O/0697/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3830544 BY INTERNATIONAL FOODSTUFFS CO. LLC TO REGISTER THE TRADE MARK:

IN CLASS 30

AND

THE OPPOSITION THERETO UNDER NO. 438170 BY BRITANNIA SUPERFINE LIMITED

BACKGROUND & PLEADINGS

1. International Foodstuffs Co. LLC ("**the applicant**") applied to register the (figurative) trade mark shown on the front page of this decision in the United Kingdom on 16 September 2022. It was accepted and published in the Trade Marks Journal on 30 September 2022. I note that on 7 March 2023 the applicant filed a Form TM21B,[1] amending its specification as follows:

> **Class 30:** Ready to cook dough namely frozen bagels; frozen dough for making bagels; ice creams; bread products namely bagels.

2. On 20 December 2022, Britannia Superfine Limited ("**the opponent**") opposed the application on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act")[2]. The Sections 5(2)(b) and 5(3) grounds are based upon the following earlier UK registered marks:

Trade Mark no.	UK00001135112 ('112)
Trade Mark	ICE POPS
Goods for which the mark is registered	**Class 30:** Preparations included in Class 30 in liquid or frozen form for use in making water ices.
Filing date	10 June 1980
Date of entry in register	Registered with effect from the filing date

[1] The Registry accepted the amended specification by way of official letter dated 22 March 2023.

[2] 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.

Trade Mark no.	UK00000960194 (‘194)
Trade Mark	GLENVILLE ICE POPS
Goods for which the mark is registered	**Class 30:** Fruit flavoured preparations in liquid form for use in making frozen confections in the nature of water ices.
Filing date	27 May 1970
Date of entry in register	Registered with effect from the filing date

3. For the purposes of the claims under Sections 5(2)(b) and 5(3), the opponent relies upon all goods.

4. Under Section 5(2)(b) of the Act, the opponent in its notice of opposition claims that the competing marks are visually and phonetically highly similar and conceptually identical, and the respective goods are identical, similar or complementary.

5. Under Section 5(3), the opponent claims a reputation in its marks for all the goods in Class 30, such that the relevant public will believe the applicants’ goods are from an economically linked undertaking. It claims that the applicant would gain an unfair advantage as it would not have to make as much of an investment in promoting and marketing the goods sold under the mark, as it could “free ride” on the investment made by the opponent. The opponent also contends that it will be unable to control the quality of the goods supplied by the applicant and, if that quality is inferior, the reputation of the earlier marks will be tarnished. Such use of the applied-for mark in relation to the contested goods will be detrimental to the earlier marks’ distinctive character and attraction, and erode their distinctiveness, meaning that they would no longer be capable of arousing an immediate association with the opponent’s goods.

6. Under Section 5(4)(a) of the Act, the opponent relies upon the signs “ICE POPS” and “GLENVILLE ICE POPS” which it claims to have used

throughout the UK since 2001 in relation to "*Preparations included in Class 30 in liquid or frozen form for use in making water ices*" and "*Fruit flavoured preparations in liquid form for use in making frozen confections in the nature of water ices*", respectively. It claims that use of the opposed mark would be contrary to the law of passing off.

7. In response, the applicant filed a lengthy counterstatement, denying the grounds of opposition under Sections 5(2)(b), 5(3) and 5(4)(a) of the Act and making submissions in defence of the opponent's claims. The applicant requested that the opponent provides proof of use of its earlier marks relied upon. The applicant requested that the opposition be refused in its entirety and that costs be awarded in its favour.

Papers Filed and Representation

8. The opponent filed evidence in chief in these proceedings. This comes in the form of a witness statement (the "first witness statement") from Colin Manser, the director of the opponent in these proceedings. His witness statement is dated 24 July 2023 and is accompanied by 6 exhibits (CM1-CM6). The purpose of the evidence is to prove use, reputation and goodwill in the opponent's marks.

9. The applicant filed evidence in these proceedings. This comes in the form of a witness statement from Daniella Michelle Garvey, trainee Trade Mark Attorney at Fox Williams LLP. Her witness statement is dated 29 January 2024 and is accompanied by two exhibits (DMG1-DMG2).

10. In addition, the opponent filed evidence in reply which also comes in the form of two witness statements from Colin Manser. The initial second witness statement, dated 12 April 2024, is accompanied by three exhibits (CM7-CM9), while the initial third witness statement, dated 24 April 2024, includes one exhibit (CM10). However, upon reviewing the case file, it became clear that both the second and third witness statements were missing the necessary statement of truth and had been admitted into the proceedings in error. It was also brought to the attention of the Tribunal

that the signatures on the second and third witness statements appeared to be different. Therefore, in line with Rule 74 of the Trade Marks Rules 2008, the Tribunal requested on 21 May 2025 that the opponent file a form TM9R and the witness statements in their proper format, bearing Mr Manser's signature as per Rule 62, alongside confirmation of his signature on all documents. On 2 June 2025, the opponent refiled the above witness statements, addressing the deficiencies, allowing for their admission into the proceedings.

11. The applicant filed written submissions on 29 January 2024 and the opponent on 24 July 2023. Also, the applicant filed submissions in lieu of a hearing on 12 June 2024 and the opponent on 11 June 2024.

12. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

13. No hearing was requested and so this decision is taken following a careful consideration of the papers.

14. In these proceedings, the applicant is represented by Fox Williams LLP and the opponent by Wilson Gunn.

DECISION

Relevant Period

15. An "earlier trade mark" is defined in Section 6(1) of the Act:

> "(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where

appropriate) of the priorities claimed in respect of the trade marks,

[…]

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

16. As the earlier mark '194 was renewed in 2015 and 2025, and the earlier mark '112 was renewed in 2011 and 2021, it is reasonable to infer that both earlier marks had been registered for more than five years on the date on which the contested application was filed. Therefore, Section 6A of the Act applies, which states:

"(1) This Section applies where–

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

17. In accordance with Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier marks. The relevant period for proof of use of the opponent's marks is from **17 September 2017 to 16 September 2022**.

18. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **16 September 2022**. This is also the relevant date for the

assessment of whether the earlier marks had a reputation under section 5(3). I shall come back to the question of relevant date in respect of section 5(4)(a) in due course.

PROOF OF USE

Relevant Case Law

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted

in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of

the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. […]
>
> 22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

20. Proven use of a mark which fails to establish that "*the commercial exploitation of the marks is real*" because the use would not be "*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark*" is, therefore, not genuine use.

Evidence of Use

21. Mr Manser in his first witness statement states that:

> "3. The Opponent has owned and used the ICE POPS and GLENVILLE ICE POPS marks in the UK since 2001, having acquired the trade mark registrations and goodwill from Ice Pops Limited. The Opponent is a manufacturer and retailer of sugars and confectionery, as well as fruit flavoured frozen water lollies under the ICE POPS and GLENVILLE ICE POPS." (sic)

22. He also provided annual sales figures in the UK of its goods bearing the earlier mark '112. He does not say whether the goods also bear the '194 mark. These are shown in the following table:

Year	Turnover
2016	£200,694
2017	£120,000
2018	£119,660
2019	£148,007
2020	£23,796
2021	£28,594
Total	£640,751

Nevertheless, it is not specified in the witness statement to what extent the above figures concern the sales of goods under each of the earlier marks. Whilst the 2017 figures include turnover falling outside (pre-dating) the relevant time period, it is reasonable to infer from the subsequent annual figures that at least a portion of the turnover falls within the relevant time period. I also note the applicant's criticism that the opponent's turnover figures show that the total sales have diminished, especially between 2020 and 2021, and that there is a lack of data for the years 2022 and 2023. I note that the years with significantly lower sales were also those that were affected by the COVID 19 pandemic, which may have had an impact on the volume of sales.

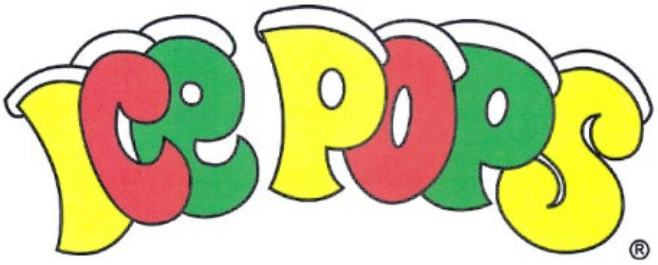
23. **Exhibit CM1** it is said to be an excerpt from 'Multiple Buyer and Retailer' brochure dated June 1998 and titled "NEW SUGAR FREE ICE POPS LAUNCHED". It outlines the launch of a new version of pasteurized freeze drinks sold in 500ml cartons containing 20 sachets. I note that this exhibit falls outside the relevant period and is of no evidential value for the purposes of the proof of use assessment.

24. **Exhibit CM2** is a set of 16 invoices covering the period from 2016 to 2021. The invoices show sales of ICE POP/ICE POPS and GLENVILLE ICE POPS products. One invoice is addressed to RICHER SOUNDS PLC, one to SUN EXOTIC WHOLESALE LTD, and another one to APPLETON & SONS LTD, all located in London, while the rest of the invoices are addressed to FREEMANS CONFECTIONERY LTD based in Walsall. According to Mr Manser's third witness statement, FREEMANS CONFECTIONERY LTD is a distributor of the registered products to outlets across the UK since 2014. I note that 6 invoices dated from 11 April 2016 to 23 May 2017 fall outside the relevant periods. Nevertheless, the total for the invoices (shown in the table below) that do fall within the relevant period amounts to over £33k (including VAT) from which over £26k are sales under GLENVILLE ICE POPS brand and over £7K under ICE POP/ICE POPS brand.

Date	Amount in GBP	Quantity	Units
13/05/2018	4,406.40	6,120	60
13/06/2018	6,364.80	8,840	60
16/07/2018	269.28	374	60
23/07/2018	204.00	340	60
31/03/2019	3,835.20	6,392	60
23/07/2019	5,385.60	7,480	60
12/08/2019	6,364.80	8,840	60
02/04/2021	403.20	80	6
31/05/2021	6,364.80	8,840	60
14/08/2022	366.48	509	70
Total	33,964.56	47,815	556

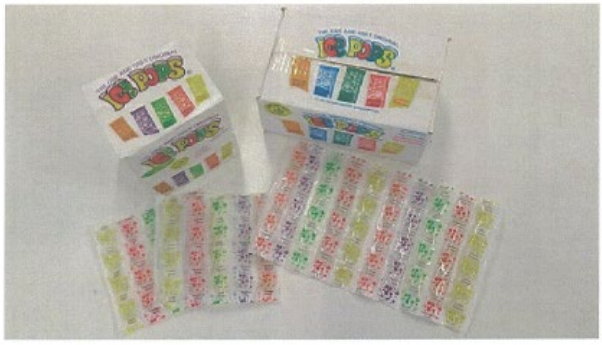
25. **Exhibit CM3** features undated printouts showcasing images of what appear to be fruit-flavoured products along with their (carton) packaging,

bearing variant forms of the registered mark ICE POPS. Mr Manser explains that the exhibit comprises "*a selection of branding and advertising material showing the variety of ICE POPS and GLENVILLE ICE POPS branded products (differing in the size and volume available to purchase), which were used to advertise and market the product range to retail customers between 1998 and 2021 throughout the UK*." Also, page 6 of the exhibit contains a table listing the products and various details such as product code, size, and contents per carton. Further, **Exhibit CM7** contains two versions of the printouts from Exhibit CM3, as shown below, both featuring added dates of June 2019 and November 2018 at the bottom of the page.



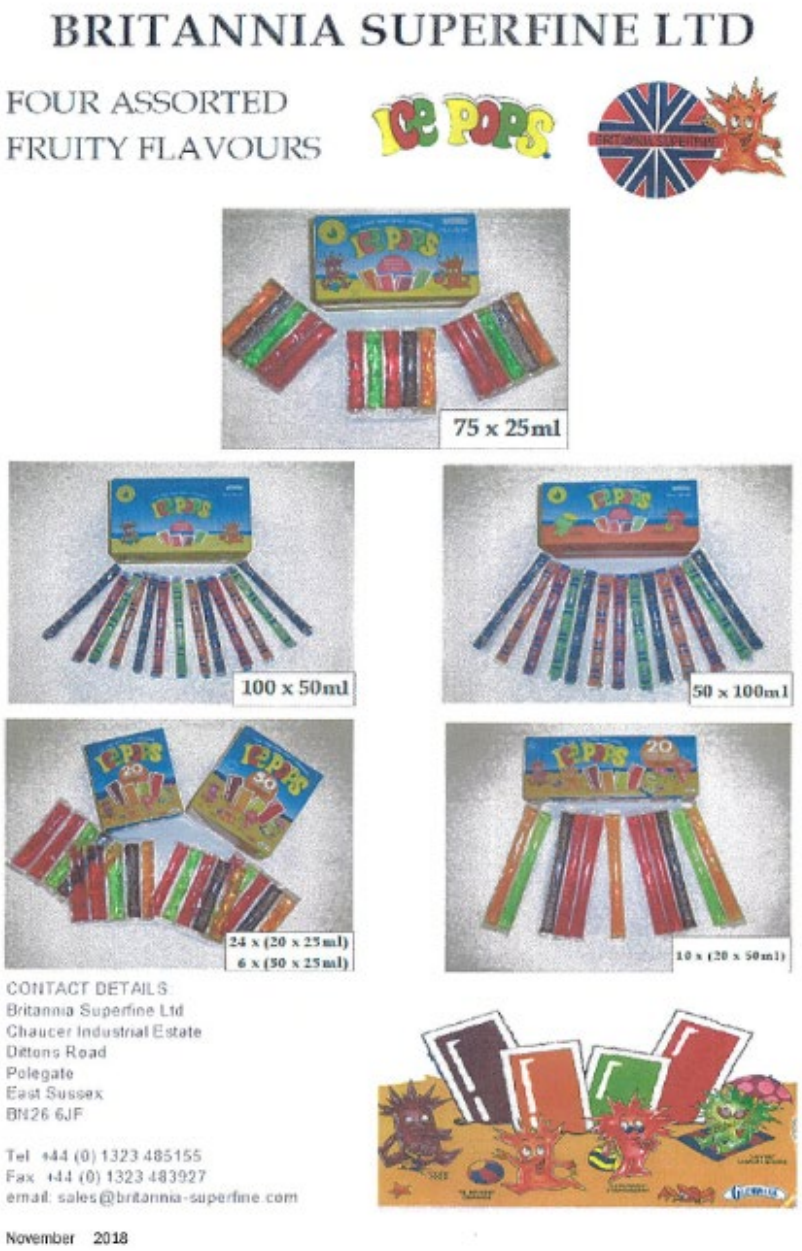
Fruit flavour Pops for Home freezing

5 Fruity flavours: Apple, Blackcurrant, Lemon, Strawberry, Orange



Britannia Superfine Ltd; telephone +44(0)1323 485155 or Email: sales@britannia-superfine.com

June 2019



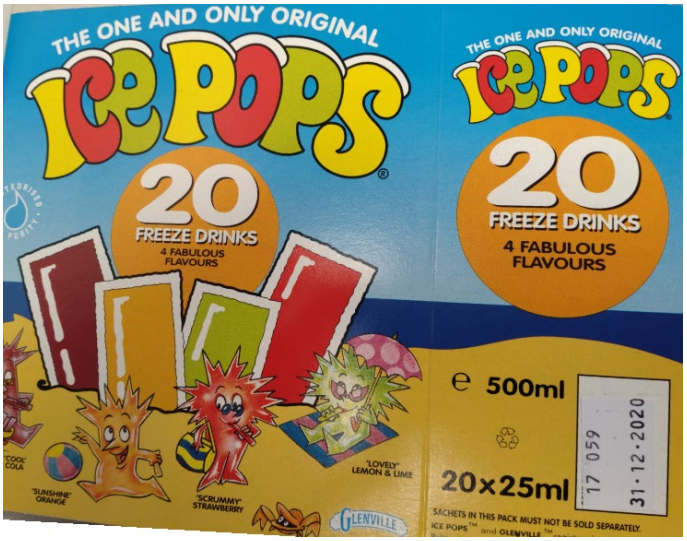
26. I acknowledge that the applicant has raised concerns regarding the authenticity of the evidence presented in Exhibit CM7. Specifically, it contends that the date November 2018 (as shown above) "*appears in a darker and different font to the rest of the wording on the document and could have been added after the fact and is therefore unreliable*." While I agree that the date does stand out, I note that the document is the same as the one filed with Exhibit CM3. It also appears that the evidence in chief document was cut off at the bottom, and it is also evident that the final image is not entire. Therefore, in the absence of other corroborating

evidence by the applicant, I consider that the opponent can rely on the exhibited materials.

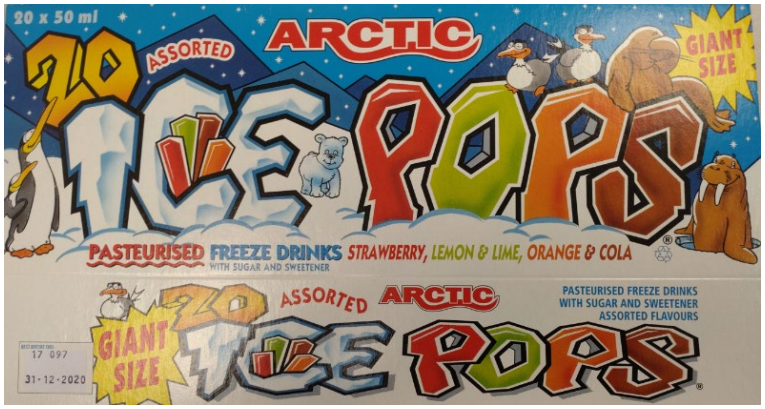
27. **Exhibit CM4** comprises a printout dated 6 August 1998 illustrating a packaging design bearing a variant form of the mark ICE POPS. I note that this exhibit falls outside the relevant period and has no evidential value for the purposes of the proof of use assessment.

28. **Exhibits CM5 and CM6** feature images from 13 July 2023, showcasing a variety of packaging examples. Mr Manser describes these as "*various examples of the different packaging produced for ICE POPS products, between 1998 and 2021 throughout the UK, including the ARCTIC range, as well as a collaboration with TINY iDOLS in 2014*." However, I note that these images are all dated outside the relevant period and do not shed any light on whether the marks were used during the relevant period.

29. **Exhibits CM8 and CM9** contain the images (shown below) of packaging which indicate best before dates of 31 December 2020 and 31 December 2024, respectively. Mr Manser states that Exhibit CM9 demonstrates "*how the mark is used on packaging in the UK marketplace at this time."* I note that Exhibit CM9 is outside the relevant period and unlikely to have evidential value as opposed to Exhibit CM8 which shows the following images of packaging:



Zoomed in version



30. Exhibit **CM10** consists of a signed letter from Tom Freemans dated 22 April 2024. The statement outlines that Freemans Confectionery Supplies Ltd has been trading continuously with the opponent since 2014 distributing ICE POPS branded products to outlets across the UK. I note that this evidence is hearsay, and that the 'Manual of Trade Marks Practice' sets out the following:

> "Parties to proceedings have on occasions solicited letters from third parties for the purposes of the proceedings, rather than getting the third party to file evidence by witness statement, affidavit or statutory declaration. These are often headed 'to whom it may concern', or, in some cases, are addressed directly to the Tribunal. Such letters will be treated as hearsay evidence. Parties are encouraged to present such evidence in the form of a witness statement rather than in the form of a letter if they wish to rely on it. A signatory to a witness statement, who can be cross-examined, is likely to exercise greater care and precision than a signatory to a letter."

31. Section 4 of the Civil Evidence Act 1995 permits hearsay evidence in civil proceedings but provides the following guidance as to the weight to be accorded to such evidence:

"Considerations relevant to weighing of hearsay evidence.

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following -

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

32. On this basis, it is clear that the letter post-dates the instigation of the opposition proceedings and its content suggests that it has been written for the purposes of the proceedings in issue. Even though I acknowledge that there are invoices between the opponent and the author of this letter, it would not have been too onerous for the opponent for this to have been presented in the form of a witness statement. Therefore, it is my view that the hearsay evidence should be given little weight.

Form of the Marks

33. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark."
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.
>
> 34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the

purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (Emphasis added)

34. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under Section 46(2). He said:

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

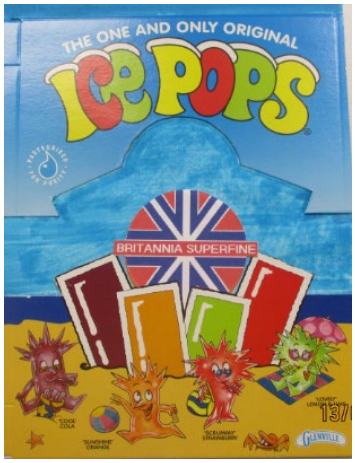
15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

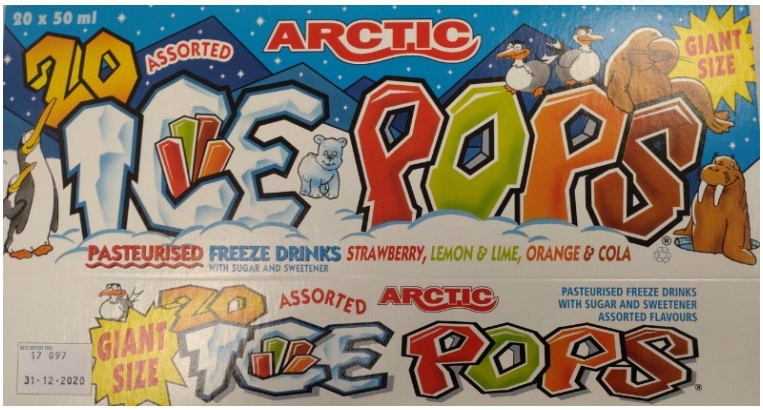
35. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Phillip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

36. There are examples of use of both earlier marks as registered in the evidence, such as invoices. There is also use in the following forms:

i. 

ii. ICE POPS®

iii. 

iv. 

v. ICE POP

37. The parties disagree about whether the above forms, as used by the opponent, are acceptable variants.

38. There are multiple differences between the word-only mark and the stylised variants. I bear in mind that in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, the General Court ("GC") held that a registration for a word mark is protected for the word or words contained therein in whatever form, colour or typeface.[3]

39. The forms in 'i' and 'ii' show the word elements "ICE POPS" in a comic/cartoon-style typeface, with each letter displayed in a different colour (yellow, red, and green) and outlined in black. Additionally, there appears to be a white shadow effect on the top of the letters. Notably, many of the letters overlap, and the text is presented in a mixed case, featuring both upper and lower case letters. The strapline "THE ONE AND ONLY ORIGINAL" in 'i' sits above the words "ICE POPS" in a standard typeface and upper case, using a significantly smaller white font. In accordance with the case law set out above, word marks have a broad protection in that the font (referring to typeface, size and weight) they are presented in must not be taken into account.[4] With regard to the colours used, whilst fair and notional use of a black and white mark does cover use in colour, it does not cover complex colour arrangements.[5] In my view, the colours used in the above variants do not represent a complex arrangement. They are three solid colours, including black outline, and they are acceptable in line with the relevant case law. The white shadow effect is non-distinctive, especially as it appears to be used to contrast with the background. Moreover, the strapline in 'i' is laudatory and does not indicate any trade origin. I find these differences do not alter the distinctiveness of the registered mark, and I am of the view that the distinctiveness of the words "ICE POPS" remains intact, and as such I consider this to be an acceptable variant.

[3] I also note Mr Philip Harris's comments on *HUMANRACE*, BL O/0234/25, in paragraphs 67 onward.

[4] See also T-333/15 *Josel v EUIPO*, EU:T:2017:444.

[5] See the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

40. The form in ‘iii’ showcases a variant of the plain or stylised word element “GLENVILLE” isolated without the words “ICE POPS”. I note that this element is displayed in the bottom right corner of the product packaging or the small print of packaging in Exhibit CM7, as depicted in ‘i’ above, appearing significantly smaller in size compared to the other elements on the packaging. Consequently, this use alters the distinctive character of the registered mark “GLENVILLE ICE POPS”, and I find this to be an unacceptable variant.

41. There are multiple differences between the registered mark and the form shown in ‘iv’ above. The latter consists of the word element “ICE POPS” presented in a 3D typeface, where the word “ICE” is designed to resemble ice blocks, while the colourful word “POPS” has a glossy finish. There are also additional figurative elements such as square blocks incorporated within the letter ‘C’, along with other figurative elements, such as animals, positioned either above or beside the word elements on the upper part of the packaging (as depicted in ‘iv’), albeit these are absent from the bottom of the packaging. These figurative elements would be seen as decorative, and thus “ICE POPS” would be perceived as indicating the origin of the goods. Consequently, I do not consider that the figurative elements form part of the mark, as they are not consistently present in the packaging of the goods, and as a result the distinctiveness of this form lies in the word elements. Despite the stylisation of the variant and the figurative elements, the verbal elements “ICE POPS” are present and will not alter the distinctiveness of the mark. Therefore, I consider that this form is an acceptable variant.

42. Lastly, there is also use in the singular form “ICE POP” of the registered mark in the invoices. I note that this will be seen as an indicator of commercial origin in accordance with the principles set out in *Colloseum*. Even if I am wrong in this finding, the difference stemming from the singular/plural would not alter the distinctive character of the registered mark. I, therefore, consider such use as an acceptable variant use of the registered mark as per *Lactalis*.

Sufficient use

Preliminary Points

43. The applicant filed evidence (Exhibit DMG2) with which it contends that "*the opponent's brand is no longer in use and appears to be a historical brand*." However, I note that the screenshots from the opponent's website are dated 29 January 2024. In addition, the applicant's evidence includes user discussions from the forums *theanswerbank.co.uk* and *forums.digitalspy.com*[6], with the former thread dated 25 August 2004 and the latter thread dated 5 January 2015. These dates fall outside the relevant period, and I note that post-dated evidence could have relevance if it contains information that sheds light on what the position was during the relevant period, that is not the case in this instance.

Assessment of the Evidence

44. I have previously set out the legislative provisions under Section 6A of the Act relating to proof of use, and the evidential burden on the opponent under Section 100. In determining whether there is real commercial exploitation of the mark, the assessment must take into account a number of factors.[7] A finding of genuine use does not depend on economic success or large-scale commercial use;[8] rather, it is concerned with the sort of use that is regarded as "*warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.*"[9]

45. Throughout these proceedings, the applicant's critique of the opponent's evidence is extensive, making a series of points about the inadequacies and deficiencies of the evidence filed. Central to the applicant's argument is the issue of the variant forms of the earlier marks, and the assertion that

[6] I also note that the .com domain does not indicate the website is aimed at a UK audience.

[7] See *easyGroup Ltd v Nuclei Ltd & Ors* above.

[8] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

[9] *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].

the opponent's evidence fails to support proof of use of the earlier marks as to the place and extent of such use. Earlier in my decision, I have delineated my findings in relation to the acceptable/unacceptable variant forms of the marks as shown in the evidence, and I will not expound on this matter any further. Regarding the place of use, the applicant contends that the invoices only show the sellers' addresses (three addresses in London and one address in Walsall), which the applicant claims that it is insufficient evidence of use across the UK. On the extent of use, the applicant asserts that the opponent has not provided adequate details about the extent of use or sales for the registered products. Further, the applicant contends that various pieces of evidence either fall outside the relevant period or are undated. It also submits that the total amount of the invoices within the relevant period is insignificant and that there has been a considerable drop throughout the relevant period. Lastly, the applicant puts forward that the use may amount to mere token use and considers it to be inconsistent throughout the relevant period.

46. The opponent in its evidence in reply responded to the applicant's claims. In summary, the opponent submits that the invoices cover the relevant period, and those that fall outside the relevant period for proof of use purposes, are still relevant to the assessment of the goodwill and reputation associated with the earlier marks. In addition, the opponent contends that the total value of the invoices reflects sufficient use, in line with the rationale established in *Ansul*. The opponent concluded by positing that the evidence demonstrates use of the registered goods bearing the earlier marks.

47. Whilst I have considered all the submissions, my account of the evidence in this decision made clear that I found there to be shortcomings in the evidence. The question is whether I consider the evidence taken as a whole convinces me that there has been genuine use of the registrations in the UK for the relevant periods.

48. The opponent's documentary evidence of use falling within the relevant periods can briefly be summarised as ten invoices, images of the (carton) packaging of the goods, as well as the annual sales figures provided in its narrative evidence.

49. The invoices indicate sales of products under the registered marks and their acceptable variants made to four entities, three of which are based in London and one in Walsall. Also, I note that the majority of the sales appear to be directed to a single UK distributor rather than directly to end-users. In its third witness statement and submissions in lieu, the opponent has pointed out that this distributor has been responsible for the distribution of the registered goods to various outlets throughout the UK. Although I note that there is no evidence of sales other than to four companies in the UK, this alone does not rule out the possibility of finding genuine use. I also note that evidence of sales to distributors, such as distribution invoices, does not rule out the possibility of finding genuine use as long as the goods bear the opponent's marks.

50. The invoice evidence shows sales of the goods bearing both earlier marks (including the acceptable variant of ICE POPS, namely ICE POP). Even though the opponent has not provided any evidence on the market share it possesses, and while the frozen desserts/treats industry in the UK is significant, based on the evidence, the above sales (falling within the relevant period) accrued over £26k under the earlier mark '192 and over £7k under the earlier mark '112 and the annual turnover from the sales of the goods accrued approximately £440k between 2017 and 2021. However, I note that the turnover figures themselves are not immune from criticism. As indicated earlier in this decision, these are not broken down by reference to the sales under each of the earlier marks. Even though a more precise indication of the turnover figures would have undoubtedly been helpful, the turnover figures are indicative of an attempt to create a market in the UK for the opponent's goods during the relevant period. Lastly, although I have no specific information on the distribution of the goods to determine the exact geographical spread of the marks within the

UK, it is reasonable to infer from the evidence, such as the quantities sold (exceeding 47k items), that the opponent is likely to have had sufficient distribution of the goods across the UK.

51. Although the evidence could have been better and more comprehensive in parts, such as how the goods were marketed, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.[10] Even though the opponent did not provide any evidence as to the market share it possesses, and the marketing expenditure, I am satisfied that the evidential picture as a whole supports that the opponent has operated in a way aimed at real commercial exploitation and has done so for a number of years. As such, the opponent can rely upon the registered marks for the purposes of these proceedings.

Fair specification

52. I must now consider what a fair specification would be for the use shown.

53. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

[10] See *New Yorker SHK Jeans GmbH & Co KG v OHIM,* T-415/09.

54. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to be followed:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.
>
> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate

interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

55. This approach was endorsed by the Supreme Court in *Skykick UK Ltd & Anor v Sky Ltd & Ors* (Rev1) [2024] UKSC 36, with the following comment:

> "261. … so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

56. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

57. The opponent has submitted that the earlier marks have been used in relation to all the goods relied upon in this opposition as follows:

> Earlier mark '112
>
> **Class 30:** Preparations included in Class 30 in liquid or frozen form for use in making water ices.
>
> Earlier mark '194

Class 30: Fruit flavoured preparations in liquid form for use in making frozen confections in the nature of water ices.

58. Given that the evidence describes the opponent's goods as "*pasteurised freeze drinks with sugar and sweetener assorted flavours*"[11] and as "*fruit flavour pops for home freezing*"[12], I am content to conclude that when confronted with the use shown, the average consumer would perceive the goods to be described by the terms as registered, and they would not seek to interpret them by using narrower terms. Therefore, I accept that the opponent has shown use of both marks for the registered goods in Class 30.

Section 5(2)(b)

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

> "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."

60. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market*

[11] See Exhibit CM8.

[12] See Exhibit CM7.

(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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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 Goods

61. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

> "23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. 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 complementary."

62. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

63. Taking into account the fair specification as set out earlier in this decision, the competing goods to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods
Earlier mark '112 **Class 30:** Preparations included in Class 30 in liquid or frozen form for use in making water ices. Earlier mark '194 **Class 30:** Fruit flavoured preparations in liquid form for use in making frozen confections in the nature of water ices.	**Class 30:** Ready to cook dough namely frozen bagels; frozen dough for making bagels; ice creams; bread products namely bagels.

64. The opponent claims that the contested goods are "*at the very least highly similar to the Opponent's goods in Class 30. The respective goods are all food products (with the majority being frozen products), aimed at the same*

consumers and sold through the same channels of trade. This being particularly the case for "ice creams" as covered by the Applicant's mark, being highly similar to the goods of the Opponent, with such goods being sold, marketed and consumed in exactly the same manner, and to the same consumers."

65. The applicant made lengthy submissions, which I will not reproduce here but have taken into consideration, denying any similarity.

66. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[13]

Ice creams

67. I consider that the competing goods share the same purpose and users. Even though the applicant highlights in its submissions that specific consumer groups, such as vegans or those who are lactose intolerant, cannot usually consume ice cream, I consider that the contested term is broad enough to reasonably include ice creams specifically designed for those groups of consumers. As a result, the competing goods target members of the general public in a comparable way, resulting in an overlap in users. Also, there is a degree of competition in this case, as users may choose to buy the earlier goods for home freezing or choose ready-to-eat ice cream. Although the goods may differ in their nature (milk/cream-based products vs water-based products) and method of use (being ready for consumption vs preparations), they overlap in trade channels, although they would not be found on the same shelves or in the same sections of supermarkets and grocery stores next to each other. The applied-for goods would need to be stored in freezers, while the opponent's goods can be

[13] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

kept at room temperature in the shop. I find that the goods are similar to between a medium and high degree.

Ready to cook dough namely frozen bagels; frozen dough for making bagels; bread products namely bagels

68. The contested goods are considered as being either ready to eat or ready to bake bagels. The competing goods differ in nature as the earlier goods come in liquid form as opposed to the contested goods which are either finished, partially prepared, or raw bakery items. They also differ in the method of use. Even though the competing goods may commonly be offered for sale in supermarkets or grocery shops, it is not likely they will be found in same sections or shelves (frozen bakery/bakery aisles v ice creams/frozen desserts aisle). Further, I do not consider that the competing goods are complementary or in competition. Even though the competing goods share users, namely members of the general public, such a factor is not sufficient per se to find similarity. I find the goods to be dissimilar.

69. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier marks' goods.[14] **The opposition cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

> **Class 30:** Ready to cook dough namely frozen bagels; frozen dough for making bagels; bread products namely bagels.

Average Consumer and the Purchasing Act

70. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average

[14] Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

71. The goods at issue would be purchased and consumed by the general public. These are inexpensive goods purchased through primarily visual means, most often selected from supermarket shelves or on their online equivalents. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Whilst the average consumer will predominantly purchase them following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing them will be no more than medium as the average consumer is likely to consider dietary requirements, flavour and/or nutritional information.

Comparison of Trade Marks

72. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in

mind their distinctive and dominant components. 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."

73. 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.

74. The marks to be compared are:

Earlier Mark	Contested Mark
Earlier Mark '112 ICE POPS Earlier Mark '192 GLENVILLE ICE POPS	

Overall Impression

75. The applicant in its submissions states the following:

> "39. The Applicant argues that "ice pops" have become customary in the course of trade to mean a frozen stick of flavoured ice, see the Witness Statement of Daniella Michelle Garvey ("**DMG**") and pages

24 to 28 of **Exhibit DMG1** showing a screenshot from Wikipedia detailing the meaning of “ice pop” as well as a history of the brand, of which the Opponent is not mentioned.

40. The Applicant argues that because “ice pops” have become customary in the course of trade for ice lollies (and thus the Relevant Goods), the Earlier Trade Marks have lost any previous distinctiveness as “ice pops” and the Earlier Trade Marks are therefore no longer an indicator of origin to the Opponent. This is supported by the number of products being sold by a variety of sellers using “ice pops” (see the Witness Statement of DMG and **Exhibit DMG2**). Therefore, the Earlier Trade Marks are no longer valid for the Relevant Goods, “on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered” as per the decision in *Merz & Krell GmbH case C-517/99*.

[…]

51. […] “GLENVILLE” does not appear to have a specific meaning. The marks are conceptually dissimilar on this basis.” (original emphasis)

76. In its submissions in lieu of a hearing, the opponent states that:

“34. The Applicants Mark consists of the words iGLOO ICE POP in a stylised form. The mark is dominated by the words ICE POP positioned on over the other with iGLOO positioned to the left of the word ICE and taking up about the same space as the letters IC of ICE.

35. The Opponent’s first Mark consists of the plain word ICE POPS, being the plural form of ICE POP. The Opponent's second Mark consists if the plain word GLENVILLE ICE POPS. GLENVILLE and ICE POPS have substantially equal dominance in the mark, taken as a whole.

36. ICE POP is a distinctive and dominant part of all three Marks."

77. Both of the earlier marks are word marks. Registration of a word mark protects the words themselves.[15] The earlier mark '112 consists of the words "ICE POPS". I consider that the significant proportion of the average consumers will perceive these words as a single unit, conceptualising them as a type of frozen treat or snack. It is my view that only a minority of consumers may be aware that they refer to edible ices with a sweet fruit flavour. The applicant submits that the words are non-distinctive, and I will return to this point later in my decision. I consider that the overall impression conveyed by the mark rests in the unit created by the combination of the words it comprises, the whole of which is highly allusive to the opponent's goods.

78. As to the earlier mark '192, I concur with the applicant that no immediate perceptible meaning can be attributed to the term "GLENVILLE". In this regard, the average consumer will likely perceive it as an invented word or name. Moreover, I consider that the word "GLENVILLE" will not give rise to a unified meaning that will hang together with the rest of the words in the mark, namely "ICE POPS". Therefore, I consider that the word element "GLENVILLE" will be the most dominant and distinctive element in the mark, having the greatest relative weight in the overall impression, with the words "ICE POPS" playing a lesser role in the overall impression due to their high allusiveness to the registered goods.

79. The contested mark is a composite mark consisting of stylised words and figurative elements in black, grey, and white. At the top left corner of the mark, the word "iGLOO" is enclosed in a round-shaped device, appearing in a stylised typeface and a bold font where the first letter is in lower case and the remaining letters are in upper case. There is also a thin curved line positioned underneath the letters "-OO" that the applicant submits could evoke "*the impression of eyes and a smiling mouth*". Without excluding the

[15] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

possibility that it could be perceived as a smiley face, it is my view that a significant proportion of consumers will see it as merely a decorative element. Further, I agree with the applicant's definition of the word "iGLOO" from the Cambridge Dictionary, as it will be understood in its ordinary dictionary meaning. It is my view that the term will be weakly allusive of the frozen nature of the contested goods, thereby being distinctive to a slightly less than medium degree. Centrally and next to the word "iGLOO", the words "ICE POP" are the largest word elements appearing in a stacked format and gradient black font with a white outline and a shadow effect. Similarly, in this case, the words "ICE POP" will be attributed the same meaning as articulated above, albeit in the singular form. Despite being the visually dominant elements, the words "ICE POP" will be highly allusive to the goods. As a result, the stylisation and presentation of the words will play a greater role, though they will still be secondary to the words. Further, it is my view that the average consumer will pay attention to the word "iGLOO" by virtue of its distinctiveness, albeit being the smallest element in the mark, thereby making a contribution. Although the word "iGLOO" is presented in a specific typeface along with figurative elements, they will all have some but less impact on the overall impression of the mark.

Visual Comparison

Earlier mark '112 and contested mark

80. The earlier mark consists of two words, "ICE POPS", which are seven letters long, whereas the contested mark contains three word elements, namely "iGLOO" and "ICE POP", which are eleven letters long. I note that the contested mark incorporates the entirety of the earlier mark apart from the final letter 'S', namely ICE POPS/ICE POP. Whilst it is not legitimate to perform a comparison between a word mark and a stylised word mark by considering specific ways in which the words might be presented, the

typeface[16] and colour[17] in which the earlier mark is presented in this case do not provide a point of distinction in itself. However, the marks differ in more than one element. In particular, there is no counterpart of the word "iGLOO" in the earlier mark nor any of the figurative elements. In addition, the stacked presentation of the contested mark and its stylisation are all points of visual difference. Thus, weighing the various points of similarity and difference, including the overall impression of the marks, I consider that the marks are visually similar to a medium degree.

Earlier mark '192 and contested mark

81. Visually, the earlier mark consists of three words "GLENVILLE ICE POPS" which are 16 letters long as opposed to the verbal elements of the contested mark which are 11. Similarly, in this case, the marks share the same six letters, namely "ICE POP", but they differ in the rest. Further, they diverge in the presence/absence of the word elements "iGLOO" and "GLENVILLE". As advanced in the preceding paragraph, the typeface and colour in which the earlier mark is presented does not provide a point of distinction in itself. That said, the presentation and stylisation, and the figurative elements of the contested mark would create another point of difference between the marks. Taking all this into account, including the overall impression of the marks, I find that the marks are visually similar to between a low and medium degree.

Aural Comparison

Earlier mark '112 and contested mark

82. The earlier mark will be verbalised as "ICE-POPS". The contested mark contains three verbal elements, namely "ICE-POP" and "IG-LOO". I consider that both the earlier and the contested marks will be sharing the same syllables "ICE-POPS/ICE-POP", save for articulating the letter 'S'. It

[16] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

[17] See *Specsavers* [2014] EWCA Civ 1294; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290.

is my view that the average consumer will also articulate the word “IG-LOO” adding to the aural difference between the competing marks. I find that the marks are aurally similar to a medium degree.

Earlier mark ‘192 and contested mark

83. The earlier mark will be pronounced as “GLEN-VILLE-ICE-POPS”. The shared verbal elements “ICE-POP” in the contested mark will be similarly pronounced as the earlier mark but in its singular form. However, the marks differ in the presence/absence of the verbal elements “IG-LOO” and “GLEN-VILLE”. Therefore, I find that there is a low to medium degree of aural similarity.

Conceptual Comparison

84. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

85. Although the competing marks differ in their singular and plural forms of the shared elements “ICE POP/POPS”, the average consumer in the UK will readily extract the same concept. I also consider that the term will be perceived as highly allusive to the competing goods. It is my view that either the singularisation or pluralisation of the term does not affect the perception of the average consumer, or if it does, it is very minimal. Therefore, the common elements in the competing marks are conceptually identical. Further, I have also considered above the meaning of the words “GLENVILLE”, “iGLOO”, and whether the curved line underneath the letters ‘-OO’ (in “iGLOO”) will carry a concept. Taking all the above factors into account and the overall impression of the marks, I find that the competing marks are conceptually similar to between a medium and high degree.

Distinctive Character of the Earlier Trade Marks

86. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "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).
>
> 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)."

87. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

88. The opponent in its submissions in lieu of a hearing put forward the following:

"17. The word ICE POPS, relative to the goods of the registration, and from the perspective of the average consumer for those goods, has no direct reference to the characteristics of the goods at issue and subject of the ICE POPS Mark in its entirety. It is submitted that, whilst ICE might be construed as referring to the composition of the goods, POPS is fanciful in relation to such goods and therefore it follows that the mark as a whole (without erroneously artificially dissecting it into its constituent components) is therefore inherently distinctive."

89. On the other hand, as quoted earlier in this decision, the applicant submits that the words "ICE POPS" in the earlier marks have become customary in the trade and have lost any previous distinctiveness.[18] However, I note that it is not open to me to find the marks as a whole non-distinctive. This is because they are registered trade marks and as such they must be regarded as having at least a minimum level of distinctive character.[19]

90. As outlined in the previous section, the opponent's word marks consist of or contain the words "ICE POPS". When considered against the goods relied upon, I find that these will be viewed as highly allusive. Bearing in mind when making my assessment the rationale in *Formula One*, and weighing all the factors, I find the earlier mark '112 is inherently distinctive to a low degree. As to the earlier mark '192, the additional element "GLENVILLE", having no particular concept, will be the most distinctive element in the mark, thereby awarding some additional degree of distinctiveness to the mark. Thus, I find the earlier mark '192 to be inherently distinctive to a medium degree.

[18] I note that Exhibit DMG1 is an extract from a Wikipedia page for "ice pop" dated 29 January 2024, which falls outside the relevant date. I also bear in mind that Wikipedia is an open-source encyclopaedia website that can be collaboratively edited or amended by any user, which makes its reliability questionable. In addition, the rest of the evidence adduced with Exhibit DMG1 consists of search results using the term "ice pops" found across various online marketplaces for products (some of which are cookbooks and recipe books) sold by third party traders, all of which are also dated after the relevant date.

[19] *Formula One Licensing BV v OHIM,* Case C-196/11P.

Enhanced Distinctiveness

91. I have summarised the opponent's evidence at paragraphs 21 to 32 above. Taking all of the evidence into account, I find it insufficient to demonstrate that both the earlier marks have acquired an enhanced degree of distinctive character through use in the UK. Although invoices and turnover figures are provided, there is no indication of the market share held by each of the marks. The level of sales in relation to the given goods bearing the marks do not on their face appear trivial but they are unlikely to represent more than a very small share in what is undoubtedly a significant market. Importantly, no evidence of advertising spend, promotional material or activities were provided to support any extensive media coverage or intensive advertising or promotional activities in the UK. I do not consider that the use shown establishes enhanced distinctiveness for the relevant UK public as a whole or even for a significant enough subset of it. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness for the registered goods.

Likelihood of Confusion

92. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[20] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[21]

[20] See *Canon Kabushiki Kaisha*, paragraph 17.

[21] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

93. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

94. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, sitting 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 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."

95. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC 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."

96. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average

consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

97. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth KC, as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHWC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

"(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

98. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

99. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a

reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

100. Earlier in this decision I have concluded that:

- the competing goods at issue are similar to between a medium and high degree;
- the average consumer of the goods will be a member of the general public. The selection process is predominantly visual without discounting aural considerations. The degree of attention will be no more than medium;
- the contested mark and the earlier mark '112 are visually and aurally similar to a medium degree, and conceptually to between a medium and high degree;
- the contested mark and the earlier mark '192 are visually and aurally similar to between a low and medium degree, and conceptually to between a medium and high degree;
- the earlier mark '112 has a low degree of inherent distinctive character; the earlier mark '192 has a medium degree of inherent distinctive character; and the use is not sufficient to establish enhanced distinctiveness of the marks.

Earlier mark '112 and contested mark

101. Although I have found earlier in this decision that the inherent distinctiveness of the earlier mark is of a low degree, this does not rule out a likelihood of confusion.[22]

[22] See *L'Oréal SA v OHIM*, Case C-235/05 P. Also, in *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*, O/0331/23, Phillip Johnson, as the Appointed Person, found that there was a likelihood of confusion, despite the common elements only having low distinctiveness.

102. Taking into account the above factors and case law, I am persuaded that there is no likelihood of direct confusion for similar goods. I have previously found that the common word elements, “ICE POP/POPS”, would be weakly distinctive,[23] and as a result greater weight will be attributed to the remaining elements of the contested mark. In this respect, the contested mark combines different elements, namely the additional stylised word element “iGLOO”, which is sufficiently more distinctive than the common elements,[24] and the stylisation/presentation of the word elements “ICE POP”, each playing their respective role to the overall impression. Whilst the marks may be conceptually similar, that shared concept is not materially significant, especially as the concept relates to the goods being provided. Therefore, the visual and aural differences are sufficient to differentiate between them. Notwithstanding the principle of imperfect recollection and the degree of attention being no more than medium, I consider that the additional elements in the marks will be sufficient to enable the consumer to differentiate between them. Therefore, taking all of the above into account, I find that there exists no likelihood of direct confusion between the contested mark and the opponent’s mark.

103. Even if the average consumer recalls that one mark contains the additional elements and the other does not, I still consider that the marks would not be indirectly confused for similar goods. This is because while both marks contain the common elements “ICE POPS/ICE POP”, which are of low distinctiveness, the consumers would have no reason to believe that only one undertaking would use these words in relation to the competing goods. Further, it is my view that the addition of the word element “iGLOO” together with the stylisation and presentation of the contested mark as a

[23] In this regard I note that in *Whyte & Mackay v Origin Wine* [2015] EWHC 1271 (Ch) (Ch), Arnold J. (as he then was) found that there was no likelihood of confusion between the marks ‘ORIGIN’ and ‘JURA ORIGIN’ (both of which were for alcoholic beverages). Despite the similarity in the use of the word ORIGIN, it was found that that word was inherently descriptive and had low distinctiveness and, in particular, he stated that:

> “44. […] what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

[24] See guidance in *Face2FaceHR Partners Limited v Peninsula Business Services Limited.*

whole are not consistent with a brand extension or sub-brand of a house mark; hence, I do not consider that it is likely that the average consumer would interpret it in this manner. Whilst I acknowledge that the categories in *L.A. Sugar* are not exhaustive, I can see no other basis for concluding that the average consumer would perceive the marks to be from the same, or economically linked, undertakings. I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word elements in the marks but would not confuse the two. Thus, I consider that there is no likelihood of indirect confusion.

Earlier mark '192 and contested mark

104. Taking into account the above factors and even considering the similar goods in play, there is no likelihood of direct confusion. Despite the presence of the common word elements "ICE POP/POPS" in the competing marks, the average consumer will not misremember the marks as each other because of the presence of the additional distinctive and divergent word elements "GLENVILLE", which is placed at the beginning of the earlier mark (a position which tends to be considered more impactful), and "iGLOO". In this respect, and according to the rationale in *Kurt Geiger* as quoted above*,* the likelihood of confusion in this case is reduced. Notwithstanding the principle of imperfect recollection, the consumers will not confuse one mark for the other. Thus, the various differences between the competing trade marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

105. Turning to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I consider the marks would not be indirectly confused for the respective similar goods. In particular, while the average consumer will identify the difference in the competing marks, they will recognise the words "GLENVILLE" and "iGLOO" in the competing marks are unconnected and do not form a

cohesive whole with the rest of words. Such differences between the competing marks are not consistent with a sub-brand, brand extension or variant. Bearing in mind my assessment of the overall impression, I find that the average consumer, when coming across the respective marks will view the shared common elements as a coincidence, rather than indicating that those undertakings are economically linked. I do not, therefore, consider there to be a likelihood of indirect confusion

106. The opposition under Section 5(2)(b) has been **unsuccessful in its entirety**.

Section 5(3) of the Act

107. Section 5(3) of the Act states:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

108. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

109. The conditions of Section 5(3) are cumulative. First, the opponent must show that the marks are similar. Second, the opponent must show that the earlier marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Third, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods be similar, although the relative distance between them

is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

110. The opponent relies on the same marks and goods here as it did under its Section 5(2)(b) ground. I note that the applicant denied the opponent's claim regarding Section 5(3), providing extensive submissions. The applicant submits that the marks are used in different variant forms and not in the registered form. It also submits that the opponent's evidence is either insufficient or does not show reputation of the earlier marks in the UK. Further, it argues that the term "ICE POPS" has lost its distinctiveness and is a generic term for an ice lolly, and thus cannot be found to have a reputation for the registered goods. In addition, the applicant argues that a brand with an alleged reputation would exhibit higher sales volume over the provided six-year period. It highlights the fact that only one invoice has been submitted as evidence that falls within the relevant date, asserting that the use in the years previous to this date is insignificant. As outlined in paragraph 24 of this decision, there are ten invoices that fall within the relevant period, and I note that any use prior to the relevant date can also be considered in the assessment under Section 5(3). The applicant further argues that even if reputation is found, there is little or no link or economic connection between the competing marks, as there are clear differences between the competing marks and the competing goods are dissimilar. The applicant denies that the use of the contested mark will take unfair advantage or be detrimental to the distinctive character or the repute of the earlier marks. The applicant emphasises that it has been selling ice creams under its IGLOO brand since 1978, acquiring its own reputation. In this respect, the applicant posits that the contested mark would not be linked or confused with the earlier marks.

111. In response, the opponent filed further arguments with its submissions in lieu of a hearing. The opponent contends that the evidence provided demonstrates that the earlier marks possess an inherent and enhanced distinctiveness while enjoying significant reputation, and that there is a high similarity between the goods. As such, the opponent asserts that the

required link is established and that the earlier marks will be called to mind when the average consumer encounters the applicant's mark. On that basis, the opponent further claims that the use of the contested mark will be detrimental to the distinctive character of the reputed earlier marks and to their individual capability to function as a badge of origin. Lastly, the opponent submits that the applicant will "free ride" on the coat tails of the earlier reputed marks and the investment made by the opponent. The opponent restated its concern that it cannot control the use of the contested mark, or the quality of the goods associated with it, and if that quality is inferior, the reputation of the earlier marks will be tarnished.

112. As delineated earlier in this decision, the first condition of similarity between the marks is satisfied as I have already found under Section 5(2)(b) the marks to be visually, aurally, and conceptually similar.[25] I will proceed to consider the next condition, that of reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. The relevant date for the assessment under Section 5(3) is the filing date of the contested application, namely 16 September 2022.

Reputation

113. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

[25] See paragraphs 72-81.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

114. In *Spirit Energy Limited* v *Spirit Solar Limited,* BL O/034/20, Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for Section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of Section 5(3).

115. I also bear in mind that the question relates to a knowledge requirement, similar issues arise here as in relation to enhanced distinctive character. However, it is a higher bar than for genuine use. I have already assessed the opponent's evidence above. Thus, for the same reasons as given at paragraph 91, including shortcomings in the evidence showing marketing

expenditure or how the mark has been promoted to the consumers, I do not consider that the opponent has established that the earlier marks had a qualifying reputation at the relevant date.

116. The opposition reliant upon Section 5(3), therefore, **fails**.

Section 5(4)(a)

117. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> (aa) […]
>
> (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

118. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

119. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

120. 'Halsbury's Laws of England Vol. 97A' (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant date

121. The contested mark was applied for on 16 September 2022, and that filing date is the relevant date. However, if the applicant had used its trade mark prior to this date then this use must also be taken into account.[26] The applicant states in its submissions that it "*has been selling ice creams under its IGLOO brand in the United Kingdom for at least 40 years (since 1978)*". However, the applicant has not filed any evidence in this regard. Therefore, I am unable to infer whether the applicant was actually trading at the time of the application for the contested mark, and, if so, for how long. Consequently, the opponent must show that it had goodwill in a business at the application date, that is on 16 September 2022, and that the signs relied upon are associated with, or distinctive of, that business.

[26] See *Advanced Perimeter Systems v Keycorp Limited* (MULTISYS), BL O-410-11, paragraph 43.

Goodwill

122. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, at paragraph [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

123. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

124. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

125. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so

as of the relevant date, which is, at least in the first instance, the date of application."

126. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

127. The case law above makes it clear that goodwill must be more than trivial in extent, but that a business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.

128. The applicant has raised several criticisms regarding the insufficiency of evidence[27] demonstrating that the opponent's signs have accrued protectable goodwill. In particular, the applicant contends that the

[27] This includes the additional evidence CM7-CM10 filed by the opponent.

opponent's evidence only shows limited use of ICE POPS in various formats and not as a word mark. It further argues that "*the Opponent's brand is outdated and the evidence provided is either undated, appears outdated or is limited in relation to the dates provided. It cannot be found that the brand currently has goodwill in the UK in the Unregistered Marks* […]."[28] The applicant also raises that the opponent failed to explain how misrepresentation would result from the use of the contested mark, highlighting that there are significant differences between the contested mark and the earlier signs. In addition, the applicant denies that any damage will be caused to the goodwill of the opponent's unregistered signs, reiterating that the marks and goods are dissimilar.

129. An assessment of genuine use is, of course, not the same thing as an assessment of goodwill. In *Mercis BV v Bunnyjuice* Inc, BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, said:

> "57. […] In trade mark law, the analysis of proof of use, reputation and enhanced distinctive character needs to be performed on a granular basis, looking at each of the individual goods and services in turn. […] In passing off law, however, goodwill attaches to a business, rather than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, 'What is the nature of the business?', but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc."

130. The opponent claims to have used the signs for all the goods shown in the specifications of the earlier marks since at least 2001. Bearing in mind my summary and assessment of the evidence earlier in this decision, there are certain deficiencies. However, I note that Mr Manser, in his first witness statement, has provided annual sales figures for the UK covering the periods from 2016 to 2021 for "*ICE POPS and GLENVILLE ICE POPS branded range of products, with sales (all being in relation to ICE POPS*

[28] Paragraph 85 of the applicant's submissions.

branded products)[…]", reporting total sales exceeding £640k. Further, Exhibit CM2 contains invoices dated between 2016 and 2022 of goods under the ICE POPS and GLENVILLE ICE POPS signs, as shown in the following table:

Date	Amount in GBP	Quantity	Units
11/04/2016	5,834.40	6,120	60
06/06/2016	7,001.28	8,840	60
27/06/2016	5,834.40	374	60
30/06/2016	5,834.40	340	60
30/07/2016	4,161.60	6,392	60
23/05/2017	6,364.80	7,480	60
13/05/2018	4,406.40	8,840	60
13/06/2018	6,364.80	80	60
16/07/2018	269.28	8,840	60
23/07/2018	204	509	60
31/03/2019	3,835.20	6,120	60
23/07/2019	5,385.60	8,840	60
12/08/2019	6,364.80	374	60
02/04/2021	403.2	340	6
31/05/2021	6,364.80	6,392	60
14/08/2022	366.48	7,480	70
Total	68,995.44	77,361	916

I also note that the majority of the invoices from the opponent demonstrate repeat purchases from a distributor based in Walsall, who, according to Mr Manser, distributed the goods to outlets throughout the UK.

131. No information about the size of the relevant market and the market expenditure has been provided, and there is no evidence before me to that effect. Nonetheless, Exhibit CM1 shows use of the "ICE POPS" sign on a brochure as early as 1998. In addition, taking into account the sample invoices, which confirm sales volume exceeding 77k items coupled with annual turnover data covering a fairly longstanding period of time (i.e. 2016-2021), I consider the evidence to be sufficient to demonstrate a level of protectable goodwill. I will proceed on the basis that the opponent has a moderate goodwill in relation to the same goods for which there is

genuine use for the “ICE POPS” and “GLENVILLE ICE POPS” signs and that the signs are distinctive of that goodwill.

Misrepresentation

132. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> “There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:
>
> > “is it, on a 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].
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.

And later in the same judgment:

> […] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

133. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails deception of a substantial number of members of the public rather than confusion of the average consumer, it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different results.[29] This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

134. I remind myself that under this ground of opposition there is no requirement for the goods at issue to be similar, in the sense that an assessment of whether there is a likelihood of confusion under Section 5(2)(b) requires some degree of similarity.[30] Rather, I must have regard to the closeness or otherwise of the respective fields of activity in which the parties carry on their business. The opponent's goodwill relates to Class 30 preparations as shown earlier in this decision. I remind myself that the applicant's goods are as follows: "*ready to cook dough namely frozen bagels; frozen dough for making bagels; ice creams; bread products namely bagels"*. Under Section 5(2)(b), I found that the contested term "*ice creams*" was similar to between a medium and high degree to the earlier goods, while the remaining contested goods (bagel goods) were dissimilar.

135. In considering "*ice creams*", I must determine whether a substantial number of the opponent's customers or potential customers would be deceived. I recall that the parties' goods would be purchased by members of the general public, exercising no more than medium degree of attention. In my view, the use of the applicant's mark would not result in substantial numbers of the general public being misled into purchasing the applicant's ice creams in the belief that they are the responsibility of the opponent. This is primarily due to the weakly distinctive character of the terms "ICE

[29] Although this was an infringement case, the principles are equally applicable to Section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

[30] eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

POPS" and the difference emanating from the term "iGLOO", which I previously found to be more distinctive than the terms "ICE POPS". I find no misrepresentation in respect of these goods. It is my view that in this instance, the test for misrepresentation under Section 5(4)(a) will not produce a different result to my assessment under Section 5(2)(b).

136. I now turn to the remaining goods (bagel goods). In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego case Falconer J*. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> '…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':
>
> Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling

on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'…in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

137. For the same reasons I have identified under Section 5(2)(b), namely due to the distance between the goods, I find there will be no misrepresentation in respect of the remaining goods as the opponent's customers will not assume that there is a trade connection. In my view, the moderate goodwill of the opponent is not sufficient to bridge the gap in this case.

138. The 5(4)(a) ground, therefore, **fails**.

CONCLUSION

139. **The opposition under Sections 5(2)(b), 5(3), and 5(4)(a) has failed**. Therefore, subject to any successful appeal, the application can proceed to registration.

COSTS

140. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the applicant on the following basis:

Preparing a counterstatement and considering the other side's statement	**£200**
Preparing evidence and considering and commenting on the other side's evidence	**£500**
Preparing for and considering on the other side's written submissions and written submissions in lieu of a hearing	**£500**
Total	**£1,200**

141. I, therefore, order Britannia Superfine Limited to pay to International Foodstuffs Co. LLC the sum of £1,200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of July 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General