

IN THE MATTER OF THE TRADE MARKS ACT 1994

**AND IN THE MATTER OF UK TRADE MARK APPLICATION No 2577122
BY GREYLEG INVESTMENT LIMITED TO REGISTER THE MARK
HOKEY POKEY**

**AND IN THE MATTER OF OPPOSITION NO. 102551 THERETO
BY BR IP HOLDER LLC**

**APPEAL BY THE OPPONENT FROM THE DECISION OF
MR MARK BRYANT DATED 4 APRIL 2014**

DECISION

1. This is an appeal from a decision of Mr Mark Bryant on behalf of the Registrar, number BL O/146/14, by which he rejected the opposition by BR IP Holder LLC ("Baskin Robbins") to a trade mark application in the name of Greyleg Investment Ltd ("the Applicant").

Background

2. On 31 March 2011, the Applicant applied to register the word mark HOKEY POKEY for "ice cream frozen yoghurt" in Class 30 ("the Mark"). Despite the ambivalence of that specification, the Mark was accepted in that form. Baskin Robbins filed a notice of opposition to the application, which objected to the application on two bases: first, pursuant to section 3 of the Act because the Mark had been used for many years to denote a flavour of ice cream, and secondly pursuant to subsection 5(4)(a) on the basis that Baskin Robbins owned a goodwill in the Mark. The section 3 objection was dropped prior to the hearing of the opposition.
3. The Applicant disputed Baskin Robbins' claim to own any goodwill in the name, relying in part upon its own earlier trade mark also for the words Hokey Pokey, registered since the year 2000 in respect of confectionery in Class 30. The Applicant also claimed to have concurrent goodwill in the Mark in respect of ice cream.
4. Both sides filed evidence and attended a hearing before Mr Bryant. Baskin Robbins was represented, as at the appeal before me, by Mr McLeod of Squire Sanders. The Applicant was

represented by Mr David Garnsworthy and his wife Deirdre, who as I understand it are the retired accountants whose sons are directors of the Applicant company, they are not themselves officers of the company.

5. Mr Bryant carefully considered the substantial volume of evidence which had been filed and went on to consider the Applicant's arguments disputing the claim that Baskin Robbins had acquired goodwill in the name Hokey Pokey. He started by reminding himself of the kind of evidence necessary to assess whether Baskin Robbins had goodwill in a business conducted under the Hokey Pokey mark. No criticism was made of that analysis. He then rejected the detailed arguments which had been made by the Applicant as to the scale or extent of use of the Hokey Pokey name by Baskin Robbins, and concluded at paragraphs 47-48 that Baskin Robbins had shown that it had "traded in a HOKEY POKEY flavoured ice cream" under the Baskin Robbins brand on a scale which was "not trivial."
6. The Hearing Officer then went on to consider the Applicant's argument that Baskin Robbins had only used the name descriptively, and considered the evidence from this standpoint. He noted that there was no evidence from the trade to support the claim to goodwill, and went on to consider whether there was evidence that the sign denoted origin to the public:

"51) ... The opponent's evidence does contain some sparse evidence from the public in the form of extracts from online discussion forums. Little can be gleaned from these, but if anything, they would appear to support Mr Garnsworthy's submission that HOKEY POKEY is perceived by the consumer as a description of a flavour.

52) In addition to the *JIF LEMON* case, when considering the impact of descriptive use upon a consideration of passing off, I keep in mind the well established principle (see for example *Reddaway v Banham* 13 RPC 218 (HOL) and *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA)) that if a trader uses a sign which is descriptive of its products, the trader must show that the public understands that the products come from him when they see the mark so that the mark has in this way acquired a 'secondary meaning'. I also keep in mind the similar guidance on this point in *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 19.

53) However, the current case is not on "all fours" with the circumstances in these earlier cases. There is no evidence that the sign HOKEY POKEY is descriptive, even if it is used in a manner that suggests it is so. On the evidence before me, it is not clear what

the consumer's level of understanding is of the term HOKEY POKEY. In its original statement of case, the opponent relied upon a Section 3(1) objection, but subsequently removed this pleading. The result of this is that I have no evidence on the point from the opponent. The applicant has provided no evidence beyond assertion that other traders are using it descriptively.

54) On the face of it, HOKEY POKEY appears to be a distinctive mark. However, how the opponent used the sign can be important. Use can be such that a sign will only be perceived as indicating the product (see *Jeryl Lynn* [1999] FSR 491) and the consumer can be educated to see a distinctive mark as descriptive. The earlier use by the opponent must relate to the use of the sign for the purposes of distinguishing goods or services (*WILD CHILD*). This does not appear to be the case here. Use, going back to the late 1990s, has been consistently as a flavour designation. Such long use in this manner will have the effect of dispelling any distinctive meaning that may have been attributed to the mark. There is no evidence to suggest that either the consumer or the opponent's franchisees perceive the sign as anything other than indicating a flavour of ice cream.

55) Certainly, the evidence of use of the sign by the opponent itself appears to support this. It consistently states that HOKEY POKEY is a flavour of one of its ice creams. It appears on invoices alongside other flavours, on freezer strip labels indicating to the public the flavour of the ice cream, references to it under "flavour lists" and photographs of packaging where the sign HOKEY POKEY appears with BASKIN ROBBINS. In the latter example, the packaging in the form of tubs, appears in a consistent format where the flavour is identified at the bottom and the Baskin Robbins mark appearing at the top (see, for example, the representation at paragraph 17).

56) Taking all of the above into account, I conclude that the goodwill vested in the opponent company and its affiliates is not identified by the sign HOKEY POKEY.

57) In the absence of goodwill, there can be no misrepresentation or damage. As a result of this finding, the opponent cannot rely upon its use of HOKEY POKEY to identify its goodwill and its case against the applicant must fail.

58) This finding is fatal to the opponent's case and, consequently, it is not necessary for me to consider the other defences put forward by the applicant."

Standard of appeal

7. This appeal is by way of a review not a rehearing. *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") show that neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. Instead, I need to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong; as Robert Walker LJ (as he then was) said at [28] in *Reef*:

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

8. Those principles have since been affirmed by the House of Lords in *Datec Electronics Holdings Ltd & Ors v. United Parcels Services Ltd* [2007] UKHL 23, [2007] 1 WLR 1325. Mr Daniel Alexander QC sitting as the Appointed Person in case BL O/471/11, *Petmeds*, 14 December 2011, summarised the position thus:

"Datec and other cases since REEF and BUD all reinforce the need for caution before overturning a finding of the tribunal below of the kind in issue in this case. Difference of view is plainly not enough and, to that extent, the applicant's submissions are correct. However, those cases and the practice of appellate tribunals specifically to trade mark registration disputes show that the degree of caution should not be so great as to permit decisions based on genuine errors of approach to go uncorrected."

The Grounds of Appeal

9. The appeal was based on the premise that the Hearing Officer's decision turned on an unsubstantiated conclusion that, because the Baskin Robbins had used the name as a "flavour designation," it was impossible for the trade mark to function as a trade mark and so generate goodwill for the purposes of founding an earlier right. In summary, Baskin Robbins' main contentions were that
- a. a "flavour designation" could function as a trade mark and its evidence showed that it had done so;
 - b. the name was inherently distinctive, such that the public did not need to be educated into seeing it as a trade mark and the Hearing Officer was wrong to hold that it had become descriptive through the use made of it by Baskin Robbins; and
 - c. it was a logical consequence of Baskin Robbins' extensive use of the name that it had generated goodwill in it.

Merits of the appeal

10. Mr McLeod's first main point was that the Hearing Officer's decision was based on a false premise that the use of a flavour designation could not amount to use for the purpose of distinguishing the goods of Baskin Robbins from those of other undertakings. Whilst he accepted that the name did indicate a flavour of ice cream, Mr McLeod submitted that in the absence of evidence that it had been so used by anyone else that did not mean that it could not generate goodwill for Baskin Robbins. He submitted that by analogy with the decision in Case C-353/03, *Société des Produits Nestlé SA v Mars UK Limited*, ('Have a Break') [2006] F.S.R. 2, use of a flavour descriptor alongside the trade name Baskin Robbins would not preclude the descriptor from also generating goodwill. In that case, the CJEU held

"30 ... acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

31 The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber* [1999] E.C.R. I-2779 , [49] and [51])."

11. It seems to me that the argument put forward on Baskin Robbins' behalf in this respect was correct. As a matter of principle, a flavour designation or descriptor may be capable of generating its own goodwill, independent of the goodwill attaching to the trade name with which has been used, just as a secondary mark may generate its own goodwill or acquire its own distinctiveness despite having been used together with a primary or "house" mark. However, providing evidence that such a designation is recognised as indicating origin may be difficult, and this doubtless explains why cases in which a secondary mark, name or slogan has been found to

have acquired independent distinctiveness in this way are relatively rare. That is demonstrated by the exceptional facts of *Have a Break* itself.

12. The Hearing Officer took the view that on the facts of the case and the evidence before him, Baskin Robbins had not proved that the average consumer or its own franchisees perceived the Hokey Pokey sign as indicating trade origin. Baskin Robbins was unable to point me to any specific error made by Hearing Officer in his assessment of the evidence which led him to that conclusion. It had provided evidence of the very lengthy period over which it had sold Hokey Pokey ice cream to its franchisees in the United Kingdom, and evidence of the large quantity of ice cream which had been sold, but there was no evidence that any significant marketing activities had been undertaken with respect to its Hokey Pokey ice cream. I was invited to infer that there must have been more significant marketing by an entity of the size and type of Baskin Robbins, but I do not consider that I may infer that any marketing related to this particular flavour of ice cream.
13. There was some limited evidence showing consumer familiarity with the name, but the Hearing Officer concluded that the evidence did not show that the average consumer would see the sign as indicating anything but flavour. In other words, Baskin Robbins did not produce evidence of the kind identified in *Have A Break* to show that the name had come to operate as an indicator of trade origin. In this respect, it seems to me that Baskin Robbins has failed to identify any material error or error of principle on the part of the Hearing Officer, and it is clear to me that the Hearing Officer's finding was one which he was entitled to make on the basis of the limited consumer evidence before him.
14. The second area of complaint about the Hearing Officer's decision related to paragraph 54 of his decision, which I have set out above. The finding in the first sentence of paragraph 54 that "On the face of it, Hokey Pokey appears to be a distinctive mark" clearly arose out of the point made in the previous paragraph, that there was no evidence either to show that "hokey pokey" is a descriptive term, or to show how the average consumer would see the mark. I am aware that "hokey pokey" is a descriptive term for honeycomb, but it would appear that there was no evidence before the Hearing Officer that the average consumer in the UK sees the term as such. Doubtless that position arose because Baskin Robbins had withdrawn its initial objection that "hokey pokey" is a descriptive term, and it would not have been in the Applicant's interests to suggest that it was descriptive.¹

¹ In earlier IPO proceedings it had claimed to have used the name as a trade mark at least for chocolate confectionery, see BL O/383/11.

15. As a result, the Hearing Officer concluded that "*On the face of it*, Hokey Pokey appears to be a distinctive mark." However, that does not appear to me to have been a finding by the Hearing Officer that the name was inherently distinctive, such that the public did not need to be educated into seeing it as a trade mark. His view was rather more nuanced, as is clear from the following sentence in paragraph 54 of his decision: "use in this manner will have the effect of dispelling any distinctive meaning that may have been attributed to the Mark."
16. It appears from paragraphs 54 - 55 of the decision that the Hearing Officer took the view that despite "hokey pokey" appearing on the face of it to be a distinctive term, it had been used only descriptively by Baskin Robbins. Mr McLeod submitted that there was a real distinction to be drawn between descriptive use of a term like vanilla to identify a flavour of ice cream, and the use of "hokey pokey" as a flavour descriptor, because the latter would not be seen as descriptive by the average consumer. However, the possibility that the term "hokey pokey" would not be seen as descriptive would not of itself have sufficed to show that Baskin Robbins had acquired a goodwill in that term. The problem that Baskin Robbins faced was that the evidence did not, in the Hearing Officer's view, establish that it had acquired goodwill and was seen as an indication of origin by average members of the public and it was unable to identify any material error in the Hearing Officer's assessment of the evidence to show that he should have found that the mark had been used to show origin, rather than descriptively. The Hearing Officer had found that the manner in which the sign had been used only indicated the flavour of the ice cream (that is clear from paragraph 55) and the website extracts and discussions in his view showed that the reaction of consumers to the mark, and the way in which they referred to it, was also merely descriptive of a flavour of ice cream, the trade origin of which was identified by reference to the name Baskin Robbins.
17. In the circumstances, it does not seem to me that the Hearing Officer held the name was inherently distinctive, such that the public did not need to be educated into seeing it as a trade mark or that inherent distinctiveness had been lost by reason of Baskin Robbins' use of the name in a descriptive manner. I therefore reject this basis of the appeal.
18. Lastly, it was submitted that it was a logical consequence of Baskin Robbins' extensive use of the name that it had generated goodwill in it. Again, I do not accept this criticism of the Hearing Officer's decision. He took the view that the use which had been made of the name by Baskin Robbins had not amounted to trade mark use and so had not generated goodwill. In the absence

of any identifiable material error in his analysis of the evidence, it does not seem to me that this is a ground of appeal which can succeed.

19. For all these reasons, the appeal is dismissed and the opposition fails.

20. The Applicant has again been successful and is entitled to a contribution towards its costs which are the costs incurred by Mr Garnsworthy in preparing for and attending the hearing. Mr Garnsworthy indicated that he had spent a huge amount of time preparing for the appeal but he accepted that it would not be appropriate for all of the hours which he had spent upon it to be reflected in any costs order I might make. I take into account the hourly rate of £18 to which a litigant in person is entitled under the Civil Procedure Rules, and on that basis I will order Baskin Robbins to pay the Applicant the sum of £180 in respect of its costs of the appeal, to be paid within 14 days of the date of this decision.

Amanda Michaels
The Appointed Person
27 October 2014

Mr CHRIS McLEOD of Squire Sanders (UK) LLP appeared for the Appellant

Mr David Garnsworthy appeared for the Applicant