

O-365-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2462925  
BY DAVID HALEWOOD AND ANNE-LYDIA HALEWOOD  
TO REGISTER IN CLASS 25 THE TRADE MARK:**

**ICE SCREAM**

**AND**

**IN THE MATTER OF OPPOSITION NO 96351 BY  
BBC ICE CREAM, LLC**

## **TRADE MARKS ACT 1994**

**In the matter of application No 2462925  
by David Halewood and Anne-Lydia Halewood  
to register in class 25 the trade mark ICE SCREAM**

**and**

**In the matter of opposition No 96351 by  
BBC Ice Cream, LLC**

### **Background**

1. Mr David Halewood and Mrs Ann-Lydia Halewood (“the Halewoods”) applied for the trade mark ICE SCREAM on 1 August 2007. Registration is sought for “clothing, footwear, headgear” in class 25 of the Nice classification system<sup>1</sup>.

2. On 19 March 2008 opposition to the registration of the Halewoods’ application was made by BBC Ice Cream, LLC (“BBC”) under sections 5(1), 5(2)(a) & 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was also initially pleaded under sections 5(3) & 5(4)(a) of the Act but BBC subsequently withdrew its opposition on these grounds. BBC rely on three of its trade marks<sup>2</sup> as the basis for its opposition, each of which consists of the words ICE CREAM (one of them is stylised) and each of which include goods (which I will detail later) in class 25.

3. All three of BBC’s marks have dates of filing prior to that of the Halewoods’ application and, therefore, they constitute earlier trade marks as defined in section 6(1) of the Act. I also note that the earlier marks have yet to be registered; there are two consequences of this. Firstly, the proof of use provisions contained in section 6A<sup>3</sup> of the Act do not apply, meaning that the earlier marks may be taken into account in these proceedings for their current specifications. Secondly, even if I were to find in favour of BBC, my decision must be provisional until such a time that at least one of the earlier marks becomes registered.

4. The Halewoods filed a counterstatement denying the grounds of opposition. Both sides filed evidence, this is summarised below. Neither side requested a hearing. BBC filed written submissions. The Halewoods did not file any written submissions, however, I will take into account their comments made in their counterstatement.

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<sup>2</sup> UK application 2355496, Community trade mark 3317369 and Community Trade Mark 4122677

<sup>3</sup> Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

## **BBC's evidence**

### Witness statement of Abida Rifat Chaudri

5. Ms Chaudri is employed by Davenport Lyons who, at the point in time when the evidence was given, had conduct of these proceedings on behalf of BBC. She includes three exhibits to her witness statement the details of which are:

ARC1 – This consists of three documents:

- 1) A *Google* results page for the words *ice cream* (searching the web rather than UK pages) which produced over 85 million hits. Ms Chaudri states that at the bottom of the first page of results there is an entry which reads “Searches related to: **ice cream**” and that two of the related searches read “ice cream **shoes**” & “ice cream **trainers**”. I note, however, that Ms Chaudri is partly wrong here because there is no text reading “ice cream **trainers**”. There is, though, a reference to “ice cream **sneakers**”.
- 2) A *Google* results page for the words *ice cream trainers* (searching the web rather than UK pages) which produced over 3.6 million hits. Ms Chaudri says that this was obtained from clicking the link in the search above. This could not, of course, be correct because there was no link to “ice cream **trainers**”. In any event, the search results identify a number of websites selling ice cream brand trainers.
- 3) A *Google* results page for the words *ice cream shoes* (again searching the web rather than UK pages) which produced over 700k hits. Ms Chaudri says that this was obtained from clicking the link in the search at 1 above. The search results identify a number of websites selling ice cream brand shoes/trainers/sneakers.
- 4) A *Google* results page for the words *ice cream and clothing* (searching the web rather than UK pages) which produced over 8 million hits. The search results identify a number of websites selling ice cream brand clothing/sneakers and I also note that the brand has something to do with a person called Pharrel Williams and that BBC appears to stand for “Billionaire Boys Club”.

ARC2 – This consists of a number of press extracts which Ms Chaudri states were obtained from a press search against what Ms Chaudri identifies the:

“...term “ice cream” and (“billionaire boys club” or “pharrell williams” or nigo or “tomoaki nagao”).”

The results show press articles from 2003-2008. The publications include New Musical Express, Daily Star, The Daily Telegraph, The Mirror, The Evening Standard, The Observer, The Times, Just-Style, WENN Entertainment News Wire Service, AFX-Asia, AFX International Focus, AFX.COM, The Press Association Ireland, Irish News, ZDNET UK, Marketing Week, Brand Strategy, Marketing, Design Week. There are frequent references to the trade mark ICE CREAM and that it is associated with Pharrell Williams. Mr Williams is a rap artist. ICE CREAM seems to be the brand used on footwear whereas Billionaire Boys Club is used on the whole range of clothing. The range was co-developed with a Japanese artist called Nigo. The footwear appears to have been manufactured by Reebok under some form of license agreement.

ARC3 - This consists of some prints from BBC's website. It shows the addresses of various BBC stockists in major cities of the UK. It also shows various goods, but I note that the descriptions all refer to BBC (even the footwear) and not ICE CREAM. I note, however, that ICE CREAM is used on the banner at the top of the website.

### **The Halewoods' evidence**

#### **Witness statement of Steven Jennings**

6. Mr Jennings works for Lewis Silkin LLP, the Halewoods' representatives in this matter. He conducted his own *Google* search for *ice cream* and notes that his results differ from those of Ms Chaudri in that his had no entry for *ice cream trainers*. Mr Jennings states that this is to do with the way that *Google* learns from previous searches conducted on an individual's computer and, therefore, that Ms Chaudri (who he assumes will have previously searched for her client's goods) will have a report more closely matched to her client's goods. He does note, however, that his own search revealed the website of *Billionaire Boys Club – Ice Cream*.

7. In relation to BBC's business, Mr Jennings highlights text from BBC's website. I will not repeat it in full here, but Mr Jennings highlights the cost of various items of clothing (a t-shirt costing \$80, a western shirt at \$230, a hoodie at \$225, jeans at \$395 and a pair of shorts at \$165). He suggests that BBC's consumer base must have a generous budget and must be opinionated on design and fashion. He adds that with warnings about fakes and imitations ringing in their ears, the consumer will be discriminating. The rest of the evidence is submission (including a submission that BBC dropped its claim to its marks possessing a highly distinctive character) rather than evidence of fact. I will not summarise it further here but will, of course, take it into account.

## **BBC's reply evidence**

### Witness statement of Simon William Tracey

8. Mr Tracey works for Mishon de Reya, the new representatives of BBC. He previously worked for Davenport Lyons. He corrects Mr Jennings' view that BBC's claim to its marks having a highly distinctive character has been dropped. He states that all that was withdrawn was its opposition under sections 5(3) and 5(4) of the Act. He responds to Mr Jennings' claim that BBC is an elitist brand by stating that there is no evidence to support this. He highlights that BBC's website states:

“BBC and Ice Cream's customer base is largely male, between 16-30. However the clientele is very diverse, from college students to corporate executives.”

9. He states that the above comes from the “about” icon on BBC's web site. It is shown in Exhibit SWT2.

### Second witness statement of Abida Rifat Chaudri

10. This was actually filed as Exhibit SWT1 of Mr Tracey's evidence. Mr Tracey instructed Ms Chaudri to produce the evidence whilst he was still working for Davenport Lyons.

11. Ms Chaudri states that another *Google* search was conducted on a colleague's computer who has never worked for BBC. She states that very similar results to her search were obtained (the results are shown in Exhibit ARC4). She cannot explain the differences produced by Mr Jennings' search. She also repeats Mr Tracey's comment that BBC has not withdrawn its claim to its marks possessing a highly distinctive character.

### **The section 5(2)(b) ground of opposition**

12. Although there are grounds under sections 5(1) & 5(2)(a), I intend to consider the position firstly in relation to section 5(2)(b) of the Act. If BBC cannot succeed here then it is difficult to see how it can be in any better position under section 5(1) & 5(2)(a) of the Act. Section 5(2)(b) 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.”

13. When reaching my decision, I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably: *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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). The above judgments set out the primary principles to be applied in matters such as these; I will refer to them, if and when relevant, in more detail later in this decision.

### ***The average consumer and the purchasing act***

14. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) I will begin with an assessment of who this is.

15. Both sets of goods cover items of clothing. These are not specialist or niche products. They are general consumer items purchased by the public at large. The case-law informs me that the average consumer is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Whilst it is true that clothing purchases are often made on the basis of the brand alone (or at least that this is a primary motivating factor), such goods are not, generally speaking, of the highest degree of expenditure (although cost will, of course, vary item to item). Furthermore, attention will be paid not just to the brand itself, but also to the style, size, colour, intended purpose etc. of the actual item of clothing. All of this, it seems to me,

creates a degree of purchasing care and attention that is neither low (such as low cost casual purchases) nor high (such as costly and specialised purchases).

16. I note that the Halewoods' evidence (given by Mr Jennings) is that BBC's actual goods are high cost items of clothing and, therefore, this means that its consumers will be opinionated on fashion and discriminating in choice. BBC dispute this, its evidence is that its customer base is diverse. However, BBC also submit that its actual customer base is irrelevant as matters must be assessed notionally. BBC is correct on this. Whether BBC's marketing strategy is to target the wealthy and fashion conscious may or may not be true. However, matters must be assessed on a notional and objective manner, not reflective of a particular marketing strategy which may only be temporary<sup>4</sup> (and which, in any event, is not reflected in the specifications).

17. In terms of the purchasing act, the goods are ones which, routinely, will be self-selected from a shelf, online, or from a catalogue, so making this, primarily, a visual act of purchase<sup>5</sup>. This means, potentially, that any degree of visual similarity/dissimilarity may play a more significant role in the assessment of a likelihood of confusion than aural similarity/dissimilarity. This does not mean, however, that aural similarity should be ignored completely; it is still a relevant factor that needs to be considered in the global appreciation of whether there exists a likelihood of confusion<sup>6</sup>.

### ***Comparison of the goods***

18. The Halewoods seek registration for:

“Clothing, footwear; headgear”.

19. All of BBC's earlier marks include the terms:

“Clothing”, “footwear”, “headwear”.

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<sup>4</sup> See, for example, the judgment of the Court of First Instance (“CFI”) in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03*.

<sup>5</sup> See, for example, the judgment of the CFI in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* - Joined cases T- 117/03 to T-119/03 and T-171/03, and the decision of Simon Thorley QC, sitting as the appointed person, in *React Trade Mark* [2000] R.P.C. 285.

<sup>6</sup> See the decision of Amanda Michaels (sitting as the Appointed Person) in *The Outdoor Group Limited* (BL-O-131-09) and the judgments referred to therein, namely: *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R.58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303.

20. As can be seen from the very similar terminology used, the goods are, self evidently, identical. There is no dispute between the parties on this.

### ***Comparison of the marks***

21. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). The marks to be compared are:

**BBC's mark:** ICE CREAM

**The Halewoods' mark:** ICE SCREAM

22. In terms of visual similarity, the Halewoods concede (in their counterstatement) that there may be some degree of similarity between the marks. BBC put it stronger than that, highlighting that both marks are of two words and two syllables, that the first word in both is identical and that in relation to the respective second words, CREAM is encompassed within SCREAM and that the letter S is somewhat lost.

23. I begin my assessment by observing that neither the word ICE or CREAM/SCREAM has greater prominence or impact in the respective marks, be it from a visual perspective or when they are spoken/heard. Furthermore, I agree with the assessment that BBC has made of visual similarity in terms of the clear points of similarity identified. The letter S in the Halewoods' mark does, though, create a difference. Nevertheless, balancing the similarities with this one point of difference, the impact on the eye points towards their still being a good deal of visual similarity.

24. In terms of aural similarity, the Halewoods say (in their counterstatement) that the marks are phonetically dissimilar but say nothing to explain their view. BBC, on the other hand, argue that the two words in each of the marks, when pronounced, will be run together so meaning that the words ICE and SCREAM will be pronounced without pause and which results in it sounding identical to ICE CREAM.

25. I agree with BBC to the extent that if the words ICE and SCREAM were pronounced with little or no pause between them then this will produce an overall sound that is virtually indistinguishable from the sound produced by the words ICE CREAM. However, if the words ICE and SCREAM were spoken with a more deliberative oral delivery then it could no longer be said that the words were virtually indistinguishable from ICE CREAM, although, it strikes me that the sound and intonation produced will still be reasonably similar. The question must be assessed on the basis of an average consumer. Whilst they are reasonably circumspect, it strikes me that to undertake such a deliberative oral delivery of



the mark in question is unrealistic and would not reflect the manner in which the mark will be spoken in the course of trade. Therefore, I believe that the former of the two propositions is likely and this creates a degree of aural similarity which is of the highest order.

26. Conceptual similarity and its importance in the overall assessment of a likelihood of confusion has been dealt with in the jurisprudence on a number of occasions. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the CFI<sup>7</sup> stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

27. In terms of conceptual similarity, BBC highlight that both marks contain the word ICE and, therefore, there is an element of conceptual similarity on this basis alone. It further argues that ICE CREAM as a whole has a meaning (a frozen dessert) and that ICE SCREAM may be seen as a play on words with this. The Halewoods say there is no conceptual similarity.

28. There is no conceptual similarity based purely on the common presence of the word ICE. The average consumer perceives a mark as a whole and will not break the marks down into individual conceptual components. BBC’s mark as a whole has a conceptual meaning capable of immediate grasp by the average consumer. As BBC says, it relates to a frozen dessert. In relation to the Halewoods’ ICE SCREAM mark, the words, taken literally, do not combine to

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<sup>7</sup> The Court of First Instance of the European Communities.

create a concept as a whole. However, I am conscious that a mark may still create a concept in the mind of the average consumer on the basis of evocation or suggestion<sup>8</sup>. This is a case in point. In my view, although the words ICE SCREAM have no literal meaning in combination, it will nevertheless be suggestive or evocative to the average consumer of ice cream. Such obvious points of similarity (as discussed above) together with no literal and dissonant meaning to point in the other direction, will lead to the view that the mark ICE SCREAM is, effectively, a play on words for ice cream. Although the average consumer will not analyse in detail the intention of the trader responsible for the goods, it seems to me that this is what the average consumer will believe is being got at and the message that they are intended to take, albeit a dual message because the words are not literally ice cream. Whilst this does not create conceptual identity, there is a degree of similarity rather than dissonance.

29. The concept of the ICE SCREAM mark as identified above has a further impact. This is because the mark will be seen as a single phrase rather than as two individual components that happen to be presented next to one another. This is important given the judgment of the ECJ in *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04).

30. Before leaving the issue of mark similarity, it should be noted that one of the three marks on which BBC rely is stylised thus:



31. In terms of specific analysis against this mark, the aural and conceptual assessments are the same. In terms of visual similarity, whilst the presentation of the above mark creates an additional point of difference, it does nothing to disguise the fact that the mark is made up of the words ICE CREAM and, in my view, there is still a good deal of visual similarity with the Halewoods' ICE SCREAM mark.

#### ***Distinctive character of the earlier trade marks***

32. The distinctiveness of the earlier marks is another factor to consider because the more distinctive they are (based either on inherent qualities or because of the use made of them), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The Halewoods' argue (in its evidence from Mr Jennings) that BBC has dropped any claim to its marks being highly distinctive. BBC dispute this. Having examined the correspondence on the official file, there is nothing to suggest that BBC no longer claim to have a highly distinctive earlier mark. BBC dropped its claims under sections 5(3) and 5(4) which require

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<sup>8</sup> See, for example, the decision of the CFI in *Usinor SA v OHIM* (Case T-189/05).

evidence of a reputation and goodwill respectively, however, they said nothing about the earlier mark for the purpose of the remaining grounds of opposition.

33. From an inherent distinctiveness point of view, BBC say that its marks are highly distinctive. The Halewoods highlight in their counterstatement that ICE is a popular word used in trade marks and that this is a weak element of the mark. Whilst I will come back to this point when determining whether there exists a likelihood of confusion, the fact that ICE may or may not be an element weak in distinctive character has little bearing on distinctiveness here. This is because the marks as a whole must be considered and the marks are ones with a distinct meaning. The words ICE CREAM have no relationship with clothing. The words are neither suggestive nor evocative. I see no reason other than to accord them with a reasonably high degree of distinctive character.

34. In terms of the use made of the earlier marks, BBC's evidence consists of *Google* searches, press exposure (mainly editorial in nature) and details of its website (and UK stockists). There is no evidence of the scale of use in terms of sales quantum, neither is there evidence as to how it advertises and promotes its goods in the traditional sense and how much it spends on doing so. The scale and significance of use is, therefore, difficult to gauge. Whilst the *Google* results show that the brand is used, I note that the searches were not limited to UK websites and, inevitably, it includes overseas use. Furthermore, only the first few pages of results are provided and the websites underpinning them are not given in evidence. The *Google* evidence does not advance matters in favour of BBC, and in view of this, there is little point in addressing the alternative *Google* search detailed in Mr Jennings' evidence. BBC's evidence also includes a number of articles that have appeared in the UK press (including nationals), however, the degree to which such articles will concentrate the reader on the ICE CREAM name and the consequent extent to which it will be remembered is unclear, particularly as some of these articles relate more to the person behind the brand (Pharrel Williams) rather than to the brand itself (even if the brand is also mentioned). Evidence of the existence of a website and inclusion of UK stockists is indicative of actual trade, but, again, its significance and extent is not clear.

35. In the absence of evidence such as sales and advertising, the remaining evidence does not persuade me that the average consumer of clothing in the UK (from whose perspective these matters must be judged) will know of the ICE CREAM brand. The mark, though, as stated earlier, is reasonably high in distinctiveness based on its inherent qualities.

### ***Likelihood of confusion***

36. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

37. One of the factors highlighted by the Halewoods in their evidence is the nature of BBC's customers and goods. It says they are elitist. However, in line with my earlier finding regarding the average consumer (see paragraph 16) this argument has little weight. They also say that ICE is an element of low distinctiveness and commonality, the argument being, presumably, that the average consumer is used to differentiating between various ice based marks. There are a number of problems with this argument. Firstly, the only support for the proposition of commonality is that in their counterstatement they say that there are 126 pending/registered marks on the register. This does not, however, show what is happening in the marketplace and, thus, this state of the register evidence is, essentially, irrelevant<sup>9</sup>. The other problem is that, in any event, the marks as a whole, as I have already found, have a good deal of visual similarity and a very high degree of aural similarity. It does not, therefore, strike me as being particularly relevant that the element ICE may be common because the overall impressions of the marks are so similar.

38. There is a good deal of visual similarity and a very strong degree of aural similarity. The marks are not conceptually identical, but there is a degree of similarity. The respective goods are identical. The earlier mark is reasonably high in distinctiveness. I must bear in mind the concept of imperfect recollection which relates to the fact that consumers rarely have the chance to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she may have kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.*). Whilst brand awareness in relation to clothing is a factor to consider, I do not consider that this mitigates completely against the potential effects of imperfect recollection. Imperfect recollection is an important factor here because even though the marks are not conceptually identical, there is a similarity based on, as I have already found, ICE SCREAM being evocative of ice cream. Therefore, if ice cream forms part of the conceptual hook of ICE SCREAM, a consumer encountering, subsequently, the ICE CREAM mark, may simply assume, based on an imperfect recollection, that they are one and the same.

39. This, in itself, is sufficient for a likelihood of confusion. However, the case is strengthened by the fact that the aural degree of similarity is so high that aural

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<sup>9</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] R.P.C. 281.

confusion is almost inevitable. Furthermore, the degree of visual similarity is reasonably high which means that the average consumer, during his or her purchasing process, may not even spot the difference between the respective marks. All of these factors lead to a likelihood of confusion. The ground of opposition under section 5(2)(b) succeeds.

40. Given the above finding, there is no need to address the grounds of opposition under sections 5(1) or 5(2)(a).

#### **Provisional decision and appeals**

41. As mentioned in paragraph 3, the earlier marks of BBC are not yet registered. This decision is, therefore, provisional until such a time that BBC's earlier marks (or at least one of them) secures registration for the relevant goods.

42. I direct that BBC advise me within one month of the registration of any of the three earlier marks. If none secure registration, BBC must advise me within one month of their final determination. On receipt of this information, a supplementary decision will be issued giving a final determination of the subject proceedings and making an award of costs.

**Dated this 23<sup>rd</sup> day of November 2009**

**Oliver Morris  
For the Registrar  
The Comptroller-General**