

O-558-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 3072016 & 3072022
BY KEEP BRITAIN TIDY
TO REGISTER THE TRADE MARKS
LOVEMYBEACH
AND**



**ALL IN CLASSES 16, 18, 21, 24, 25, 35, 36, 41 & 42
AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 403657 & 403656 BY
LOUISA ANN NEWMAN AND MICHAEL CLIVE BOWKER SMITH**

BACKGROUND

1) On 10 September 2014, Keep Britain Tidy (hereinafter the applicant) applied to register the trade marks shown on the front page of this decision in respect of the following (identical) goods and services:

In Class 16: Printed matter; printed publications; diaries, writing implements; reports, manuals, leaflets, brochures, stickers, posters, banners and badges; educational material; photographs, prints, paintings; address books, organisers; stationery items.

Class 18: Bags, cases, trunks, backpacks, holdalls, satchels, purses, wallets; umbrellas, walking sticks.

Class 21: Litter bins; containers and boxes; mugs, plates and cups; bottles and drinks containers of plastic; ornaments; kitchen and household utensils.

Class 24: Flags; textile products; household linens.

Class 25: Articles of clothing; footwear; headgear; scarves, ties, belts, tabards; visors and caps; socks.

Class 35: Promotional and publicity campaign services; conducting surveys and market research and processing associated data and producing reports; promoting public awareness of environmental issues and initiatives; organising and running environmental and social campaigns; production and distribution of marketing and publicity materials and promotional matter; organisation of networking and marketing events; organising and operating award schemes.

Class 36: Charitable fund raising services; sponsorship of campaigns, programmes and initiatives relating to environmental issues.

Class 41: Education, training and instructional services; organising campaigns and events to raise awareness of environmental issues; publication of books, publications, printed matter and electronic material on environmental matters; organisation of conferences, seminars, training courses and workshops.

Class 42: Consultancy and advisory services; provision of information; preparation of studies and reports; all in connection with environmental issues; providing guidance and advice on litter collection and disposal, waste management, processing and disposal, noise pollution, and other matters relating to care of the environment.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 24 October 2014 in Trade Marks Journal No.2014/044.

3) On 22 January 2015 Louisa Ann Newman and Michael Clive Bowker Smith (hereinafter the opponents) filed notices of opposition, subsequently amended. The opponents are the proprietors of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification relied upon
<i>loving the beach</i>	CTM 7355134	29.10.08 10.06.09	21	Kitchen and tableware, kitchen utensils and containers; but not including rubber gloves or hot water bottles.
			25	Articles of clothing, including knitwear, footwear, headwear, belts, gloves, mittens, scarves, beachwear, swimwear, underwear, socks, shirts, skirts, vests, jackets, gilets, waistcoats, sweatshirts, polo shirts, T-shirts, trousers, jeans, shorts, dresses, coats.
			28	Toys and games; balls for games, beach toys, inflatables and buoyancy aids, surfboards, fishing equipment, swimming webs, goods for use in watersport and

			swimming.
		29	Prepared meals; instant meals and snack foods; preserves; eggs, yoghurt, milk and milk products; edible oils, olive oil.
		30	Prepared meals; snack foods and instant meals; bread, pastry, cereals, sandwiches, rolls, pasties, pastries, cakes, biscuits, flapjacks, tray bakes, ice cream, tea, coffee and cocoa, condiments and confectionery.
		32	Beer; non-alcoholic beverages, fruit drinks and fruit juices, syrups and mineral water.
		43	Catering for the provision of food; preparations of foodstuffs and non-alcoholic beverages and/or meals for consumption off the premises; snack bars; cafeterias; restaurant services; beach catering services.

a) The opponents contend that their mark and the mark applied for are similar. They also contend that the goods for which their mark is registered are identical and/or similar to the goods applied for under classes 16, 18, 21, 24 & 25. The application therefore offends against Section 5(2)(b) of the Act. The services under classes 35, 36, 41 & 42 are NOT opposed.

4) On 27 March 2015 the applicant filed counterstatements in relation to both oppositions. It basically denies the ground of opposition (other than accepting that the goods in classes 21 & 25 have a degree of similarity). It puts the opponent to proof of use of its mark.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, but both sides provided written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 8 June 2015, by Michael Clive Bowker Smith a Director of The Venus Company Ltd, a position he has held since 1998, and, since October 2008, joint proprietor of CTM 7355134. He states:

“2. The company is one of the UK’s leading beach cafe and shop operators and is present at three beach sites across Devon, a cafe in The Shops at Dartington, and two beach cafes in Cornwall. The company operates two beach shops, two cafes and six take away operations as well as providing water sports facilities at two beach sites. The company serves over 650,000 customers each year, and has a turnover topping the £2million mark.

3. The company’s mission is to be the greenest cafe and shop operator. As part of this mission we adopted the motto LOVING THE BEACH where consumers’ needs were carefully balance with environmental and social considerations.”

7) He states that the company has won, in 2005 and 2010, two Queen’s Awards for Enterprise, Sustainable Development, the only beach operator and cafe owner to have done so. The motto was registered as a trade mark in 2008. He states that the company has been using it as a trade mark upon the goods and services for which it is registered since 2009. He states that the company has

spent an average of approximately £80,000 per annum during the period 2008-2014 inclusive on advertising and marketing, although he does not provide details. During the same period he states that turnover in the mark has been approximately £13 million. He provided the following exhibits:

- MCBS3: Evidence of the mark attached to goods in class 21. The scanned images show use of the mark underneath or alongside another trademark “Venus” where the letter “V” is highly distinctive. See Annex1. This exhibit shows use on cups (as per image 2 Annex 1), as well as on candles and candle holders, bottle openers, and food containers. The term “loving the beach” has an ® symbol after it. The exhibit also has copies of invoices which show that Venus purchased quantities of cups and food containers during the period 2009-2014.
- MCBS4: Evidence of the mark attached to goods in class 25. The scanned images show the mark “loving the beach” below the stylised “Venus” mark on swing tags attached to all the goods such as hats, T-shirts, footwear and swimwear. Also provided are copies of invoices for the period 2009-2014 inclusive, showing that Venus purchased considerable numbers of hats, T-shirts, swimwear, shorts and footwear.
- MCBS5: Evidence of the mark attached to goods in class 28. The scanned images show the mark “loving the beach” below the stylised “Venus” mark on stickers/swing tags attached to buckets and spades, balls and other toys and games. Also included are copies of invoices dated 5 February 2009 – 6 June 2009, showing that Venus purchased a quantity of toys and games.
- MCBS6: Evidence of the mark attached to goods in class 29. The scanned images show the mark “loving the beach” below the stylised “Venus” mark on menus and food and drink containers.
- MCBS7: Evidence of the mark attached to goods in class 30. The scanned images show use of the mark underneath images of ice creams and ice lollies as per image 3 Annex 1. Also shown is the artwork designed for the ice cream cone holders which also feature both marks.
- MCBS8: Evidence of the mark attached to goods in class 32. This is the same scanned image of cups as shown in image 2 Annex 1.
- MCBS9: Evidence of the mark used in the provision of food and drink in class 43. This consists of images of the exterior of the cafe and shop where signs showing the name “The venus cafe and shop” (stylised) are prominently shown as are maps with the locations of other “Venus” outlets, these also have the trade mark “loving the beach” upon them. Also included are menus which also carry both marks. These show items such as non alcoholic drinks, snacks, pastries, sandwiches and various meals offered for sale.
- MCBS10: This consists of an invoice dated 11 May 2012 which shows Venus purchasing 5,000 “loving the beach” labels which it states have been used on goods for sale such as clothing, and toys.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

11) The opponent is relying upon its trade mark listed in paragraph 3 above. Given the interplay between the date that the opponent’s mark was applied for and the dates that the applicant’s marks were published, the opponent’s mark is subject to proof of use. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication dates of both applications 3072016 & 3072022 was 24 October 2014, therefore the relevant period for the proof of use is 25 October 2009 – 24 October 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

- (1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].
- (2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].
- (4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

13) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

14) Also in *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

"31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott."

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports

by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

15) Whilst Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

16) The applicant contends:

“The proof is required to demonstrate use of the opponents mark as part of a genuine trade in the goods and services on which their opposition is based, which is all of the goods and services for which it is registered. It is the applicant’s contention that the proof falls a long way short of establishing this for the relevant goods.

The evidence as filed is consistent with operation of a beach side cafe under the name Venus, with a retail outlet alongside selling a narrow range of toys and beach items. However, it is not consistent with use of the mark relied upon as part of a genuine trade in any of the classes 21, 25 and 28 registered goods.

The evidence does not show any separate use of the mark relied on: the use shown is always together with, and subordinate to, the name Venus.

The evidence contains images of various items apparently on sale in the shop that adjoins the cafe. The cafe/shop name can be seen applied to the items by over-stickering as seen on pages 55 to 59, for example, or by the use of swing tags, as seen on pages 36 to 39, for example. This is evidence of a retail service mark: it is not evidence of a product trade mark.

The figures given for marketing and sales in the opponents' evidence are too vague to have probative value. For a start, they fail to distinguish between the different revenue streams from the cafe services and the retail services. They also refer generally to "the mark" with the implication that this means the mark relied upon, whereas in fact the evidence shows no use of this as a mark in its own right.

The evidence is also unusual in that it does not exhibit any samples of invoices for sales of any of the items allegedly sold through the retail outlet. The exhibited invoices are for purchases of such items. The evidence thus fails to properly establish that there has been a genuine trade in the relevant goods under the mark relied on.

It is not usually sufficient to establish genuine use of a mark simply by applying it to items sold at retail by over-stickering or labelling. If such is able to indicate anything it is of a retail service. That is as much as the opponents' proof can be said to show. Moreover, it is of a retail service under the name Venus, reflecting the name on the shop front. This is also the name that is featured most prominently on the stickering and labelling. Although the mark relied on is present on the stickering and labelling it is doubtful whether customers will notice it or pay it any attention."

17) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a

broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

18) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

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

19) I will turn first to deal with the contention that the opponents have shown no use of its mark CTM 7355134 on its own. All the use shows that the main trade mark is the word “VENUS” where the letter “V” appears to be shaped as a plant. I do not accept the contention that simply because the mark relied upon is never used on its own, that the evidence does not show use of the mark. It is well accepted that companies often use a “house” mark and a secondary mark e.g. Aston Martin Vanquish. In the instant case I note that both the word “Venus” and the words “loving the beach” have the symbol ® immediately after them. Most consumers will see this and recognise it for what it is; an indication that the words preceding the symbol are a registered trade mark. Although CTM 7355134 is used as a secondary mark it is nonetheless quite prominent and very difficult to overlook. I therefore regard the use demonstrated as use of the opponents registered mark. I accept that the opponents operate a number of beach side cafes which incorporate shops and this is precisely how the opponents describe themselves in the evidence. The cafes/shops are indeed identified by the “Venus” mark, and the evidence does indeed show that the opponents use the mark Venus on retail services and also cafe services. However, the suggestion that applying swing tags and stickers, showing a trade mark, to goods somehow invalidates the use of the trade mark is, in my view, extraordinary. Equally the suggestion that applying swing tags and stickers to goods simply shows use in relation to retail services is simply incorrect. If the opponents sold goods labelled with a variety

of trade marks such as Adidas, Nike and Reebok and simply applied a small price tag I would accept this contention. However, in the instant case the opponents purchase goods from a variety of suppliers and apply their own mark to those goods. As such they are trading in those goods. Whilst I agree that it would have been preferable to have individual figures for each of the goods and services upon which the mark has been used I must consider the evidence provided in its entirety. To my mind the evidence provides a cogent narrative. The opponents have shown that they have made a considerable number of purchases of various goods, and they have shown pictures of these goods offered for sale with the mark relied upon shown clearly upon these goods. The goods are sold individually and so there are no invoices in relation to sales merely till slips. However, we have the witness statement of Mr Smith, a director of Venus Co Ltd, stating clearly that this company has sold a range of goods under the mark and providing evidence of purchases of such goods and evidence of how these goods are sold to the public. There is little other corroborative evidence that could be filed and the evidence is, on the balance of probabilities perfectly acceptable, particularly in light of the fact that it has not been challenged in evidence and nor has Mr Smith been subjected to cross examination.

20) To my mind the evidence shows use upon the following goods and services: Cups; candles; corkscrews; food containers; hats; T-shirts; footwear; shorts; swimwear; buckets; spades; balls; toys and games; food and drink containers; catering services; ice creams; lollies; non alcoholic drinks; snacks; pastries; sandwiches; meals and cafe/restaurarant/catering services. When considering the registered specification this equates to use of the following

- In Class 21: Kitchen and tableware, kitchen utensils and containers; but not including rubber gloves or hot water bottles.
- In Class 25: Footwear, headwear, beachwear, swimwear, shirts, vests, T-shirts, shorts.
- In Class 28: Toys and games; balls for games, beach toys, goods for use in watersport and swimming.
- In Class 29: Prepared meals; instant meals and snack foods.
- In Class 30: Prepared meals; snack foods and instant meals; bread, pastry, cereals, sandwiches, rolls, pasties, pastries, cakes, biscuits, flapjacks, tray bakes, ice cream, tea, coffee and cocoa, condiments and confectionery.
- In Class 32: non-alcoholic beverages, fruit drinks and fruit juices, syrups and mineral water.
- In Class 43: Catering for the provision of food; preparations of foodstuffs and non-alcoholic beverages and/or meals for consumption off the premises; snack bars; cafeterias; restaurant services; beach catering services.

21) The above is the specification I shall use in the comparison of goods and services test. When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

22) Only the goods in Classes 16, 18, 21, 24 and 25 of the applicant are opposed therefore this issue needs to be considered in relation only to these goods. 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 the course of trade. 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.”

23) To my mind, the average consumer for the goods covered by the classes set out above would be the general public including businesses. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that more expensive items of the actual goods may, for example, be researched or discussed with a member of staff. The latter, along with personal recommendations, bring aural considerations into play. I note that in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

24) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

25) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer for these types of goods is likely to pay a reasonable degree of attention to the selection of items of clothing, luggage, household articles etc.**

Comparison of goods

26) In the judgment of the CJEU in *Canon*, Case 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”.

27) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

28) As the specifications applied for in respect of each of the applicant’s two marks are identical I need only carry out a single comparison. The goods of the two parties are:

Applicant’s goods	Opponents’ goods
In Class 16: Printed matter; printed publications; diaries, writing implements; reports, manuals, leaflets, brochures, stickers, posters, banners and badges; educational material; photographs, prints, paintings; address books, organisers; stationery items.	
Class 18: Bags, cases, trunks, backpacks, holdalls, satchels, purses, wallets; umbrellas, walking sticks.	
Class 21: Litter bins; containers and boxes; mugs, plates and cups; bottles and drinks containers of plastic; ornaments; kitchen and household utensils.	In Class 21: Kitchen and tableware, kitchen utensils and containers; but not including rubber gloves or hot water bottles.
Class 24: Flags; textile products; household linens.	
Class 25: Articles of clothing; footwear; headgear; scarves, ties, belts, tabards; visors and caps; socks.	In Class 25: Footwear, headwear, beachwear, swimwear, shirts, vests, T-shirts, shorts.
	In Class 28: Toys and games; balls for games, beach toys, goods for use in watersport.
	In Class 29: Prepared meals; instant meals

	and snack foods.
	In Class 30: Prepared meals; snack foods and instant meals; bread, pastry, cereals, sandwiches, rolls, pasties, pastries, cakes, biscuits, flapjacks, tray bakes, ice cream, tea, coffee and cocoa, condiments and confectionery.
	In Class 32: non-alcoholic beverages, fruit drinks and fruit juices, syrups and mineral water.
	In Class 43: Catering for the provision of food; preparations of foodstuffs and non-alcoholic beverages and/or meals for consumption off the premises; snack bars; cafeterias; restaurant services; beach catering services.

29) I shall deal with each of the class of goods applied for in turn. I begin with the class 16 goods. The opponents contend that their use of headed notepaper and the various brochures it offers are identical to the goods of the applicant in this class. This is nonsense. There is no evidence of the opponents offering any printed matter for sale. The fact that it uses paper is not relevant. **The applicant's goods in class 16 are not similar to any of the opponents' goods or services.**

30) Turning to the applicant's goods in class 18. Some of these items are complementary to items of clothing and footwear and there is considerable case law to this effect (*El Corte*). **I am willing to accept that "Purses and wallets" are similar to a medium degree to footwear as it is common for them to be purchased together and for them to be colour co-ordinated. However, the other items in this class, "Bags, cases, trunks, backpacks, holdalls, satchels, umbrellas and walking sticks" are not similar to the opponent's class 25 goods.**

31) It is clear that both specifications in Class 21 have, in part, identical wordings. The terms "Litter bins; containers and boxes; bottles and drinks containers of plastic;" are clearly encompassed with the term "kitchen containers". The terms "mugs, plates and cups;" are encompassed by the opponents "tableware". Similarly "kitchen utensils" are identical to the term "kitchen utensils". The term "household utensils" would be similar to a medium degree to "kitchen utensils". **Therefore the whole of the opponents' specification is identical or similar to a medium degree with the exception of ornaments which are not similar to any of the opponents' goods.**

32) The opponent contends that the term "flags" in the opponent's Class 24 specification was similar to the toys and games in its class 28 goods as flags are often used on beaches particularly on sand castles. **I am willing to accept that there is a medium degree of similarity between "flags" and "toys and games"**. The opponent also contends that "textile products" can include reed mats which it claims are often found in beach stores and are likely to be purchased at the same place as beach toys. I do not accept this contention. The users may be the same but the uses are different, so to the physical nature of the goods, nor are the goods in competition. **Therefore, "textile products and household linens are not similar to any of the goods and services of the opponent.**

33) Lastly, I consider the applicant's goods in class 25. There is clear identity in that both have the term "Footwear and headgear". The term "visors and caps" in the applicant's specification must be

encompassed by the opponents term “headwear”. Similarly the term “Articles of clothing” in the applicant’s specification would encompass the terms “beachwear, swimwear, shirts, vests, T-shirts, shorts” and must be regarded as identical. Whilst the terms “scarves, ties, belts, tabards; socks” do not appear in the opponent’s specification they must be regarded as similar to a medium degree to the opponent’s goods.

34) For ease of reference the following table summarises the position:

Class	Identical	Similar to a medium degree	Not Similar
16:			Printed matter; printed publications; diaries, writing implements; reports, manuals, leaflets, brochures, stickers, posters, banners and badges; educational material; photographs, prints, paintings; address books, organisers; stationery items.
18		purses, wallets;	Bags, cases, trunks, backpacks, holdalls, satchels, umbrellas, walking sticks.
21	Litter bins; containers and boxes; mugs, plates and cups; bottles and drinks containers of plastic; kitchen utensils.	household utensils.	ornaments;
24		Flags	textile products; household linens.
25	Articles of clothing; footwear; headgear; visors and caps;	Scarves, ties, belts, tabards; socks.	

Comparison of trade marks

35) It is clear from *Sabel BV v. Puma AG* (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 them, 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.”

36) It would be wrong, therefore, artificially to dissect the trade 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 them. The trade marks to be compared are:

Opponents’ trade mark	Applicant’s trade marks
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Loving the beach	3072016 LOVEMYBEACH
	3072022 LOVEmy BEACH

37) I shall first compare the opponents' mark with the applicant's mark 3072016. Visually the opponent's mark consists of three words whereas the applicant's mark shows three words fused together. However, the average consumer will immediately view the mark as though the words were separated. There is a slight difference between the first word of the opponent's mark "loving" and that of the applicant's mark "love" although they share the first three letters. The two middle words are different "the" against "my", and the last word of each is identical "beach". I do not consider the difference in lower and upper case to be significant as if either mark were used in a different case it would be regarded as use of the mark as registered and the fact that the opponents' mark is in a cursive form will pass unnoticed with most consumers. Visually the marks are similar to a medium degree. Aurally, the first syllable "LUV" is identical, the opponent's mark then has as its second syllable "ING", its third "THE", then "BEE" and "TCH". The applicant's mark differs having as its second syllable "MY" then "BEE" and "TCH". Overall, aurally the marks are similar to a medium degree. Conceptually both convey the same type of message. It could be viewed as a state of mind in that someone enjoys being on the beach, or it could be seen as a more PC form of concern for the environment. I do not consider the identification of the beach in terms of "the" and "my" to be significant. Each individual will form the same view about both marks and so conceptually they are highly similar. **Overall the marks have at least a medium degree of similarity.**

38) Moving onto consider the applicant's mark 3072022 all of the points above are valid. The fact that the mark is slightly stylised does not, in my opinion, affect the overall outcome. **Overall the marks have at least a medium degree of similarity.**

Distinctive character of the earlier trade marks

39) 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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and

industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

41) The opponents’ mark consists of three well known English words. Apart from use on buckets and spades, none of the goods are solely for use on the beach. I do not consider any of the words as being dominant. Instead the three words form a phrase or unit which describes a feeling of being happy about being on the beach or expresses a conservation view of wishing to protect the beach/environment. **To my mind, the opponents’ mark is inherently distinctive to an average degree but cannot benefit from enhanced distinctiveness as the opponent has not shown that it has a significant reputation in the UK.**

Likelihood of confusion

42) In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents’ trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon cost but they are likely to pay a reasonable degree of attention to the selection of items of clothing, luggage, household articles etc.
- the goods of the two parties are either identical, similar to a medium degree or not similar as set out at paragraph 34 above.

- trade mark number 3072016 is visually and aurally similar to the opponents' mark to a medium degree. Conceptually they are identical. Overall the marks have at least a medium degree of similarity.
- trade mark number 3072022 is visually and aurally similar to the opponents' mark to a medium degree. Conceptually they are highly similar. Overall the marks have at least a medium degree of similarity.
- the opponent's earlier trade mark has an average level of inherent distinctiveness in relation to all the goods but cannot benefit from an enhanced distinctiveness.

43) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods listed below provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to both marks in relation to the following goods:**

In Class 18: purses, wallets.

In Class 21: Litter bins; containers and boxes; mugs, plates and cups; bottles and drinks containers of plastic; kitchen utensils; household utensils.

In Class 24: Flags.

In Class 25: Articles of clothing; footwear; headgear; visors and caps; Scarves, ties, belts, tabards; socks.

44) In view of the above and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that the goods listed below provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to both marks in relation to the following goods:**

In Class 16: Printed matter; printed publications; diaries, writing implements; reports, manuals, leaflets, brochures, stickers, posters, banners and badges; educational material; photographs, prints, paintings; address books, organisers; stationery items.

In Class 18: Bags, cases, trunks, backpacks, holdalls, satchels, umbrellas, walking sticks.

In Class 21: ornaments;

In Class 24: textile products; household linens.

45) The following goods were not opposed and so both applications can continue to registration in respect of the services in addition to the goods listed at paragraph 44 above.

Class 35: Promotional and publicity campaign services; conducting surveys and market research and processing associated data and producing reports; promoting public awareness of environmental issues and initiatives; organising and running environmental and social campaigns; production and distribution of marketing and publicity materials and promotional matter; organisation of networking and marketing events; organising and operating award schemes.

Class 36: Charitable fund raising services; sponsorship of campaigns, programmes and initiatives relating to environmental issues.

Class 41: Education, training and instructional services; organising campaigns and events to raise awareness of environmental issues; publication of books, publications, printed matter and electronic material on environmental matters; organisation of conferences, seminars, training courses and workshops.

Class 42: Consultancy and advisory services; provision of information; preparation of studies and reports; all in connection with environmental issues; providing guidance and advice on litter collection and disposal, waste management, processing and disposal, noise pollution, and other matters relating to care of the environment.

CONCLUSION

46) As the opponents have been mainly successful they are entitled to a contribution towards their costs.

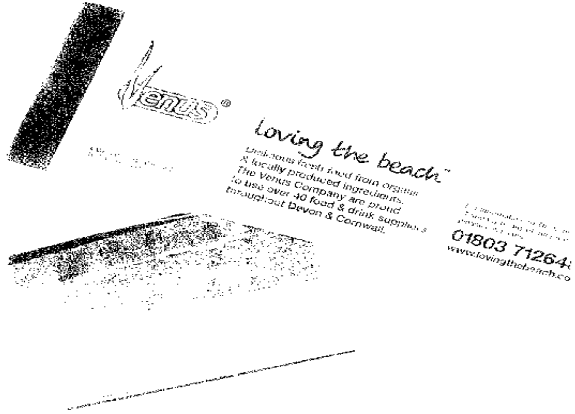
Expenses x2	£200
Preparing a statement and considering the other side's statement x2	£400
Preparing evidence	£500
Preparing submissions	£600
TOTAL	£1,700

47) I order Keep Britain Tidy to pay Louisa Ann Newman and Michael Clive Bowker Smith the sum of £1700. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of December 2015

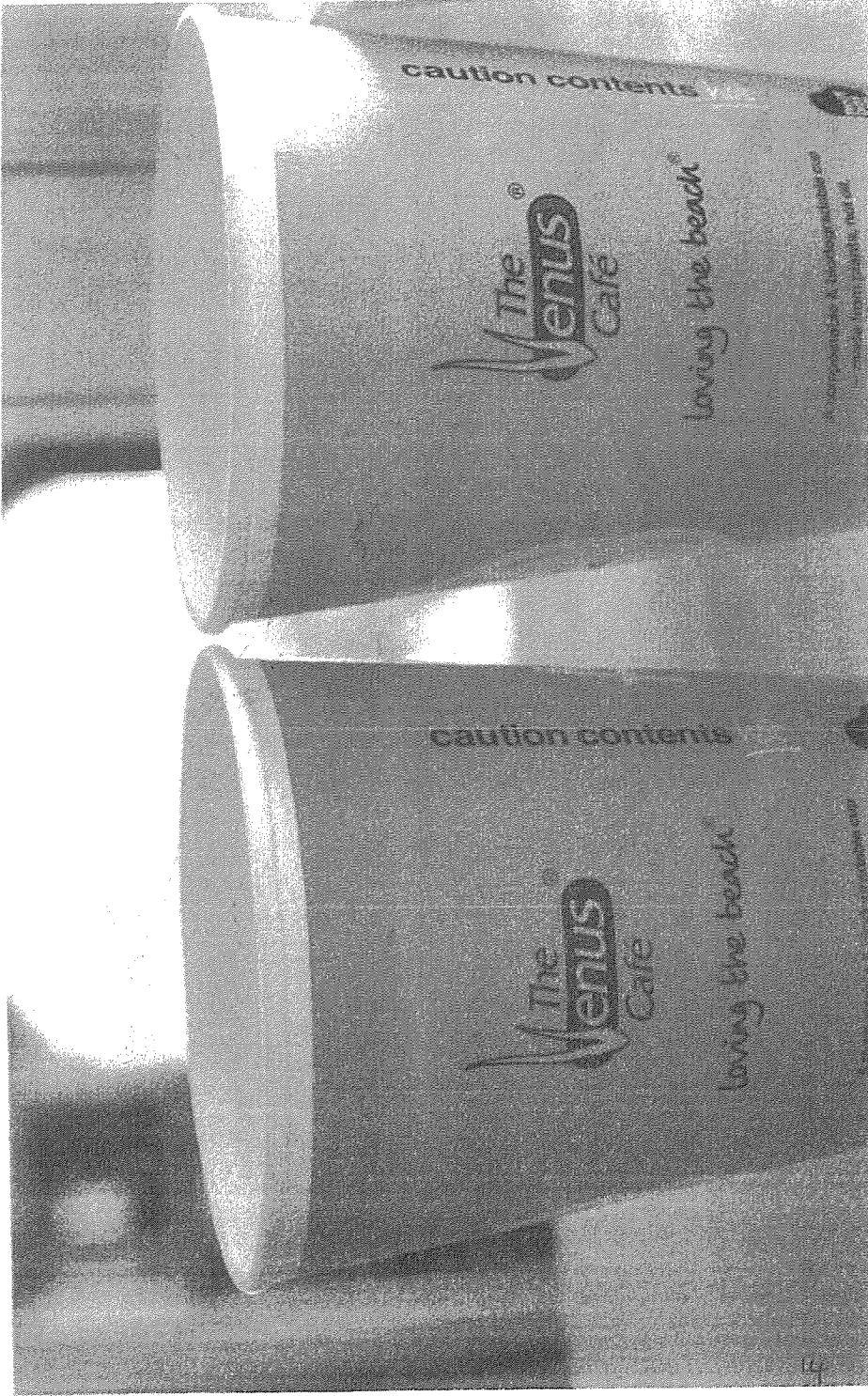
**George W Salthouse
For the Registrar,
the Comptroller-General**

Annex 1:Image 1



19

IMAGE 2:



z://C:/Users/Saniav.Raphael/AppData/Local/Microsoft/Windows/Temporary/Temporary%20Internet%20Files/Content.Outlook/1CK8YU1G/Venus%20L TB%20C... 01/06/2015

Image 3:

Venus Ice Cream

