

O-480-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2590725  
BY PETTY WOOD & COMPANY LIMITED  
FOR THE TRADE MARK:**

**Beenies**

**AND**

**OPPOSITION THERETO (NO 102633)  
BY WHAT NEXT CANDY COMPANY LIMITED**

## The background and the pleadings

1) Application 2590725 was filed by Petty Wood & Company Limited (“the Applicant”) on 9 August 2011, and published in the Trade Marks Journal on 9 September 2011. The mark and the goods for which registration is sought are as follows:

### Beenies

Class 30: Boiled sugar confectionery.

2) What Next Candy Company Limited (“the Opponent”) opposes the registration of the mark. Its opposition was filed on 8 November 2011 on a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Two earlier marks are relied on, both of which are registered for the following goods:

Class 30: Confectionery and sweets

Trade mark no. 2433141 for the word mark **WEENIE BEANIES** was filed on 20 September 2006 and registered on 16 March 2007. Trade mark no. 2439547 was filed on 24 November 2006 and registered on 1 June 2007 for the following composite mark:



The consequence of the above dates is that both marks relied on by the Opponent constitute an earlier mark in accordance with section 6 of the Act, and neither is subject to the proof of use conditions contained in section 6A of the Act, as their respective registration procedures had not been completed more than five years before the publication of the Applicant’s mark.

3) The Applicant filed a counterstatement denying the ground of opposition. The Opponent filed written submissions and the Applicant filed evidence. The matter then came to be heard before me on 9 November 2012. The Applicant was represented by Mr Alan Bernard of FJ Cleveland LLP. The Opponent did not attend the hearing.

## The written submissions and evidence

4) The Opponent filed written submissions. It asserts that the earlier marks on which the opposition is based do not have any meaning in relation to the goods for which they are registered, and are thus distinctive. The Opponent attaches to its submissions print-outs from Collins English Dictionary online, showing, firstly, that the word “beanie” is there defined as “a round close-fitting hat resembling a skullcap”, and, secondly, that although the word “weenie” does not appear as such in Collins English Dictionary, the word “weeny” is defined as meaning “very small; tiny”.

5) The Applicant's evidence consists of a witness statement of 14 June 2012 from Ms Danielle Jeeves, who explains that she is a trade mark paralegal employed by FJ Cleveland LLP, which represents the Applicant in these proceedings. Ms Jeeves says that she undertook searches via an internet browser in May and June 2012 to see whether the word BEANIES was in use by others in this field, and that she discovered a significant number of uses of the word in relation to food products which in one way or another used beans. Ms Jeeves says that some examples of these, which seemed to her to be current, are shown in **Exhibit DJ1**:

- Beanies coffee – based in Durham
- Beanie's Health Foods – vegetarian and vegan foods
- Beanies Wholefoods – based in Sheffield

One of the websites bears a topical reference to the impending jubilee holiday in 2012. The other two bear no embedded dating material – just the date when they were printed out: 7 June 2012.

6) Of more relevance, Ms Jeeves submits, is that she says she found several UK sites offering sweets described as "beanies". These, she says, included the following:

- ASDA – "Chosen by You Mini Beanies";
- SweetieBag.com – a business based in Dorking, Surrey and selling "milk chocolate beanies";
- Tudor Sweets – based in Ross-on-Wye, Herefordshire, claiming to sell retro sweets, including in their range "chocolate flavour beanies";
- Premcrest – selling "Traidcraft Fair Trade Milk Chocolate Beanies".

**Exhibit DJ2** contains webshots from the websites referred to. They do not appear to contain any embedded material indicating how long they have been in operation and offering the relevant items – just the date when they were printed out: 7 June 2012. Ms Jeeves reports that she applied online for samples of these products, and attaches:

- as **Exhibit DJ3** a pack of "Traidcraft Fair Trade Milk Chocolate Beanies", with invoice of 14 May 2012, obtained from Premcrest;
- as **Exhibit DJ4** a photograph of the bag of sweets from Tudor Sweets sent in a generic paper bag, together with the order confirmation of 11 May 2012 for "chocolate flavour beanies";
- as **Exhibit DJ5** a photograph of a bag of sweets and order confirmation of 11 May 2012 for "chocolate flavour beanies" from SweetieBag.com;
- Ms Jeeves recounts that ASDA reported they had sold out of the relevant item.

Ms Jeeves states that it would appear that the name "Weenie Beanie" is not an original one, this having been the name of a chain of fast food restaurants in the USA, although the spelling in that case is "Weenie Beenie". **Exhibit DJ6** is a copy of the Wikipedia entry for Weenie Beenie, the restaurant chain to which she refers. The use referred to took place in the USA. I have no evidence to suggest either that

the average consumer of sweets and confectionery in the UK would have heard of this American fast food restaurant or, if s/he had heard of it, that this would in any way affect her/his perception of the mark WEENIE BEANIES in connection with the purchase of sweets and confectionery in the UK. I therefore do not find this evidence at paragraph 6 of Ms Jeeves' witness statement and in **Exhibit DJ6** relevant.

7) In written submissions in reply to the Applicant's evidence, the Opponent observed: that only evidence dated prior to the publication date of the opposed application, i.e. 9 September 2011, should be taken into account in these proceedings; and that evidence showing use of the word "beanies" in connection with coffee, vegetarian, vegan, and wholesale foods, and with a US fast food restaurant chain was irrelevant to registration or use of the mark WEENIE BEANIES in the UK in relation to confectionery.

8) The nub of Mr Bernard's argument at the hearing was that a proper analysis of WEENIE BEANIE as a trade mark is that any distinctiveness in it resides in the combination; it is, he submitted, a rhyming couplet made from two weak, mainly descriptive components, which "hang together". On this analysis, he contended, use of BEENIES is not likely to cause confusion with WEENIE BEANIES.

#### **The law: section 5(2)(b)**

9) Section 5(2)(b) of the Act reads:

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

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

10) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union ("CJEU") in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The average consumer**

11) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting

goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). *Confectionery and sweets* are everyday items and their average consumer will consist of the general public. Their purchase will usually be casual, which increases the scope for imperfect recollection. The process of selecting confectionery and sweets will nowadays typically be by self-service, but it may also sometimes, albeit less frequently, be bought over the counter. As a result, the visual aspect will normally be more important, but both visual and aural aspects may have a role to play.

### **Comparison of the goods**

12) The parties agree that the goods are identical.

### **The distinctiveness of the earlier marks**

13) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have no evidence of use of the earlier marks, so I have only their inherent distinctiveness to assess.

14) Distinctiveness must be assessed in relation to the goods covered by the relevant specifications. Both earlier marks are registered for *confectionery and sweets*. It is the distinctiveness of the marks as a whole which must be assessed, but in coming to that view the words (and other elements) that make up the mark must be considered. The degree of distinctiveness of the word BEANIES will vary in relation to different types of sweets or confectionery. In relation to bean-shaped sweets, it clearly has a strongly allusive or suggestive element. At the hearing Mr Bernard pointed out that sweets can commonly be bean-shaped – jelly beans, for example. Whenever such a bean-shaped product is sold, he argued, it is a trivial move to call it a “beanie”, this being a childish or diminutive version of “bean”. The fact that other traders have come up with this idea independently, he submitted, tends to confirm what a small step it is from “beans” to “beanies”. Thus, **Exhibit DJ1** shows coffee and health food shops calling themselves “beanies” because they deal in beans; and **Exhibits DJ2-DJ5** show businesses selling chocolate-coated chocolate beans, and biscuits decorated with such beans, as “beanies”.

15) This evidence was collected in May/June 2012, whereas the date of the trade mark application was 9 August 2011. The Opponent submits that only evidence dated prior to the publication date of the opposed application, i.e. 9 September 2011, should be taken into account in these proceedings. Mr Bernard’s reply is that it is hardly conceivable that the usage existing in May 2012 had just appeared. In this case, he submitted, the short period between the filing and the collection of evidence made it reasonable to take account of materials published after the relevant date. However, the fact is that we simply do not know if all, the majority, a minority, or any of the examples of usage were in play before the relevant date (the date of application). Apart from this, the evidence is in any case limited to start with; it concerns only seven traders overall, and only four traders in relation to sweets.

Therefore, whilst I do not disregard the evidence, its weight is not particularly significant.

16) Mr Bernard argued that **Exhibits DJ2-DJ5** establish that other traders are selling chocolate bean sweets with the expectation that the customer knows what a „beanie’ is. However, I note that ASDA describes its “Mini Beanies” product as a biscuit “topped with mini sugar-coated milk chocolate beans”; two other traders describe their “Chocolate Flavour Beanies” as “coated chocolate flavour pieces” and “candy coated chocolate beans” respectively. The webshot of the final trader shows pictures of its “Milk Chocolate Beanies” products without providing a written description. I note, however, that it invoices the goods as “milk chocolate beans”. The evidence falls well short of establishing that BEANIES is (or was before the relevant date) being generally used as a descriptor. Neither does the evidence establish that such uses will be known by the average consumer. The position is not helped by some of the uses put forward (particularly those in **Exhibit DJ1**) being clearly examples of trade mark use even if the intention (and impact) of the others is less clear

17) Mr Bernard argued that the fact that other traders have come up with the name BEANIES independently tends to confirm that it is a small step from “beans” to “beanies”. In my view, I do not consider that the evidence establishes anything beyond the fairly obvious fact that the word BEANIES has an allusive character in relation to bean-shaped sweets. However, it is not descriptive, and is at least moderately distinctive alone; it has more distinctiveness than WEENIE. It is true that the word WEENIE, spelt in that way, does not appear as such in Collins English Dictionary, where the word appears as “weeny” and is defined as meaning “very small; tiny”. However, it is a word which will be familiar to the average consumer. Some people may notice the difference in spelling, but I am not persuaded that the average consumer will. Whether the difference is noticed or not, I think the average consumer will simply perceive the word WEENIE in word mark no. 2433141 (and in composite mark 2439547) as the adjective “weeny”, and thus as descriptive; any distinctiveness conferred by misspelling will be at best very low. Viewed as a whole, WEENIE BEANIES has a degree of rhythm and assonance. I consider the earlier word mark 2433141 overall to have an average level of distinctiveness.

18) The words WEENY BEANIES remain the most important element of the composite mark no. 2439547, but the word BEANIES is given far more prominence. The simple red frame adds little, but the allusive and suggestive quality of the word BEANIES is strongly reinforced by the representation of what in this context can surely only be seen as a red jelly bean. Nevertheless, viewed overall, I consider that, even for bean-shaped sweets, the mark retains an average degree of distinctiveness.

### **Comparison of the marks**

19) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Earlier mark 2433141	Earlier mark 2439547	The Applicant's mark
<b>WEENIE BEANIES</b>		<b>Beenies</b>

20) I must make a whole mark comparison, and in this context bear in mind, for example, that the phrase WEENIE BEANIES coheres together as a whole. Nevertheless, in the earlier mark 2433141, despite its misspelling, WEENIE will be perceived by the consumer as “weeny”, a descriptive adjective qualifying the distinctive BEANIES. BEANIES is therefore the dominant and distinctive feature of the mark. This is even more the case in the earlier mark 2439547, where the word BEANIES is given graphic prominence. The simple red frame plays a very minor role, and the depiction of a jelly bean reflects the allusive quality of the prominent BEANIES, rather than distracting from the word. BEANIES is the dominant and distinctive element of the mark, though the other elements are not negligible and must be considered in the whole mark comparison. The Applicant’s mark consists exclusively of the word Beenies, which, by virtue of being the sole component of the mark, is its dominant and distinctive element.

21) Visually, the Opponent’s earlier word mark 2433141 consists of two words, the Applicant’s of only one. The sole word of the Applicant’s mark is almost the same as the second word of the Opponent’s mark, the only difference being their third letters. There is a reasonable degree of visual similarity between the marks. The Opponent’s earlier composite mark 2439547 adds a simple red frame and a picture of a red jelly bean to the words WEENIE BEANIES. But, in terms of graphic representation, the word WEENIE is clearly subordinate to the word BEANIES. Although it appears at the bottom of the mark, the word BEANIES is given prominence. The focus on the word BEANIES gives the mark a reasonable degree of visual similarity with the Applicant’s mark Beenies.

22) Both the Opponent’s marks will be pronounced in the same way. From an aural perspective, they consist of two quasi-rhyming, rhythmically balanced words of two syllables. The Applicant’s mark consists of one word of two syllables, pronounced identically with the second word of the Opponent’s mark. There is a reasonable degree of aural similarity.

23) Various types of sweets may be described as bean-shaped in one way or another; in relation to sweets of this kind, the Applicant’s mark, Beenies, though misspelt, and the BEANIES component of the Opponent’s earlier marks, are both strongly allusive. To this extent the marks share some conceptual content.

**Likelihood of confusion**

24) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of

confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer, and determining whether they are likely to be confused.

25) The goods are identical. Their purchase will usually be casual, which increases the scope for imperfect recollection. I have found both earlier marks to have an average level of distinctiveness. I have found the word BEANIES to be the dominant and distinctive element of the earlier word mark 2433141, and to be even more dominant in the composite mark 2439547. For both earlier marks I have found a reasonable degree of both visual and aural similarity, and some shared conceptual content with the Applicant's mark. Bearing in mind the identity of the goods, the purchasing process, and the low level of attention of the average consumer of sweets, and allowing for imperfect recollection, I think the difference in spelling between BEANIES and BEENIES will go unnoticed by the average purchaser of sweets. Furthermore, given the more dominant role that the word BEANIES plays in the earlier marks I consider, when all other factors are borne in mind, that there is a likelihood of confusion, and that such confusion may arise from directly confusing the marks. However, even if I am wrong on this assessment, and the average consumer notices (and recalls) the addition of WEENIE in the Opponent's marks, I consider that the consumer will perceive the word WEENIE as essentially descriptive, and regard sweets sold under the marks as coming from the same stable. In other words, the consumer will regard the BEANIES/BEENIES element in the marks as indicating that the undertakings responsible for them are the same or related. There is a likelihood of indirect confusion. Accordingly, **the opposition succeeds** in its entirety.

### **Costs**

26) The Opponent has been successful and is entitled to a contribution towards its costs. In its written submissions in reply to the Applicant's evidence the Opponent submitted that all the evidence filed by the Applicant was irrelevant, and requested that I take this into account when considering costs. I did not find the evidence at paragraph 6 of Ms Jeeves' witness statement and in **Exhibit DJ6** to be relevant. However, this evidence was brief and simple, and could be quickly and briefly dealt with by the Opponent. While the degree of relevance of the rest of the Applicant's evidence varied, I found none of it completely irrelevant to the Applicant's case, even though I did not ultimately find it persuasive. The Applicant's submission has therefore played no part in my assessment of costs. My assessment on filing of submissions and evidence, however, does reflect the fact that, although the Opponent did not attend the hearing or file written submissions in lieu of attendance, it did file full submissions (with attached dictionary extracts) during the evidence rounds.

I hereby order Petty Wood & Company Ltd to pay What Next Candy Company Ltd the sum of £1,000. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£200
<i>Filing submissions and considering evidence submitted by the Applicant</i>	£600

*Opposition fee*

£200

27) The above sum should 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 4th day of December 2012**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**