

O-576-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3128046 BY
LITTLE BEANS COFFEE LIMITED TO REGISTER**



AS A TRADE MARK IN CLASSES 7, 11, 16, 21, 30 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 405530 BY
LITTLE BEANS & CO LIMITED**

BACKGROUND

1. On 22 September 2015, Little Beans Coffee Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for a range of goods and services in classes 7, 11, 16, 21, 30 and 43. The application was published for opposition purposes on 23 October 2015. The specifications in classes 30 and 43 were as follows:

Class 30 - Coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; Coffee in whole-bean form; Coffee based drinks; Coffee essence; Coffee flavourings; Coffee in brewed form; Coffee in ground form; Coffee, tea, cocoa and artificial coffee; Coffee [roasted, powdered, granulated, or in drinks]; Coffee (unroasted-).

Class 43 - Restaurant services; Restaurants; Restaurants (self-service-); Restaurants (Self-service -); Restaurant information services; Restaurant reservation services; Restaurant services; Carvery restaurant services; Fast food restaurant services.

2. The application is opposed in classes 30 and 43 by Little Beans & Co Limited (“the opponent”) under section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is based upon the goods and services (shown below) in the following United Kingdom trade mark registration:

No. 3078687 for the trade mark shown below which was applied for on 25 October 2014 and entered in the register on 6 February 2015:



Class 30 - Birthday cake; beverages made of coffee; prepared coffee and coffee-based beverages; beverages based on coffee; coffee based drinks; coffee flavourings; artificial coffee; coffee based fillings; coffee in brewed form; coffee in ground form; coffee, tea, cocoa and artificial coffee.

Class 43 - Provision of food & beverages.

In its Notice of opposition, the opponent states:

“After looking at their website, www.little-beans.co.uk, they are clearly a very similar business to ours, offering similar goods and services. Putting aside the fact that their name is exactly the same as ours, they are also within 10 miles of our Chorleywood store. We have already experienced confusion from our customers thinking we our (sic) associated with Little Beans Coffee. We feel this is extremely damaging to our brand name and our company image.”

3. The applicant filed a counterstatement in which the basis of the opposition is denied. It states:

“Both the companies have different legal names, different logo and different websites. Even their clients are different as the opponent is advertising them (sic) as a bespoke play farm for young children whereas the applicant is advertising as a standard coffee. So we believe that their clients are different and there is no chance of clients getting confused or mix up both the companies between them.

Opponent is advertising on their website that they are not a standard café - “We are not your standard coffee house...” Whereas the applicant is advertising themselves as a coffee shops in the UK...”

4. Neither party is professionally represented. Only the applicant filed evidence. No hearing was sought nor did either party file written submissions in lieu of attendance at a hearing.

The applicant’s evidence

5. This consists of a witness statement from Irfan Awan; Mr Awan does not state the position he holds at the applicant nor does he indicate that he is authorised to speak on the applicant’s behalf. Notwithstanding those omissions, attached to Mr Awan’s statement (as exhibits L, M and N), are pages downloaded from, inter alia, the competing parties’ websites, filed in support of the comments contained in the counterstatement. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, in which the Court of Justice of the European Union (“CJEU”) stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

6. For the above reasons, the applicant’s evidence is of no assistance to it in these proceedings.

DECISION

7. Although the opposition is based solely upon section 5(2)(a) of the Act, in an effort to explain to the unrepresented parties in these proceedings the legal framework of which section 5(2)(a) is part, I have also included below the provisions of sections 5(1) and 5(2)(b) of the Act. The provisions read as follows:

“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.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years when the application was published, it was not necessary for the opponent to provide use of its earlier trade mark.

10. In the normal course of events, I would now go on and compare the goods and services in the competing specifications to determine whether they were identical, similar or different, identify the average consumer of the goods and services at issue and the nature of the purchasing process, and having compared the competing trade marks and assessed the degree of distinctiveness the opponent’s earlier trade mark possessed, determine whether there was a likelihood of confusion. However, for reasons which will shortly become obvious, it is not necessary for me to adopt this approach.

Comparison of trade marks

11. As one can see from the legal framework I have included above, the purpose of section 5(1) of the Act is to prevent the registration of **identical** trade marks for **identical** goods and/or services, whereas the purpose of 5(2)(a) of the Act (which is being relied upon in these proceedings), is to prevent the registration of **identical** trade marks for **similar** goods and/or services; the use of the word “identical” in both sections 5(1) and 5(2)(a) is important and is a point to which I will return shortly. Finally, section

5(2)(b) of the Act prevents the registration of **similar** trade marks for **identical and/or similar** goods and services. With the above in mind, the competing trade marks are as follows:

The opponent's trade mark	The applicant's trade mark
	

12. The applicant seeks registration for a trade mark which consists of what, in my view, is a fairly unremarkable device of a mug containing a hot beverage (presented in varying shades of brown), below which appears the words “Little Beans” presented in title case in a cursive script in dark brown and in which the “L” of the word “Little” is stylised.

13. The opponent's trade mark also contains the words “Little Beans” presented in title case in a cursive script in brown. Following these words is an ampersand and the letters “Co” presented in the same colour brown; the letters “Co” would be readily understood as an abbreviation for the word “Company”. The opponent's trade mark contains another component; this is a device of four anthropomorphized coffee beans (presented in red, dark brown, light brown and green). As the coffee beans are of varying sizes and as the green coffee bean is wearing a napkin, it suggests that the device is intended to represent a family unit.

14. As I mentioned above, in its Notice of opposition, the opponent stated:

“Putting aside the fact that their name is exactly the same as ours...”

While I accept that the competing trade marks contain either the words “Little Beans” or a component which, despite the stylisation of the letter “L” would be understood as the words “Little Beans” presented in title case in brown, there are a number of important differences i.e. the mug device and the stylised letter “L” in the applicant’s trade mark and the ampersand, abbreviation “Co” and the device element which appears in the opponent’s trade mark.

15. Having identified the various differences between the competing trade marks, I remind myself that in order for section 5(2)(a) of the Act to apply the competing trade marks must be “identical”. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU commented on what constitutes an identical trade mark. The Court concluded:

“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.”

16. As the various differences between the competing trade marks I have described are significant within the context of the trade marks as a whole, I have no hesitation concluding that they will be noticed by the average consumer i.e. a member of the general public. As a consequence, the trade marks at issue are not identical. As the provisions of section 5(2)(a) of the Act are cumulative i.e. the trade marks must be identical before, inter alia, an assessment of the goods and services is necessary and as there is no other ground relied upon by the opponent, the opposition fails at the first hurdle and is dismissed accordingly.

Conclusion

17. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

18. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. As both parties are unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate whether they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed “no costs will be awarded”. Only the applicant responded to that invitation.

19. The applicant indicated that it spent a total of nine hours dealing with the matter. This was split as follows: “Notice of Opposition” one hour, “Notice of Cancellation” two hours, “Notice of Defence” four hours and “Considering forms filed by the other party” two hours. It claims £1080 in respect of these activities. The applicant makes no specific claim in respect of the preparation of its evidence which, as mentioned at paragraph six above, would not have assisted it and for which I would have made no award even if one had been sought. There are, I note, no “other expenses” claimed. As the applicant did not file a Notice of Opposition or Cancellation, the time said to have been spent in relation to these activities appears to have been entered in error. That leaves either the four hours in relation to its Notice of Defence and two hours in relation to its consideration of the Notice of Opposition to consider or, more likely, nine hours in total in relation to all its activities in relation to the opposition.

20. As an unrepresented party, I accept it was necessary for the applicant to familiarise itself with the Notice of Opposition and having done so, to research the position and to formulate an appropriate response; as this is likely to have taken the applicant some time, a claim in respect of six (rather than nine hours) is not, in my view, unreasonable. The applicant's request for an award of costs of £1080 in respect of the nine hours claimed amounts to an hourly rate of £120; the applicant has, however, provided no explanation of how it arrived at this figure and, absent such an explanation, I do not consider it can be justified. Assuming that figure had been explained, in relation to the six hours of work I consider to be justified, it would have amounted to £720. That would, however, be significantly above the figure suggested in the TPN mentioned above, which states that in respect of its consideration of a Notice of Opposition and the filing of its defence, a professionally represented applicant is likely, depending on the nature of the statements, for example, their complexity and relevance, to be entitled to an award between £200 and £600.

21. Taking the best view I can of the matter given: (i) the apparent errors which appeared in the costs pro-forma, (ii) the lack of explanation of an hourly rate of £120, (iii) the nature of the Notice of Opposition and the applicant's defence to it and (iv) making no award in respect of its evidence, I award costs to the applicant in the amount of £108 i.e. 6hrs x £18, the latter being the minimum level of compensation for litigants in person in The Litigants in Person (Costs and Expenses) Act 1975.

22. I order Little Beans & Co Limited to pay to Little Beans Coffee Limited the sum of **£108**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

23. Finally, I note that although the opposition was based solely upon Section 5(2)(a) of the Act (attracting a fee of £100), the opponent incorrectly paid £200. The Tribunal will arrange a refund of £100 in due course.

Dated this 7th day of December 2016

A handwritten signature in black ink, appearing to be 'C J Bowen', written in a cursive style.

C J BOWEN

For the Registrar