

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No. 2514284
IN THE NAME OF CHICKEN JOES LIMITED**

**AND IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF UNDER No. 83657
BY AMANDA LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST THE DECISION OF MR G.W. SALTHOUSE
DATED 17 FEBRUARY 2011**

DECISION

Introduction

1. This is an appeal against a decision of Mr. G.W. Salthouse acting for the Registrar, dated 17 February 2011, BL O/056/11, in which he refused an application by Amanda Limited (“the Applicant”) to declare invalid UK Trade Mark Registration number 2514284 standing in the name of Chicken Joes Limited (“the Registered Proprietor”).
2. UK registration number 2514284 is for the following trade mark:



3. It was registered on 14 August 2009 with effect from 22 April 2009 in respect of the goods and services listed below:

Class 16

Paper, cardboard and goods made from these materials, printed matter; photographs; stationery; printed publications

Class 25

Clothing, footwear, headgear

Class 29

Meat, fish, poultry and game, meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps

Class 30

Flour and preparations made from cereals, bread, pastry, vinegar, sauces (condiments); spices, sandwiches, prepared meals, pizza, pies and pasta dishes

Class 35

Advertising, business management, business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; data processing; provision of business information; retail services connected with the sale of chicken foodstuffs

Class 39

Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities

Class 43

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services

4. On 8 January 2010, the Applicant applied to invalidate the Registration under section 47(2)(a) of the Trade Marks Act 1994 on the ground that there is an earlier trade mark to which the conditions of section 5(2)(b) of the Act obtained.
5. Section 5(2)(b) provides that a trade mark must be refused registration if because 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, which includes the likelihood of association with the earlier trade mark.
6. To this end, the Applicant relied upon its earlier Community trade mark Application number 7142367 for the words JO LOVES, which was applied for on 7 August 2008 and registered on 2 February 2011 in relation to the following goods and services:

Class 11

Apparatus for lighting, lamps, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; candle and storm lanterns

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones, watches, clocks

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; publications; periodicals; magazines; newsletters; pamphlets; brochures; books; booklets; calendars, photographs; stationery; adhesives for

stationery or household purposes; artists` materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes)

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics

Class 21

Household or kitchen utensils and containers (not of precious metal or coated therewith) including cups, mugs, combs and sponges; graters, spatulas, spoons, whisks, bowls, bottle openers; kitchen and bathroom accessories, including soap and lotion dispensers, soap dishes, tumblers, toilet tissue holders, tooth brush holders, waste baskets, pitchers, and napkin rings not made of precious metal; dinnerware; beverage ware; bakeware; cookware, cleaning supplies, table accessories, brooms, brushes and dusters (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, vases and pitchers, porcelain and earthenware not included in other classes

Class 25

Clothing, footwear, headgear; clothing accessories, belts, scarves

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; smoothies made from milk

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; ice cream, ice creams

Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; smoothies made from fruit

Class 33

Alcoholic beverages (except beers)

Class 35

Retail services in department stores, stand alone retail outlets, retail services via mail and telephone order and via websites on the internet, all for the following type of goods: lamps, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, candle and storm lanterns, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, watches, clocks, paper, cardboard and

goods made from these materials, printed matter, publications, periodicals, magazines, newsletters, pamphlets, brochures, books, booklets, calendars, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching materials (except apparatus), plastic materials for packaging, furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum, and substitutes for these materials or of plastics, household or kitchen utensils and containers including cups, mugs, combs and sponges, graters, spatulas, spoons, whisks, bowls, bottle openers, kitchen and bathroom accessories including soap and lotion dispensers, soap dishes, tumblers, toilet tissue holders, tooth brush holders, waste baskets, pitchers and napkin rings made of precious metal, dinnerware, beverage ware, bakeware, cookware, cleaning supplies, table accessories, brooms, brushes and dusters (except paint brushes), brush making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, vases and pitchers, porcelain and earthenware, clothing, footwear, headgear, clothing accessories, belts, scarves, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, smoothies made from milk, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice, ice-cream, ice-creams, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, smoothies made from fruit, alcoholic beverages

Class 39

Transport; packaging and storage of goods; travel arrangement and delivery of goods

Class 40

Treatment of materials, air freshening services

Class 43

Services for providing food and drink; restaurant, cafe, bar and catering services, temporary accommodation

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services

7. The Registered Proprietor took issue with the ground of invalidity in a Notice of defence and counterstatement filed on 31 March 2010. There was no evidence but both parties filed written observations and were represented at an oral hearing.

Hearing Officer's decision

8. The Hearing Officer instructed himself as to the law under section 5(2)(b) by reference to the usual summary of principles extracted by the Trade Marks Registry from the relevant case law of the Court of Justice of the European Communities (cited, e.g., by Arnold J. in *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee (trading as "Crompton Brewery")* [2011] EWHC 1879 (Ch), paras. 76 – 77).

9. The average consumer was the general public (with the exception of the Registered Proprietor's Class 35 services which were aimed at business users), and the general public would purchase the respective goods and services exercising a reasonable degree of care and attention.
10. The respective goods and services in Classes 16, 25 and 43 were identical. There was also overlap in the other classes involved although some of the respective goods and services in Classes 29, 30, 35 and 39 were only similar and some were dissimilar.
11. There was no challenge the above on appeal. The contentious issue was the Hearing Officer's comparison of the trade marks below:

“17) Clearly, the registered proprietor's mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components.

18) The applicant contends that the dominant elements of the registered proprietor's mark are the two words LOVE JOES. They state that the fact that JOE is traditionally associated with the male, being a shortened version of Joseph, whilst JO is seen as female might lead to one being viewed as a sub-brand or variant with one targeting the male and the other the female consumer. The applicant also contends that the words “a food service you'll just love!” are trivial elements in the mark as a whole and are descriptive in relation to the goods and services covered by the registration. The applicant also states that as the average consumer reads from left to right the registered proprietor's mark will be seen as JOES LOVE.

19) The applicant further contends that the mere inversion of the first two words of its mark by the registered proprietor cannot allow a conclusion that the marks are visually or phonetically different. They refer me to the General Court decision in *MIP Metro Group Intellectual Property GmbH & Co. KG v OHIM*.

20) I agree that the most dominant aspects of the registered proprietor's mark are the two words LOVE JOES. Whilst the eye is initially drawn to the word JOES simply because of its size the average consumer will then discern that the word above it is LOVE and that grammatically it must precede the word JOES. This is made more obvious by its positioning, which, although it starts further across the page than the word JOES, is not that much further across starting just above the letter “E” in JOES. The natural manner of reading will therefore provide the result which is also grammatically correct “Love Joes”. Clearly, the mark is a statement that the purchaser will “love Joes” goods or services. The answer to the “what” question is supplied just underneath by the words “a food service you'll just love”. I do not agree that the qualifying statement “a food service you'll just love” can be regarded as trivial or descriptive of many of the goods and services covered by the registration.

21) Nor do I agree that the average consumer would view them as connected simply because one uses the female form of JO and the other the male form JOE. To my mind the applicant's mark "JO LOVES" will be seen in two ways. Some will view it as a statement that a female called JO loves something although there is no clue as to what. Alternatively they may see it as the forename and surname of a lady called JO LOVES. Usually a trade mark identifies the origin of goods or services, and I believe that at least some will see the applicant's mark as simply a name indicating the origin of the goods or services on which it is used.

22) With the registered proprietor's mark this mistake cannot occur. The forename JOE is common, but not JOES. Therefore, the mark will always be seen as LOVE JOES. Further, the words are not simply inverted as claimed but there is a significant difference in the possessive case of the registered proprietor's mark as well as the use of male and female forenames which whilst having a degree of similarity also have significant differences.

23) Considering the marks as wholes and acknowledging that there are some visual and phonetic similarities I must also recognise that there are very significant differences, visually, phonetically and conceptually."

12. On the question of likelihood of confusion, the Hearing Officer concluded:

"24) I take all of the above into account when considering the marks globally. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. The differences in the marks are such that even when used on goods which are identical, I believe that there is no likelihood of consumers being confused into believing that the goods provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them, such as by way of a licence. The invalidity action under Section 5(2) (b) therefore fails in relation to the whole of the specification which was registered."

The appeal

13. On 17 March 2011, the Applicant filed Notice of appeal to the Appointed Person under section 76 of the Act. At the appeal hearing, the Applicant was represented by Mr. Andrew Norris of Counsel and the Registered Proprietor by Ms. Jessie Bowhill of Counsel (who also appeared for the Registered Proprietor below).

14. On the standard of review, Ms. Bowhill referred me to the decision of Mr. Daniel Alexander QC sitting as a deputy High Court judge in *Digipos Store Solutions Group Ltd v. Digi International Inc.* [2008] EWHC 3371:

"5. It is important at the outset to bear in mind the nature of appeals of this kind. It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for

this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that I it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference. I approach this appeal with that in mind."

15. As already indicated, the grounds of appeal relate to the Hearing Officer's appreciation of the mark in suit and its comparison with JO LOVES.
16. First, the Applicant argued that the Hearing Officer gave too much weight in the comparison to the words element "a food service you'll just love!" in the mark in suit.
17. Focussing on paragraph 20 of the decision, Mr. Norris said that since the Hearing Officer decided: (1) LOVE JOES was the dominant element of the mark; and (2) the phrase "a food service you'll just love!" was descriptive for at least some of the goods and services, he should have ignored the latter in his comparison of the marks because it was negligible (Case C-334/05 P, *Shaker di Laudato & C. Sas v. Limiñana y Botella, SL* [2007] ECR I-4529, para. 42) and made the comparison with JO LOVES solely on the basis of LOVE JOES.
18. Further, Mr. Norris contended that the Hearing Officer was wrong to ask the "what" question at paragraph 20: LOVE JOES what? – *a food service you'll just love!* – because the general public would perceive LOVE JOES as the dominant element in the mark and therefore the question would not arise.
19. In my view, there is nothing in those arguments. The Hearing Officer correctly compared each of the marks as a whole (Case C-552/09 P, *Ferrero SpA v. OHIM*, 24 March 2011, para. 87). While in the mark in suit, the two words LOVE JOES were the most dominant aspects, the phrase *a food service you'll just love!* also had a role to play when the mark was viewed overall. Those were determinations he was entitled to make. They do not justify my interference on appeal.
20. In any event, as Ms. Bowhill said, the Hearing Officer at paragraph 22 identified the possessive case in the Registered Proprietor's mark and the use of male (mark in suit) and female (Applicant's mark) forenames as contributing to the differences in the marks.

21. Second, again concentrating on paragraph 20 of the decision, Mr. Norris contended that the Hearing Officer wrongly decided that the public would view the dominant aspects of the mark in suit as JOES LOVE rather than LOVE JOES. The latter would be perceived because of the relative sizes and positioning in the mark of the words LOVE and JOES and the fact that the public reads from left to right. Those points were put to and dismissed by the Hearing Officer below and I see no reason to disturb his decision on that account.

Conclusion

22. In the result, the appeal has failed. I will order the Applicant to pay the Registered Proprietor the sum of £250 towards its costs of this appeal in addition to the sum of £500 ordered by the Hearing Officer to be paid to the Registered Proprietor by the Applicant in respect of the opposition such sums to be paid on the same terms as specified by the Hearing Officer.

Professor Ruth Annand, 31 October 2011

Mr. Andrew Norris of Counsel, instructed by D Young & Co appeared for the Applicant

Ms. Jessie Bowhill, instructed by Charles Russell LLP appeared for the Registered Proprietor