

**O/0664/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001548611**

**IN THE NAME OF COFIX GLOBAL LIMITED**

**FOR THE FOLLOWING TRADE MARK:**



**IN CLASSES 29, 30, 32 & 43**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**THERE TO UNDER NO. CA000506543**

**BY HANCOCK & ABBERTON LIMITED**

## BACKGROUND AND PLEADINGS

1. COFIX GLOBAL LIMITED is the proprietor of the International Registration (“the IR”) shown on the cover page of this decision. The IR is registered with effect from 18 June 2020 but claims priority from 24 April 2020.<sup>1</sup> With effect from the same date, the proprietor designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The date of protection of the IR in the UK is 10 December 2020. The IR is protected for goods and services in classes 29, 30, 32 and 43, as annexed to this decision.
2. On 27 September 2023, HANCOCK & ABBERTON LIMITED (“the applicant”) applied to have the contested mark declared invalid under section 47(2)(a) of the Trade Marks Act 1994 (“the Act”). The application was brought under section 5(2)(b) of the Act, is targeted against all goods and services and is reliant upon the following trade marks:



(“the first earlier mark”)

UK registration no. 917055906 <sup>2</sup>

Filing date 31 July 2017; registration date 9 January 2018

Relying on the following goods and services:

Class 30: Coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

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<sup>1</sup> Claimed from Russian trade mark number 2020721547

<sup>2</sup> Both of the applicant’s marks are comparable marks based upon earlier EUTMs. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterpart.

Class 43: Services for providing food and drink; temporary accommodation; café services; cafeteria services; canteen services; restaurant services; self-service restaurant services; snack bar services.



("the second earlier mark")

UK registration no. 917055732

Filing date 31 July 2017; registration date 9 January 2018

Relying on all goods, namely:

Class 30: Coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 43: Services for providing food and drink; temporary accommodation; café services; cafeteria services; canteen services; restaurant services; self-service restaurant services; snack bar services.

3. By virtue of their earlier filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act. The applicant's marks completed their registration process more than five years before the date on which the application for a declaration of invalidity was filed. They are therefore subject to the use requirements specified in section 47(2B) of the Act.
4. The applicant claims that the marks are highly similar and that the goods and services are identical or similar to the goods of the earlier marks. As a result, the applicant claims that there is a risk of confusion between the marks, which includes a likelihood of association.

5. The proprietor filed a counterstatement denying the claims made. The proprietor also requested that the applicant prove use of the earlier marks in relation to all of the goods and services for which the earlier marks are registered.
6. The applicant is represented by Tomkins & Co. and the proprietor is represented by RMW&C Mietzel Wohnnick & Calheiros Partnerschaft mbB. Only the applicant filed evidence. No hearing was requested, and only the applicant filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

## **EVIDENCE**

7. The applicant filed evidence in the form of the witness statement of Anne Abberton dated 11 April 2023, which is accompanied by 31 exhibits. Ms Abberton is the Director of the applicant, a position she has held since 5 November 2003.
8. The purpose of the evidence is to demonstrate that the earlier marks have been put to genuine use for the goods and services on which the applicant relies. I note that the evidence shows sales figures which show that 93% of the applicant's revenue is derived from coffee sales and 7% from consumable items such as syrups and chocolate powders.<sup>3</sup>
9. I will refer to the evidence in my decision where necessary.

## **DECISION**

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

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<sup>3</sup> Paragraph 14 of the witness statement of Anne Abberton.

11. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act, which states as follows:

“47. –

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

### **Section 5(2)(b): legislation and case law**

12. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

13. In considering the application for invalidity under this section, I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 be dominated by one or more of its components;

- (f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

- 14. The applicant's goods and services are outlined in paragraph 2 of this decision. The proprietor's goods and services are outlined in the annex of this decision.
- 15. The term "coffee" appears identically in the specifications of both earlier marks and the specification of IR.
- 16. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services at issue. The examination of the invalidity will proceed on the basis that the contested goods and services are identical to

those covered by the earlier trade marks. If the application for invalidity fails even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

### **The average consumer and the nature of the purchasing act**

17. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18. The goods and services at issue are those that will be selected by members of the general public. The goods at issue will be available via general retailers and their online equivalents or via food/drink establishments such as restaurants and cafes. In stores, the goods will be displayed on shelves where they will be self-selected by the consumer. A similar approach will apply to goods selected online as the consumer will select them after having seen an image of them on a website. In food/drink establishments, the goods are likely to be selected aurally but this will take place after a visual inspection of the goods either in display cabinets, on menus or lists displayed behind a counter. As for the services, these will be selected after the consumer has viewed signage on the high street, promotional materials, after undertaking internet searches or via word-of-mouth recommendations. In my view, the selection process for both the goods and the

services at issue will be primarily visual but I do not discount an aural component playing a role for the reasons set out above.

19. The goods and services will be selected on a frequent basis and will vary in cost but not be prohibitively expensive. The same can be said for the services in that a fast-food restaurant may be cheap but a high-end restaurant will be expensive. That being said, regardless of the costs of the goods/services the factors that the consumer considers will be relatively ordinary. For the selection of the goods, this will involve considerations as to flavour, ingredients and nutritional content. For the services, the consumer will consider factors such as selection of food/drink offered, dietary requirements, reviews and hygiene ratings. Overall, I am of the view that the selection process for the goods and services will attract a no more than a medium degree of attention.




### **Comparison of the marks**

20. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

21. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

The applicant's marks	The IR
<p data-bbox="421 528 671 562">First Earlier Mark</p>  <p data-bbox="397 801 692 835">Second Earlier Mark</p> 	

Overall impression

23. The first earlier mark consists of the word “FIXX” in a slightly stylised typeface. The word itself plays the greatest role within the overall impression with the slight stylisation playing only a small role within the same.

24. The second earlier mark consists of the word “FIXX” in a slightly stylised typeface. Beneath the wording in a much smaller font are the words “the grounded coffee company”. The word “FIXX” plays the greatest role within the overall impression. Due to its size and allusive nature, the additional wording plays a secondary role. The slight stylisation plays only a small role within the overall impression.

25. The IR consists of the word “cofix” in a slightly stylised white typeface. The wording is presented against a black square background. I find that the word “cofix” plays a greater role within the overall impression with the stylisation and background playing lesser roles.

## Visual comparison

### *The first earlier mark and the IR*

26. Visually, the marks overlap through use of the letters “FIX”; these are the first three letters of the first earlier mark and the last three letters of the IR. Differences lie in the presence of the letters “co” at the beginning of the IR which has no counterpart in the first earlier mark. The first earlier mark also includes an additional “x” at the end of the mark which is not present in the IR. I also note the differences in stylisation with the first earlier mark being presented in black lettering on a white background whereas the IR is presented in white lettering on a black background however, I do not consider this to be a significant difference as it is well-established that figurative marks presented in black and white can be used in different colours and this would include inverting the colours to have black text on a white background. Clearly, the parties’ marks are short marks, and while I appreciate that there is no special test for “short” marks,<sup>4</sup> it is nonetheless true that the shorter a sign, the more easily the public is able to perceive all its single elements also impacting the similarity (or lack thereof) of the marks. Accordingly, I find that the addition of the letters “co” at the beginning of the IR (a position which tends to have more impact)<sup>5</sup> creates quite a striking visual difference, the visual difference is further impacted by the second “X” in the first earlier mark; and the respective stylisation differences. Taking all of this into account, I find there is a low to medium degree of visual similarity between the marks.

### *The second earlier mark and the IR*

27. In respect of the second earlier mark and the IR, the same points made above are applicable here. That being said, I note the presence of the additional wording “the grounded coffee company” in the second earlier mark which has no counterpart in the IR. Whilst I remind myself that I found this wording to play a secondary role in the overall impression of the second earlier mark, it nonetheless creates a further

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<sup>4</sup> See paragraph 44 of *BOSCO*, BL O/301/20

<sup>5</sup> Case T-183/02, *El Corte Ingles, SA v OHIM*

point of visual difference that will not go unnoticed. Overall, I find there is a low degree of visual similarity between the marks.

### Aural comparison

#### *The first earlier mark and the IR*

28. The first earlier mark will be pronounced in one syllable as “FIX”, while the IR will be pronounced in two syllables as “CO-FIX”. Aurally, the entirety of the first earlier mark is included in the second syllable of the IR. Consequently, I consider the marks hold a medium degree of aural similarity.

#### *The second earlier mark and the IR*

29. In respect of the second earlier mark and the IR, the same points made above are applicable here, however, the second earlier mark includes the words “the grounded coffee company” which has no counterpart in the IR. This wording appears to be a laudatory slogan and therefore may not be voiced by the average consumer. If the additional words in the second earlier mark were to be voiced, the competing marks would be aurally similar overall to a very low degree. If the additional words were not voiced, the second earlier mark and the IR would be similar to a medium degree.

### Conceptual comparison

30. In its counterstatement, the proprietor states that, “Due to its portrayal in a uniform script without any breaks or other indications for separation, there is no reason for the relevant public to artificially dissect the word ‘cofix’ into its two syllables ‘co’ and ‘fix’. Instead, ‘cofix’ will not only be perceived as a single unit that has no outstanding or dominant element, but also as a fanciful term without any meaning.” However, later in the counterstatement, the proprietor appears to contradict themselves by claiming, “the sign ‘cofix’ is meant to convey the concept ‘fresh coffee, fixed price” (original emphasis).

31. It is settled case law<sup>6</sup> that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. Therefore, I consider the identification of ‘cofix’ as meaning ‘fresh coffee, fixed price’ would involve an extra step of analysis by the average consumer and I remind myself that the assessment must be made by reference to the overall impression created by the mark.<sup>7</sup> I do not find it likely that the average consumer, when faced with the IR will perceive it as meaning “fresh coffee, fixed price”. Instead, I find that a significant proportion of consumers will perceive ‘cofix’ as an invented word with no attributable meaning however, I accept that some users may at least recognise that the mark contains the ordinary word ‘fix’.

32. Turning to the earlier marks, the proprietor states that, “The word element ‘FIXX’ is a fanciful word without any meaning. Especially in light of its brevity and the fact that it consists of only one syllable, the relevant public will indeed perceive ‘FIXX’ as an invented whole which is neither allusive nor descriptive with regard to the goods and services protected under the prior marks.” In respect of the second earlier mark, the proprietor claims, “The addition of ‘the grounded coffee company’ ... functions to identify ‘FIXX’ as the name of a company trading grounded coffee.”

33. In its statement of grounds, the applicant claims, “FIXX is an invented word.” However, they go on to make the following remarks regarding the conceptual comparison in their submissions in lieu:

58. For those of the relevant public who view the elements “FIXX” and “FIX” as a mere variation of the other, the Applicant contends that conceptually the Applicant’s Marks and the Proprietor’s Mark would be conceptually at least highly similar.

59. For those members of the public who attribute no meaning to “FIXX” or “cofix” no conceptual comparison is possible, and the Applicant contends, in

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<sup>6</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>7</sup> *Sabel BV v. Puma AG* (particularly paragraph 23)

this event, the marks should be considered conceptually neutral for the purposes of an overall comparison. This second position appears to be shared by the Proprietor in the submitted counterstatement accompanying the TM8.

60. For the sake of completeness, I shall consider both points made by the applicant.

61. For consumers who recognise: “fixx” as being a misspelling of the dictionary defined term ‘fix’; and the ‘fix’ element of “cofix” as also referring to the dictionary defined term ‘fix’, there is a high level of conceptual similarity. For consumers who attribute no meaning to either mark, the marks are conceptually neutral.

62. The second earlier mark has the added concept of a company that sells ground coffee, this is not a concept present in the IR. Therefore, if consumers attribute the ordinary meaning of the word ‘fix’ to “fixx” in the second earlier mark, and to the suffix “-fix” in the IR, the marks are conceptually similar to a medium degree. For consumers who attribute no meaning to the “fix” element in both marks, the marks will be conceptually dissimilar.

### **Distinctive character of the applicant’s mark**

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

65. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

66. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

67. I remind myself that the proprietor has conceded that the "FIXX" element in the first earlier mark is an invented word with no attributable meaning. As such, I will proceed on the basis that the first earlier mark holds a high degree of inherent distinctiveness.

68. Turning to the second earlier mark, my comments above are applicable here however, I find that the additional wording "the grounded coffee company" alludes to a company that sells ground coffee and appears to be a laudatory slogan. However, given its size and placement in the mark, it holds less weight than the 'FIXX' element. On balance, I consider the second earlier mark to have a medium degree of inherent distinctiveness.

69. I now turn to consider whether the distinctiveness of the applicant's earlier marks have been enhanced through use. Whilst the earlier marks are comparable marks, I remind myself that the relevant market for assessing enhanced distinctiveness is solely the UK market.

70. I note the following from the applicant's evidence:

- a) The applicant has been using the FIXX brand since 2017 in relation to coffee and coffee related goods such as cups and syrups.
- b) Both earlier marks have been used on the applicant's website since 2018.<sup>8</sup>
- c) The applicant has provided figures for sales to wholesale customers (business to business) within the UK between 2018 to 2023 in connection with FIXX products:

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<sup>8</sup> Exhibit AA2

Year	Sales (€)
1 January to 30 December 2018	42,052.29
1 January to 30 December 2019	46,434.50
1 January to 30 December 2020	35,426.71
1 January to 30 December 2021	45,954.70
1 January to 30 December 2022	56,016.54
1 January to 30 December 2023	53,932.95

- d) The applicant also claims that their online sales of FIXX products, direct to consumer via the online platform Shopify amounted to a total of €15,180.30 between 1 January 2018 and 20 May 2024.<sup>9</sup> It is also confirmed that these sales figures are approximately 93% coffee sales and 7% consumable items such as syrups, chocolate powders and branded takeout coffee cups.
- e) A selection of invoices has been provided that are dated between 2018 to 2023.<sup>10</sup> The majority of invoices are addressed to UK consumers and display the earlier marks. I note that the invoices relate to sales of ground coffee and coffee beans.
- f) Advertising figures have not been provided however the applicant claims that they regularly invest in targeted online advertisements. A selection of invoices has been provided showing the applicant's payments made for Google advertising.<sup>11</sup> I note from the invoices that the total spent in July 2023 was €148, in May 2021 the total was €182, in February 2021 the total was €183, in November 2022 the total was €146 and in August 2019 the total was €263. It is not clear from the invoices if the advertisements are targeted to consumers in the UK nor has the applicant clarified the territory in which these advertisements are targeted.
- g) In connection with the applicant's social media presence, I note that the applicant's Facebook page has just over 3000 followers, their Instagram

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<sup>9</sup> Exhibit AA6

<sup>10</sup> Exhibit AA7

<sup>11</sup> Exhibit AA23

page has 1731 followers, and their YouTube channel has 16 subscribers. It is not clear what these figures would have been at the relevant date and in any event, the reach of the applicant's social media posts appears to be limited.

71. I first note that none of the evidence filed is in relation to the applicant's goods or services apart from coffee.<sup>12</sup> There is therefore nothing to suggest that the applicant's marks have acquired an enhanced distinctiveness in relation to the following:

Class 30: cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 43: Services for providing food and drink; temporary accommodation; café services; cafeteria services; canteen services; restaurant services; self-service restaurant services; snack bar services.

72. I now turn to consider if the evidence provided demonstrates that the earlier marks have acquired an enhanced level of distinctiveness in relation to 'coffee'. Whilst I am satisfied that the applicant has been trading under the "FIXX" brand and its sales figures are not insignificant, I have no information about the market size for coffee (which I would expect to be in the millions, if not billions) and there is no information about the market share held by the applicant; nor is there any information about overall advertising expenditure. Although there is evidence that the applicant has used its earlier marks in relation to coffee, I remind myself that the bar for proving enhanced distinctiveness is considerably higher than the bar for proving genuine use. This is because it requires a level of knowledge of the mark amongst average consumers leading to the marks having a greater capacity to identify the goods and services as coming from a particular undertaking, not simply

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<sup>12</sup> Some evidence of syrups is also shown in the evidence however, the applicant does not rely on this term for either of its earlier marks.

that there has been an attempt to create or maintain a market for goods and services under the marks. Taking into account all the evidence, I am not satisfied that the distinctiveness of the earlier marks has been enhanced through use.

### **Likelihood of confusion**

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods at hand and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

74. I have found as follows:

- At least some of the goods are identical.
- The average consumer is a member of the general public who will pay no more than a medium degree of attention during the purchasing process. The purchasing process is predominantly visual, although I do not discount an aural component.
- The IR is visually similar to the first earlier mark to a low to medium degree and aurally similar to a medium degree. For consumers who recognise the "fix" element, the IR and first earlier mark are conceptually similar to a high

degree. For consumers who attribute no meaning to either mark, the marks are conceptually neutral.

- The IR is visually similar to the second earlier mark to a low degree. If the additional wording in the second earlier mark is articulated, the marks are aurally similar to a very low degree, if the additional wording is not articulated, the marks are aurally similar to a medium degree. For consumers who recognise the “fix” element, the IR and second earlier mark are conceptually similar to a medium degree. For consumers who attribute no meaning to the “fix” element, the marks are conceptually dissimilar.
- I have proceeded on the basis that the first earlier mark is inherently distinctive to a high degree. The second earlier mark is inherently distinctive to a medium degree. Neither mark has established an enhanced level of distinctiveness through the use made of it.

#### First earlier mark

75. The identity of at least some of the goods is clearly a factor in favour of the applicant. However, taking all of the above factors into account, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. The purchasing process will be predominantly visual, and the marks are likely to be encountered visually prior to purchase. As I outlined previously, the visual element the respective marks share (“FIX”) is found at the end of the IR. When considering the marks as a whole, the IR is noticeably longer and includes two letters at the beginning which have no counterpart in the applicant’s mark resulting in a low degree of visual similarity. Further, I remind myself that although I proceeded on the basis that the first earlier mark held a high degree of inherent distinctiveness, this distinctiveness lies in the overall impression created by the mark which is dominated by the word “FIXX” whereas I found the word “cofix” as a whole to play a dominant role in the overall impression of the IR. I therefore consider that notwithstanding the shared presence of the letters ‘FIX’ the differences between the marks will assist in distinguishing one mark from the other and the average consumer even when paying no more than a medium degree of attention will recognise these differences and not confuse the marks for one

another. Taking into account all of the relevant factors, I do not find there to be any likelihood of direct confusion. As this finding applies where the goods are identical, it will also apply even if the remaining goods and services are only similar.

### Second earlier mark

76. For similar reasons I have made above, I also find it unlikely that the applicant's second earlier mark and the IR will be mistaken for one another. This is because the second earlier mark includes an additional element from the first earlier mark by way of the wording "the grounded coffee company". The additional element resulted in me finding a lower degree of visual, aural<sup>13</sup> and conceptual similarity. In view of this, I consider that the average consumer paying no more than a medium degree of attention will recognise the differences between the respective marks and there will be no confusion between the same even on goods and services that are identical or only similar.

77. I now proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

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<sup>13</sup> If the additional wording is articulated by the average consumer.

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example”).

78. These examples are not exhaustive but provide helpful focus.

79. I recognise that the Court of Appeal has emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>14</sup> In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>15</sup>

80. On reflection of my findings throughout the decision, even when approached in regard to identical goods, I see no logical basis on which the average consumer,

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<sup>14</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

<sup>15</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

having identified that the marks are not the same and acknowledged their differences, would be minded to conclude that they originate from a shared or related undertaking. The differences between the marks are not consistent with any of the examples set out in *L. A. Sugar* and I cannot identify any additional basis on which the consumer would reasonably be indirectly confused. Any similarity between the marks' "FIX" element, would likely be attributed to coincidence rather than shared or related undertakings providing those goods. Consequently, I do not consider there to be any likelihood of indirect confusion between the IR and both earlier marks. As was the case for my finding of direct confusion, I find that this applies where the marks are viewed on goods and services that are only similar.

81.As the outcome is no likelihood of confusion, there is no need to consider the question of whether or not the earlier trade marks have been used as it is irrelevant to the outcome.

## **CONCLUSION**

82.The application fails in its entirety and the contested mark is, subject to any successful appeal of my decision, permitted to remain on the trade marks register for all of the goods and services for which it is registered.

## **COSTS**

83.The proprietor has succeeded in full and, therefore, is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. I note that the only task the proprietor was required to undertake was to review the application for invalidity and to prepare a counterstatement in response to the same. For such a task, I award the proprietor the sum of **£400** as a contribution towards its costs.

84.I hereby order HANCOCK & ABBERTON LIMITED to pay COFIX GLOBAL LIMITED the sum of **£400**. The above sum should be paid within 21 days of the

expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 18<sup>th</sup> day of July 2025**

**Catrin Williams**  
**For the Registrar**

**Annex:**

Class 29: Agar-agar for culinary purposes; aloe vera prepared for human consumption; alginates for culinary purposes; andouillettes; anchovy, not live; peanuts, prepared; artichokes, preserved; albumen for culinary purposes; white of eggs; beans, preserved; soya beans, preserved, for food; bouillon; ginger jam; ham; fatty substances for the manufacture of edible fats; laver, preserved; edible birds' nests; cabbage rolls stuffed with meat; peas, preserved; mushrooms, preserved; guacamole; game, not live; gelatine; meat jellies; jellies for food; fruit jellies; yolk of eggs; coconut fat; bone oil for food; lard; suet for food; edible fats; fruit-based snack food; milk substitutes; charcuterie; raisins; caviar; eggplant paste; vegetable marrow paste; fish roe, processed; ginger, preserved; pickled ginger; yogurt; sauerkraut; cassoulet; quark; kephir; kimchi; isinglass for food; clams, not live; potato-based dumplings; klipfish [salted and dried cod]; milk shakes; black pudding; onion rings; arrangements of processed fruit; compotes; meat, tinned; vegetables, tinned; fish, tinned; fruits, tinned; duck confits; bouillon concentrates; vegetable-based concentrate for cooking; fruit-based concentrate for cooking; corn dogs; gherkins; shrimps, not live; prawns, not live; buttercream; croquettes; silkworm chrysalis for human consumption; sweet corn, processed; kumys; spiny lobsters, not live; lecithin for culinary purposes; edible ant larvae, prepared; salmon, not live; onions, preserved; margarine; marmalade; oils for food; peanut butter; cocoa butter for food; coconut oil for food; coconut butter; corn oil for food; sesame oil for food; linseed oil for food; extra virgin olive oil for food; olive oil for food; palm oil for food; palm kernel oil for food; sunflower oil for food; colza oil for food; butter; soya bean oil for food; shellfish, not live; almonds, ground; animal marrow for food; mussels, not live; milk; peanut milk; peanut milk for culinary purposes; coconut milk; coconut milk for culinary purposes; almond milk; almond milk for culinary purposes; oat milk; rice milk; rice milk for culinary purposes; albumin milk; condensed milk; soured milk; soya milk; powdered milk; fermented baked milk; fish meal for human consumption; vegetable mousses; fish mousses; fruit pulp; meat; meat, preserved; freeze-dried meat; lactic acid drinks; milk beverages, milk predominating; peanut milk-based beverages; coconut milk-based beverages; almond milk-based beverages; edible insects, not live; sausage casings, natural or artificial; vegetables, preserved; freeze-dried vegetables; vegetables, processed; vegetables, dried; vegetables, cooked; hash browns; potato fritters; olives, preserved; lobsters, not live; omelettes; flavored nuts; candied nuts; coconut, desiccated; nuts,

prepared; tomato purée; pressed fruit paste; liver pâté; pectin for culinary purposes; preserved peppers; liver; pickles; jams; powdered eggs; milk products; fish-based foodstuffs; poultry, not live; white pudding; bulgogi; pollen prepared as foodstuff; cranberry compote; apple purée; crayfish, not live; crustaceans, not live; ratatouille; fish, preserved; fish, not live; salted fish; vegetable salads; fruit salads; bacon; sardines, not live; satay; pork; herrings, not live; seeds, prepared; sunflower seeds, prepared; cream [dairy products]; whipped cream; vegetable-based cream; fat-containing mixtures for bread slices; smetana; lemon juice for culinary purposes; tomato juice for cooking; vegetable juices for cooking; salted meats; sausages; sausages in batter; hot dog sausages; preparations for making bouillon; preparations for making soup; tofu skin; vegetable-based spreads; nut-based spreads; tripe; soups; vegetable soup preparations; whey; cheese; tajine [prepared meat, fish or vegetable dish]; tahini; cottage cheese; tofu; tempeh; fermented tofu; sea-cucumbers, not live; truffles, preserved; tuna, not live; oysters, not live; falafel; milk ferments for culinary purposes; rennet; fish fillets; dates; crystallized fruits; frozen fruits; fruit, preserved; fruit, processed; fruit preserved in alcohol; fruit, stewed; hazelnuts, prepared; potato flakes; hummus; edible flowers, dried; fruit peel; preserved garlic; lentils, preserved; potato chips; low-fat potato chips; fruit chips; choucroute garnie; non-alcoholic eggnog; seaweed extracts for food; meat extracts; berries, preserved; eggs; snail eggs for consumption; yakitori; tofu patties; soya patties; crystallized ginger; cottage cheese fritters.

Class 30- Vanilla flavorings for culinary purposes; flavorings, other than essential oils, for cakes; flavorings, other than essential oils, for beverages; coffee flavorings; food flavorings, other than essential oils; star aniseed; baozi; cereal bars; high-protein cereal bars; pancakes; savory pancakes; noodle-based prepared meals; freeze-dried dishes with the main ingredient being pasta; freeze-dried dishes with the main ingredient being rice; buns; bulgur; bread rolls; pains au chocolat; edible paper wafers; edible rice paper; edible paper; burritos; vanillin [vanilla substitute]; waffles; vermicelli; natural sweeteners; sausage binding materials; binding agents for ice cream; orange blossom water for culinary purposes; sea water for cooking; seaweed [condiment]; malt biscuits; cloves [spice]; mirror icing [mirror glaze]; cake frosting [icing]; glucose for culinary purposes; mustard; croûtons; buckwheat, processed; gluten additives for

culinary purposes; yeast; thickening agents for cooking foodstuffs; leaven; rice-based snack food; cereal-based snack food; artificial coffee; vegetal preparations for use as coffee substitutes; dressings for salad; fruit jellies [confectionery]; candy decorations for cakes; confectionery for decorating Christmas trees; cakes; pastries; peanut confectionery; almond confectionery; fruit confectionery; pasta; ground ginger; frozen yogurt [confectionery ices]; cocoa; cream of tartar for culinary purposes; capers; coffee capsules, filled; caramels [sweets]; curry [spice]; ketchup [sauce]; quinoa, processed; quiches; gluten prepared as foodstuff; flour-based dumplings; bread, pastries and confectionery; sweets; liquorice [confectionery]; peppermint sweets; mints for breath freshening; dulce de leche; cinnamon [spice]; coffee; unroasted coffee; starch for food; crackers; rice crackers; custard; crème brûlée; croissants; hominy grits; semolina; oatmeal; crushed barley; groats for human food; ice cubes; corn, milled; corn, roasted; meat pies; turmeric; couscous; laksa; noodles; soba noodles; udon noodles; ice for refreshment; ice, natural or artificial; edible ices; ice pops; potato-based flatbreads; rice cakes; mayonnaise; macarons; macaroni; maltose; hominy; piccalilli; marinades; marzipan; honey; miso; royal jelly; ice cream; bean meal; buckwheat flour; tapioca flour; potato flour; corn flour; nut flours; flour; wheat flour; soya flour; barley meal; dessert mousses [confectionery]; chocolate mousses; muesli; mint for confectionery; cocoa beverages with milk; coffee beverages with milk; coffee-based beverages; cocoa-based beverages; chamomile-based beverages; tea-based beverages; chocolate beverages with milk; chocolate-based beverages; infusions, not medicinal; nougat; crushed oats; husked oats; kimchi pancakes; onigiri; nutmegs; chocolate-coated nuts; stick liquorice [confectionery]; ginger paste [seasoning]; pastilles [confectionery]; molasses for food; pâtés en croûte; pelmeni; pepper; allspice; peppers [seasonings]; pesto; cookies; coconut macaroons; petit-beurre biscuits; bibimbap [rice mixed with vegetables and beef]; pies; pizzas; meat gravies; fondants [confectionery]; popcorn; powders for making ice cream; baking powder; mustard meal; pralines; condiments; meat tenderizers for household purposes; cereal preparations; oat-based food; propolis; profiteroles; gingerbread; spices; petits fours; rice pudding; puddings; cake powder; fruit coulis [sauces]; ravioli; ramen; chewing gum; chewing gum for breath freshening; relish [condiment]; rice; prepared rice rolled in seaweed; instant rice; wheat germ for human consumption; spring rolls; sago; sugar; crystallized rock sugar; palm sugar; sesame seeds [seasonings]; linseed for culinary purposes [seasoning]; processed seeds for use as a seasoning; aniseed; agave syrup [natural

sweetener]; golden syrup; confectionery; savory pancake mixes; batter mixes; baking soda [bicarbonate of soda for cooking purposes]; malt for human consumption; salt for preserving foodstuffs; cooking salt; celery salt; sorbets [ices]; ham glaze; cranberry sauce [condiment]; soya sauce; tomato sauce; apple sauce [condiment]; sauces [condiments]; pasta sauce; spaghetti; seasonings; chocolate-based spreads; chocolate spreads containing nuts; preparations for stiffening whipped cream; shaved ice with sweetened red beans; rusks; breadcrumbs; sushi; sandwiches; tabbouleh; tacos; tamarind [condiment]; tapioca; tarts; dough; pastry dough; almond paste; rice pulp for culinary purposes; cake dough; tortillas; garden herbs, preserved [seasonings]; chocolate decorations for cakes; vinegar; beer vinegar; ferments for pastes; halvah; harissa [condiment]; bread; gluten-free bread; unleavened bread; chips [cereal products]; corn flakes; oat flakes; hot dog sandwiches; flowers or leaves for use as tea substitutes; jiaozi; chicory [coffee substitute]; tea; kelp tea; iced tea; chutneys [condiments]; minced garlic [condiment]; cheeseburgers [sandwiches]; chow-chow [condiment]; saffron [seasoning]; chocolate; malt extract for food; essences for foodstuffs, except etheric essences and essential oils; husked barley.

Class 32- Mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making beverages; aperitifs, non-alcoholic; barley wine [beer]; aerated water; lithia water; seltzer water; soda water; waters [beverages]; mineral water [beverages]; table waters; kvass; cocktails, non-alcoholic; beer-based cocktails; lemonades; non-alcoholic beverages; non-alcoholic dried fruit beverages; isotonic beverages; non-alcoholic honey-based beverages; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; aloe vera drinks, non-alcoholic; whey beverages; protein-enriched sports beverages; soft drinks; non-alcoholic beverages flavored with coffee; non-alcoholic beverages flavored with tea; non-alcoholic fruit juice beverages; energy drinks; fruit nectars, non-alcoholic; orgeat; beer; ginger beer; malt beer; powders for effervescing beverages; sarsaparilla [non-alcoholic beverage]; syrups for lemonade; syrups for beverages; smoothies; tomato juice [beverage]; cider, non-alcoholic; vegetable juices [beverages]; fruit juices; non-alcoholic preparations for making beverages; preparations for making aerated water; must; grape must, unfermented; beer wort; malt wort; pastilles for effervescing

beverages; shandy; sherbets [beverages]; non-alcoholic fruit extracts; extracts of hops for making beer; non-alcoholic essences for making beverages.

Class 43- Providing temporary housing accommodation; accommodation bureau services [hotels, boarding houses]; rental of temporary accommodation; rental of meeting rooms; tourist home services; hotel reservations; boarding house bookings; temporary accommodation reservations; hotel services; retirement home services; snack-bar services; information and advice in relation to the preparation of meals; café services; cafeteria services; motel services; boarding house services; boarding for animals; rental of cooking apparatus; rental of chairs, tables, table linen, glassware; rental of lighting apparatus; rental of tents; rental of transportable buildings; rental of drinking water dispensers; restaurant services; self-service restaurant services; reception services for temporary accommodation [management of arrivals and departures]; food sculpting; canteen services; decorating of food; cake decorating; holiday camp services [lodging]; bar services; hookah lounge services; providing campground facilities; personal chef services; food and drink catering; washoku restaurant services; udon and soba restaurant services; day-nursery [crèche] services; office catering services for the provision of coffee; services for providing food and drink; serving of food and drink; providing food and drink in bistros; providing food and drink for guests; preparation and provision of food and drink for immediate consumption; consultancy services in the field of food and drink catering; catering services for the provision of food and drink; mobile cafe services for providing food and drink; providing food and drink in restaurants; rental of units for dispensing heated and chilled beverages, other than vending machines; preparation and provision of food and drink for consumption on and off the premises.