

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

UK Trade Mark Application No. 00004308936  
in classes 30 and 35  
in the name of Andrew Baker (“**the Applicant**”)

-and –

Opposition thereto by Busy Limited (“**the Opponent**”)  
under No. OP698231

---

**APPLICANT’S SKELETON ARGUMENT**

---

**Introduction**

1. On 10 February 2020 the Applicant applied to register UK Trade Mark Application No. 00004308936 (the “**Application**”) for the mark BUSY BAKER (the “**Opposed Trade Mark**”) in classes 30 and 35.
2. The Application was published on 10 March 2020 for the following goods and services:

**Class 30:** *Cakes; chocolate; chocolate sculptures.*

**Class 35:** *Mail order services relating to cakes, chocolates and chocolate sculptures.*

3. On 10 April 2020 a Notice of Opposition was filed by the Opponent. No Notice of Threatened Opposition was filed and no approach was made by the Opponent to the Applicant in advance of the filing of the Notice of Opposition.
4. The Opposition was initially brought solely on the basis of s5(2)(b) of the Trade Marks Act 1994 (the “**Act**”), with the Opponent relying on UK Trade Mark Registration No. 00004308936 for the word mark BUSY covering “café services” in class 43 (the “**Earlier Trade Mark**”).
5. Following a CMC a claim of bad faith under s3(6) of the Act was also admitted into the Opposition.
6. The Application is opposed in full and both grounds of opposition are directed against the entirety of the specification covered by the Application, as set out at paragraph 2 above.

7. Both parties filed evidence in these proceedings. The Applicant relies on the witness statement of Mr Andrew Baker dated 15 August 2020 whilst the Opponent relies on the witness statement of Amanda Sills, director and co-founder of the Opponent dated 1 August 2020. The evidence relates to the s3(6) ground so shall be considered in that context.

### **Section 5(2)(b): likelihood of confusion**

8. Section 5(2)(b) of the Act states that:

*“A trade mark shall not be registered if because—*

*(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. The law on section 5(2) and the likelihood of confusion is well known to the Registry and is not rehearsed in this skeleton.

### **Comparison of marks**

10. The marks to be compared are as follows:

The Earlier Trade Mark	The Opposed Trade Mark
<b>BUSY</b>	<b>BUSY BAKER</b>

11. Whilst the inclusion of the element BUSY within the Opposed Trade Mark leads to some similarity between the marks this is a low level of similarity at best.
12. Visually the Earlier Trade Mark consists of a single word composed of four letters, whilst the Opposed Trade Mark consists of two words and contains a total of nine letters. These visual differences would not go unnoticed by the relevant average consumer. Therefore, the marks can be said to be visually similar to a low degree at best.
13. There are also clear aural differences between the marks BUSY and BUSY BAKER. Whilst the BUSY element in both marks will have the same pronunciation the inclusion of a second, longer, element within the Opposed Trade mark results in clear aural differences between the marks. The alliteration between the two elements contained within the Opposed Trade Mark further distinguishes this mark from the

Earlier Trade Mark meaning that, at most, the marks can be said to be aurally similar to a low degree.

14. There are very clear conceptual differences between the marks at issue.
15. BUSY can be both an adjective and a verb and has a number of meanings as is clear from the Collins Online Dictionary.

<https://www.collinsdictionary.com/dictionary/english/busy>

1. **ADJECTIVE** [oft ADJ v-ing]: When you are **busy**, you are working hard or concentrating on a task, so that you are not free to do anything else.
2. **ADJECTIVE** [usually ADJECTIVE noun]: A **busy** time is a period of time during which you have a lot of things to do.
3. **ADJECTIVE** [verb-link ADJECTIVE, oft ADJ -ing]: If you say that someone is **busy** thinking or worrying about something, you mean that it is taking all their attention, often to such an extent that they are unable to think about anything else.
4. **VERB**: If you **busy yourself** with something, you occupy yourself by dealing with it.
5. **ADJECTIVE**: A **busy** place is full of people who are doing things or moving about.
6. **ADJECTIVE** [usually verb-link ADJECTIVE]: When a telephone line is **busy**, you cannot make your call because the line is already being used by someone else.

16. BAKER is predominantly used as a noun, as can also be seen from the Collins Online Dictionary.

<https://www.collinsdictionary.com/dictionary/english/baker>

### 1. COUNTABLE NOUN

A **baker** is a person whose job is to bake and sell bread, pastries, and cakes.

### 2. COUNTABLE NOUN

A **baker** or a **baker's** is a shop where bread and cakes are sold.

17. The Opposed Trade Mark consists of the combination of elements BUSY and BAKER, to form the mark BUSY BAKER. The conceptual meaning conveyed by this mark is one of a person whose job is a baker, and who is busy. Alternatively, it could be seen to refer to a particular type of establishment (i.e. a bakery) that is busy. In either case a clear conceptual meaning is conveyed.

18. The conceptual meaning conveyed by the Earlier Trade Mark is much more abstract in nature. When used in relation to café services this mark is likely to be deemed to refer to the nature of the target consumers – i.e. those who are busy and who do not have time to prepare food or drinks for themselves. This is a very different concept to that conveyed by the Opposed Trade Mark, in which the person who is “busy” is the provider of the goods and services, rather than their target consumer.

### ***Comparison of goods and services***

19. The goods and services to be compared are as follows:

<b>Services covered by the Earlier Trade Mark</b>	<b>Goods/services covered by the Application</b>
Class 43: Café services	Class 30: Cakes; chocolate; chocolate sculptures.
	Class 35: Mail order services relating to cakes, chocolates and chocolate sculptures.

20. When assessing the similarity of goods and/or services, all relevant factors relating to those goods and/or services should be taken into account. As set out by the CJEU in Canon<sup>1</sup>:

*“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”.*

21. Considering firstly the class 30 goods covered by the Application, these goods can all be classified as “sweets” that are purchased as a treat or to form part of a celebration. Cakes and chocolate sculptures, in particular, can be extremely elaborate and expensive, and are likely to be purchased following careful consideration. Café services, by contrast, are services that exist to satisfy the daily needs of consumers, by providing food and beverages. Whilst such establishments may sell cakes and/or chocolate they do not typically offer for sale chocolate sculptures, and they do not typically only offer chocolate and/or cakes. Indeed, cafes are traditionally associated primarily with the provision of coffee and tea, with the word “café” itself being derived from the French word for “coffee”.

---

<sup>1</sup> C-39/97

22. The class 30 goods “cakes; chocolate” covered by the Opposed Application are therefore similar to the class 43 services covered by the Earlier Trade Mark to a low degree at most. The goods “chocolate sculptures” are dissimilar to the class 43 services covered by the Earlier Trade Mark.
23. Turning to the class 35 services covered by the Application, namely “mail order services relating to cakes, chocolates and chocolate sculptures”, it is clear that these services are dissimilar to the class 43 services covered by the Earlier Trade Mark. Such mail order services are typically used when cakes, chocolates and chocolate sculptures are required for a party or celebration, or where they are being provided as a gift. By contrast, café services are used by consumers who are in immediate need of refreshments in the form of beverages and/or food. Therefore, the class 35 services covered by the Application are clearly dissimilar to the class 43 services covered by the Earlier Trade Mark.

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

24. Likelihood of confusion is a key requirement for a case to succeed under s5(2)(b). In the present instance, it is submitted that even if the marks are deemed similar and there is found to be similarity between the goods and services at issue the case should still fail as there is no likelihood of consumer confusion.
25. The likelihood of confusion must be appreciated globally, taking account of all relevant factors, including the level of distinctiveness of the earlier rights. The assessment is carried out through the eyes of the average consumer of the goods and services at issue.

### **The average consumer**

26. The services covered by the Earlier Trade mark are aimed at and used by the general public. The goods and services covered by the Opposed Trade Mark are also largely aimed at and used by the general public. However, some of the goods and services in question, namely “cakes” and “chocolate sculptures” in class 30 and “mail order services relating to cakes...and chocolate sculptures” are also often aimed at and purchased by a more specialist public, namely event or wedding planners who may be seeking out such goods for large scale events.
27. The level of attention paid by the general public will be average, whilst the level of attention paid by the specialist public will be average to high.

### **Distinctiveness of the Earlier Trade Mark**

28. The Earlier Trade Mark consists wholly of the term BUSY, which is a known word in the English language that is typically used in a descriptive sense.

29. This mark enjoys a low level of inherent distinctive character in relation to the goods covered by the Earlier Trade Mark, and the Opponent has not provided any indication that it enjoys an enhanced distinctive character.

#### Assessment of likelihood of confusion

30. There is a low level of similarity, at best, between the marks at issue here. As regards the class 30 goods there is some arguable (low level) similarity between “cakes; chocolate” and the services covered the Earlier Trade Mark. However, the class 30 goods “chocolate sculptures” and the class 35 services covered by the Application are dissimilar to the services covered by the Earlier Trade Mark.
31. Taking account of these facts, as well as the fact that the average consumer normally perceives a mark as a whole, the fact that the Earlier Trade Mark enjoys a low level of distinctive character, and that the relevant average consumer in this instance will pay at least an average level of attention (and in some instances a high level of attention) it is clear that there is no likelihood of consumer confusion here in relation to any of the goods and services concerned.

#### **Section 3(6): bad faith**

32. Section 3(6) of the Act states that:

*“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”*

33. The key principles relating to trade mark applications made in bad faith can be found in the following cases of which the Registry is aware: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C- 22 371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch). 38)
34. An allegation of bad faith is a serious allegation which must be distinctly proved. It is presumed that a person acted in good faith unless the contrary is proved. In deciding whether bad faith is proved, the usual civil evidence standard applies (i.e. balance of probability). It is not enough to establish facts which are also consistent with good faith.<sup>2</sup>

---

<sup>2</sup> Red Bull

35. Bad faith includes dishonesty, but also “*some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined*”.<sup>3</sup>
36. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case.<sup>4</sup>
37. This assessment requires consideration of both objective and subjective factors. The applicant’s intention at the time of filing the application is relevant, but it is a subjective factor which must be considered with reference to the objective circumstances of the particular case.<sup>5</sup>
38. In applying the relevant criteria to the facts of the present case it is apparent that the requirements for a finding of bad faith are not met here. This is a simple case of two parties deciding upon the same name, and one (the Applicant) filing a trade mark application before the other was at the stage in their planning to even carry out a trade mark clearance search.
39. The Opponent claims that the Applicant had knowledge of their intended use of the mark BUSY BAKER as the name of a proposed range of products such as cakes and sandwiches. Whilst it is true that the Applicant took part in the Opponent’s mini-poll, in which they sought views on the potential name BUSY BAKER, at this point the Opponent itself did not “know” whether it would proceed further with this name – the point of the poll was to assess views on this potential name. At most, the Applicant was aware that this name was a potential being considered by the Opponent, nothing more. The mere fact that the Opponent thought they might use the mark and that the Applicant knew about this potential use does not establish bad faith.<sup>6</sup>
40. Whilst Amanda Stills makes reference to having had discussions with their regulars “since around September 2019” it appears that such discussions were around the viability of the concept of expanding their commercial offering<sup>7</sup>. No indication is provided that there was any discussion with such customers regarding potential names, and it appears that the name was first mentioned to customers by way of the mini-poll, which was not run until February 2020.
41. It is not clear how long the poll went on for and/or whether the results of the poll were announced to the Opponent’s customers, and no indication has been given by Ms Stills that the poll had closed or that a final decision had been taken on pursuing the name BUSY BAKER as a serious option in advance of the filing date of the Application (i.e. the relevant date for considering bad faith).

---

<sup>3</sup> Daawat

<sup>4</sup> Lindt

<sup>5</sup> Lindt

<sup>6</sup> Lindt, Koton (para 55)

<sup>7</sup> Paragraph 7 of the witness statement of Amanda Stills

42. It is clear from the witness statement of Andrew Baker that the Applicant reasonably believed he was entitled to file the Application. He has provided the Registry with his reasons for choosing the mark BUSY BAKER and shown his genuine intention to use that mark in relation to the goods and services covered by the Application.<sup>8</sup>
43. Mr Baker has for many years created elaborate cakes for his children and for friends. He has recently been considering quitting his day job and starting up a bespoke business. Mr Baker independently came up with the name BUSY BAKER, as a clever play on his name and lifestyle. This happened before the Opponent ran its survey – i.e. before Mr Baker had any idea that the Opponent may potentially be considering making use of the name BUSY BAKER.
44. In filing the Application the Applicant was in no way acting in a dishonest manner, nor did his behavior fall short of the standards of acceptable commercial behavior, judged by ordinary standards of honest people.<sup>9</sup>
45. The Applicant is a hard-working individual with a keen interest in baking. He is a long-standing customer at the Opponent's café and has been supportive of their plans to expand their commercial offering. He has not tried to extract payment from the Opponent or gain an advantage. Considering the "friendly and chatty" relationship that the Applicant had developed with the Opponent<sup>10</sup>, he is extremely upset and distressed that they have made an allegation of bad faith against him.
46. Whilst the Applicant was aware of the Opponent's potential interest in the name BUSY BAKER as a result of taking part in their survey, at this point the name was a potential only for the Opponent and was one that had already been decided upon by the Applicant. The Applicant, in his response to the mini-poll/survey, suggested they adopt a different name.<sup>11</sup> By contrast, the Opponent took no steps to contact the Applicant upon discovering that he had filed the Application. They simply proceeded to file a Notice of Opposition one month after the publication of the Application.
47. On the balance of probabilities, it is clear that this is not a case of bad faith.

## **Conclusion**

48. The Opposition should be dismissed in its entirety and the Application should be allowed to proceed to registration for the full range of goods and services covered.
49. The Applicant requests that an award of costs is made in favour of the Applicant.

---

<sup>8</sup> Paragraphs 6 & 7 of the witness statement of Andrew Baker

<sup>9</sup> Red Bull

<sup>10</sup> Paragraph 8 of the witness statement of Andrew Baker

<sup>11</sup> Paragraph 10 of the witness statement of Andrew Baker



50. In the event the Opposition is successful in whole or in part the Applicant requests that an award of costs is not made in favour of the Opponent due to their failure to notify the Applicant of their intention to file the Opposition, by way of the filing of a Notice of Threatened Opposition or otherwise.

**PATRICIA COLLIS**  
**Representative for the Applicant**  
**September 2020**