

O/215/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2542029 BY MIKE WOODS
TO REGISTER IN CLASSES 29 & 30 THE TRADE MARKS:**



just love
food company



just love
food company



AND

OPPOSITION THERETO (NO 100841) BY FOX'S CONFECTIONERY LIMITED

The background and the pleadings

1) On 15 March 2010 Mr Mike Woods filed application 2542029 for the series of four marks depicted on the front page of this decision. The differences between the four marks he applied for makes no real difference to the assessments that I will come to make¹ so, throughout this decision, I will refer to Mr Woods' mark in the singular and will make my assessments on the basis of the following mark which is depicted below, together with the goods for which Mr Woods seeks registration:



Class 29: Prepared meals including chilled and frozen ready meals; ready meals made from fish, meat, poultry, vegetables and /or tofu, frozen cooked meats; meat; fish; poultry; game; soups; all the aforementioned which are nut and gluten-free or substantially nut and gluten-free, all included in Class 29.

Class 30: Flour and preparations made from cereals; bread; sandwiches; prepared meats; pizzas; pies; pasta dishes; bread; pastry; confectionery; cakes including chocolate cakes, cream cakes, sponge cakes, tea cakes, birthday cakes, gift cakes, cup cakes, muffins, tray-bakes, whole cakes, carrot cakes, flapjacks, cake bars, and cheesecakes; sponge puddings; fruit pies; biscuits including biscuits decorated for celebratory events such as birthdays; preparations for making cakes; pastries including Danish pastries, chocolate pastries and fruit pastries; desserts including patisserie desserts, frozen desserts, ice cream, ice cream birthday cakes; ice cream products including dairy ice cream and non-dairy ice cream; all the aforementioned for individuals with special dietary needs; all the aforementioned which are nut and gluten-free or substantially nut and gluten-free, all included in Class 30.

Mr Woods' application was published in the Trade Marks Journal on 14 May 2010.

2) Fox's Confectionery Limited ("Fox") opposes the registration of Mr Woods' mark in respect of all the goods set out above. The opposition is made under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The earlier marks relied upon under sections 5(2)(b) and 5(3) are:

¹ Particularly given that colour in the applied for mark cannot act as a distinguishing feature if the earlier mark is registered without regard to colour – see *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and, also, the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

- i) UK registration 2203866 for the mark: JUST
- ii) Community trade mark (“CTM”) registration 3684834 for the mark: JUST
- iii) CTM registration 4592556 for the mark: JUST BRAZILS
- iv) UK registration 2203869 for the mark: JUST BRAZILS
- v) UK registration 2423467 for the mark: JUST STRAWBERRIES

3) Given their dates of filing, all of the above constitute earlier marks compared to Mr Woods’ mark. Marks i) and iv) are subject to the requirement to prove that they have been genuinely used, the other marks are not, with the consequence that they may be taken into account for their specifications as registered. Under section 5(4)(a) Fox relies on the use of the signs: JUST, JUST BRAZILS and JUST STRAWBERRIES. It is noted that as well as relying on its marks individually, Fox also refers to the existence of a family of marks.

4) Mr Woods filed a counterstatement denying the grounds of opposition. In essence, he does not believe that the common presence of the word JUST will cause confusion. He states that many businesses use the word JUST. Mr Woods did not ask Fox to provide proof of genuine use in respect of marks i) and iv) with the consequence that these earlier marks may be considered on the basis of their specifications as registered (Fox’s statement of use was that the marks have been used for all of their goods).

5) Fox filed evidence, Mr Wood did not. He did, though, file a letter which contained a) submissions (which I will bear in mind), b) references to other companies using the word JUST and c) a reference to him testing whether there exists a likelihood of confusion with 112 people. Mr Woods was advised that this did not constitute evidence because it was not in evidential form². Mr Woods attempted to resubmit the materials as evidence but it was not only filed out of time, but it was still not in evidential form because it did not contain a statement of truth. Even if the material could be considered, the reference to the “testing” of 112 people would have told me little without understanding the full methodology of what is, essentially, a survey. Furthermore, the evidence of others using the word JUST consisted of a print showing a number of different brands that use this word, there is little in this to explain to the tribunal the degree to which these marks exist in the marketplace and the subsequent impact on the average consumer.

6) Neither side requested a hearing so I make this decision on the basis of the evidence and submissions before me.

Fox’s evidence

7) This comes from Ms Jane James, Fox’s Managing Director. Her evidence contains submissions which I will bear in mind but will not summarise here. In

² The requirements for filing evidence are set out in Rule 64(1) of the Trade Mark Rules 2008.

terms of evidence of fact, she focuses on the use that Fox has made of its marks. I note the following statements/evidence:

- i) That the marks JUST and JUST BRAZILS (which began life as PAYNES JUST BRAZILS) have been used for several decades. It is added that the JUST mark has more recently been used in its own right (as well as in combination with JUST BRAZILS). This means that it can only be the JUST BRAZILS mark which has been used for several decades.
- ii) JUST BRAZILS are a chocolate covered brazil nut confection. It is stated that JUST is used on a wider range of confectionery such as chocolate covered strawberries, almonds and mints.
- iii) Packaging is provided of the JUST and JUST BRAZILS products. There is a picture of Paynes Just Brazils, Just ® Strawberries (Just is presented on a contrasting coloured background). In terms of the JUST mark (which I assume Ms James means to be the product with the words Just ® Strawberries) there is an internal tray which features the word JUST.
- iv) Turnover of both JUST and JUST BRAZILS was £2.7 million in 2009. Figures for 2010 and 2011 are provided but such figures fall, predominantly, after the relevant date.
- v) A market research company (Nielsen) has provided Ms James with information that Fox has a 34% market share of the chocolate covered nuts and raisins market under the JUST and JUST BRAZILS marks.
- vi) Exhibit JJ4 contains a selection of internal company presentations relating to marketing strategies etc. Confidentiality has been granted in respect of this exhibit so I will not disclose any of the contents here. The majority of the material relates to JUST BRAZILS. Ms James highlights the word JUST being emphasized in its different product varieties.
- vii) Promotional expenditure has ranged between £45k in 2005/2006 to £80k in 2009/2010.
- viii) Exhibit JJ5 contains press articles from various publications (which I accept are high profile) which are said to feature JUST and JUST BRAZILS; they all relate to the JUST BRAZILS product.
- ix) Reference is made to a youtube video said to demonstrate that since 1980 the phrase “Just because you love them” has been associated with the JUST brands. It is stated that, therefore, the words JUST and LOVE (words that also appear in Mr Woods’ mark) have been used by Fox. Ms James invited me to view the video on the Internet rather than supply the video. I have not done so. If a party wishes evidence to be considered it must be put properly before the tribunal. Ms James says the phrase is mentioned in the material in Exhibits JJ4 & JJ5; I could not find it in the material before me.

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

8) 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.”

9) 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."

10) Some of the issues require little analysis. In terms of the goods, Mr Woods' seeks registration for a wide range of food products, one of which is confectionery. All of the earlier marks cover confectionery and, therefore, identical goods are in play. I will focus, to begin with, on these identical goods. If Fox do not succeed on this basis then it will be in no better position in respect of the other goods it opposes; if Fox do succeed on this basis then I will return to consider the position in respect of Mr Woods' other goods. In terms of the average consumer, the case-law informs me that such a person 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 can, however, vary depending on the particular goods in question (see, for example, the judgment of the General Court "GC" in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Confectionery is a general consumer product. The selection of such goods is not undertaken with a high degree of consideration, indeed they are one of the more casual purchases a consumer will make; the consequence of this is that the propensity for the average consumer to be confused due to imperfectly recalling marks is increased. That then leads to a comparison of the marks which are:



JUST
JUST BRAZILS
JUST STRAWBERRIES

11) 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

12) Mr Woods' mark is made up of the words "just love" with the letter o of love represented by a heart, together with the words "food company" below in smaller script. The words are in a cursive script. "food company", on account of its position, size and descriptive connotations, will not be regarded as a dominant component of the mark. It is dominated by the just love element and, although I will not ignore the figurative aspects, the words themselves will take on much more focus. JUST LOVE will be seen as a single phrase not separating into individual components. In terms of Fox's marks, the JUST mark has only one component so is its dominant and distinctive element. In terms of JUST BRAZILS and JUST STRAWBERRIES, even though brazils and strawberries describe characteristics of the goods, it is still a whole phrase, suggesting that the contents are only made from brazil nuts or strawberries.

13) In comparison to Mr Woods' mark, the closest earlier mark is JUST solus. The word JUST is included in both marks which creates a degree of visual and aural similarity. There are, though, obvious differences resulting from the additional aspects of Mr Woods' mark. Furthermore, JUST LOVE in Mr Woods' mark stands as a single phrase – the word just qualifies the word love – it does not perform an independent role in the mark. I consider that the differences in Mr Woods' mark are unlikely to be overlooked and have the capacity to play a significant distinguishing role. The degree of visual and aural similarity is, therefore, of only a low degree. In terms of concept, the word JUST alone means various things including merely, simply or honorably. In terms of JUST LOVE, the word JUST is tied to the word LOVE to create a phrase, the concept of which encourages love i.e., do nothing else, just love. Compared to the word JUST alone this, to my mind, creates a conceptual difference.

14) Similar observations apply to the comparison with the JUST BRAZILS and JUST STRAWBERRIES marks. Indeed, due to the additional (and different elements) BRAZILS and STAWBERRIES, the degree of similarity with Mr Woods' mark is even lower.

15) It is clear that all 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. The factors assessed in paragraph 10 are more in favour of Fox than Mr Woods. However, I have assessed the degree of similarity between the marks to be low. I must bear in mind, though, that a low degree of similarity between the marks can be counteracted by a high (in this case identical) degree of similarity between the goods.

16) Another factor that must be borne in mind is the distinctiveness of the earlier marks. From an inherent perspective, I consider JUST to be an averagely distinctive mark – the word JUST is not qualifying anything so it is not suggestive in any way, but nor is it highly distinctive as per an invented word. However, the marks JUST BRAZILS and JUST STRAWBERRIES are inherently low in distinctiveness due to the clear suggestive connotations they possess. In terms of the use presented, I am prepared to accept that JUST BRAZILS is a very well known mark entitled to a high degree of distinctiveness. However, the same cannot be said of JUST alone or JUST STRAWBERRIES. The evidence lacks detail as to these more “recent” introductions and the proportion of the sales figures which relate to them. The press articles relate to JUST BRAZILS not the other marks, and none of this material really emphasizes, in my view, JUST solus. This also impacts on the family of marks claim³. With such paucity of evidence I cannot accept that Fox has used its family of marks to the extent required so as to have had any material impact on the average consumer (beyond them knowing of the JUST BRAZILS mark).

17) Taking all of the relevant factors forward, I come to the conclusion that there is no likelihood of confusion with any of the earlier marks. In terms of direct confusion (mistaking one mark for the other) the differences between the marks are more than sufficient for the average consumer to distinguish between them. This is particular so in view of the word JUST not playing an independent role in Mr Woods' mark. I must also consider the possibility of indirect confusion (the same stable argument) but in my view the consumer will put the common presence of the word JUST down to co-incidence and not economic connection. They will regard the use of the word JUST in Mr Woods' mark as the use of a common English word as part of a longer phrase and not as indicating a

³ Having a used family of marks mark is a factor which may lead to a likelihood of confusion – see the CJEU's judgment in *Il Ponte Finanziaria SpA v OHIM* Case C- 234/06.

connection with the JUST BRAZILS mark or the JUST mark alone. I should add that I would have come to the same conclusions even if the JUST mark had been used more and even if the family of marks claim stood up. It is not as though Mr Woods' mark is made up of the word JUST together with the name of a food product, it creates a different concept altogether. **There is no likelihood of confusion and, so, the opposition under this ground fails.**

Other grounds of opposition

18) Given my views on the likelihood of confusion I do not see that Fox is in any better position under section 5(4)(a) of the Act. There would be no misrepresentation for the same reasons as why there would be no confusion. The opposition, therefore, fails under section 5(4)(a) of the Act.

19) In respect of section 5(3), and even accepting that Fox have a reputation at least in respect of JUST BRAZILS, it would still be necessary for the relevant public to make a link⁴ between the marks. Despite the strong reputation of JUST BRAZILS and the identical goods in play, I do not believe that the degree of similarity between the marks is sufficient for the earlier mark to be brought to mind. The opposition fails under section 5(3) of the Act.

Costs

20) Mr Woods has been successful and is entitled to a contribution towards his costs. When assessing his costs I have borne in mind that he was not professionally represented (at least when the activities relevant to the scale of costs took place) and, therefore, will not have incurred legal fees. I hereby order Fox's Confectionery Limited to pay Mr Mike Woods the sum of £350. This sum is calculated as follows:

Preparing a statement and considering the other side's statements -£150
Considering evidence and filing submissions- £300

⁴ As explained by the CJEU in *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07)

21) 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 30th day of May 2012

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