

O/123/20

TRADE MARKS ACT 1994 (AS AMENDED)

TRADE MARK APPLICATION No. 3357125

BY B & B COLE LIMITED

AND

OPPOSITION No. 416090

BY JOLLIBEE FOOD CORPORATION

Background and pleadings

1. This is an opposition by Jollibee Foods Corporation of the Philippines (“JFC”) to an application by B & B Cole Limited (“Cole”) filed on 29th November 2018 (“the relevant date”) to register JOLLIBEE for a range of goods and services in classes 9, 16, 25, 28 and 35. A full list of the goods/services is shown at Annex A.

2. There are two grounds of opposition. Firstly, under s.5(3) of the Trade Marks Act 1994 (as amended) (“the Act”), which is as follows:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

3. This ground is based on JFC’s earlier UK trade mark 3086498, which is also the word mark JOLLIBEE. The application to register that mark was filed on 17th December 2014 and the mark was registered on 20th March 2015. The earlier trade mark is registered in classes 29 and 43 for:

“Class 29: Beef, fish, poultry; milk; fast food products containing meat, fast food products containing fish, fast food products containing poultry, fast food products containing game, fast food products containing seafood, fast food products containing eggs, fast food products containing vegetables, fast food products containing edible fats, fast food products containing edible oil, fast food products containing dairy products, fast food products containing nuts.

Class 43: Services for providing food and drink; restaurant services.”

3. JFC claims that:

- (i) the earlier mark has a reputation for the registered goods/services;
- (ii) use of the contested mark would, without due cause, take unfair advantage of the reputation of the earlier mark because consumers will believe that the users of the marks are economically connected;
- (iii) even if that does not happen, the contested mark will gain an unfair advantage as a result of the image of the earlier mark transferring to the contested mark;
- (iv) use of the contested mark may damage the reputation of the earlier mark, if it is used in relation to goods of inferior quality and/or the brand's values do not align with those associated with the earlier mark;
- (v) use of the contested mark by an unconnected entity will dilute the distinctive character of the earlier mark by making consumers uncertain about the origin of goods/services marketed under it.

4. The second ground of opposition is based on s.5(4)(a) of the Act, which is as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

5. JFC claimed that it has used JOLLIBEE throughout the UK since December 2014 and acquired goodwill under that mark in relation to:

"Beef fish, poultry; milk; fast food products containing meat, fast food products containing fish, fast food products containing poultry, fast food products containing game, fast food products containing seafood, fast food products containing eggs, fast food products containing vegetables, fast food products containing edible fats, fast food products containing edible oil, fast food products containing dairy products, fast food products containing nuts" and "Services for providing food and drink; restaurant services."

6. There was originally a third ground of opposition based on the earlier mark being a well-known mark in the UK and entitled to protection as such under s.56 of the Act. However, at the hearing discussed below Cole (rightly) accepted that this added nothing to its s.5(3) ground based on registered UK trade mark 3086498. Consequently, there is no need to say any more about this.

7. Cole filed a counterstatement denying the grounds of opposition and putting JFC to proof of its claimed reputation.

Representation

8. Cole is represented by Trade Mark Wizards Limited. JFC is represented by Baker & McKenzie LLP. A hearing took place on 7th February 2020 via a videoconference facility. Mr Jamie Muir Wood appeared as counsel for Cole. Ms Charlotte Blythe appeared as counsel for JFC.

The evidence

9. Only JFC filed evidence.

10. It consists of a witness statement by Sheryl Molera, who is Corporate Legal Counsel for JFC. Ms Molera explains that JFC is a fast-food chain with around 1400 outlets worldwide. Most are in the Far East, Middle East, USA/Canada. In March 2018 it opened its first JOLLIBEE outlet in Europe in Milan, Italy. Later that year, on 20th October 2018, it opened a further such outlet in Earls Court, London.

11. Ms Molera says that the London launch was preceded by pre-launch material and advertising. She provides a selection of the material, which includes coupons, money-off vouchers, promotional T-shirts and posters¹. However, Ms Molera does not explain where the material was used, how many such items were distributed, or say how much was spent on the launch. There are examples of posts on Facebook about the opening of JOLLIBEE in London². These show the numbers of 'comments', 'shares' and 'likes' (typically in double or triple figures, the highest is 2.6k 'comments' for a post on 18th September 2018). However, it is not clear how much of this public 'sharing' occurred prior to the relevant date (as opposed to the date in 2019 when the pages were downloaded).

12. Between the date of opening and the date of Ms Molera's statement on 22nd October 2019, the London JOLLIBEE outlet generated sales of over \$3m. However, as the matter must be judged at the relevant date, only those sales that occurred between 20th October 2018 and 29th November 2018 (i.e. a period of just 40 days) are directly relevant to the reputation of JOLLIBEE in the UK. Ms Molera has not provided a breakdown of sales over the 13-month period she describes. Therefore, it is not possible to say what proportion of those sales occurred prior to the relevant date. Self-evidently, it is likely to have been only a fraction of the sales over the much longer period.

13. Mr Molera gives evidence that the opening of the JOLLIBEE London store attracted significant media interest. Examples are provided³. Some are undated and/or it is difficult to say what their reach would have been prior to the relevant date⁴. However, it is clear that the opening of the outlet also attracted media coverage from well-known publications prior to the relevant date. For example, articles appeared on the website of The Telegraph on 17th October 2018, in the Evening Standard on 29th September 2018 and 18th October 2018, on the website of The Independent on 18th October 2018, on the website of BBC Radio 4 on 18th October 2018, and on page 44 and the website of The Sun on 18th and 19th October

¹ See exhibit SASM2

² Also in exhibit SASM2

³ See exhibits SASM5, SASM7 and SASM9

⁴ For example, the article on the 'HotDinners' website in exhibit SASM5

2018, respectively. There is also some evidence of coverage in the local press outside of London. For example, an article appeared on the website of the Birmingham Mail on 18th October 2018 referring to the imminent launch of JOLLIBEE in London and plans to expand the JOLLIBEE business to other UK locations, including Birmingham.

14. Ms Molera does not say how many customers the London outlet has attracted. However, it is clear from the media coverage which is in evidence that the opening of the London JOLLIBEE outlet attracted many customers and resulted in long queues⁵. Ms Molera points out that the UK has a Filipino population of around 150k, of which around 52k live in London, and 60% live in the wider area of the South East on the UK. This is consistent with the pictures of the queues that occurred when the JOLLIBEE outlet in London, which appear to consist primarily of people with ethnic connections to the Far East⁶.

15. In October 2019, Jollibee had 306K followers on Instagram, 564k on Twitter and 427k on YouTube. However, not only is this nearly a year after the relevant date, but these appear to be worldwide figures, not limited to the UK. At the same date, Jollibee had 18k followers on JFC's UK page of Facebook.

16. Ms Solera provides examples from TripAdvisor of customer reviews of Jollibee's UK outlet. The earliest of these is dated February 2019, i.e. after the relevant date. I note that at the date the pages were downloaded (October 2019) there had been 976 reviews and (presumably based on these reviews) Jollibee was ranked 1558 out of 1671 'Quick Bites' in London.

17. Ms Solera also provides pictures of "*JOLLIBEE branded products, such as T-shirts, which are available in the United Kingdom.*"⁷ The picture of a T-shirt provided appears to be a mock-up of a promotional T-shirt for use in connection with the opening of the first JOLLIBEE outlet in the UK. It carries a picture of the Houses of Parliament, the JFC mascot (a smiling bee) and, on the reverse, the words "*Proud to*

⁵ Queues of 18 hours were experienced at the time of opening, according to an article on inews.co.uk

⁶ See, for example, the picture in SASM6

⁷ See SASM3

be part of history! First Jollibee in United Kingdom.” The same exhibit includes pictures of the JFC smiling bee mascot in the form of a toy and also a backpack. There is no evidence that any of these goods were offered for sale in the UK (or anywhere else). They appear to be promotional items.

18. There is evidence of some online media coverage during 2017/18 of the opening of the first JOLLIBEE outlet in Europe, in Milan, Italy⁸. However, it is not clear how much of this coverage (if any) was on UK websites, or was seen by potential UK consumers.

19. Ms Solera says that during 2019 (i.e. after the relevant date) JFC made its JOLLIBEE fast food available on UberEats and Deliveroo. At the date of Ms Solera’s statement \$90k worth of sales had been achieved via these routes. The purpose of this evidence appears to be to show that JFC’s UK business grew quickly following its successful launch in 2018. However, the sales claimed appear to me to rather modest in the context of the UK market for fast food. And it was confirmed at the hearing that JFC still only has one UK outlet, in London.

The section 5(3) ground of opposition

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

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

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

⁸ See exhibit SASM10

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark, or of the characteristics which it projects, to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Qualifying reputation?

21. In *General Motors*⁹ the CJEU held that:

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade

⁹ Case C-375/97

mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

22. There is no evidence about the size of the UK market for food products of the kinds covered by the earlier mark or restaurant services. However, even if the enquiry is limited to fast food and fast food outlets, the market is clearly huge and would be measured in £billions. The opponent's share of the UK market at the relevant date was therefore microscopic. The use was focussed on one fast food restaurant in central London which had been open for 40 days. There is no evidence as to the amount spent promoting the outlet and the goods sold at it. This analysis of the relevant factors identified by the CJEU provides a bleak outlook for the opponent's prospects of succeeding under s.5(3).

23. JFC points to three other factors which it considers to assist its claim. Firstly, the level of UK media interest in the opening of its first UK fast food outlet. Secondly, spill over reputation from its worldwide business. Thirdly, the familiarity of the UK-based Filipino community with the JOLLIBEE brand.

24. I accept that there was significant UK media interest in the launch of the first JOLLIBEE outlet in the UK. However, it was far from saturation coverage and was mostly in articles on online websites. In the absence of any real evidence of substantial investment in promoting the UK launch of JOLLIBEE, I do not consider that this comes close to establishing that a significant part of the UK public for food or fast food was familiar with the JOLLIBEE mark at the relevant date.

25. Reputation is a knowledge threshold¹⁰. I therefore accept that, in principle, spill over reputation in the UK resulting from use elsewhere may help to establish a reputation for the purposes of s.5(3). However, there is very limited evidence of media coverage in the UK of JFC's use of JOLLIBEE elsewhere in the world, including the opening of its Milan outlet earlier in 2018. I therefore find that the limited coverage of the opening of the JOLLIBEE outlet in Milan does not materially assist JFC's case.

¹⁰ It was described as such by Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited*, [2018] EWHC (IPEC) at paragraph 69 of the judgment.

26. As regards the familiarity of the UK-based Filipino community with the JOLLIBEE mark as a result of its reputation in the Philippines and elsewhere, Ms Blythe submitted that this was an important factor. In this connection, she drew my attention to a recent decision of Mr Daniel Alexander QC as the Appointed Person in ZOHARA¹¹. That case was primarily about the relevance of a likelihood of confusion amongst a substantial subgroup of the relevant class of consumers. The most relevant part of the decision is shown below.

“22. Second, it is equally clear that the test of likelihood of confusion does not require evaluation of whether a statistical majority of actual consumers would in fact be confused. Equally, it does not require a quantitative assessment of particular proportions of a notional or real population which would in fact be confused.

23. Third, it is implicit in the test that, given the diversity of consumers, in appropriate cases, a tribunal should take account of classes of consumer where they form substantial subgroups of consumers as a whole. There are numerous illustrations of this in the case law (see for example Alcon v. OHIM C-41/05 – where patients using the products as well as medical professionals ordering or supplying them were taken into account; Schütz v. Delta [2011] EWHC 1712 – where end users as well as tank fillers were considered). That is appropriate where it is possible to identify particular kinds of consumers with readily identifiable common characteristics which make confusion more (or sometimes less) likely for that group. In cases of that kind, the law is really saying that because a significant class of consumers of a particular kind to which the mark is specifically directed and whose interests are therefore particularly relevant are likely to be confused, taken as a whole there is a likelihood of confusion on the part of the notional average consumer even if consumers in other classes may not be. This issue is helpfully discussed, with reference to some of the difficulties in doing so practice in as a result of inhomogenous populations and diverse responses, in: Fhima and Gangee

¹¹ BL O/040/20. An appeal against the registrar’s rejection of an opposition.

The Confusion Test in European Trade Mark Law, Oxford, 2019, Chapter 6, referred to in argument at the hearing.”

27. This case was not identified in Ms Blythe’s skeleton argument and so I allowed Cole to make written submissions about it following the hearing. In those submissions, Cole argued, in essence, that JFC was attempting to artificially focus the enquiry on the UK-based Filipino community when the relevant public for fast food was virtually the whole UK public. According to Cole, even if all the UK-based Filipino community was aware of JFC’s JOLLIBEE mark at the relevant date, this could not amount to more than 0.3% of the relevant public. Consequently, it could not amount to a reputation amongst ‘a significant part’ of the relevant UK public.

28. In *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*¹², Ms Anna Carboni, as the Appointed Person, held that where goods are targeted at the general public the mere fact that they might be of greater interest to a particular sub-set of the relevant public did not justify narrowing the assessment of distinctiveness to just that sub-set of the relevant public. See, to similar effect, the judgment of the General Court in *Aranynektar v OHIM*¹³. The same must apply to the assessment of the reputation of a trade mark.

29. It is true that in *Loutfi v AMJ Meatproducts NV and Another*¹⁴ the CJEU held that:

“Article 9(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a Community trade mark and a sign which cover identical or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the Community trade mark and for the sign at issue has a basic knowledge of written Arabic, the meaning and pronunciation of those words must be taken into account.”

¹² BL O-195-15

¹³ Case T-503/15

¹⁴ Case C-147/14

30. However, the goods in that case were halal foodstuffs, which the referring court had held were mainly targeted at members of the Muslim religion. Where it is shown that the goods or services at issue are mainly targeted at a particular section of the public in the UK because of the type of goods or services at issue, it is appropriate to take particular account of the perception of the trade marks by the section of the public who are likely to be the principal consumers of those goods/services. By contrast, the goods and services for which JFC claims that JOLLIBEE has a reputation in the UK are not special foods targeted at a particular ethnic or religious group, but ordinary fast foods aimed at the whole of the UK public. Therefore, although I must take account of the reputation of the mark amongst the UK-based Filipino community, it is not appropriate to give that disproportionate weight in my assessment of JOLLIBEE's UK reputation. Rather, JFC must show that the mark was known to a significant part of the entire relevant class of UK consumers, which in this case is the general public. Looked at like this, I find that Mr Muir Wood is correct to submit that the reputation of the mark amongst the UK based Filipino community is insufficient to constitute a significant part of the relevant UK public. This is the case even if the reputation in question extends to the whole of the UK-based Filipino community¹⁵.

31. Standing back and looking at JFC's evidence as a whole, I find that it is insufficient to establish that JOLLIBEE had a qualifying reputation in the UK at the relevant date. This conclusion appears to be consistent with other recently decided cases. For example, in *Spirit Energy Limited v Spirit Solar Limited*¹⁶, Mr Phillip Johnson, as the Appointed Person, held that the registrar had been wrong to accept that the opponent in that case had established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the

¹⁵ In fact there is no evidence that the mark is universally known to the Filipino community in the UK.

¹⁶ BL O/034/20

amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3). In my view, JFC has presented a weaker case than the opponent in *Spirit Energy Limited v Spirit Solar Limited*. Ms Blythe said everything that could be said in support of JFC's case (as well as one or two things that could not be said on the evidence), but I have no hesitation in rejecting the opposition under s.5(3) because JFC has failed to establish the necessary reputation.

Link

32. In case I am wrong to find that JFC has not established the necessary reputation, I will briefly consider whether, if there is a qualifying reputation, the relevant public would make a link between the marks (and thus create the possibility of unfair advantage or damage to the earlier mark).

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

The degree of similarity between the conflicting marks

34. The marks are identical.

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

35. JFC accepts that there is no "direct similarity" between the parties' goods/services. However, it submits that they are not entirely distinct. The alleged proximity between the goods/services is said to arise from three things. Firstly, it is submitted that it is well-known that "huge brands from a variety of sectors sell

clothing as merchandise.” At the hearing, The Hard Rock Café and Rainforest Café were cited as examples¹⁷. Secondly, it is submitted that fast foods are well known to appeal to children and there is therefore a relevant connection between fast foods and goods that appeal to children, such as DVDs in class 9, colouring books in class 16, toys in class 28 and services for retailing such goods in class 35. The McDonald’s Happy Meal was cited as an example of a children’s meal that includes a toy. Thirdly, it is submitted that it is common for fast-food chains to expand by way of franchising and this creates a connection with the marketing and business management services covered by class 35 of the contested application.

36. There is no evidence that “*huge brands*” sell clothing as merchandise. I have no doubt that some of them do, but that is irrelevant because the evidence comes nowhere near establishing that JOLLIBEE is a “*huge brand*” in the perception of UK consumers. There is no evidence that restaurants and/or traders in fast foods typically sell clothing. It is certainly not a notorious fact. I therefore reject JFC’s submission that there is a relevant commercial proximity between fast food and clothing (or headgear and footwear). In my view, this is a considerable distance between these goods/services.

37. Apart from McDonald’s Happy Meals, I am not aware of any other examples of toys being sold with food. However, I accept that fast foods appeal to children and younger adults, probably more so than to the public at large. This means that there is a high degree of overlap between the users of some of the goods/services, but the goods/services themselves are otherwise wholly dissimilar.

38. The suggested connection between fast food goods/services and marketing/business management services is even more tenuous. It depends upon certain kinds of marketing/business management services being offered to would-be franchisees (not users) of a fast-food business. In any event, at the relevant date the UK public would not have perceived JOLLIBEE as being connected with an expanding range of fast-food outlets in the perception of the UK public. It was known

¹⁷ Ms Blythe’s skeleton argument suggested that JFC itself sells own-branded T-shirts and backpacks. After discussion, I think Ms Blythe was constrained to accept that there is no evidence of any such sales in Molera’s evidence. In any event, I find that there is no evidence of any such sales.

by some to have one outlet in London. That remains the position. There is no similarity or connection between the services in class 35 and fast food.

The strength of the earlier mark's reputation

39. If the earlier mark had a qualifying reputation in the UK at the relevant date, it was a weak one.

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

40. The earlier mark will be seen by average consumers as either an invented word or as a mis-spelling of Jolly Bee. In either event the mark is not descriptive. It therefore has at least an average degree of inherent distinctive character: above-average to those who see it as an invented word. The evidence does not show that the distinctiveness of the mark has been materially enhanced by the relevant date (to UK consumers) through use.

Whether there is a likelihood of confusion

41. Despite the identity of the marks, there is, in my view, no likelihood of confusion, direct or indirect. In the absence of the earlier mark having acquired any substantial reputation in the UK at the relevant date, the average consumer is unlikely to think that the dissimilar goods/services offered under the contested mark are those of JFC, or a related undertaking.

Link

42. Considering the matter in the round, I find that average UK consumers will not make a link between the earlier mark and the contested mark. Further, even if I am wrong about this, any link would be so weak and fleeting that it would not result in a serious risk of any of the commercial consequences covered by s.5(3).

43. The s.5(3) ground of opposition fails accordingly.

The passing off right ground of opposition

44. There is no dispute about the applicable law. This was conveniently summarised by Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, in *Discount Outlet v Feel Good UK*¹⁸, as follows:

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

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

Goodwill

45. Cole disputes that JFC had acquired goodwill in the UK at the relevant date. However, in my view, the evidence is sufficient to support a claim that JFC had acquired goodwill in the UK under JOLLIBEE as a result of the opening of its London outlet on 20th October 2018 and subsequent trade prior to the relevant date. I accept that the period of trading is quite short, but the law of passing off protects businesses operating on a relatively small scale and/or over a relatively short period of time, provided the extent of the trade is more than trivial¹⁹. I have no doubt that the law of passing off could have been used to prevent another trader opening a food outlet called JOLLIBEE, at least in London, at the relevant date.

¹⁸ [2017] EWHC 1400 IPEC

¹⁹ See, for example, *Stannard v Reay* [1967] FSR 140

Misrepresentation

46. In my judgement, this is where JFC's case falls down. This is because the modest extent of the goodwill acquired under JOLLIBEE prior to the relevant date, combined with the fact that the respective goods/services are in different sectors of the market, means that there was no likelihood that a substantial number of JFC's (UK) customers, or potential customers, would be deceived into believing that Cole's goods/services are connected with JFC's fast-food restaurant. The fact that JFC may have given away some T-shirts, toys and bags as promotional items at the time of opening its London outlet changes nothing. JFC is plainly not in the business of clothing, bags or toys.

47. It is true that the law of passing off is not restricted to situations where the parties operate in the same field of commercial activity. However, the fact that they are in different fields of activity is plainly relevant to the likelihood of deception. As Millett L.J. stated in *Harrods Limited v Harrodian School Limited*²⁰:

“Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one.”

48. At the hearing, Ms Blythe invited me to infer that Cole intended to take unfair advantage of JFC's goodwill. This was based on two points. Firstly, that JOLLIBEE is an invented word and Cole has not explained why it chose that mark. Secondly, Cole has not filed any evidence and, therefore, has not answered JFC's case that it intended to take unfair advantage.

49. Taking the second point first, I accept that evidence of an intention to pass off (or take unfair advantage) is relevant. As Lord Simonds stated in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*²¹:

²⁰ [1996] RPC 697 (CA)

²¹ [1946] RPC 39 (HOL)

“Confusion innocently caused will yet be restrained. But, if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade.”

50. However, after carefully examining JFC’s pleaded case and Ms Molera’s witness statement, I find that neither includes any specific allegation that Cole adopted JOLLIBEE with the intention of taking unfair advantage of the goodwill or reputation of JFC’s mark, or with the intention of passing off²². Intention is not an essential element of such grounds, so it is not implicit from the mere act of bringing these grounds of opposition. Cole cannot therefore be criticised for failing to answer an allegation that was not clearly made.

51. As regards the first point, I accept that some consumers will see JOLLIBEE as an invented word (as opposed to a mis-spelling and conjoining of JOLLY and BEE). However, the onus is on JFC to make out a *prima facie* of passing off. In my view, JFC has not done so. In these circumstances, Cole’s failure to explain why it adopted the same mark is not material.

52. As I have rejected JFC’s case that Cole’s use of JOLLIBEE will amount to a misrepresentation to the public, the question of damage does not arise.

53. For the reasons given above, I reject the ground of opposition under s.5(4)(a) of the Act.

Overall outcome

54. The opposition has failed. The contested trade mark will be registered.

Costs

55. As the opposition has failed, the applicant is entitled to a contribution towards its costs. I assess these as follows.

²² Ms Molera does not even mention Cole or its business.

£450 for considering the notice of opposition and filing a counterstatement;
£400 for considering JFC's evidence;
£750 for attending a hearing and filing a skeleton argument;
£200 for filing written submissions after the hearing.

56. I therefore order Jollibee Foods Corporation to pay B & B Cole Limited the sum of £1800 as a contribution towards the cost of the proceedings. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated 27th February 2020

**Allan James
For the Registrar**

ANNEX A – THE GOODS AND SERVICES APPLIED FOR

Class 9: Baby monitors; inflatable arm-bands being flotation devices; camera cases and bags; monitoring instruments; educational programmes in the form of software; children's educational software; computer software; eyeglasses; children's eyeglasses; science sets for children being teaching apparatus; baby alarms; electronic baby monitoring devices; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; compact discs, DVDs and other digital recording media; mobile software applications; downloadable software.

Class 16: Printed matter; calendars; drawing materials; drawing instruments; modelling materials; decalcomanias; personal organizers; photographs; mail order catalogues; diaries; gift cards; gift vouchers; photo albums; writing implements; writing instruments; writing materials; writing or drawing books; books for babies, infants and children; children's activity books; children's books incorporating an audio component; babies' journals; correcting and erasing implements; educational equipment; arts, crafts and modelling equipment; stationery; adhesives for stationery or household purposes; gift boxes; gift bags; instructional and teaching material (except apparatus); colouring books; catalogues; cards; cards for use in connection with sales and promotional incentive schemes and promotional services; small blackboards; whiteboards; writing brushes; writing chalk; modelling clay; modelling clay for children; children's paint-boxes; crayons; colouring crayons; drawing sets; drawing brushes; drawing stencils; oil pastels; papier mâché; fluorescent paper; kraft paper; glitter for stationery purposes; felt pens; felt tip markers; felt tip pens; fingerprint kits; drawing ink; sticker books; sticker activity books; writing stationery; wet erase markers; stationery cases.

Class 25: Clothing, footwear, headgear; children's clothing; children's outerclothing; clothing for babies; romper suits; sleepsuits; casual clothing; woollen clothing; waterproof clothing; bathing caps; costumes for use in children's dress up play; swimwear for children; overalls for infants and toddlers; pyjamas; swimwear; hooded tops; plush clothing; pullovers; undergarments; underwear; clothing made of fur; denim clothing; denim jeans; shorts and briefs; sports shirts with short sleeves; t-shirts; printed t-shirts; polo shirts; camisoles; jackets; denim jackets; fur jackets; fur coats; trousers; tights; legwarmers; handwarmers; gloves and mittens; scarves; hosiery; children's headwear; fashion hats; headbands; hats; bandannas; beanies; caps; woolly hats; ear muffs; fur muffs; nightcaps; knitted caps; leisure footwear; slip-on shoes; children's footwear; boots; ankle boots; football boots; boots for sports; footwear for track and field athletics; footwear for use in sport; dance slippers; heeled shoes; infants' boots; lace boots; shoes for infants; booties; sneakers; sports shoes; athletic shoes.

Class 28: Toys, games and playthings; toys for babies and infants; board games; soft-toys; plush toys; baby playthings; electronic learning toys; hand-held electronic

games; floats for bathing and swimming; children's playthings; play structures for children; children's playground apparatus; infants swing sets; tricycles for children for use as playthings; indoor play apparatus for children; children's punch balls; climbing slides being play apparatus for children; action figure toys; accessories for dolls; arcade games; arcade game machines; baby playthings; bath toys; balloons; building games; cots for dolls; cuddly toys; developmental toys; dolls' houses; doll accessories; electronic toys; inflatable toys; toy pushchairs; jokes (play things); jigsaw puzzles; masks [playthings]; memory games; model cars; outdoor toys; party games; play mats containing infant toys; play structures for children; play money; playground balls; puppets; quiz games; sandboxes [playthings]; scooters [toys]; swing sets; talking toys; target games; swimming floats; toy construction sets; toys adapted for educational purposes; toys being for sale in kit form; trampolines; video game apparatus; video game machines; water guns; water toys; wheeled toys; sporting equipment.

Class 35: Advertising and marketing services; product demonstrations and product display services; trade show and exhibition services; loyalty, incentive and bonus program services; publication of publicity materials; provision of advertising space, time and media; business management; office functions; distribution of advertising, marketing and promotional material; wholesale, retail, online retail services in relation to the sale of baby monitors, inflatable arm-bands being flotation devices, camera cases and bags, monitoring instruments, educational programmes in the form of software, children's educational software, computer software, children's eyeglasses, science sets for children being teaching apparatus, baby alarms, electronic baby monitoring devices, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, compact discs, DVDs and other digital recording media, mobile applications, downloadable software, printed matter, calendars, drawing materials, drawing instruments, modelling materials, decalcomanias, personal organizers, photographs, mail order catalogues, diaries, gift cards, gift vouchers, photo albums, writing implements, writing instruments, writing materials, writing or drawing books, books for babies, infants and children, children's activity books, children's books incorporating an audio component, babies' journals, correcting and erasing implements, educational equipment, arts, crafts and modelling equipment, stationery, adhesives for stationery or household purposes, gift boxes, gift bags, instructional and teaching material (except apparatus), colouring books, catalogues, cards, cards for use in connection with sales and promotional incentive schemes and promotional services, small blackboards, whiteboards, writing brushes, writing chalk, modelling clay, modelling clay for children, children's paint-boxes, crayons, colouring crayons, drawing sets, drawing brushes, drawing stencils, oil pastels, papier mâché, fluorescent paper, kraft paper, glitter for stationery purposes, felt pens, felt tip markers, felt tip pens, fingerprint kits, drawing ink, sticker books, sticker activity books, writing stationery,

wet erase markers, stationery cases, clothing, footwear, headgear, children's clothing, children's outerclothing, clothing for babies, romper suits, sleepsuits, casual clothing, woollen clothing, waterproof clothing, bathing caps, costumes for use in children's dress up play, swimwear for children, overalls for infants and toddlers, pyjamas, swimwear, hooded tops, plush clothing, pullovers, undergarments, underwear, clothing made of fur, denim clothing, denim jeans, shorts and briefs, sports shirts with short sleeves, t-shirts, printed t-shirts, polo shirts, camisoles, jackets, denim jackets, fur jackets, fur coats, trousers, tights, legwarmers, handwarmers, gloves and mittens, scarves, hosiery, children's headwear, fashion hats, headbands, hats, bandannas, beanies, caps, woolly hats, ear muffs, fur muffs, nightcaps, knitted caps, leisure footwear, slip-on shoes, children's footwear, boots, ankle boots, football boots, boots for sports, footwear for track and field athletics, footwear for use in sport, dance slippers, heeled shoes, infants' boots, lace boots, shoes for infants, bootees, sneakers, sports shoes, athletic shoes, games and playthings, toys for babies and infants, board games, soft-toys, plush toys, baby playthings, electronic learning toys, hand-held electronic games, floats for bathing and swimming, children's playthings, play structures for children, children's playground apparatus, infants swing sets, tricycles for children for use as playthings, indoor play apparatus for children, children's punch balls, climbing slides being play apparatus for children, action figure toys, accessories for dolls, arcade games, arcade game machines, baby playthings, bath toys, balloons, building games, cots for dolls, cuddly toys, developmental toys, dolls' houses, doll accessories, electronic toys, inflatable toys, toy pushchairs, jokes (play things), jigsaw puzzles, masks [playthings], memory games, model cars, outdoor toys, party games, play mats containing infant toys, play structures for children, play money, playground balls, puppets, quiz games, sandboxes [playthings], scooters [toys], swing sets, talking toys, target games, swimming floats, toy construction sets, toys adapted for educational purposes, toys being for sale in kit form, trampolines, video game apparatus, video game machines, water guns, water toys, wheeled toys, sporting equipment.