if both businesses were confused by the marks alone, two instances of confusion is not sufficient to mean that a finding of confusion is necessary.

81. I have found the marks to be visually, aurally and conceptually similar to a low degree. I have found the earlier mark to have no more than an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process. I have found the parties goods’ to be identical or highly similar. Taking all of these factors into account, I consider that the visual, aural and conceptual differences between the marks are sufficient to prevent consumers from mistaking one mark for the other. I am, therefore, satisfied that there is no likelihood of direct confusion.

82. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

83. Bearing in mind my conclusions listed at paragraph 81 above, notwithstanding the evidence provided by the opponent at Exhibit TL2 and TL3, I can see no reason why the average consumer, having recognised the differences between the marks, would assume that the marks come from the same or economically linked undertakings. The visual, aural and conceptual differences are, in my view, too significant for indirect confusion to arise. The common element LONDON in both marks is far more likely to be seen by the average consumer as indicating businesses or products linked in some way with the city of London, rather than indicating linked businesses. I am, therefore, satisfied that there is no likelihood of indirect confusion.

84. The opposition under section 5(2)(b) fails.

Section 5(3)

85. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics

which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

86. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the relevant public will believe that the marks are used by the same undertaking or that there is an economic connection between the users. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of application – 8 September 2017.

Reputation

87. In *General Motors*, Case C-375/97, the CJEU stated:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout the territory of the Member State. It is sufficient for it to exist in a substantial part of it.'

88. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

89. The opponent has demonstrated that it has a customer base in the UK, having provided turnover figures of £319,140 in 2015 to 2016, £389,941 in 2016 to 2017 and £289,352 in 2017 to 2018. The opponent's total turnover for this period is £998,000. However, the breakdown of this figure shown at Exhibit TL1 to Mr Lock's first statement shows that approximately £248,000 of this relates to the period October 2017 to April 2018, which is after the relevant period. Some of the turnover for the month of September 2017 also, presumably, falls after the relevant date. This leaves the opponent with turnover of approximately £750,000 at the relevant date. This is around £250,000 per year. No information has been provided by the opponent as to what market share this represents. However, it is reasonable to assume that the crisp market in the UK is significant and in the context of a market of that size this figure is low. The opponent has spent over £145,000 on advertising and promoting its products in the UK. Over the course of three years, whilst not an insignificant amount, this is a relatively low advertising spend per year, particularly in a market which is so crowded and competitive.

90. The opponent's evidence is that its goods are available in over 300 outlets as well as in supermarkets, independent retailers and wholesalers. The opponent also sells

its goods online via Amazon. The purchase orders provided by the opponent are all dated after the relevant date. The opponent's evidence is that it attends a variety of shows and events and maintains a social media presence. The opponent has provided print outs from its social media accounts and, although these are all in the name of one of its other trade marks, there are posts made from these accounts which promote the earlier mark. However, the opponent's social media accounts display relatively low numbers of followers. Examples of brochures have been provided which display the opponent's goods, but no information is provided as to the scale of the distribution of these. The opponent has demonstrated that it has been referenced in both online and printed publications.

91. In my view, the turnover and advertising figures provided by the opponent are relatively low, particularly given the size of the market concerned. The amount spent on advertising is also low. Whilst I note that the opponent's mark has been referenced in published articles, I am not satisfied that this is sufficient to demonstrate that it is known by a significant part of the public in relation to crisps. In my view, the evidence falls short of demonstrating a reputation.

92. The opposition under section 5(3) must fail at the first hurdle. However, in the event that I am wrong in my finding that the opponent has a reputation in relation to crisps, I will go on to consider whether there will be a link made by the consumer between the marks in circumstances in which the opponent has demonstrated a reasonable reputation.

Link

93. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

For the reasons set out earlier, I consider there to be a low degree of visual, aural and conceptual similarity between the marks.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

For the reasons stated earlier, the goods are identical or highly similar.

The strength of the earlier marks' reputation

If the opponent's mark does, in fact, have a reputation, then it will be only a reasonable reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

As noted above, the earlier mark has no more than an average degree of inherent distinctive character.

Whether there is a likelihood of confusion

For the reasons set out above, I do not consider there to be a likelihood of confusion.

94. The evidence provided by the opponent at Exhibit TL2 and TL3 as described at paragraph 80 above also goes to the question of whether a link will be made by the consumer. In my view, the lack of information as to what caused these individuals to believe that there was some connection with the opponent limits the use of this evidence to the opponent. Further, two examples are far from sufficient to make a finding of a link necessary. In my view, even if the opponent had a reasonable reputation in the UK, notwithstanding the fact that the goods are identical, the low level of similarity between the marks and the distinctiveness of the earlier mark being no more than average means that consumers will not make a link between the marks in use. The opposition under section 5(3) must, therefore, fail.

Section 5(4)(a)

95. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

96. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceeding as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.””

97. Although the applicant has stated that it has enjoyed some success in the Middle East prior to making the present application, there is no suggestion that the mark has been used prior to the application date in the UK so that the outcome may be different if the assessment under section 5(4)(a) were conducted in reference to an earlier date. The relevant date for assessing whether section 5(4)(a) applies, therefore, is the date of the application which is the subject of these proceedings – 8 September 2017.

Goodwill

98. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

99. 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.”

100. 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.”

101. Goodwill arises as a result of trading activities. The opponent's claim to goodwill is supported by the turnover figures referred to above. As noted above, these are fairly low given the size of the market in question. However, a small business which has more than trivial goodwill can protect signs which are distinctive of that business under the law of passing off². Taking all of the evidence into account, I am satisfied that the opponent has acquired a degree of goodwill in relation to crisps.

Misrepresentation

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

² *Stacey v 2020 Communications* [1991] FSR 49

“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.”

103. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumers are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that is the case here. I consider that the marks are so different that members of the public are not likely to be misled into

purchasing the applicant's goods in the belief that they are the goods of the opponent. The opposition under section 5(4)(a) must, therefore, fail.

CONCLUSION

104. The opposition is unsuccessful and the application will proceed to registration.

COSTS

105. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,350 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement	£250
Preparing evidence and considering the opponent's evidence	£700
Preparing two sets of written submissions	£400
Total	£1,350

106. I therefore order AP Brands Limited to pay London Flavours International Limited the sum of £1,350. This 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 19th day of November 2018

S WILSON

For the Registrar