

O-249-13

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION  
Nos. 2601512 & 2573520  
BY MISS ELLIES ( a partnership)  
TO REGISTER THE TRADE MARKS**

**Coffee & Subs**

&



**IN CLASSES 29 & 30**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER Nos. 103564 & 103635 BY  
DOCTOR'S ASSOCIATES INC.**

## BACKGROUND

1) On 16 November 2011 and 25 February 2011 Miss Ellies (a partnership) (hereinafter the applicant), applied to register the following trade marks:

Number	Mark	Filing Date	Class	Goods
2601512	 <p>The Color of "Coffee" Black Pantone 426c The Color of "Subs" Orange Pantone P158c</p>	16.11.11	29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; soups and potato crisps.
			30	Tea, cocoa, sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; pizzas, pies and pasta dishes.
2573520		25.02.11	29	Meat, fish, poultry and game; meat extracts; preserves, dried and cooked fruits and vegetables; jellies, jams, compotes; dairy products; eggs, milk and milk products; edible oils and fats, sauces; fruit sauces; edible oils and fats; frozen cooked meals; deep frozen foods; frozen prepared meals; frozen ready meals; prepared meals and snacks; sandwiches; bagels; baguettes; paninis.
			30	Coffee, mixtures of coffee and chicory, coffee essences, coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; tea; sandwiches for food; seasonings (not being essential oils), mustard, sauces, sugar; bread, pizzas, pastries and doughnuts; rice; tapioca; sago; cereal preparations and flour; bread; biscuits; cakes and pastry; ice cream; water ices; confections; non-medicated confectionery; pies and puddings; pasta; pizzas; quiche; flans; snack products; dessert products; sauces and spices; prepared meals; sandwiches; bagels; baguettes; paninis.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 6 April 2012 in Trade Marks Journal No.6934 and on 4 May 2012 in Trade Marks Journal No.6938 respectively.

3) On 9 July 2012 and 30 July 2012 respectively Doctor's Associates Inc. (hereinafter the opponent) filed notices of opposition, subsequently consolidated. The grounds of opposition are in summary:

- a) The marks consist of the words "COFFEE" and "SUBS"; and the slogan "MORE THAN JUST SUBS" which are the names of food and drink products/ an indication that goods in addition to subs are being offered. They are presented in a common font and with part of the mark in colour. It will be shown that SUBS is a generic term indicating sandwiches of a particular form. The mark in suit therefore offends against section 3(1)(b) of the Act.

- b) The applications were filed under the names “Miss Ellies Coffee and Subs” and “Miss Ellies”. At the relevant date no such legal entities existed in the UK. Therefore as the party which made the declaration in accordance with Section 32(3) did not exist the application was filed without the possibility of a bona fide intention to use the mark in suit. Therefore, the application offends against Section 3(6) of the Act.
- c) The mark in suit is likely to deceive the public as to the nature of the goods, in that the goods claimed in the application include those other than coffee and subs/ subs. The mark in suit therefore offends against section 3(3)(b).
- 4) On 13 September 2012 and 10 October 2012 the applicant filed counterstatements. These confirm that at the date of the applications the partnership which initially traded under the name “Miss Ellie’s Coffee and subs” (later “Miss Ellies”) has been trading since 2009, when it purchased a business including trade mark and goodwill which had existed for forty years. It is pointed out that the forms of the marks in suit were adopted in 2010 following the opponent’s threat to take legal action in respect of the stylisation which the applicant had been using. The applicant states that it accepts that the marks may not be distinctive for restaurant services in Class 43 but are distinctive for foods which are the subject of the applications. They deny there is any possibility of deceiving the public.
- 5) Only the opponent filed evidence. Both seek an award of costs in their favour. Neither side wished to be heard, but they did provide written submissions which I shall refer to in my decision as required.

## **OPPONENT’S EVIDENCE**

6) The opponent filed a witness statement, dated 20 December 2012, by David Brian Lutkin the opponent’s Trade Mark Attorney. He states that he has seen the correspondence between the parties and also read the IPO case files, and that he is authorised to make his statement. He states that the opponent is the franchisor of the “SUBWAY” restaurants, which is often imitated by non-franchisees. In December 2010 a business trading in Esher under the name “Miss Ellies Subs” was believed by the opponent to be trading off the goodwill associated with SUBWAY. Correspondence with the representative of this Esher business (Silverman Sherliker LLP) ensued and the matter was concluded in April 2011, with the Esher business agreeing to use only certain colours in their stores and on packaging, literature etc. They also provided two marks which they would use both of which were the words “Miss Ellie’s coffee and subs” with variations to the colour used on the word “subs”. These marks have been registered by the UK IPO under numbers 2579094 and 2550585 and the opponent did not raise an objection to either mark. The proposed agreement is contained at exhibit 1 of his statement. Mr Lutkin states that although it is marked “without prejudice” he believes that the applicant’s representative has waived this right as they have referred to this document in correspondence as a binding agreement, despite the opponent

never having signed it. Mr Lutkin states that it is not at all certain that the party represented by Silverman Sherliker LLP in 2010 is the same as the party in the instant case. He states that in 2010 the ownership of the marks used by the Esher business was not an issue, but it is an issue in the instant case. He points out that the applicant has been referred to in a number of ways, "Miss Ellies Subs"; "Miss Ellies Partnership"; "Miss Ellies" and "Miss Ellies coffee & subs". He also points out that on the application form the question "if you are applying in the name of a company where is it incorporated" was answered as "GB". He states that on 8 June 2012 the applicant's representatives applied on forms TM21 to record the change of name of each of "Miss Ellies Partnership"; "Miss Ellies Coffee & Subs" and "Miss Ellies" to "Miss Ellies (a partnership)". He states that form TM21 cannot be used to change the ownership of a registration or application.

7) Mr Lutkin provides quotes from the IPO examiners' reports in respect of both applications. However, he takes issue with their overall appraisal which resulted in the specifications listed above being advertised, following only minor amendments to the specifications applied for by the applicant. In the case of 2573520 he states that the examiner identified a "sub" as a form of sandwich, but did not remove references to sandwiches, and similar, from the specification. He also states his view that the mark is a slogan which were it "more than just snacks/ drink" would not have been accepted. Regarding the other mark he comments that it is not distinctive for any food or drink product. He also comments that when used on food packaging both marks are deceptive as the consumer will purchase something which says coffee and subs but actually receive eggs or tea or crisps.

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

## **DECISION**

9) I first deal with the ground of opposition under Section 3(6) which reads:

"3.(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

10) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

"Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that....

(c) the application for registration of the trade mark was made in bad faith by the applicant."

11) I refer to case O/094/11 *Ian Adam* where Mr Hobbs QC acting as the Appointed Person said:

“32. Any attempt to establish bad faith must allow for the fact that there is nothing intrinsically wrong in a person exercising *‘the right to apply the rules of substantive and procedural law in the way that is most to his advantage without laying himself open to an accusation of abuse of rights’* as noted in paragraph [121] of the Opinion delivered by Advocate General Trstenjak in Case C-482/09 Budejovicky Budvar NP v. Anheuser-Busch Inc on 3 February 2011. In paragraph [189] of his judgment at first instance in Hotel Cipriani SRL v. Cipriani (Grosvenor Street) Ltd [2009] EWHC 3032 (Ch); [2009] RPC 9 Arnold J. likewise emphasised:

“... that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Art. 107 can hardly be said to be abusing the Community trade mark system.”

These observations were not called into question in the judgment of the Court of Appeal in that case: [2010] EWCA Civ 110; [2010] RPC 16. They were re-affirmed by Arnold J. in Och-Ziff Management Europe Ltd v. Och Capital LLP [2011] ETMR 1 at paragraph [37].

33. The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose. The appropriate remedy will in that case be rejection of the offending application for registration to the extent necessary to render it ineffective for the purpose which made it objectionable in the first place.

34. In a case where the relevant application fulfils the requirements for obtaining a filing date, the key questions are: (1) what, in concrete terms, is the objective that the applicant has been accused of pursuing? (2) is that an objective for the purposes of which the application could not properly be filed? (3) is it established that the application was filed in pursuit of that objective? The first question serves to ensure procedural fairness and clarity of analysis. The second question requires the decision taker to apply a moral standard which, in the absence of any direct

ruling on the point from the Court of Justice, is taken to condemn not only dishonesty but also ‘*some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined*’: Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd [1999] RPC 367 at 379 (Lindsay J). The third question requires the decision taker to give effect to the principle that innocence must be presumed in the absence of evidence sufficient to show that the applicant has acted improperly as alleged.

35. In assessing the evidence, the decision taker is entitled to draw inferences from proven facts provided that he or she does so rationally and without allowing the assessment to degenerate into an exercise in speculation. The Court of Justice has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case: Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH [2009] ECR I-4893 at paragraph [37]; Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht [2010] ECR I-00000 at paragraph [42]. As part of that assessment it is necessary as part of that approach to consider the intention of the applicant at the time when the application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case: Chocoladefabriken Lindt & Sprüngli GmbH (above) at paragraphs [41], [42]; Internetportal and Marketing GmbH (above) at paragraph [45]. This accords with the well-established principle that ‘national courts may, case by case, take account -on the basis of objective evidence -of abuse or fraudulent conduct on the part of the persons concerned in order, where appropriate, to deny them the benefit of the provisions of Community law on which they seek to rely’: Case C16/05 The Queen (on the applications of Veli Tum and Mehmet Dari) v. Secretary of State for the Home Department [2007] ECR I-7415 at paragraph [64].

36. The concept of assessing subjective intention objectively has recently been examined by the Court of Appeal in the context of civil proceedings where the defendant was alleged to have acted dishonestly: Starglade Properties Ltd v. Roland Nash [2010] EWCA Civ 1314 (19 November 2010). The Court considered the law as stated in Royal Brunei Airlines v. Tan [1995] 2 AC 378 (PC), Twinsectra Ltd v Yardley [2002] 2 AC 164 (HL), Barlow Clowes International Ltd v. Eurotrust International Ltd [2006] 1 WLR 1476 (PC) and Abu Rahman v. Abacha [2007] 1 LL Rep 115 (CA). These cases were taken to have decided that there is a single standard of honesty, objectively determined by the court and applied to the specific conduct of a specific individual possessing the knowledge and qualities that he or she actually possessed: see paragraphs [25], [28], [29] and [32]. This appears to me to accord with treating intention as a subjective factor to be determined by reference to the objective circumstances of the particular case, as envisaged by the judgments of the Court of Justice relating to the assessment of objections to registration on the ground of bad faith.”

12) In the case of *Red Bull GmbH v Sun Mark Limited, Sea Air & Land Forwarding Limited* [2012] EWCH 1929 (Ch) Arnold J. Set out the general principles of what constitutes “Bad Faith” as follows:

“130 A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52 (1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131 First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case-529/07 Chocoladenfabriken Lindt & Sprungli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc. V Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133 Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207–2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134 Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004 ) at [8].

135 Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly’s Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant

knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136 Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137 Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138 Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth* :

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

13) It is well established (*Chocoladenfabriken Lindt & Sprungli AG v Franz Hauswirth GmbH; Nonogram Trade Mark* [2001] RPC 21 and *Hotpicks Trade Mark* [2004] RPC 42)

that the relevant date for consideration of a bad faith claim is the application filing date or at least a date no later than that. In the instant case the relevant dates are 16 November 2011 and 25 February 2011.

14) In asserting that the marks were registered in bad faith, the onus rests with the opponent to make a prima facie case. A claim that a mark was registered in bad faith implies some action by the applicant which a reasonable person would consider to unacceptable behaviour or, as put by Lindsay in the *Gromax* trade mark case [1999] RPC 10:

“includes some dealings which fall short of the standards of acceptable commercial behaviour”.

15) The issue must be determined on the balance of probabilities. On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the applicant’s state of mind regarding the application for registration if I am satisfied that its actions in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct.

16) In the instant case the opponent contends that the applications were made in the name of “MISS ELLIES” (2573520) and “MISS ELLIES COFFEE & SUBS” (2601512). On the application forms the applicant is identified at paragraph ten as shown in the second line of this paragraph. Against the question “if you are applying in the name of a company where is it incorporated?” the applicant in both cases stated “GB”. Shortly after the applications were opposed, the applicant’s representatives filed two forms TM21 to change the names of the applicants as both were said to have changed their names to “Miss Ellies (a partnership)”. The opponent contends that this was deceptive, as was the filing of form TM21 which said that the applicant had changed its name when it later stated that the change was to “clarify” and “emphasise” the status of the applicant.

17) To the best of my knowledge, there is nothing to prevent individuals trading as a partnership under a number of different names. The opponent has not provided any evidence to undermine this belief, nor has it referred to any relevant authorities. The name of the applicant was clearly set out on each application form, and there the matter would rest were it not for the fact that the letters “GB” were put next to the question on incorporation. Clearly, this implied that the applicant in each case was a company incorporated in the UK when it was not. The applicants were contactable and responded to the opposition. Once the error was realised, the applicant’s representatives sought to clarify matters. To my mind, a simple clerical error in writing in the letters “GB” does not amount to making an application in bad faith. Neither is there any reason to believe that there is no bona fide intention to use the marks and the ground of opposition based upon Section 3(6) fails.

18) I now turn to consider the ground of opposition under Section 3(3)(b) which reads:

- “3. (3) A trade mark shall not be registered if it is –
  - (a) Contrary to public policy or to accepted principles of morality, or
  - (b) Of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

19) The opponent contends, particularly in the case of 2601512 that the public will be deceived if the mark is used on anything other than (coffee and) subs. The opponent contends that the marks in suit describe food and drink products which are not included in the applications and which food and drink products will be substituted for coffee and subs in the branded pack acquired by the purchaser. The registrar has to take what I would describe as a realistic and pragmatic view. Whilst the provision is there to protect the public, the registrar has to have regard to the intentions of businesses applying the marks in their own interests so that they do not deceive. I have to take cognisance that the average consumer is reasonably well informed and circumspect. They are accustomed to traders using marks which allude to their products. No-one would be deceived if they entered e.g. a Subway and purchased a drink or a salad. If they were led to believe that they were purchasing coffee and a sub and received instead edible oils and fats they would complain not just to the business but to the trading standards authority and also the local press. It does not make good business sense for traders to misuse such marks as it would damage the goodwill of that trader and lead to loss of custom. I therefore dismiss the ground of opposition under Section 3(3)(b).

20) Lastly, I turn to the ground of opposition under Section 3(1)(b) which reads:

- “3.-(1) The following shall not be registered -
  - (a) ....
  - (b) trade marks which are devoid of any distinctive character,
  - (c) .....
  - (d) .....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use.”

21) In *Combi Steam Trade Mark* (BL O/363/09) the Appointed Person commented on section 3(1)(b) of the Act in the following terms:

“7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of

types of marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 Linde AG, Winward Industries Inc and Radio Uhren AG [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance ("CFI") has repeatedly referred to "a minimum degree of distinctive character" as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM ("EUROCOOL") [2003] ETMR 4 at [39]; Case T-128/01 Daimler Chrysler Corp v OHIM [2003] ETMR 87 at [33]; Case T-320/03 Citicorp v OHIM ("LIVE RICHLY") at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: Deutsche Krankenversicherung AG v OHIM ("COMPANYLINE") [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the Court's view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: SAT.1 v OHIM at [23]; Case C-37/03 P BioID AG v OHIM [2005] ECR I-7975 (ECJ) at [27]."

22) I must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM*, T-130/01(Real People Real Solutions), stated the following:

"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

23) In its submissions the opponent said:

"12. Both examiners took the view that the graphic features of the two marks do not provide sufficient "surplus" and that both marks need to be considered as, essentially, word marks. This view was accepted without argument by the applicant in connection with application No, 2573520 and accepted by the applicant's representatives (after initial arguments) in connection with Application No. 2601512. In both cases, the representatives have said in these proceedings that they do not accept what had already been accepted by them and their clients. We submit that the views of the two examiners were correct and that the acceptance of those views by the applicant and the applicant's representatives was correct and that the marks must be considered as, essentially, word marks and treated accordingly.

13. We submit that both examiners took too narrow a view of the inherent distinctiveness of the marks by allowing both for a limited range of food and drink goods. In the case of MORE THAN JUST SUBS, the mark has been incorrectly allowed in respect of "sandwiches" in Class 29 and "sandwiches for food" and "sandwiches" in Class 30 (all of which expressions therefore include "subs" or "submarine sandwiches") and similar goods (e.g. bagels, baguettes and paninis in both classes and snacks in Class 29 and snack products in class 30). As already mentioned in the witness statement referred to above [Mr Lutkin's statement] and in the examiner's initial report, the phrase is a slogan and is the beginning of a sentence that would go on in the consumer's perception to read "more than just subs but also their contents and accompanying products". If the phrase in the mark had been "more than just snacks" or "more than just drinks", we submit that the phrase would have been adjudged non-distinctive in relation to all food and drink products. As such, we submit that a mark of this nature should not be allowed for any goods in Classes 29 or 30.

In the case of COFFEE AND SUBS, we submit that the examiner again erred in only requiring limitations which deal with the products coffee and subs when, in our submission, the phrase is non-distinctive in relation to goods similar to coffee and subs, e.g. tea & bread and, as with MORE THAN JUST SUBS, we submit that the mark is non-distinctive of any food and drink products."

24) For its part the applicant points out:

“6. It is observed that, while the opponent on one hand avers the word “subs” to be [non-]distinctive, on the other it is the owner of Registered Trade Mark 1292579 for the singular version of the same word, for services which are highly similar to those in the application.”

7. It is submitted that by its continuing ownership of that Registered Trade mark the opponent makes an implicit representation that the word “subs” is inherently distinctive.

8. The opponent must choose one position or the other, either the word “subs” is distinctive, or is devoid of distinctiveness. Until it does so, and against the background of the above implicit representation, it is submitted that the opponent debars itself from at the same time making a case that the word is devoid of distinctive character.”

And:

“25. The applicant does not rely on the verbal elements of the marks alone. Considering the marks as a whole, it must be taken into account that they are presented in a specific colourway [sic] and in a specific an [sic] unusual font. One mark in particular is surrounded with an emphatic broken border, drawing attention to it, and is presented in the form of a partly-eroded rubber stamp.”

25) Firstly, I should state that I am not constrained by any comments made by an examiner, or by a party in the ex-parte stage. If the applicant agreed with the examiner that the device element provided no surplus this could have been a tactical acceptance in the circumstances. The opponent has commented that the marks “more than just snacks” or “more than just drinks” would not be acceptable for any food or drink respectively. I agree with this view, however, the mark in suit is not as generalised as those put forward by the opponent and so the argument is somewhat spurious. When assessing a mark’s distinctiveness it is necessary to consider the perception of that mark by the average consumer, in the instant case this would quite clearly be the public at large. The average consumer would be fully aware that a “sub” is a distinct form of sandwich, originating in the USA. The bread is usually leavened and in the form of a French loaf which is then cut lengthways. The filling is very substantial unlike the normal British sandwich. The opponent is well aware of the oversize nature of subs as its own business is founded on the American version of a sandwich. However, having said this I accept that the term “sandwich” in the specification falls foul of the ground of objection under 3(1)(b) as clearly a sub is a sandwich. The other bread items in the specification “bagels, paninis and baguettes” can all be sold without any filling whatsoever and as such would not be described as a sandwich or a sub. Indeed to my mind even if for example an average consumer saw a panini with a filling they would not regard it as a sub. Therefore, the specification of mark 2601512 does not fall foul of section 3(1)(b) as the average consumer would regard the mark “coffee and subs” as being an indication

of origin when used on the goods applied for. With the exception of the word “sandwiches” in classes 29 and 30 the same is true of the specification applied for in relation to mark 2573520. The ground of opposition under Section 3(1)(b) therefore succeeds to this very limited extent.

## CONCLUSION

26) The opposition failed completely under the grounds of 3(6) and 3(3)(b), and succeeded, under the 3(1)(b) ground of opposition, only in relation to term “sandwich” in classes 29 and 30 of application 2573520. The marks can proceed to registration with the following specifications:

2601512

In Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; soups and potato crisps.

In Class 30: Tea, cocoa, sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; pizzas, pies and pasta dishes.

2573520

In Class 29: Meat, fish, poultry and game; meat extracts; preserves, dried and cooked fruits and vegetables; jellies, jams, compotes; dairy products; eggs, milk and milk products; edible oils and fats, sauces; fruit sauces; edible oils and fats; frozen cooked meals; deep frozen foods; frozen prepared meals; frozen ready meals; prepared meals and snacks; bagels; baguettes; paninis.

In Class 30: Coffee, mixtures of coffee and chicory, coffee essences, coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; tea; seasonings (not being essential oils), mustard, sauces, sugar; bread, pizzas, pastries and doughnuts; rice; tapioca; sago; cereal preparations and flour; bread; biscuits; cakes and pastry; ice cream; water ices; confections; non-medicated confectionery; pies and puddings; pasta; pizzas; quiche; flans; snack products; dessert products; sauces and spices; prepared meals; bagels; baguettes; paninis.

## COSTS

27) As the applicant has been almost completely successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x2	£600
Preparing evidence and considering the other side's evidence	£500

Written submissions	£500
TOTAL	£1600

28) I order Doctor's Associates Inc. to pay Miss Ellies (a partnership) the sum of £1600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of June 2013**

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