

ENGLAND AND WALES / JUDGMENT

Bocacina Ltd v (Boca Cafes Ltd (Rev 1)

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Neutral Citation Number: [2013] EWHC 3090 (IPEC) IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION INTELLECTUAL PROPERTY ENTERPRISE COURT Before: MR DANIEL
ALEXANDER QC Sitting as an Enterprise Judge

- ----- Between: BOCACINA LIMITED and

(1) BOCA CAFES LIMITED

(2) DERCIO DE SOUZA JUNIOR

(3) MALGORZATA DE SOUZA

- -----

- ----- Claim No. CC12P04557 Rolls Building 110 Fetter Lane, London EC4A
1NL Date: 14 October 2013 Claimant Defendants Mr Jonathan Hill (instructed by Humphreys
& Co) for the Claimant The Second Defendant in person Hearing date: 8 October 2013

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Judgment

Mr Daniel Alexander QC

Introduction

The main issue in this action is whether the defendants who, until recently, operated a restaurant and bar in Bristol under the name “Boca Bistro Café” are liable for passing off, having regard to the claimant’s earlier use of the mark “Bocabar” for an earlier bar and restaurant in Bristol and “Boca” for some of the goods and services provided there. There is a secondary issue as to whether the defendant’s trade mark registration for BOCA BISTRO CAFE should be declared invalid. The defendants filed no skeleton argument or evidence (save as in the defence), despite the order of HH Judge Birss QC and, when the case was called on, they were not present. I adjourned the hearing for a few hours to give the defendants further time to attend and, when the hearing resumed later in the day, the second defendant came and advanced oral argument in effect on behalf of all of the defendants. Summary of facts The claimant (“Bocacina”) operates a successful and trendy bar, restaurant and gallery in Bristol under the name Bocabar. The Bocabar is sometimes referred to as the Boca bar or simply Boca and some of its meals and services are provided just using the mark Boca (such as Boca pizza, Boca salad, Boca roasts, Boca bargains,

Boca brownies and Boca Socca – a football night). The Bocabar, which is located in the Bristol Paintworks development, opened in 2005 and has used that name ever since in plain text or in stylised form with a logo. It serves a range of food and drink, not particularly focussed on any given region, including pizzas, salads and delicatessen foods, including tapas, as well as breakfast and a range of drinks (non-alcoholic, wine and cocktails). Some perceive that there is a Brazilian flavour to the place as a result of one of the people behind it. The Bocabar has been successful and in recent years (2008-2011) has enjoyed a turnover of in excess of £1million p.a. The evidence shows that it is widely known in Bristol, particularly in the immediate vicinity, albeit probably less so further afield. The business has also had a website: www.bocabar.co.uk which has prominently displayed the mark Bocabar including in stylised form. The web-site receives a substantial number of visits, including many thousands of page views and unique visitors a year. The mark Bocabar is prominently displayed at the bar and on menus. There has been substantial advertising in the local press and by way of flyers, all of which has included the mark Bocabar. Local art exhibitions have been held at the Bocabar as well as music and fashion events. The Bocabar has been the subject of considerable press exposure including reviews in local guides and newspapers as well as on web-sites promoting visits to Bristol. Bocacina or its predecessors in business, previously operated two other food business in Bristol, a delicatessen called Bocacina (operated for four years from 2003-2007 using a web-site at www.bocacina.co.uk) and a restaurant called Bocanova (operated from 2000-2008 using a web-site at www.bocanova.co.uk). The goodwill of that restaurant was assigned to Bocacina. The defendants, Boca Cafes Limited and two individuals, Mr Dercio De Souza Junior and Mrs Malgorzata De Souza (who run Boca Cafes Limited), started up a cafe and bistro entitled the Boca Bistro Café in or about 2012. The Boca Bistro Café is also in Bristol, not very far away (3 miles) from the Bocabar. It has a more Portuguese theme than the Bocabar but it also serves breakfast lunch and dinner and snack-type meals of a similar kind to that of the Bocabar (including a big breakfast of the same name “Big Boca breakfast”). Like the Bocabar it serves a wide range of drinks. Like the Bocabar it has served Sunday roasts and has been a venue for live music. The defendants registered the company name Boca Cafes Limited and successfully registered the trade mark BOCA BISTRO CAFE in respect of cafeteria and restaurant services in class 43. Registration was achieved on 20 January 2012, having been applied for in 2011. Internet searches for terms such as “Boca Bristol” or “Boca Restaurant Bristol” bring up both parties in close proximity. Earlier this year, according to the second defendant, the first defendant apparently ceased trading and the company is on the way to being removed from the register. A cafe now trades at the same place “Bica Bistro Café” which uses the same Facebook account. The second defendant said in his submissions (he did not give evidence) that he did not know who was running this cafe although his wife, the third defendant, is a director of a company with “Bica” in its name registered to the same address giving rise to a strong suspicion of a continuing connection, which it is impossible to confirm on the state of the evidence before me now.

Issues

HH Judge Birss QC identified the following three issues as requiring determination in the order for directions dated 23 April 2013: (i) (ii) (iii) Does goodwill or reputation attach to the claimant's goods or services in the mind of the purchasing public or trade by association with the word "Bocabar" or "Boca" and if so what is the nature and extent of that goodwill? Have the defendants misrepresented to the public or trade that their business or their goods or services are those of the claimant or someone connected with it? Should the defendants' UK trade mark registration no. 2594410 be declared invalid? There is no dispute that the defendants are jointly liable for any tort, if any has been committed. Following a request from Bocacina to which the defendants agreed, HH Judge Birss QC gave a preliminary non-binding indication that the defendants' defence was not meritorious and that the claim was likely to succeed. The recent change of name At some point in the summer of 2013, without informing Bocacina, there was a change of name of the café on that site to Bica Bistro Café – and (so it is said) a change in the people behind it. That prompted further correspondence from Bocacina's solicitors dated 20 August 2013 in which they said (in essence) that this minor change would not be sufficient to avoid passing off and requested that the use of Bica stop as well. They indicated an intention to amend the Particulars of Claim to that end but, in the event, that was not done and Bocacina's stance is that they will wait to see whether there is significant confusion as a result of the use of the term "Bica" for that business to merit pursuit of that further complaint. Their position on this is therefore reserved. At the hearing, I invited consideration of whether that was a satisfactory course, given the potential impact of *Henderson v. Henderson* on any further action. Counsel for the claimant indicated that his client appreciated the risk of *Henderson v. Henderson* estoppels and was prepared to take it. I think this is the correct course in this case and, in my judgment, even though this cannot bind a future court, it is appropriate for this court to indicate briefly why, so that a future court can consider the thinking at that stage. Even if it turns out that there are defendants common to those in the present action behind the "Bica Bistro Café", having regard to the principles in *Johnson v. Gore Wood & Co.* [2000] UKHL 65; [2001] 1 All ER 481; [2001] 2 WLR 72, I do not think that it would give rise to an estoppel. In *Johnson*, Lord Bingham said: "The underlying public interest is the same: that there should be finality in litigation and that a party should not be twice vexed in the same matter. This public interest is reinforced by the current emphasis on efficiency and economy in the conduct of litigation, in the interests of the parties and the public as a whole. The bringing of a claim or the raising of a defence in later proceedings may, without more, amount to abuse if the court is satisfied (the onus being on the party alleging abuse) that the claim or defence should have been raised in the earlier proceedings if it was to be raised at all. I would not accept that it is necessary, before abuse may be found, to identify any additional element such as a collateral attack on a previous decision or some dishonesty, but where those elements are present the later proceedings will be much more obviously abusive, and there will rarely be a finding of abuse unless the later proceeding involves what the court regards as unjust harassment of a party. It is, however, wrong to hold that because a matter could have been raised in early proceedings it should have been, so as to render the raising of it in later proceedings necessarily abusive. That is to adopt too dogmatic an approach to what should in my

opinion be a broad, merits-based judgment which takes account of the public and private interests involved and also takes account of all the facts of the case, focusing attention on the crucial question whether, in all the circumstances, a party is misusing or abusing the process of the court by seeking to raise before it the issue which could have been raised before. In intellectual property cases, the maxim “business needs to know where it stands” is of great importance. In general, if there are complaints about current conduct, they should all be dealt with together and not piecemeal (see e.g per Jacob LJ in *Nokia GmbH v IPCOM GmbH & Co KG* [2011] EWCA Civ 6: “It is not normally procedurally fair to subject the other side to successive cases when you could readily have put them all in one go”). However, it does not seem to be an abuse of process in the specific context of this passing off dispute between two SMEs for the claimant to wait and see whether a mark altered by a defendants during the course of proceedings (if it is them or one of them) is actually causing problems before pressing further action in respect of it, instead of amending this action to deal with it now. It would not accord with the overriding objective of this court, which is to assist SMEs in resolving their disputes at low cost, to force these particular litigants into unnecessary and procedurally costly fights as a result of an over-zealous application of rules designed to stop abuses usually involving unjust harassment by repeated litigation in quite different circumstances. It is not *prima facie* unjust harassment for a claimant who has resolved the main issue and the mark has been changed by the defendant to say “let’s wait and see if there is a problem with the new mark, before having a costly further dispute on a point which may never arise” rather than “let’s fight about it now, although there might be no problem”, even if that leaves a defendant in some state of uncertainty as to whether it will be vulnerable to further proceedings in the future. If a defendant in those circumstances is particularly concerned about immediate certainty, it is possible to obtain declaratory relief that conduct is permissible, where a claimant has asserted that it is not or might not be, or to resist the point being held over. In this case, no objection was suggested to that latter course, perhaps because the second defendant’s position was that the Bica Bistro Café was nothing to do with him or the defendants at all. Law Returning to the claim as formulated, the principles of the law of passing off which equally apply in a case concerning a challenge to the registration of a trade mark on section 5(4) grounds are uncontroversial. They were set out in the Particulars of Claim and may be summarized in the words of Halsbury’s Laws as follows: “The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiffs goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered to is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.” Goodwill It is possible for relatively small trade to result in sufficient goodwill for a passing off case so long as it is more than

trivial. For example, in *Knight v. Beyond Properties Pty Ltd & Ors* [2007] EWHC 1251 (Ch) (24 May 2007) David Richards J said: “A reputation on a relatively small scale will still attract the protection of a claim in passing off, but at some point the reputation may exist among such a small group of people that it will not do so. The minimum size of goodwill required for this purpose is a matter of fact and degree. A claim in passing off cannot be sustained to protect goodwill which any reasonable person would consider to be trivial: *Sutherland v V2 Music Ltd*

[2002] EMLR 568 at para 22 per Laddie J”. Confusion/misrepresentation The law of passing off requires that a substantial number of members of the relevant public are likely to be deceived by the use complained of. In *Reckitt & Colman Products Ltd. v. Borden Inc. (Jif Lemon)* [1990] RPC 341 at 407, from which the general principles set out above are derived, Lord Oliver said that the question on the issue of confusion was: “...is it on the balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ product?” Even though it is not necessary to show that the majority of the relevant population would be confused, the odd one or two will be unlikely to be enough. In *Neutrogena Corporation v. Golden Ltd (Neutrogena)* [1996] RPC 473, Jacob J, describing the perspective of the first instance tribunal attempting to form a view in the absence of satisfactory evidence, said at 482: “...if the judge’s own opinion is that the case is marginal, one where he cannot be sure whether there is a likelihood of sufficient deception, the case will fail in the absence of enough evidence of the likelihood of deception. But if that opinion of the judge is supplemented by such evidence then it will succeed.” That approach was implicitly approved by the Court of Appeal in upholding his judgment (see 496) although Morritt LJ particularly emphasised the need for a “substantial number” of members of the public, questioning Jacob J’s language in the use of the terms “more than de minimis” and “above a trivial level”. In forming its own view on the subject of deception without live witnesses of confusion, a court is not acting without evidence: it is taking all of the relevant circumstances into account in determining whether and the extent to which confusion is likely. In *Neutrogena*, Morritt LJ also drew attention to the observations of Lord Diplock in *GE Trade Mark (GE)* [1973] RPC 297 at 321 albeit in the context of trade mark infringement: where the goods are sold to the general public for consumption or domestic use, courts are entitled to give effect to their own opinions on the likelihood of deception or confusion. The Court of Appeal returned to this subject in *Marks And Spencer Plc v Interflora Inc & Anor* [2012] EWCA Civ 1501, where it made the following observations in the light of *Neutrogena* at [27]-[30]:

27. In *Neutrogena* the claimant had substantial reputation and goodwill in haircare and skincare products sold under the name *Neutrogena*. It was also the owner of three registered marks for that word. The defendant began to market a range of shampoo and other products under the name *Neutralia*. *Neutrogena* sued for passing off and infringement of its marks. It was accepted by the defendant (represented as it happens by both Mr Hobbs

and Mr Silverleaf) that the case on trade mark infringement stood or fell with the case in passing off: [1996] RPC 473, 488. So the judge (Jacob J) concentrated on passing off. He directed himself ([1996] RPC 473, 481): "It is not a defence to passing off that many of a defendant's sales do not cause deception or confusion. There is passing off even if most of the people are not fooled most of the time but enough are for enough of the time. By "enough" I mean a substantial number of the plaintiff's customers or potential customers deceived for there to be a real effect on the plaintiff's trade or goodwill. In this case (where most of these are probably not confused) the crucial question is whether or not the plaintiffs have established a sufficient degree of confusion and deception to take the case above a de minimis level. For there are always some people who are confused and even when products and names are well- differentiated, mistakes do occur."

28. Having considered a variety of different kinds of evidence Jacob J concluded on the facts

[1996] RPC 473, 483: "...the plaintiffs have managed to adduce what I find to be convincing evidence that there is deception and confusion and that this is above a trivial level, even though most people are not deceived." (Emphasis added)

29. He therefore concluded that passing off had been established.

30. The judge's self-direction was attacked in the Court of Appeal but largely survived. Morritt LJ thought that the use of the phrases "more than de minimis" and "above a trivial level" were best avoided; but held that the judge had applied the correct test; namely whether a substantial number of members of the relevant public had been deceived. The judge's finding that passing off had been established was upheld. The important point is that passing off had been established even though most people were not deceived. I therefore approach the issue of confusion/misrepresentation with the following principles in mind. First, at least in a case involving ordinary consumer products or services, the court can form its own view as to whether there is a likelihood of misrepresentation, without the need for there to be actual witness of confusion. Second, the court must consider whether there is a substantial number of people who were or would be deceived by the defendant's use of the mark, even if there are many, or even most, who would not be deceived. Not all of the above authorities were expressly cited by the parties. However, at the hearing, I summarised the effect of them in terms similar to the above to provide the parties with an opportunity to comment on the principles. Neither side suggested that an approach different from the above should be applied. (i) Goodwill and reputation In my judgment, Bocacina's evidence, including that referred to in the Particulars of Claim, summarised in the introduction above, is sufficient to show that Bocacina has at all material times had a significant, albeit substantially local, goodwill centred on Bristol and the surrounding area attaching to the mark Bocabar and, to a lesser extent, Boca itself. This goodwill exists in relation to restaurant, bar and café services as well as to an art gallery and music venue. It was submitted for the defendants that the goodwill was very small and the second defendant indicated that he had not heard of the Bocabar when the defendants started their business. Even if that was so, it seems clear on the evidence that many people and probably many

thousands in Bristol have heard of it and possibly eaten or drank there. It is a fairly large venue attracting a diverse crowd of media folk and families. In one document, albeit one which is an element of advertising, it is said that Bocabar has: "fast become the hippest haunt of both local residents and those in the know from further afield." Although one reviewer suggests that it is not quite as hip as it might hope to be, it is described as a more stylish experience than one would get elsewhere in Brislington (a part of Bristol). Another says that it is "very popular with the local community". The reviews draw attention to the fact that a wide range of people go there. I have considered whether the goodwill is even more geographically confined (say to South East Bristol) and have concluded, given the city-wide circulation of the advertising and press reports and the fact that Bristol is not a very large city, that the goodwill extends to Bristol and somewhat beyond. I am satisfied that this goodwill was at all material times well beyond trivial, albeit that it did not extend beyond Bristol and the surrounding area. This was and is a substantial goodwill. I therefore answer the first issue as follows. Substantial goodwill and reputation attaches to the claimant's restaurant, bar, café, gallery and music venue services in the minds of the purchasing public and trade by association with the word "Bocabar" or "Boca" and the goodwill and reputation extends throughout Bristol and surrounding area. (ii) Confusion and misrepresentation

Applying the above principles, I share HH Judge Birss QC's view that there is a real likelihood that a significant number of people will be confused into thinking that there is a connection between the two businesses. I take the following matters into account. First, having regard to all the circumstances, including the similarity of the names, the proximity of the businesses and the similarity of the food and services offered, my view is there is a likelihood that a significant number of people would be confused into thinking that the claimant's and defendants businesses were connected. This is a situation somewhat like that in *Wagamama v. City Centre Restaurants* [1995] FSR 713 where Laddie J held that one kind of confusion likely to occur between WAGAMAMA and RAJAMAMA was that some would think that the businesses were associated "in the sense that one is an extension of the other ...or otherwise derived from the same source." The defendants draw attention to the fact that their respective businesses are somewhat different, with a much smaller bar in the case of the Boca Bistro Café, a different range of food (mainly Portuguese in nature) and different décor, including front signage. They also point to the fact that they have received favourable reviews from the Bristol Post (with particular praise for the custard tarts) and no reference to any connection with the Bocabar. They submit that the two businesses, although both in Bristol, are geographically far apart with the Boca Bistro Café situated off the Cheltenham Road in North Bristol and the Bocabar situated in South East Bristol off the Bath Road. I have considered these points individually and cumulatively and, to some extent, they explain why the evidence of confusion is limited. One can certainly see why people familiar with one might not have come across the other. However, I am not satisfied that they mean that the likelihood of confusion is not significant having regard to the standard required by the law of passing off. Second, Schedule 2 to the Reply lists a number of instances of confusion which have come to light during 2012 although there is no evidence from the individuals themselves. This material is verified by the Witness Statement of Melissa Banks, which was

confirmed on oath, went unchallenged and which I accept. It gives details of further instances of confusion from 2013. During 2012 several people appear to have thought that the Boca Bistro Café was connected to Bocabar, either as a new branch or otherwise, although some appear to have merely asked whether it was. Among the people confused, according to this schedule, was a local environmental health officer who thought that Boca Bistro was another business owned by the claimant. Another, Vanda Grant, a friend of Ms Banks', congratulated her on the opening of a "new Boca" (referring to the defendants' business). Another, Vicky Crotty, told her that she thought that Boca Bistro was the same company as Bocabar and that she had visited it because she used to frequent Bocabar and was disappointed that it was not as good as Bocabar. Ms Crotty said that many of her friends thought it was the same company as well. There are several other instances mentioned of people enquiring whether there was a connection. In my view, although this evidence is not particularly extensive and it is not possible to test how solid it is by cross-examination, it provides some support for the view I take in any event. This is a case in which the court at the case management stage rightly thought that it would be disproportionate to require further evidence. I agree. This material is sufficient to provide backing for the court's prima facie view. Third, although it is not possible reliably to quantify what proportion of the relevant public is likely to be confused, in my view, taking all of those matters into account, it is likely to be a significant number. I therefore answer the second issue as follows. The defendants have misrepresented to the public or trade that their business or their goods or services are those of the claimant or someone connected with it. There is no dispute that if there is goodwill and misrepresentation, there would be damage. It follows that the claim in passing off succeeds. (iii) Validity of the registered trade mark I can deal with the third issue shortly. I outlined the law to the parties at the hearing and in particular explained that, if there was a finding of passing off and the defendants' conduct was one example of normal and fair use of the mark, it was inevitable that the trade mark would be invalidly registered as a result of section 5(4) of the Trade Marks Act 1994. Neither side suggested that was wrong. Accordingly, for the reasons given above in connection with the passing of claim, the claim for invalidation of the registered trade mark succeeds: UK trade mark registration no. 2594410 should be declared invalid. The defendants' additional points The defendants also contend that the fact that they obtained registration as a trade mark of the company name at Companies House and a domain name incorporating the word "boca" should protect them from a claim in passing off. That is, however, not the law as, again, I explained at the hearing and as was set out at some length in the Reply. They also draw attention to the fact that there are other restaurants called Boca including the Boca Cafe Bar in Poulton le Flyde, La Boca restaurant in Belfast, Boca restaurant in Northampton and an Italian restaurant called Bocca in Streatham. They submitted, in essence, that it would be undesirable for a name such as "boca" to be monopolised by one undertaking, even in a limited geographic area such as Bristol, bearing also in mind that boca is at least allusive to food (meaning "mouth" in Portuguese). Again, that is not an answer to this specific claim. Bocacina is not seeking a monopoly in the word "boca" or "bocabar" or suggesting that the use of such a word for a restaurant or bar anywhere in the country would involve passing off. Its claim is that the

specific uses made by the defendants of the term Boca Bistro Café in Bristol constitute passing off. I therefore reject the defendants' argument on this point. Relief The issue of relief is made somewhat more complex by the facts that (i) there has been a change of name of the business, (ii) the position is reserved with respect to the use of Bica and it is not wholly clear who is behind that new venture, (iii) there is some historical reference to "Boca" on the Bica Bistro Café Facebook page, (iv) the first defendant is on its way to being struck off (v) the defendants' domain name may apparently be about to lapse for non payment of relevant fees and (vi) an inquiry or account may be disproportionate in all the circumstances. Provisionally, I believe that the relief should therefore be slightly altered from that provided for in the particulars of claim as follows, to enable the parties to clear up the loose ends in an orderly manner. These minor alterations come within the general prayer for further or other relief and the court's general jurisdiction to grant injunctions and orders in support of them where just and convenient. Paragraph 1 An injunction to restrain the Defendants and each of them (whether acting directly or indirectly, through officers, servants, agents or subcontractors, or by procuring or encouraging others to act, or by acting in any other way howsoever) from passing off its business, goods or services as and for those of the Claimant or a business connected with the Claimant by using the signs "Boca", "Boca Bistro Cafe", "Boca Bistro", "Boca Cafe", or "Bocabar" in relation to any such business, goods or services. Paragraphs 2-3 As drafted. Paragraph 4 Deleted. Paragraph 5 As drafted with the following addition "and that the Claimant be at liberty to apply for (i) an order cancelling the domain name "bocacafes.co.uk" in the event that the same does not lapse within 3 months of the date of this order and (ii) an order requiring the removal of references to the Boca Bistro Bar or Boca in relation to restaurant, cafe or bar services (save any reference to the claimant, if any) on any Facebook page controlled by any of the Defendants in the event that such are not substantially removed or altered within 3 months of the date of this order". Paragraphs 6-8 As drafted. Paragraphs 9-10 There shall be liberty to the Claimant to apply for an inquiry as to damages or an account of profits and consequential payment with interest and/or disclosure to enable an election between an enquiry and account to be made, provided that any application for such inquiry be made within 6 months of the date of this order and supported by evidence showing that the financial sums proposed to be recovered justify such a procedure. Paragraph 11 As drafted. Costs and further submissions I direct that written submissions should be filed and supplied to the other side on costs and on the above draft order with the following timetable indicating where there are points of disagreement: Claimant's submissions (to include a proposed draft order): on or before 4.00pm on 18October 2013 Defendants' submissions: on or before 4.00pm on 25 October 2013

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