

O/823/22

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NO. 3092547
IN THE NAME OF THE JOLLY HOG GROUP LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK**

PORKY BLACK

AND

**AN APPLICATION FOR A DECLARATION OF THE INVALIDITY
THEREOF UNDER NO 503690
BY
PORKY WHITES LIMITED**

BACKGROUND AND PLEADINGS

1. UK Trade Mark (“UKTM”) No. 3092547 **PORKY BLACK** stands registered in the name of The Jolly Hog Group Limited (“the proprietor”). It was applied for on 3 February 2015 and completed its registration procedure on 8 May 2015. The mark was originally registered for goods and services in Classes 29, 30 and 43, but, following an amendment to the specification, the goods for which it is registered are as follows:

Class 29

Sausages.

2. On 5 March 2021, Porky Whites Limited (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), which are relevant in invalidation proceedings under section 47 of the Act. It withdrew its claim under sections 5(4)(a) and 47(2)(b) on 6 August 2021 for reasons of procedural economy. The application for invalidation covered all the goods for which the mark was registered at the time.

3. The applicant is relying on UKTM No 2375195 **PORKY WHITES**, which has a filing date of 7 October 2004 and a registration date of 4 March 2005. It is registered for the following goods:

Class 29

Sausages.

4. The applicant claims that the contested mark offends against sections 5(2)(b) and 5(3) of the Act. Under the former, it argues that the marks are highly similar and that the goods are identical. It also claims that the distinctiveness of the earlier mark has been enhanced through use. For these reasons, it claims that there is a very strong likelihood of confusion on the part of the public.

5. Under section 5(3), it claims that the earlier mark has a reputation in the United Kingdom, such that use of the contested mark in respect of the contested services

would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

6. The proprietor filed a defence and counterstatement denying the claims made and putting the applicant to proof of use of the earlier mark, and its claims to enhanced distinctiveness and reputation. It also asserted that it had made substantial use of the contested mark in the UK in relation to *Sausages* since 2013, and that as a result of such use, the contested mark had acquired enhanced distinctiveness and a significant reputation.

Evidence and submissions

7. The applicant's evidence comes from Francesca Wyatt, the Managing Director of Porky Whites Limited, and is dated 8 October 2021. It is accompanied by 30 exhibits adduced to show the use that has been made of the earlier mark and its reputation in the United Kingdom.

8. The proprietor also filed evidence in the form of a witness statement from Maxim Julius Kohn, director of The Jolly Hog Group Limited, dated 9 December 2021. It is accompanied by 22 exhibits and goes to the use of the contested mark for over 10 years.

9. The applicant filed written submissions dated 6 August 2021.

The hearing and preliminary issues

10. The matter came to be heard by me via video conference on 17 August 2022. The applicant was represented by Jacqueline Reid of Counsel, instructed by Penningtons Manches Cooper LLP, and the proprietor by Sonia Amrar of Wynne-Jones IP Limited.

11. It was necessary to deal with two preliminary issues at the start of the hearing. The first of these concerned the two annexes attached to the proprietor's skeleton argument: a definition of the word "porky" retrieved from the online version of the Collins English Dictionary, and a series of print-outs from the applicant's website

showing the range of products sold by the applicant company. The day before the hearing, the applicant also filed its own, different, definitions of the word “porky”.

12. Ms Reid for the applicant objected to the inclusion of the annexes, characterising them as an attempt to introduce late evidence into the proceedings. I asked Ms Amrar whether she was intending to make an application for additional evidence to be admitted and she withdrew Annex 1 containing the definition. Ms Reid confirmed that she was not seeking to introduce the definitions filed by the applicant into evidence.

13. On the subject of Annex 2, Ms Amrar said that the purpose of this annex was to show that the applicant used a number of different marks and so the turnover figures provided did not only relate to sales of goods bearing the earlier mark. The evidence that had already been adduced by the applicant included brochures showing the range of different brands used on the applicant’s products. The point that Ms Amrar sought to make was equally able to be supported by the evidence already admitted. Furthermore, as Ms Reid noted, the date of printing of the first pages of the annex was 12 August 2022 and other screenshots obtained via the Wayback Machine had a date later than 2019. All the contents of the annex, therefore, were dated after the relevant date. I refused to admit Annex 2.

14. I now come to the second preliminary issue. In its skeleton, the proprietor sought to rely on a defence of honest concurrent use. Ms Reid objected, submitting that the defence should have been pleaded up-front and noting that it had not been mentioned at all earlier in the proceedings. She also submitted that the evidence was insufficient to support such a defence.

15. I asked Ms Amrar if she sought to amend the proprietor’s pleadings. She replied that it was her view that it was implicit from the following extract from the counter-statement that the proprietor was relying on a defence of honest concurrent use:

“23. The Proprietor has made extensive use of the Registration in the United Kingdom in respect of sausages in Class 29 since at least 2013.

24. As a result of such use, the Registration has acquired enhanced distinctiveness, a significant reputation and goodwill in the United Kingdom in relation to sausages.”

16. In its written submissions of 6 August 2021, the applicant required the proprietor to explain the relevance of these assertions in the context of these proceedings. This was not addressed during the evidence rounds.

17. Tribunal Practice Notice (“TPN”) 4/2000 states that:

“19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.

20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. ...”¹

18. Ms Amrar submitted that it was not necessary to use the exact phrase “honest concurrent use” in order to plead it as a defence.² However, as Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Demon Ale* [2000] RPC 345:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do.”

19. In addition, based on Ms Amrar’s response to my questions, I had some doubt as to whether the proprietor were actually relying on a *Budweiser*-type of honest

¹ The terms used in the TPN are those that pertain to oppositions; however, they apply equally in the case of applications for a declaration of invalidity.

² Transcript, page 6.

concurrent use, as considered by Carr J in *Victoria Plumb Ltd v Victorian Plumbing Ltd*, [2016] EWHC 2911 (Ch). He said:

“The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant’s trade mark is not impaired by the defendant’s use, because the trade mark does not denote the claimant alone.
- iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant’s goodwill.”³

20. It seemed to me that instead the proprietor was claiming that there had been no instances of actual confusion in the marketplace, as in *Roger Maier & Anor v ASOS*, [2015] EWCA Civ 220, where Kitchen LJ said:

“... the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. ...”⁴

³ Paragraph 74.

⁴ Paragraph 80.

21. I asked Ms Amrar directly whether she was claiming a *Budweiser*-type honest concurrent use defence or the more commonly argued position that both marks are in use on the marketplace and that there have been no instances of confusion. She replied that it was the latter, and the hearing proceeded on this basis.

Legislation

22. Section 47 of the Act is as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection 1(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered -

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the ‘variant form’) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.

...

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are –

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

23. Section 100 of the Act is also relevant and states that:

“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.”

Section 5(2)(b)

24. Section 5(2) of the Act is as follows:

“A trade mark shall not be registered if because –

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

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

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

25. As the earlier mark completed its registration process more than five years before the date of application for a declaration of invalidity, it is subject to the use provisions set out in section 47 (2A)-(2G) of the Act. The applicant must show use of the mark in both the five-year period ending with the date of application for a declaration of invalidity (6 March 2016 – 5 March 2021) and the five-year period ending with the date of application for the contested mark (4 February 2010 – 3 February 2015). Ms Amrar accepted that the applicant had shown genuine use of the earlier mark during the relevant periods.

26. In considering the application for invalidity under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):⁵

- 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 they have kept in their 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;

⁵ Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of the EU courts.

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; and

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.

27. The relevant date is the date of application for the contested mark: 3 February 2015.

Comparison of goods

28. There is no dispute between the parties that the goods in question are identical, both being *Sausages*.

Average consumer and the purchasing process

29. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) 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.”⁶

30. The parties were in agreement that the average consumer would be an omnivore member of the general public, but Ms Amrar disagreed with Ms Reid’s submission that there would be another average consumer, namely a business who purchased sausages to include in meals or other products sold to its own customers. I agree with Ms Reid that there will be two average consumers, but accept that the general public will pay a lower degree of attention than a business that will need to consider its reputation and profitability when deciding what ingredients it will use in its own products or serve to its customers. The general public are therefore more likely to be confused than businesses, and so that is the average consumer I shall keep in mind in this decision.

31. The average consumer will purchase the goods from supermarkets or other food retailers, either visiting a physical store or ordering them online via a website. They will select the goods themselves, and this means that it is the visual aspect of the marks that will be most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 40. These are routine purchases that would form part of a weekly or monthly shop. On the other hand, I do not think that the attention will be particularly low: these are neither the “bag of sweets” impulse purchase nor a basic ingredient like flour. The consumer will want to check flavourings and that the goods are compatible with any dietary requirements. In my view, the average consumer will pay a medium degree of attention.

Comparison of marks

32. It is clear from *SABEL* (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

⁶ Paragraph 60.

marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”⁷

33. 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.

34. The respective marks are shown below:

Earlier mark	Contested mark
PORKY WHITE'S	PORKY BLACK

35. Both marks are plain word marks consisting of two words, the first of which is identical. The second word in the earlier mark is followed by an apostrophe and the letter “S”, suggesting that the goods bearing the mark belong to, or come from, an individual or entity by the name of “PORKY WHITE”. The overall impression of this mark lies in the two-word phrase as a whole. In the contested mark, the word “PORKY” is followed by the adjective “BLACK”. Both words make a roughly equal contribution to the overall impression of that mark.

36. The parties agree that the marks are visually and aurally similar. As I have already noted, they have identical first words. The average consumer has a tendency to pay more attention to the beginning of marks than to the end: see *El Corte Inglés, SA v*

⁷ Paragraph 34.

OHIM, Joined cases T-183/02 and T-184/02, paragraph 81. I find that the marks are visually and aurally similar to a medium degree.

37. The parties were not agreed on the conceptual content of the marks. Ms Reid submitted that the average consumer would understand “PORKY” as an informal way of saying that someone was fat, or, less likely, that it would be seen as a slang expression meaning a lie. She considered it was not likely that the average consumer would believe it to be a reference to pork, as the mark was used for goods made from other ingredients, such as chicken.⁸ Ms Amrar, on the other hand, submitted that “PORKY” was descriptive of the pork content of the goods. In my view there will be some consumers who side with Ms Reid and some with Ms Amrar. I am not required to identify one, and only one, perception among the relevant class of average consumer: see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), paragraph 27. However, the average consumer interprets the word, though, it is my view that they would understand it in the same way in both marks. Both parties agreed that the second word in the mark would be seen as a reference to a colour. I find that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [1999] ECR I-0000, paragraph 49).

⁸ Transcript, page 9.

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).”

39. Ms Reid claimed that the distinctive character of the earlier mark had been enhanced through use, but first I shall consider its degree of inherent distinctive character. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

40. For those consumers who think that the word “PORKY” refers to a type of meat that comes from pigs, the earlier mark is mildly allusive, as this is a common ingredient in the goods that are covered by the registration. In this case, the earlier mark has a relatively low degree of inherent distinctiveness, although not the very lowest. To those consumers whose perception accords more closely with that of Ms Reid, the allusion is weaker. One might become “porky” through eating too many of the applicant’s goods. For these consumers, I find that the earlier mark has a no more than medium degree of inherent distinctiveness.

Has the inherent distinctiveness of the earlier mark been enhanced through use?

41. The factors that I must consider are set out in the case law quoted above.

42. The applicant is a family business that has been in operation since 1935. It was incorporated in 1993 as Cabinwood Limited and changed its name to Graham White

& Co Limited a few weeks later.⁹ When the business went into administration, the family established a new company, Porky Whites Limited, that bought the trade marks of Graham White & Co, in 2019.¹⁰

43. In 1988, the business started selling its sausages in Selfridge’s and from 1990 they were served on Concorde. In both these cases they were referred to as “Porky Whites”.¹¹ In 2004, the business started selling PORKY WHITES branded sausages in Asda. They later sold them in Sainsbury’s, Tesco, Waitrose, Morrison’s, Budgens and Londis as well. Sample invoices have been provided.¹²

44. The applicant’s sales are shown in the table below:¹³

Year	Turn Over (£)	Retail	Wholesale
2009	2729184	45%	55%
2010	3133007	60%	40%
2011	3302885	60%	40%
2012	3882061	60%	40%
2013	4637908	60%	40%
2014	4606568	65%	35%
2015	5611829	65%	35%
2016	5379590	80%	20%
2017	7413308	83%	17%
2018	6886152	78%	22%
2019	6389406	78%	22%
2020	3162770	88%	12%

45. The following sums were spent on advertising:¹⁴

⁹ Exhibit FW1.

¹⁰ Exhibits FW2 and FW3.

¹¹ Paragraph 7.

¹² Paragraph 9; Exhibits FW4, FW11-FW15, FW29.

¹³ Exhibit FW8.

¹⁴ Exhibit FW16.

Year Ending 31st March	AMOUNT SPENT ON ADVERTISING	
2020		
2019	£	57,478.00
2018	£	68,322.00
2017	£	84,755.00
2016	£	55,906.00
2015	£	61,095.00
2014	£	8,067.00
2013	£	11,171.00
2012	£	21,490.00
2011	£	21,718.00
2010	£	17,402.00
2009	£	9,206.00
2008	£	1,235.00
	£	417,845.00

46. It will be seen that the figures do not distinguish between products, although they indicate the proportions of revenue earned through the retail and the wholesale side of the business. Ms Wyatt states that unbranded versions of the sausages were sold to customers such as Brands Hatch (motor racing circuit catering), Weddel Swift (catering butchers) and Charlie Bigham's (ready meal company).¹⁵ Product portfolios indicate that the wholesale business was carried out under the "Porky Whites" name.¹⁶

47. Ms Amrar submitted that the fact that these are aggregate figures and do not show sales under specific marks makes it impossible to determine whether the distinctiveness of the earlier mark has been enhanced. She also noted that there is no information on market share. I do not consider that the CJEU was laying down a prescriptive list of factors that must be present before a finding of enhanced distinctiveness can be made. Rather, I should look at the evidence as a whole and consider all relevant factors.

48. Ms Wyatt states that *"During the relevant periods, the business used **PORKY WHITES** as its formal and informal trading name, as well as the name of one of its product ranges."*¹⁷ From 2011, the website highlighted "PORKY WHITES" in larger

¹⁵ Paragraph 14.

¹⁶ Exhibit FW5.

¹⁷ Paragraph 12.

letters than the company name. The screenshot below states that “Today, Porky Whites is still an independent, family-run business.”¹⁸



49. In newspaper and website articles published between 24 May 2006 and 2019, the applicant is also referred to as “Porky Whites” and described as a sausage manufacturer.¹⁹ Articles come from sources such as Mail Online, *Surrey Advertiser*, *The Times*, Which? Online and the *Daily Star*. The applicant also ran competitions, attended radio interviews and placed radio advertisements. While some of these were focused on the south-east of England, others, notably the 2018 “Sausies Awards”, where the public was invited to vote for its “*tastiest celebs and personalities*”, received more national coverage.²⁰ The applicant also used a variety of social media channels (Facebook, Twitter and Instagram) and a Porky Whites Appreciation Society Facebook Group was set up in 2007 by enthusiasts. By 2014, it had 500 members and the applicant assumed responsibility for its administration.²¹

¹⁸ Exhibit FW18, page 185.

¹⁹ Exhibit FW21.

²⁰ Exhibit FW22. See also the article from *The Daily Star* in Exhibit FW21.

²¹ Paragraph 38.

50. I remind myself that the relevant date for my assessment of enhanced distinctiveness is 3 February 2015. The majority of the advertising examples and the articles from *The Times*, *Which? Online* and the *Daily Star* all post-date this relevant date. Taking the evidence as a whole, in my view it falls short of what would be required to show that the inherent distinctiveness of the earlier mark had been enhanced by 3 February 2015.

Conclusions on likelihood of confusion

51. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind 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 they have in their mind.

52. First, I shall consider the relevance of the proprietor's argument that there have been no recorded instances of confusion. The Jolly Hog Group Limited was founded in 2008. They first sold sausages at a rugby international the same year. The following year, they began to sell sausages during fairs, festivals and events throughout the country.²² In 2010, the proprietor developed a black pudding and apple-flavoured sausage. Mr Kohn claims that the name "PORKY BLACK" was arrived at "*independently*" and that "*it is also linked with some of our other products, i.e. PROPER PORKER and LITTLE PORKER as we wanted to have a family of brands*".²³ The first PORKY BLACK retail packs were sold in 2014 at the Royal Bath & West Show. The sausages were also sold in a pop-up restaurant which operated in Shoreditch for a month in 2015.

²² Witness statement of Maxim Julius Kohn, paragraph 4.

²³ Paragraph 6.

53. I have already cited the decision of Kitchen LJ in *Roger Maier*.²⁴ After acknowledging that the absence of actual confusion “*despite side by side use*” might be evidence that confusion is not likely, he went on to say that:

“...This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”²⁵

54. The relevant date for my assessment is 3 February 2015. At this point, the proprietor’s goods were only available for purchase from the proprietor itself at specific events. They were not available in retail outlets such as supermarkets, where the applicant’s goods were sold. Therefore, I consider that there was limited opportunity for confusion to occur and so the lack of any evidence of confusion does not assist the proprietor. For the avoidance of doubt, the evidence would not have been sufficient to show that there had been honest concurrent use, following the principles set out in *Victoria Plumb* and cited above.

55. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 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

²⁴ See paragraph 20 above.

²⁵ Paragraph 80.

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.'

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

56. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."²⁶

²⁶ Paragraph 12.

57. He also said:

“As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”²⁷

58. Ms Reid submitted that there was a likelihood of indirect confusion. I agree that there is no likelihood of direct confusion, as the average consumer is unlikely to mistake one mark for the other, even taking into account the imperfect recollection of the marks. Turning now to consider indirect confusion, I recall that the goods are identical and that the marks are similar to a medium degree. In my view, the average consumer may not accurately recall the apostrophe in the earlier mark and would assume that “WHITE” and “BLACK” denoted different varieties of one undertaking’s goods. The applicant has provided evidence that it has used the word “PORKY” alongside “LIGHTS”, “FLATS”, “BITES” or “DOGS” for other products in the range (namely, lower-fat sausages, flat sausages, small sausages, or hot dogs), and so I consider that there will be a significant proportion of consumers who believe that “BLACK” is another variety of the applicant’s sausages, perhaps containing ingredients that give them a darker colour or flavour. The application for invalidity therefore succeeds under section 5(2)(b).

Section 5(3)

59. The success of the section 5(2)(b) ground means that there is no absolute need to address the applicant’s claim under section 5(3). However, in case I am wrong about

²⁷ Paragraph 13.

the likelihood of confusion, I shall briefly examine the section 5(3) ground to see if it would succeed independently of the section 5(2)(b) ground.

60. Section 5(3) of the Act is as follows:

“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 (EU) 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 the repute of the earlier trade mark.”

61. The conditions of section 5(3) are cumulative. First, the applicant must show that the earlier mark is similar to the contested mark. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, 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 contested mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. 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.

62. I have found that the contested mark to be similar to the earlier mark and so now consider whether the applicant has shown that it has the necessary reputation by the relevant date of 3 February 2015. Based on the facts set out in paragraphs 42-50, I

consider that the evidence falls short of what would be required to show a qualifying reputation at the relevant dates and so the section 5(3) ground fails.

OUTCOME

63. The application to invalidate UKTM No. 3092547 succeeds.

COSTS

64. The applicant has been successful and is entitled to a contribution towards its costs. At the hearing, Ms Amrar had submitted that the conduct of the applicant warranted the award of off-scale costs, should the proprietor be successful. The behaviour that she claimed to be objectionable was the submission by the applicant of a large amount of evidence (845 pages) which necessitated the calling of a case management conference (“CMC”). The Tribunal has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. While I appreciate that some additional cost was incurred, I do not consider that the actions of the applicant were unreasonable. I held the CMC and it was my view that the applicant’s representative believed when she filed the original evidence that all of it was necessary. I therefore award costs based on the scale set out in TPN 2/2016 as follows:

<i>Preparing a statement and considering the proprietor’s statement:</i>	<i>£400</i>
<i>Preparing evidence and considering the proprietor’s evidence:</i>	<i>£1000</i>
<i>Preparing for and attending the hearing</i>	<i>£800</i>
<i>Official fees:</i>	<i>£200</i>
<i>TOTAL</i>	<i>£2400</i>

65. I therefore order The Jolly Hog Group Limited to pay Porky Whites Limited the sum of £2400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of September 2022

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