

O-256-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3216528 BY
SUNNY HUNNY ICE CREAM COMPANY LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 30, 35 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000687 BY
JANE WALLIS**

Background & pleadings

1. On 3 March 2017, Sunny Hunny Ice Cream Company Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods and services shown in paragraph 14 below. The application was published for opposition purposes on 19 May 2017.

2. The application has been opposed in full under the fast track opposition procedure by Jane Wallis (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon United Kingdom trade mark registration no. 3202205 for the trade mark **Sunny Hunny Ice Cream** which has an application date of 14 December 2016 and registration date of 10 March 2017. The opponent relies upon all the goods for which her trade mark is registered (also shown in paragraph 14 below). The opponent states:

“The mark is very similar to my mark all be it with the addition of the word “Company”. I originally obtained the trade mark in order to protect my business from people replicating the name “Sunny Hunny Ice cream” in production of ice cream in the area. I make ice cream in Hunstanton which is also known as “Sunny Hunny” and therefore did not want customers being confused as to who is making the product and as to who I am, and who my company is.”

3. The applicant filed a counterstatement (completed by Michael James Large) which states:

“The trade mark symbols are completely different. I do not believe people would be confused by them. I have been selling ice cream in Hunstanton for 40+ years. Mrs Wallis was well aware long before her application that I was trading under the registered company/brand name Sunny Hunny Ice Cream Company from a number of outlets in Hunstanton and the surrounding villages, including the Princess Theatre which is next door but one to her premises. Mrs Wallis already has the trade mark Hunstanton Ice Cream Company. She does not and never has traded under or used the name Sunny Hunny Ice Cream. It is my belief that Mrs Wallis’ application was made in bad

faith with malicious intent. I am happy to supply any evidence required to support my prior right to this trade mark.”

4. In these proceedings neither party is professionally represented.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In an official letter dated 17 October 2017, the parties were allowed until 31 October 2017 to seek leave to file evidence or request a hearing and until 17 November 2017 to provide written submissions. The chronology of events following that letter are as follows:

23 October 2017: The opponent filed written submissions and an extract from the Companies House database;

30 October 2017: The applicant filed written submissions accompanied by 7 exhibits;

2 November 2017: The opponent replies to the submissions/evidence mentioned above.

8. In an official letter to the opponent dated 12 February 2018 (the operative part of which is shown below), the tribunal stated:

“The documents filed have been viewed by the Hearing Officer who has advised that neither the material filed by the applicant, nor the submissions filed on behalf of the opponent are admissible or relevant.

There is no challenge to the validity of the opponent’s mark and the applicant’s argument based on prior use is not pertinent.

The evidence filed by the applicant, therefore, has now been returned to the applicant and the Hearing Officer has wished the parties be made aware of the following:

The issue of earlier use has no bearing upon the instant proceedings. Tribunal Practice Notice 4/2009 “Trade mark opposition and invalidation proceedings – defences”, under the heading “The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark”, outlines the approach. It states:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

Please note, following the above, the proceedings will now be forwarded to the Hearing Officer who will issue a decision in due course.”

9. A hearing was neither requested nor considered necessary. Both parties filed, inter alia, the written submissions referred to above which I will, as appropriate, refer to later in this decision.

DECISION

10. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

“5 (2) A trade mark shall not be registered if because –

(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.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon it in relation to all of the goods for which its stands registered and upon which she relies without her having to prove that genuine use has been made of it. That, I hope, explains to the applicant why the following of its comments i.e. the opponent "...does not and never has traded under or used the name Sunny Hunny Ice Cream", is of no assistance to it in these proceedings.

Section 5(2)(b) – case law

13. The following principles are gleaned from the decisions of the courts of the European Union 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.

The principles:

(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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(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.

Comparison of goods and services

14. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p>Class 30 - Ice cream; Ice creams flavoured with chocolate; Ice cream with fruit; Ice creams containing chocolate.</p>	<p>Class 30 - Ice cream; Cream (Ice -); Ice creams; Mixtures for making ice cream confections; Ice cream cakes; Ice cream sandwiches; Frozen confectionery containing ice cream; Non-dairy ice cream; Ice cream gateaux; Yoghurt based ice cream [ice cream predominating]; Natural flavourings for use in ice cream [other than etheric essences or essential oils]; Ice milk [ice cream]; Ice cream desserts; Ice cream cone mixes; Ice creams flavoured with chocolate; Ice, ice creams, frozen yogurts and sorbets; Ice cream with fruit; Fruit ice creams; Ice cream confectionery; Ice cream confections; Ice cream mixes; Sauces for ice cream; Dairy ice cream; Mixtures for making ice cream products; Ice cream drinks; Ice cream stick bars; Ice cream bars; Ice creams containing chocolate; Mixtures for making ice creams; Mixtures for making ice cream; Cones for ice cream; Ice cream cones.</p> <p>Class 35 - Retail services in relation to ice creams; Wholesale services in relation to ice creams.</p>

	Class 43 - Ice cream parlour services; Ice cream parlors.
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Comparison of goods and services – case law

15. The parties have not commented upon what they consider to be degree of similarity in the competing goods and services; I must, as a consequence, reach my own conclusions. In doing so, I am guided by the principles outlined in the case law which follows. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“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”.

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

(f) 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.

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

20. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

21. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359,

paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

22. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

23. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He stated (at paragraph 9 of his judgment):

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

24. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

*Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded:

- (i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

25. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC stated:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

³ Case C-398/07P

Class 30

26. The opponent's specification includes "ice cream" which is either literally identical to or broad enough to include (and thus to be regarded as identical on the *Meric* principle) the following goods in the application:

Ice cream; Cream (Ice -); Ice creams; Non-dairy ice cream; Yoghurt based ice cream [ice cream predominating]; Ice milk [ice cream]; ice creams, Ice cream confectionery; Ice cream confections; Dairy ice cream; Ice cream stick bars; Ice cream bars.

27. "Ice creams flavoured with chocolate", "Ice cream with fruit", "Fruit ice creams" and "Ice creams containing chocolate" in the application are identical to the equivalent terms in the opponent's specification.

Ice cream cakes; Ice cream sandwiches; Frozen confectionery containing ice cream; Ice cream gateaux; Ice cream desserts; Ice cream drinks

28. All of the above goods in the application contain ice cream as an ingredient. In those circumstances, the comments in *Les Éditions Albert René* are relevant. The nature of the competing goods will in part be similar and they will all be bought by the same average consumers for the same purpose i.e. as a sweet treat, from, for example, the freezer cabinet of a retail outlet such as a supermarket. In addition, as the average consumer will need to decide if they prefer an ice cream *per se*, or, for example, an ice cream gateaux, there is a competitive relationship between such goods. Notwithstanding the comments in *Les Éditions Albert René*, considered overall, there is a medium degree of similarity between the opponent's "ice cream" and the applicant's goods shown above.

Frozen yogurts and sorbets

29. For many of the same reasons outlined above, I reach the same conclusion in relation to the above goods in the application.

Ice cream cone mixes; Cones for ice cream; Ice cream cones. Sauces for ice cream

30. Although different in nature and, arguably, intended purpose to the opponent's ice cream, the average consumer of the competing goods is the same. Although likely to be sold in different parts of, for example, a supermarket, there is, in my experience (and, I am satisfied, that of the average consumer), a well-established and complementary relationship between the opponent's ice cream and the applicant's ice cream cones and sauces for ice cream, leading, once again, to a medium degree of similarity between them.

Mixtures for making ice cream confections; Natural flavourings for use in ice cream [other than etheric essences or essential oils]; Ice cream mixes; Mixtures for making ice cream products; Mixtures for making ice creams; Mixtures for making ice cream

31. The above goods are, broadly speaking, mixtures for making ice cream and ice cream products and flavourings for ice cream. Although the average consumer for such goods and those of the opponent are the same and the intended purpose is ultimately the same i.e. to allow the consumer to avail itself of a sweet treat, the competing goods are different in nature and will, in my experience, be found in different aisles of a supermarket and have no obvious complementary relationship. However, as the average consumer has the choice of buying ready-made ice cream or making it themselves, there is a clear competitive relationship between the goods. Balancing the above factors results in a low degree of similarity between the competing goods.

Ice

32. Although it is possible to identify areas of overlap between ice and the opponent's goods (e.g. both have the same average consumer and may be bought from freezer cabinets in supermarkets), the nature, intended purpose and method of use are different. As there is no complementary or competitive relationship between

such goods, when considered in a commercial context, there is, in my view, no meaningful degree of similarity between ice and the opponent's ice cream.

33. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

34. Where there is no similarity in the goods there can be no likelihood of confusion. As a consequence, the opposition to “ice” fails and is dismissed accordingly.

Class 35

35. The applicant seeks registration for retail and wholesale services in relation to goods contained in the opponent's specification i.e. ice cream. As I mentioned earlier, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. As the average consumer will be well aware of the long standing and complementary relationship between the opponent's goods and the applicant's retailing of such goods, this leads, in turn, to at least a medium degree of similarity between them. I see no reason why similar conclusions would not also apply to the applicant's “wholesale services in relation to ice cream”.

Class 43

36. The applicant seeks registration for ice cream parlour services. Like me, the average consumer will be well aware that an ice cream parlour is a place where one

goes to eat ice cream. In comparing goods with services there is, of course, a difference between the nature of a good and that of a service. Goods and services can, however, be complementary, share channels of trade and can be in competition with one another. This is particularly relevant when one is considering services which provide food (in this case ice cream) against the food itself i.e. ice cream. Ice cream is essential to the provision of the applicant's services. The respective goods and services have the same end users and purpose, and as the opponent's goods may be chosen by the average consumer as an alternative to visiting an ice cream parlour, they are in competition with one another. In my view, these factors result in, at least, a medium degree of similarity between them.

The average consumer and the nature of the purchasing process

37. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar; I must then determine the manner in which such goods and services 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.”

38. The average consumer of the goods and services in classes 30 and 43 and “retail services in relation to ice creams” in class 35 is a member of the general public, whereas the average consumer of “wholesale services in relation to ice creams” is more likely to be a business user. Insofar as the goods are concerned, they are most likely to be selected from physical outlets or from the equivalent pages

of a website. While visual considerations are likely to dominate the selection process, aural considerations in the form of, for example, word-of-mouth recommendations or requests to sales assistants will also play their part. All of the goods at issue are likely to be fairly frequent, low cost purchases. Although the average consumer will wish to ensure they select, for example, the correct type and flavour of ice cream, I would expect them to pay a somewhat lower than average degree of care during the selection process.

39. As the retail services in class 35 are most likely to be selected from, inter alia, websites, advertisements and signage on the high street, visual considerations are, once again, likely to dominate the selection process. That said, as such services may also be the subject of, for example, word-of-mouth recommendations, aural considerations must not be forgotten. As to the degree of care with which such services may be selected, in my experience, the average consumer is likely to be mindful of a range of considerations such as the breadth of ice cream/brands stocked, customer reviews, delivery times/costs and, in relation to a physical outlet, proximity to their location, opening times, parking etc. all of which suggests an average degree of attention being paid during the selection process. Many of the same considerations are also likely to apply to a business user selecting a wholesaler of ice cream (with business contacts also likely to be a source of information as to potential suppliers). Given what are likely to be the greater costs involved and as contracts may be negotiated over a period of time, I would expect a business user to pay a somewhat higher degree of attention during the selection process.

40. Ice cream parlours are, in my experience, most likely to be selected having considered signage appearing on the high street and, for example, promotional material and reviews (in hard copy and on-line); once again visual considerations will be an important part of the selection process. However, as such services may also be the subject of word-of-mouth recommendations, aural considerations will also play their part. As the average consumer will be alive to factors such as menu choices, cost, ambience etc. when selecting such services, I would expect them to pay an average degree of attention during that process.

Comparison of trade marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade 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*:

“.....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.”

42. 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 they create. The trade marks to be compared are as follows:

The opponent's trade mark	The applicant's trade mark
Sunny Hunny Ice Cream	

43. As I mentioned earlier, in its counterstatement, the applicant submits that “the trade mark symbols are completely different” and in its submissions, it adds:

“With regards to the trade mark logo Mrs Wallis has not registered a logo for her company and therefore there can be no confusion.”

44. The opponent’s trade mark consists of the words “Sunny Hunny Ice Cream” presented in title case in a conventional font. As the words “Ice Cream” are entirely descriptive, they will have very little (if any) relative weight in the overall impression conveyed. Although the word “Sunny” is unlikely to have a great deal of distinctiveness in relation to ice cream (the device in the applicant’s trade mark supporting that conclusion), as far as I am aware, the word “Hunny” is neither descriptive of nor non-distinctive for such goods. Notwithstanding the opponent’s submission that “...Hunstanton...is also known as Sunny Hunny” (a point to which I will return below), the words “Sunny Hunny” do not, in my view, create a unit (the meaning of which is different to the individual words of which it is composed. They do, however, have a rhyming quality which, in my view, will lead the average consumer to regard them as linked. As a consequence, it is the combination of the words “Sunny Hunny”, which will make the overwhelming contribution to both the overall impression the opponent’s trade mark conveys and its distinctive character.

45. The applicant’s trade mark contains a number of components i.e. (i) a circular device presented in the colour yellow reminiscent of a sun, (ii) a circular device presented in white upon which there appears (a) the words “SUNNY HUNNY” presented in bold in block capital letters, (b) two black dots (which appear below the letter “S” of the word “SUNNY” and the letter “Y” of the word “HUNNY”) and (c) the words “ICE CREAM COMPANY” presented in a lighter font in block capital letters, (iii) a circular device presented in the colour blue and (iv) an ice cream cornet presented in the colours beige, brown and pink.

46. As the various coloured circular devices act primarily as backgrounds, they will make only a limited contribution to the overall impression conveyed and to the trade mark’s distinctive character. Whether noticed or not, the two black dots will make no contribution to the overall impression conveyed or the trade mark’s distinctiveness. Although in terms of its size and positioning the device of a cornet is an important component of the applicant’s trade mark, as it is either directly descriptive or highly allusive of many of the goods and services in the applicant’s specifications, its

relative weight in the overall impression conveyed and the trade mark's distinctiveness is likely to be low. That leaves the words "SUNNY HUNNY" and "ICE CREAM COMPANY" to consider. I have commented upon the words "SUNNY HUNNY" above. Appearing at the top of the trade mark and presented in bold, these words make an important contribution to both the overall impression conveyed and the trade mark's distinctive character. While the words "ICE CREAM COMPANY" which appear at the bottom trade mark will contribute to the overall impression it conveys, as they simply indicate that "SUNNY HUNNY" is a company specialising in ice cream, their relative weight and distinctiveness will be very limited.

47. I will now compare the competing trade marks with those conclusions in mind. The words "Sunny Hunny"/"SUNNY HUNNY" and "Ice Cream"/"ICE CREAM" appear in both parties' trade marks. Although the applicant's trade mark also contains the word "COMPANY" and the various coloured figurative components mentioned above, there remains, in my view, at least a medium degree of visual similarity between the competing trade marks.

48. Insofar as the aural comparison is concerned, it is well-established that when a trade mark consists of a combination of words and figurative components, it is by the words that the trade mark is most likely to be referred. Given the descriptive nature of the words "Ice Cream" and "ICE CREAM COMPANY" in the competing trade marks, they are both, in my view, highly likely to be referred to as simply "Sunny Hunny"/"SUNNY HUNNY" i.e. they are aurally identical. However, even if they are referred to by all of the verbal elements of which they are composed, as the first four words of which the applicant's trade mark is composed i.e. "SUNNY HUNNY ICE CREAM..." are identical to the four words of which the opponent's trade mark consists, the competing trade marks are, in any event, aurally highly similar.

49. Finally, the conceptual comparison. The fact that both parties' trade marks contain verbal or figurative components which relate to ice cream will obviously create highly similar conceptual imagery in the average consumer's mind. In her submissions, the opponent states: "I consider "Hunstanton" and "Sunny Hunny" to be the same, as do a vast majority of people." While I am aware that Hunstanton is a resort in Norfolk, I am not aware that it is also referred to as "Sunny Hunny". While

that state of knowledge may apply to those who live in Hunstanton or Norfolk more generally, absent evidence to the contrary, I very much doubt it applies to the state of knowledge of the average consumer in the United Kingdom. Of course if it does, the conceptual message conveyed by those words will be identical. Much more likely, in my view, is that other than the concepts conveyed by the various verbal and figurative references to ice cream, the words “SUNNY HUNNY” will convey no concrete conceptual message to the average consumer.

Distinctive character of the earlier trade mark

50. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

51. As the opponent has filed no evidence of any use she may have made of the trade mark upon which she relies, I have only its inherent characteristics to consider. Although the words “Ice Cream” in the opponent’s trade mark are descriptive, as the words “Sunny Hunny” are neither descriptive of nor non-distinctive for the goods for which it stands registered, the words “Sunny Hunny” and the opponent’s trade mark as a whole is possessed of at least a normal degree of inherent distinctive character.

Likelihood of confusion

52. 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 services and vice versa. As I

mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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:

- while some of the remaining goods and services in the application are only similar to the opponent's goods to a low degree, the majority are either identical or similar to a medium degree;
- the average consumer of the remaining goods and services in the application is either a member of the general public or, in relation to the wholesaling of ice cream, a business user;
- whilst aural considerations must be kept in mind, the average consumer is most likely to select the goods and services by predominately visual means paying (at least) a somewhat lower than average degree of care during that process;
- the competing trade marks are visually similar to at least a medium degree, if not aurally identical, they are aurally similar to a high degree and insofar as it is relevant, conceptually neutral;
- the words "Sunny Hunny" in the opponent's earlier trade mark and the trade mark as a whole is possessed of at least a normal degree of inherent distinctive character.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

54. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.”

55. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

56. I begin by reminding myself that I have concluded that some of the applicant’s goods are only similar to the opponent’s goods to a low degree and that the average consumer will pay an average degree of care when selecting many of the goods and services at issue. However, even in relation to those goods which are similar to only a low degree (and proceeding on the basis most favourable to the applicant i.e. the average consumer will pay a high degree of attention during the selection process - thus making them far less prone to the effects of imperfect recollection), I am still satisfied that the degree of visual and aural similarity between the competing marks and the at least normal degree of distinctive character both the words “Sunny Hunny” and the opponent’s trade mark as a whole possesses, will result in a likelihood of confusion. Even if the additional components in the applicant’s trade mark are sufficient to avoid direct confusion (of which I have my doubts), I have no doubt that

the average consumer will simply assume that the applicant's trade mark is a variant or updated version of the trade mark used by the opponent or by some undertaking economically linked to the opponent i.e. there will be indirect confusion. Having reached that conclusion on the basis indicated above, the position is, in my view, even more clear-cut when considered from the perspective of an average consumer who, during the selection process, pays a low or even average degree of attention to goods and services which are either identical or similar to a medium degree.

Comments on the applicant's submissions

57. In its counterstatement and submissions, the applicant states, inter alia, that it has traded under the "registered company/brand name Sunny Hunny Ice Cream..." and that the opponent's earlier trade mark "was made in bad faith and with malicious intent". The parties' submissions also refer to various instances of confusion. However, for the reasons explained by the tribunal in its letter of 12 February 2018, in the absence of a challenge to the earlier trade mark upon which the opponent relies (and at the date of the issuing of this decision no such challenge has been made), such factors do not assist the applicant.

Conclusion

58. Subject to any successful appeal, the application will, with the exception of "ice" in class 30, be refused in respect of all the goods and services for which registration has been sought.

Costs

59. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, and as the opponent has been overwhelmingly successful, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement: £100

Written submissions: £100

Opposition fee: £100

Total: £300

60. I order Sunny Hunny Ice Cream Company Ltd to pay to Jane Wallis the sum of £300. This sum is 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 25th day of April 2018

C J BOWEN

For the Registrar