

O-117-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2570659

BY

NICHOLAS DYNES GRACEY

TO REGISTER THE TRADE MARKS (A SERIES OF TWO):

KICK ASS

KICKASS

AND

THE OPPOSITION TO THE CLASS 30 GOODS

UNDER NO 102606

BY

LEO JOHNSON

1) On 31 January 2011 Nicholas Dynes Gracey filed an application for the registration of the trade marks KICK ASS and KICKASS (the trade marks) in twelve classes. The application was published, for opposition purposes, on 5 August 2011.

2) Leo Johnson filed a notice of opposition to the registration. As per letters of 24 August 2012 and 19 September 2012, Mr Johnson's opposition is limited to the class 30 goods of the application, namely:

coffee; other caffeine containing beverages; teas and beverages made from leaves & bark.

3) Mr Johnson bases his opposition on sections 5(1), 5(2)(a), and 5(2)(b) of the Trade Marks Act 1994 (the Act), which state:

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(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.

He relies upon United Kingdom registration no 2466170 of the trade mark KICK ASS. The application for registration was filed on 7 September 2007 and the registration procedure was completed on 8 February 2008. The trade mark is registered for:

coffee; coffee as a beverage; coffee-based beverages; coffee beans; ground coffee.

The above goods are in class 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4) Mr Dynes Gracey filed a counterstatement in which he accepted coffee in the earlier registration was identical to coffee in his application. He made no other concessions and denied the grounds of opposition¹.

5) Only Mr Johnson filed evidence. A hearing was held on 8 March 2013. Mr Johnson was represented by Joel Barry of Olswang LLP.

6) Mr Dynes Gracey was notified on 22 January 2013 that a hearing would take place at 09.30 on 8 March 2013. At 11.15 on 7 February 2013 the Intellectual Property Office (IPO) sent an e-mail to Mr Dynes Gracey confirming the scheduling of the hearing. At 09.11 on 8 March 2013 Mr Dynes Gracey responded to this e-mail advising that a form TM16, assigning the trade mark, was attached. In his e-mail Mr Dynes Gracey wrote:

“Laura, hi, [urgent please] attached please find a 2-page tm16 in relation to KICKASS tm 2570659 and you should expect to receive a signed copy from Appleyard Lees today. Please arrange for an appropriate adjournment of the scheduled hearings in respect of OPP102606 [today @ 0930] & OPP102620. A copy of this email has been forwarded to Olswang. Warm-thanks; Nick.”

On receipt of the e-mail the IPO telephoned Appleyard Lees and asked to speak to Mr Moy, who is identified on the form as the person to contact. Mr Moy could not be found by the telephonist and so a message was left with him to contact the IPO.

7) Mr Barry was at the office of the IPO in London. He advised that he had just received a copy of the e-mail. He was asked if he wished to continue with the hearing. He advised that he did. Mr Barry commented that it was to be assumed that when assigning the trade mark, the assignee would have been advised of any proceedings in relation to it. He also noted that if the assignee wished to continue with the proceedings it would need to agree to be bound by any costs award and to stand by the position of the applicant.

8) The form was not signed by the new applicant or his representative, as required in box 9(b). No fee was attached to the form and at 09.30 no hard copy with fee sheet had been given to me; form TM16 is a fee bearing form. Under rule 4(2) of the Trade Marks Rules 2008:

“(2) Any form required to be filed with the registrar in respect of any specified matter shall be subject to the payment of the fee (if any) prescribed in respect of that matter by those rules.”

¹ The grounds of opposition initially also included an attack on goods in classes 5, 10, 32 and 33.

Rule 2(2) of the Trade Marks (Fees) Rules 2008 states:

“(2) In any case where a form specified in the Schedule as the corresponding form in relation to any matter is specified in the 2008 Rules, that form shall be accompanied by the fee specified in respect of that matter (unless the 2008 Rules otherwise provide).”

The form received by e-mail was not accompanied by the fee. Until the fee was paid the form could have no effect. No assignment documentation was attached to the e-mail. The form had not been assigned by proposed/future proprietor. Consequently, at the time of the hearing Mr Dynes Gracey has to be considered the proprietor of the application, and the relevant party in relation to any costs award. Even if this were not the case, without any undertaking by the future/proposed proprietor, Mr Dynes Gracey would still be liable for any costs award.

9) Mr Dynes Gracey knew of the date of the hearing. As he was assigning the trade mark, it is expected that he would have advised the potential owner of the trade mark of the date of the hearing. (The details of the hearing were published on the IPO website and the status of the application on the IPO database is “opposition outstanding”.) Owing to the notice given by Mr Dynes Gracey it would have been inappropriate and disproportionate to vacate the hearing; the timing of the assignment was a matter for the assignor and assignee, there is no issue of force majeure. If Mr Dynes Gracey had decided not to attend the hearing, the future/proposed proprietor could have attended the hearing and made the appropriate undertakings in relation to costs and substantiation of the assignment. If Mr Dynes Gracey were no longer the owner of the trade mark, he was not in a position to request the vacation of the hearing.

10) It was not appropriate to vacate the hearing on the basis requested by Mr Dynes Gracey. (Although Mr Dynes Gracey is a litigant in person he is by no means an ingénue in proceedings before the registrar. The data base of the IPO shows a large number of cases in which Mr Dynes Gracey has been involved from at least 1998.)

Evidence for Mr Johnson

11) This consists of a witness statement made by Elana Rosenfield on 23 August 2012. Ms Rosenfield is the Chief Executive Officer of Kicking Horse Coffee Ltd, which is the exclusive licensee of the KICK ASS trade mark of Mr Johnson.

12) Ms Rosenfield comments upon Kicking Horse’s business in the United States of America and Canada. She claims that Mr Johnson’s trade mark has gained a valuable reputation in the United Kingdom on the following basis:

- 137 “units” had been sold in the United Kingdom between July 2005 and July 2012. There is no explanation of what a unit is.
- Kicking Horse has a website which between August 2007 and August 2012 had over 2,700 visits from the United Kingdom. There is no indication as to if these were unique visits, what led to the visit or how long the visit lasted.
- Kicking Horse has worked “with International Food Shows” and has “actively solicited United Kingdom businesses, for example Harrods”.

The evidence of Ms Rosenfield most signally fails to establish any “valuable reputation” in the United Kingdom for the KICK ASS brand. Mr Johnson cannot rely upon any enhanced distinctiveness through use.

13) Ms Rosenfield states that “[y]ou only need to look at Starbucks to see how coffee brands can sell and move into other soft beverages”. She exhibits pages from the United Kingdom website of Starbucks, downloaded on 18 September 2012 (after the date of application). There is no evidence to draw the conclusion that Starbucks is typical of the industry.

14) The evidence of Ms Rosenfield is without any merit and has no effect upon this decision.

Comparison of trade marks

15) The upper mark in the series is identical to the trade mark of Mr Johnson. In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the CJEU considered when trade marks are identical. It stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

The lower mark of the series conjoins the words KICK and ASS. The visual, aural and conceptual effect is not in anyway changed. It is not uncommon for certain phrases or words to be written as one word or two eg trade mark and trademark. The differences in the lower trade mark are so insignificant that that they may go unnoticed by an average consumer for the goods of the application and the earlier registration. **Both trade marks of the application are identical to the trade mark of Mr Johnson.**

Average consumer, nature of purchasing decision and standard for likelihood of confusion

16) The average consumer and the purchasing process are analysed as they affect the likelihood of confusion where there are differences between trade marks eg small differences may have a significant effect where the goods or services are purchased as a result of a particularly careful and educated purchasing decision. As the respective trade marks are identical, nothing can turn upon the nature of the average consumer and the purchasing process; he or she has nothing with which to distinguish the trade marks.

Comparison of goods

17) Coffee is rehearsed in both specifications, these goods are identical. In relation to coffee it must be found that registration of the trade marks would be contrary to section 5(1) of the Act as the goods and the trade marks are identical.

18) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of tradeⁱ”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaningⁱⁱ. Consideration should be given as to how the average consumer would view the goodsⁱⁱⁱ. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

The class of the goods in which they are placed may be relevant in determining the nature of the goods^{iv}. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^v. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vi}.

19) All of the goods of the application are beverages. They are beverages which will be non-alcoholic and can all be drunk hot. Consequently, they have the same nature as the goods of the earlier trade mark. It is common for teas, coffees and other infusions to be sold on adjacent shelves in supermarkets. In coffee chains it is common for coffee and other infusions to be sold. The respective goods could have the same channels of trade. The end consumers of the respective goods are those who want a non-alcoholic beverage, they are the same end users. It is commonplace to offer people a choice between tea and

coffee. In coffee chains there is a choice of competing infusions. The respective goods are in competition with one another. The respective goods are all used to slake the thirst. They have the same purpose. The respective goods will be drunk in the same scenarios; around the tea table, watching the television, at the desk etc. **The respective goods have a high degree of similarity.**

Conclusion in relation to section 5(2)(a)

20) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{vii}. In this case the respective trade marks are identical. Owing to this identity there is nothing to allow the average consumer to distinguish the respective trade marks. The respective goods are highly similar. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{viii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{ix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^x. KICK ASS is neither allusive nor descriptive of the goods. It is an unusual trade mark that stands out. The trade mark of Mr Johnson enjoys a good deal of inherent distinctiveness. **In relation to the non-identical goods, there is a likelihood of confusion.**

21) In the event that it is considered that the lower mark of the series is not identical to the trade mark of Mr Johnson, the trade marks are so similar that a finding in favour of Mr Johnson under section 5(2)(b) would have been made in relation to the lower mark of the series.

22) The class 30 specification of the application is to be refused in its entirety.

Costs

23) A joint hearing took place on 22 May 2012 in relation to the late filing of form TM8 (the defence). At the hearing, the defence was allowed owing to an incorrect date having been given by the IPO in relation to the filing of the form TM8. As a consequence, the joint hearing became a case management conference for the management of the proceedings. It would not be appropriate to award costs in relation to this hearing to either party.

24) The evidence for Mr Johnson was without any merit and so no award of costs will be made in relation to it.

25) Mr Johnson having been successful is entitled to a contribution towards his costs. Costs are awarded upon the following basis:

Opposition fee:	£200
Preparing a statement and considering the other side's statement:	£300
Preparation for and attendance at the hearing:	£300
Total:	£800

Nicholas Dynes Gracey is to pay Leo Johnson the sum of £800. This sum is to 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 13th day of March 2103

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{iv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^v *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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.”

^{vii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{viii} *Sabel BV v Puma AG* Case C-251/95.

^{ix} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^x *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.