

**O-684-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO 3298871**

**BY MICHAEL CORRADO JACKSON & SAJID JAVED**

**TO REGISTER**



**AS A TRADE MARK IN CLASSES 30 & 43**

**AND**

**OPPOSITION THERETO (UNDER NO. 413107)**

**BY**

**UNILEVER PLC**

## BACKGROUND

1) On 22 March 2018, Michael Corrado Jackson and Sajid Javed ('the applicants') applied to register the trade mark shown on the cover page of this decision in respect of the following goods and services:

Class 30: Coffee; tea; cocoa; sugar; rice; tapioca; sago; coffee products; confectionery containing milk; bakery and confectionery products; bread; pastries; flour and preparations made from cereals; honey; yeast; baking powder; salt and mustard; vinegar; sauces; spices; ices; edible ices; ice cream; ice cream cones; water ices; frozen confectionery; ice; snacks; preparations for making the aforesaid goods, in so far as not included in other classes.

Class 43: Services for providing food and drink; temporary accommodation services; snackbar services; ice cream parlour services; catering; restaurant services; bar services; juice bar services.

2) The application was published in the Trade Marks Journal on 13 April 2018 and notice of opposition was subsequently filed by Unilever Plc ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').<sup>1</sup>

3) The opponent relies upon two earlier trade mark registrations. Details of those marks, including the goods relied upon, are as follows:

- UK registration 2237179 for the mark **WHIPPY**, filed on 26 July 2000 and entered in the register on 08 December 2000, in respect of:

Class 7: Machines and apparatus for dispensing ice, flavoured ice, ice cream, frozen yoghurt and frozen desserts; parts and fittings for all the aforesaid goods.

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<sup>1</sup> Other grounds, initially pleaded, were withdrawn by the opponent when it filed evidence in chief (as per the opponent's correspondence dated 13 December 2018).

Class 11: Apparatus for freezing, refrigerating and cooling; ice cream freezers, refrigerators and coolers; ice cream chiller cabinets; machines for making ice cream; parts and fittings for all the aforesaid goods.

Class 30: Ice creams, water ices; frozen yoghurt, frozen desserts, frozen confectionery; preparations for making the aforesaid goods.

- UK registration 786957 for the mark **MR. WHIPPY** filed on 06 February 1959 in respect of:

Class 30: Non-medicated confectionary, ices, ice cream, chocolates and sweetmeats.

4) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As both completed their registration procedure more than five years prior to the publication date of the contested mark, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in relation to all the goods relied upon.

5) The applicants filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of both earlier marks.

6) Both parties filed evidence. A hearing took place before me on 09 July 2019. The opponent was represented by Mr Jonathan Moss, of counsel, instructed by Baker & McKenzie LLP. The applicant was represented by Mr Christopher Hoole of Appleyard Lees IP LLP.

## **EVIDENCE**

### **Opponent's evidence in chief**

7) This comes from Michel Rorai, Global Trade Mark Counsel for the opponent. Mr Rorai explains that the opponent is the proprietor of various worldwide famous brands including MAGNUM and CORNETTO. The mark Mr Whippy is a local UK

brand of ice cream which is sold and marketed under the opponent's Wall's heart brand.

8) Mr Rorai states that the opponent sells ice cream under the MR WHIPPY brand through ice cream vans throughout the UK. These vans are operated by third parties whereby agreements are put in place between the opponent and those third parties operating the ice cream vans. Two franchise agreements are provided. The first is an unsigned agreement dated 26 January 2016 between the opponent and a third-party company based in Surrey<sup>2</sup>. Mr Rorai draws attention to the operating term therein which states that "The operator ensures that the Unit is filled with Mr Whippy Soft mix..." Three images of an ice cream van, bearing the opponent's 'heart' brand above the passenger-side window, are visible on the agreement. I note that clause 1(i) of the terms and conditions of the agreement state that "types and prices of Unilever products sold from the Units shall be clearly displayed." A second agreement, dated 01 January 2018, is provided between the opponent and a third-party company based in Dagenham<sup>3</sup>. Mr Rorai draws attention to the part of the agreement which states "Exclusivity – The Customer shall only stock Mr Whippy in the soft mix category..."

9) Mr Rorai states that the opponent also sells ice cream mix under the brand MR WHIPPY. He explains that these ice cream mixes are the ingredients used to produce the soft serve ice cream sold under the brand MR WHIPPY. A brochure is provided dated 2017<sup>4</sup> detailing the history of Mr Whippy and that Mr Whippy ice cream vans and the associated ice cream company were acquired by the opponent in 1966. The brochure shows that Mr Whippy ice cream mixes are available for sale in the UK. It also shows that point of sale materials, bearing the mark Mr Whippy in relation to ice cream, can be purchased by third parties from the opponent. It is said that this brochure was circulated to all Unilever Customers, Development employees, wholesalers and Field representatives (amounting to around 120 people) and subsequently distributed more widely.

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<sup>2</sup> Exhibit MR-3

<sup>3</sup> Exhibit MR-4

<sup>4</sup> Exhibit MR-5

10) Mr Rorai states that Mr Whippy ice cream mix can be purchased from a number of retailers. He provides prints from the websites of Consort Frozen Foods<sup>5</sup>, turnerprice and first4frozen<sup>6</sup> showing Mr Whippy ice cream mix listed for sale in the UK.

11) Mr Rorai states that Mr Whippy is a popular brand in the UK, with a solid market presence. UK sales figures, said to relate to ice cream mix products sold under the MR WHIPPY brand, are provided, as follows:

<b>Year</b>	<b>UK Sales Volume (figures rounded to the nearest 1000 packs)</b>
2015	109,000
2016	406,000
2017	380,000
2018	484,000

12) Mr Rorai explains that each pack of ice cream mix would produce approximately 20 Mr Whippy ice creams.

13) Mr Rorai states that, aside from ice cream vans, Mr Whippy ice cream products are also sold in various stalls across the UK. He provides a photograph, taken on 11 July 2018, showing an ice cream stall<sup>7</sup>. This does not fall within the relevant period for showing genuine use (falling just under three months after the end of that period). The front of the shop looks like this:

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<sup>5</sup> Exhibit MR-6

<sup>6</sup> Exhibit MR-7

<sup>7</sup> Exhibit MR-8



14) Images of point of sale materials<sup>8</sup> are also provided which Mr Rorai states are used in connection the opponent's Mr Whippy ice cream products. They show boards, modular stickers and product stickers bearing ice cream cones and the mark Mr Whippy underneath the opponent's 'heart' brand.

15) A photograph is provided, which Mr Rorai states was taken on 13 April 2018<sup>9</sup> (this is the last day of the relevant five-year period for proof of use), showing an ice cream van with MR WHIPPY positioned on its front, above the windscreen. The opponent's 'Walls' and 'heart' brands are also present elsewhere on the van.

16) A brochure is provided, dated 2013<sup>10</sup>, showing various ice cream products, including Mr Whippy ice cream. A second brochure, dated 2016<sup>11</sup>, shows various ice cream products (such as Calippo and Magnum) including Mr Whippy ice cream. Mr Rorai states that at least 30,000 copies of the latter brochure were ordered, produced and circulated in 2016 to all Unilever Customer Development employees, wholesalers and Field Representatives and subsequently to all leisure parks, zoos theme parks and mobile customers that sell the opponent's ice cream products. A similar brochure, dated 2018, is also provided.<sup>12</sup>

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<sup>8</sup> Exhibit MR-9

<sup>9</sup> Exhibit MR-10

<sup>10</sup> Exhibit MR-11

<sup>11</sup> Exhibit MR-12

<sup>12</sup> Exhibit MR-13

## **Applicant's evidence**

17) This comes from Mr Christopher James Hoole, a solicitor and trade mark attorney at Appleyard Lees IP LLP, the applicant's representative in these proceedings. Mr Hoole exhibits pages of the opponent's annual reports dated 2016 and 2017 showing annual revenue of the Wall's brand,<sup>13</sup> a page from "Part C- Opposition – Section 6 – Proof of Use" Section of the EUIPO Guidelines<sup>14</sup> and two judgments of the General Court.<sup>15</sup> Mr Hoole also filed accompanying written submissions, which I bear in mind but will not detail here.

## **Opponent's evidence in reply**

18) This comes from Mr Stephen Beale, Global Trade Marks Counsel for the opponent. Mr Beale provides six further agreements, all of which are between the opponent and different third-party individuals/companies<sup>16</sup>. The agreements bear various dates in 2016 and 2017 and are all signed by both parties to the agreement. The most pertinent information in those agreements is as follows:

- Agreement dated 10 April 2017: The "Joint Business Plan Matrix" states that the activity of the third party is to "sell soft mix" and its objective is "to order Mr Whippy mix".<sup>17</sup>
- Agreement dated 16 March 2016: Under the heading "Detail" it states "To stock Mr Whippy at Charlies Beach Rd".<sup>18</sup>
- Agreement dated 31 May 2017: One of the objectives of the third-party is "To sell Mr Whippy in volume".<sup>19</sup>
- Agreement dated 16 March 2016: One of the objectives of the third-party is "To stock Mr Whippy soft mix" for a five-year period.<sup>20</sup>

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<sup>13</sup> Annex 1

<sup>14</sup> Annex 2

<sup>15</sup> Annex 3

<sup>16</sup> Exhibits SB-1 – SB -6

<sup>17</sup> Exhibit SB-1

<sup>18</sup> Exhibit SB-2

<sup>19</sup> Exhibit SB-3

<sup>20</sup> Exhibit SB-4

- Agreement dated 28 January 2017: One of the objectives of the third party is “to stock Mr Whippy”.<sup>21</sup>
- Agreement dated 07 February 2016: One of the objectives of the third-party is “To stock Mr Whippy” throughout a five-year period.<sup>22</sup>

19) Mr Beale provides a photograph, which he states was taken on 9 September 2017.<sup>23</sup> It shows an ice cream van at an outdoor event. Outside the van is a menu board entitled “Walls ice cream”, below which is a list of various ice cream products including ‘Magnum’, ‘Cornetto’ and ‘Mr Whippy 99 Single’ and “Mr Whippy 99 Double”.



Further images of menu boards listing Mr Whippy ice cream are also provided, although it is not explained when or where the photographs were taken.<sup>24</sup>

20) Mr Beale also provides a list of customers of Mr Whippy ice cream mix showing the last delivery dates of products to those customers. There is a column entitled

<sup>21</sup> Exhibit SB-5

<sup>22</sup> Exhibit SB-6

<sup>23</sup> Exhibit SB-7

<sup>24</sup> Exhibit SB-8

“Quantity” which appears to list the number of units sold to each customer and the date they were delivered. Some of those dates fall within the relevant period (from 01 Jan 2018 onwards).

## **DECISION**

### **Proof of use**

21) Section 6A of the Act states:

#### **“Raising of relative grounds in opposition proceedings in case of non-use**

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in

the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

22) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the onus is on the opponent to prove that genuine use was made of the earlier marks in the relevant period.

23) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at

[36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39];

*La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

24) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the period of five years ending on the date of publication of the contested mark. In the case before me, that period is 14 April 2013 to 13 April 2018.

### **Form of use**

25) The opponent’s earlier marks, as registered, are WHIPPY and MR. WHIPPY. The evidence of use before me shows use of MR. WHIPPY, either alone or with the opponent’s ‘heart’ and/or ‘Walls’ marks. I am satisfied that use of MR. WHIPPY in conjunction with the latter marks constitutes use of MR. WHIPPY per se, as per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

26) As there is no use before me of WHIPPY, I now need to consider whether use of MR. WHIPPY constitutes acceptable variant use of the registered mark WHIPPY. In

*Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the relevant test, as follows:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

The answer to the first question is MR. WHIPPY. Turning to the three limbs of the second question, the distinctive character of the registered mark is simply the word WHIPPY. The differences between MR. WHIPPY and WHIPPY are that the former includes the title MR and the latter does not. I find that this difference alters the distinctive character of the registered mark WHIPPY. This is because there is a distinctive conceptual difference between MR. WHIPPY and WHIPPY; the concept of the former is a man whose surname is WHIPPY, the latter has no such concept. Consequently, the opponent cannot rely upon use of MR. WHIPPY as use of the registered mark WHIPPY. The opposition based upon the earlier mark WHIPPY fails.

### **The MR. WHIPPY registration**

27) I now turn to consider whether the evidence before me is sufficient to show genuine use of the earlier registered mark MR. WHIPPY. The applicants submit that the evidence is insufficient to show genuine use of that mark in relation to the goods for which it is registered. At the hearing, Mr Hoole's main points were that:

- There is no evidence showing sales figures for ice cream *per se*. Rather the evidence shows sales of packs of ice cream mix which is a preparation for making ice cream and is not covered by the specification of the MR. WHIPPY registration.
- There is no evidence to show that ice cream mix sold to ice cream van operators was subsequently sold as ice cream under the mark MR WHIPPY. The opponent was at liberty to provide witness statements from those sellers attesting to the sale of ice cream under the mark MR. WHIPPY with the opponent's consent and the volume of those sales but has not done so.
- It is noted that a single pack of ice cream mix is capable of making approximately 20 ice creams but it is a dangerous assumption to find that the evidence of sales of packs of ice cream mix between 2015 and 2018 automatically equates to the sale of nearly 30 million actual ice creams over that period under the MR WHIPPY mark, as submitted by Mr Moss.
- The size of the ice cream market in the UK is enormous and therefore it is particularly important that the opponent should have provided evidence of sales of ice cream (*per se*) under the mark MR WHIPPY, to demonstrate that its use was warranted in that sector to create or preserve a market share.
- A number of the photographic exhibits are either undated or do not fall within the relevant period.

28) I remind myself that in *Awareness Limited v Plymouth City Council*<sup>25</sup>, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the

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<sup>25</sup> Case BL O/236/13

first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

It is not, therefore, essential to provide particular types of evidence, but the evidence must, when considered as a whole, show that the mark at issue has been put to genuine use within the UK.

29) It is clear to me that there has been genuine use in relation to ice cream mix, bearing in mind, in particular, the sales figures over the relevant period for such goods. However, I agree with Mr Hoole that the specification of the MR. WHIPPY mark, being ‘Class 30: Non-medicated confectionary, ices, ice cream, chocolates and sweetmeats’ does not cover ‘ice cream mix’. The latter is a ‘preparation for making ice cream’ rather than ice cream *per se*. I also do not consider that ‘ice cream mix’ falls within ‘confectionary’ or ‘sweetmeats’, the natural and core meanings of which are sweets, chocolate and candy. It also obviously does not fall within the term ‘chocolates’ or ‘ices’. It is therefore necessary to consider whether the use shown of MR.WHIPPY is also sufficient to show genuine use in relation to ice cream *per se* (there is clearly no use on any other kinds of goods falling within the earlier mark’s specification).

30) Mr Hoole has made valid criticisms of the opponent’s evidence of use, insofar as it purports to demonstrate genuine use in relation to ice cream *per se*, as referred to in the bullet points above. I am particularly mindful of the lack of any sales figures for ice cream (as opposed to sales of packs of ice cream mix) and that the size of the relevant market is significant. I also agree that it cannot be assumed that all the ice cream mix was subsequently sold as ice cream under the mark MR. WHIPPY, as contended by Mr Moss. However, I also bear in mind that it is not strictly necessary to exhibit any particular kind of documentation. Therefore, the absence of sales figures for ice cream *per se*, is not, of itself, fatal if, when considered overall, the evidence nevertheless paints a picture of the opponent having used the mark such as to create or preserve a share of the market. Further, while I note the various

cases referred to by Mr Hoole in his evidence and at the hearing<sup>26</sup>, every case must be determined on its own particular facts and circumstances.

31) The evidence before me shows a number of agreements within the relevant period with various third parties. They indicate that those third parties must stock and sell (exclusively) MR. WHIPPY ice cream in the soft serve category. While it is true that there is no evidence from those third parties attesting to sales of MR. WHIPPY branded ice cream, I am prepared to accept that those parties purchased mix from the opponent (or from the opponent's chosen wholesaler, which appears to be a condition stipulated in at least one of the agreements) to sell as ice cream under the mark MR. WHIPPY with the opponent's consent. The photographic evidence, whilst minimal (and some of which falls outside the relevant period or is undated), does show examples of use of MR. WHIPPY within the relevant period on menu boards for ice cream and the front of an ice cream van. Further, the photograph of the ice cream stall, although outside the relevant period, is under three months after the end of that period and therefore I consider it more probable than not that it was in operation within the relevant time. There is also the evidence of brochures which the opponent has circulated in the years within the relevant period to wholesalers, leisure parks, zoos etc. showing promotion of MR. WHIPPY ice cream and related point of sale materials (of the kind shown in use on the ice cream stall). Taking the evidence in round, and whilst recognising that it is not without deficiencies, I find that the mark MR. WHIPPY has, on the balance of probabilities, been put to genuine use by the opponent, or at least with its consent, in relation to ice cream within the relevant period.

32) I now turn to determine a fair specification having regard for the goods for which genuine has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

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<sup>26</sup> Annexes 2 and 3 to Mr Hoole's witness statement of 12 February 2019.

has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

33) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;  
*Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.*”

34) I find a fair specification to be ‘ice cream’ as genuine use has only been shown for that particular category of goods falling within the specification of the earlier mark. I will assess the ground under section 5(2)(b) on that basis.

### **Section 5(2)(b)**

35) Section 5(2)(b) of the Act states:

“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.”

36) The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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 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 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**

37) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”), Case C-39/97, 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.”

38) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

39) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

40) I also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd (Avnet)* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

41) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, where the GC held:

“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 *Vedial 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).”

42) The goods and services to be compared are:

Opponent's goods	Applicant's goods
<p><b>Class 30:</b> Ice cream.</p>	<p><b>Class 30:</b> Coffee; tea; cocoa; sugar; rice; tapioca; sago; coffee products; confectionery containing milk; bakery and confectionery products; bread; pastries; flour and preparations made from cereals; honey; yeast; baking powder; salt and mustard; vinegar; sauces; spices; ices; edible ices; ice cream; ice cream cones; water ices; frozen confectionery; ice; snacks; preparations for making the aforesaid goods, in so far as not included in</p>

	<p>other classes.</p> <p><b>Class 43:</b> Services for providing food and drink; temporary accommodation services; snackbar services; ice cream parlour services; catering; restaurant services; bar services; juice bar services.</p>
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43) I will begin with the applicant's goods in class 30, grouping items together where it is appropriate to do so.

Confectionery containing milk; confectionery products; ices; edible ices; ice cream; water ices; frozen confectionery; ice

44) I find that the goods set out above are either self-evidently identical to the opponent's 'ice cream', identical on the *Meric* principle or highly similar to the opponent's 'ice cream' given that the nature of the contested goods is likely to be highly similar and that they are likely to share trade channels and be in competition.

Bakery products; pastries; snacks; ice cream cones; preparations made from cereals

45) The nature of the applicant's goods is not the same as ice cream. However, they may both be purchased as a treat/dessert and therefore there may be an element of competition. The applicant's 'preparations made from cereals' would also cover the self-standing term 'ice cream cones' which are, for obvious reasons, complementary to the opponent's goods in such a way that the average consumer is likely to believe they come from the same undertaking. I find a low degree of similarity between the applicant's goods listed above and the opponent's 'ice cream'.

sauces;

46) The applicant's 'sauces' would include 'sauces for ice cream'. Although the nature of the respective goods is not the same, there is a complementary

relationship between them and the trade channels are likely to be the same with the respective goods found in close proximity. On that basis, I find a low degree of similarity between the applicant's 'sauces' and the opponent's 'ice cream'.

Bread; rice; Salt and mustard; vinegar; spices; sugar; honey; Coffee; tea; cocoa; coffee products; Tapioca; sago; flour; yeast; baking powder

47) At the hearing, Mr Moss submitted that the goods listed above are similar to the opponent's goods because they are all foodstuffs. I do not consider that this factor alone renders the respective goods similar. The users of the respective goods are the same (the general public). However, the nature of the above goods is very different to 'ice cream'. They do not strike me as being complementary (in the sense described in the case law) to 'ice cream' and they are unlikely to be in competition. I would also not expect the respective goods to be found in close proximity in a retail outlet, for example. I find no similarity between the applicant's goods listed above and the opponent's 'ice cream'.

preparations for making the aforesaid goods, in so far as not included in other classes.

48) My findings above, regarding the similarity of the 'aforesaid goods' with the opponent's goods applies equally to the preparations for making those goods, as appropriate.

49) I now turn to the applicant's services in class 43.

Services for providing food and drink; ice cream parlour services; restaurant services; catering; snack bar services

50) The services listed above cover those which may provide ice cream to the consumer or a similar alternative. The respective users are the same, there is a degree of complementarity in play, particularly between the applicant's 'ice cream parlour services' and the opponent's goods. There may also be an element of competition with a consumer choosing between purchasing an ice cream from a shop (for example) or using the applicant's services to obtain an ice cream or similar

such foodstuff. I find a low degree of similarity between the applicant's services listed above and the opponent's 'ice cream'.

#### bar services; juice bar services

51) The natural and core meaning of the applicant's 'bar services' is an establishment that serves drinks (primarily alcoholic) and 'Juice bar services' are those which serve juice. Whilst I acknowledge that a bar/juice bar may also serve snacks such as crisps or peanuts for example, I do not consider, bearing in mind the guidance in *Avnet*, there to be any real overlap in terms of nature, methods of use or intended purpose. The respective distribution channels are also not the same and I cannot see any meaningful competitive or complementary relationship in play. I find no similarity between the applicant's services listed above and the opponent's 'ice cream'.

#### temporary accommodation services

52) The core purpose of temporary accommodation services is to provide a place to stay. The purpose of 'ice cream' is to satiate hunger or simply to be consumed as a treat. The respective natures and methods of use differ and they are clearly not in competition. Neither can I see any relevant complementary relationship or overlap in distribution channels. There is no similarity between the applicant's services above and the opponent's 'ice cream'.

#### **Average consumer and the purchasing process**

53) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

54) The average consumer for the respective goods and services at issue is the general public. Their cost is likely to vary. Many of the goods and services, such as ice cream and snack bar services, may be the subject of an impulse purchase. Others, such as restaurant services, may attract a higher degree of attention. The level of attention therefore ranges from low to medium. The goods and services are likely to be sought out visually on the high street, on ice cream vans or on websites and so I would expect the purchase to be mainly visual. However, aural considerations are also borne in mind.

### **Comparison of marks**

55) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, 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*, that:

“.....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.”

It would therefore be wrong to artificially dissect the 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 created by the marks.

56) The marks to be compared are:

Opponent's mark	Applicants' mark
<p>MR. WHIPPY</p>	

57) The opponent's mark consists of MR. WHIPPY in plain block capitals. The overall impression lies in the mark, as a whole, with no one part having greater dominance of the other. The applicant's mark consists of more than one element. The man holding an ice cream cone (with a chocolate flake) in front of a blue and pink circular background is striking upon the eye and takes up a large proportion of the mark. The words Mr Whippy, which although presented in different sizes of font, will naturally be read through together because they form a name. That name also makes an important contribution to the mark's overall impression. The word 'ice cream' is presented in a subordinate position and is much smaller than the other elements of the mark; it is also entirely descriptive for at least some of the applicant's goods. I find that the image of the man and the words Mr Whippy have the greatest (and roughly equal) weight in the mark's overall impression with the word 'ice cream' carrying far less weight.

58) Visually, the point of coincidence between the marks is the shared words Mr. Whippy. However, the stylisation of those words in the applicant's mark is absent from the opponent's mark, where they are presented in plain letters. In all other respects, the marks are visually different. I find a low to medium degree of visual

similarity overall. Aurally, I find that the parties' marks will be pronounced in an identical fashion given that the image of the man in the applicant's mark and the word 'ice cream' is unlikely to be vocalised. Even if the latter were to be articulated, there would still be a high degree of aural similarity. Conceptually, both marks convey the message of an individual named Mr Whippy. The image in the applicant's mark merely serves to reinforce that conceptual message. The word 'ice cream' is entirely descriptive for at least some of the applicant's goods. I find the marks to be conceptually highly similar, if not identical.

### **Distinctive character of the earlier mark**

59) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

60) In terms of inherent distinctiveness, the opponent’s mark, consisting of the name MR. WHIPPY does not describe any characteristic of the goods and neither is it, in my view, allusive. I find it to be possessed of a normal degree of distinctiveness.

61) I now turn to the question of whether the distinctiveness of MR. WHIPPY has been enhanced through use. The evidence filed by the opponent, whilst sufficient to show genuine use in relation to ice cream, does not show that the distinctiveness of the mark has been enhanced through the use made of it in relation to those goods.

### **Likelihood of confusion**

62) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

63) There can be no likelihood of confusion in respect of the applicant’s goods and services which I have found share no similarity with the opponent’s ‘ice cream’. The opposition therefore fails in relation to:

Class 30: Coffee; tea; cocoa; sugar; rice; tapioca; sago; coffee products; bread; flour; honey; yeast; baking powder; salt and mustard; vinegar; spices; preparations for making the aforesaid goods, in so far as not included in other classes.

Class 43: Temporary accommodation services; bar services; juice bar services.

64) I now turn to assess the likelihood of confusion between the remainder of the applicant's goods and services which I have found to be identical, highly similar or similar to a low degree to the opponent's goods. I have also found that the respective marks are visually similar to a low to medium degree and aurally and conceptually highly similar, if not identical. Bearing these factors in mind, together with the normal degree of distinctiveness of the earlier mark, I find that the average consumer, whether paying a low or medium degree of attention, is unlikely to mistake one mark for the other. However, I do consider that they are likely to believe the respective goods and services come from the same or linked undertaking(s), even in relation to those goods and services which are similar only to a low degree. There is a likelihood of indirect confusion. **The claim under section 5(2)(b) of the Act partially succeeds.**

## **OUTCOME**

65) The opposition succeeds in relation to the following goods and services:

**Class 30:** confectionery containing milk; bakery and confectionery products; pastries; preparations made from cereals; sauces; ices; edible ices; ice cream; ice cream cones; water ices; frozen confectionery; ice; snacks; preparations for making the aforesaid goods, in so far as not included in other classes.

**Class 43:** Services for providing food and drink; snackbar services; ice cream parlour services; catering; restaurant services.

66) The opposition fails in relation to the following goods and services, which may proceed to registration:

**Class 30:** Coffee; tea; cocoa; sugar; rice; tapioca; sago; coffee products; bread; flour; honey; yeast; baking powder; salt and mustard; vinegar; spices; preparations for making the aforesaid goods, in so far as not included in other classes.

**Class 43:** Temporary accommodation services; bar services; juice bar services.

67) As both parties have had a reasonable degree of success, I decline to favour either party with an award of costs.

**Dated this 11<sup>th</sup> day of November 2019**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**