

O/0800/25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 3951882  
BY RWANDA COFFEE FARMERS COMPANY LTD  
TO REGISTER THE TRADE MARK:**



**IN CLASS 30**

**AND**


**OPPOSITION THERETO  
UNDER NO. 445761 BY  
ANDREAS HÜHSAM AND PETER HÜHSAM**

## BACKGROUND & PLEADINGS

1. Rwanda Coffee Farmers Company Ltd (“the applicant”) applied to register the trade mark shown on the front page of this decision in the United Kingdom on 31 August 2023. It was accepted and published in the Trade Marks Journal on 10 November 2023 for the following goods:

**Class 30:** Coffee and substitutes therefor.

2. On 9 February 2024, Andreas Hühsam and Peter Hühsam (“the opponents”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. The opponents are the proprietors of the following UK comparable mark<sup>2</sup>:

<b>Trade Mark no.</b>	UK00911114824
<b>Trade Mark</b>	 The logo features a gorilla wearing a yellow suit and a black top hat, holding a lit cigarette. The gorilla is set against a red oval background. The word "GORILLA" is written in a black, stylized, arched font above the gorilla.
<b>Mark Description/ Limitation</b>	Colour Claimed: Yellow, Brown, red, white, black.
<b>Goods and services for</b>	Classes 30 & 43

---

<sup>1</sup> 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.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EU trade mark (“EUTM”). As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

<b>which the mark is registered</b>	
<b>Filing date</b>	13 August 2012
<b>Date of entry in register</b>	20 March 2013

3. For the purposes of this opposition, the opponents rely only on the terms “*coffee*” in Class 30 and “*providing of food and drink; catering; bar services*” in Class 43 as covered by the earlier specification.
4. In summary, the opponents claim that the contested mark is overall similar to the opponents’ mark. They also assert that the contested goods are either identical to the opponents’ goods or similar to the opponents’ services, and there exists a likelihood of confusion.
5. The applicant filed a defence and counterstatement and put the opponents to proof of use of the earlier mark relied upon, denying the opponents’ claims. Although the applicant denies any similarity or identity between the contested goods and the opponents’ services, it admits that the goods in the competing specifications are identical. Nevertheless, it claims that there will be no likelihood of confusion and/or association because the applicant’s mark is distinguishable from the opponents’ mark.

### **Papers filed and Representation**

6. The opponents’ evidence consists of a witness statement dated 26 July 2024 from Roman Hühsam, the CEO of Kaffeegroßrösterei (the licensee of the EUTM 011114824 from which the opponents’ comparable mark was created). Mr Hühsam’s evidence is accompanied by 6 exhibits (PH-1 to PH-6) and is directed to establishing genuine use of the earlier mark.
7. The applicant filed written submissions in these proceedings on 14 October 2024. Both parties filed written submissions in lieu of a hearing on 9 December 2024.
8. While I have taken the evidence and submissions into account in reaching my decision, I do not propose to reproduce or summarise them here but

will refer to the salient points below, to the extent that it is considered appropriate.

9. The applicant is represented by Groom Wilkes & Wright LLP, and the opponents are represented by Wilson Gunn.

### **Preliminary Remarks**

10. I note that the applicant with its submissions in lieu of a hearing has listed UK trade mark registrations featuring the word “GORILLA”. The fact that there may be a multitude of trade marks on the register with Class 30 protection for coffee that contain the word “GORILLA” is not a relevant factor to the assessment of this present case. The outcome of this opposition will be determined based on the merits of the case and the assessment of similarity between the marks at issue, amongst other considerations. The mere presence of these trade marks on the register cannot be said to demonstrate that there has (or has not been) confusion in the marketplace, as there is no evidence that such trade marks are actually being used or, indeed, in relation to what goods. Thus, the state of the register is “irrelevant”<sup>3</sup> to this assessment, and it is established that evidence of the state of the register is of little assistance or even “worthless”<sup>4</sup> in the context of an opposition of this nature.

## **DECISION**

### **Relevant Date/Period**

11. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(1) This Section applies where—

---

<sup>3</sup> *BREXIT* (O/262/18) at [10]; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305.

<sup>4</sup> *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2022] EWHC 1244 (Ch).

(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.”

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

13. The relevant period for proof of use of the opponents’ mark is **1 September 2018 to 31 August 2023**. In the present proceedings, the opponents rely on a UK comparable mark, and, thus in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **1 September 2018 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account. For completeness, for the remaining period (1 January 2021 to 31 August 2023), it is only the UK use that counts.
14. 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 **31 August 2023**.

### **Proof of Use**

15. 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 Bunderversvereinigung 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.”

16. As the earlier mark is a comparable mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use. [...]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. [...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or

services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

17. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the

geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In *Case T-278/13 Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I

understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of Leno persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use.”

19. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a comparable mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of a comparable mark in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of a comparable mark. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
20. Whether the use shown is sufficient to demonstrate genuine use will depend on whether there has been real commercial exploitation of a comparable mark, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the UK (and the EU prior to IP completion day) during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:
  - i. The scale and frequency of the use shown
  - ii. The nature of the use shown
  - iii. The goods and services for which use has been shown
  - iv. The nature of those goods/services and the market(s) for them
  - v. The geographical extent of the use shown

21. The onus is on the opponents of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. 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.

23. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

24. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG10*, BL O/424/14, where he stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right.

If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it.” [Original emphasis]

25. I also bear in mind the Court of Appeal’s decision in *Laboratoire de la Mer Trade Mark* [2006] FSR 5. Neuberger LJ (as he then was) stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

## Form of the Mark

26. Before considering whether the opponents have made genuine use of the mark and, if so, for what goods/services, I shall deal with the question of the form of the registered mark.
27. 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)

28. 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 s. 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.”

29. There are no examples of use of the earlier mark as registered in the evidence. However, there is use in the following forms:

i.





ii.



iii.

&

Roll over image to zoom in



iv.



v.

30. I do not consider that the use in forms 'i.-iii.' alters the distinctiveness of the registered mark. This is because the addition of the word "CAFÉ" in 'i.' and "SUPERBAR CREMA" and "BAR CREMA" in 'iii.' will be perceived as descriptive of the goods and services offered, while the website link "[www.espresso-gorilla.de](http://www.espresso-gorilla.de)" in 'ii.' will be seen as such (and nothing more) without affecting the distinctiveness of the mark. Further, the difference in colour (i.e. red background) in 'i.' between the mark as registered and the variant has minimal impact on its distinctiveness. Therefore, these are variants upon which the opponents can rely, as per *Lactalis*.
31. The form in 'iv.' shows use of the words "GORILLA Kaffeebar Ausschank und Verkauf" positioned next to the figurative element. I note that this form differs from the registered mark due to the different position of the word "GORILLA", the absence of the oval outline, and the presence of the additional word elements "Kaffeebar" and "Ausschank und Verkauf" (positioned next to and below the term "GORILLA"). The additional word element "Kaffeebar" is likely to be recognised as a foreign equivalent of "coffee bar," which carries descriptive qualities and does not alter the distinctiveness of the mark. On the other hand, it is my view that the addition of the foreign words "Ausschank und Verkauf" together with the different structure and side placement of the figurative element, compared to its central placement in the registered mark, alter the distinctive character of the mark. As such, I find that the use of this form is not an acceptable variant use of the mark as registered.
32. Following the same reasoning in the preceding paragraph, I consider that the form in 'v.' is not an acceptable variant use of the mark. This is because the distinctiveness of the mark is significantly altered due to the absence of the word "GORILLA", the incomplete depiction of the figurative element, and the addition of the words "KAFFEEGROSSRÖSTEREI A. JOERGES - Guter Kaffee seit 1847 - Für aktuelle Informationen, besuchen Sie uns bitte auf Facebook und Instagram" along with the sack of coffee beans featured in the background.

## Sufficiency of use

### Preliminary Point

33. In their submissions, the opponents state that:

“17. Exhibit PH3 was relied upon by the Opponent in the Opposition B 3 019 778 against EU Trade Mark Registration 17172263



for which the opposition was deemed successful in its entirety.”

34. Although the opponents submit that they made use of the same affidavit for the purposes of the EUIPO opposition proceedings against a different mark, they have not exhibited this decision as evidence. In any event, this Tribunal has not been privy to the decision, or the body of evidence adduced in the EUIPO proceedings and must, therefore, base its assessment of whether genuine use has been proven only on the relevant evidence adduced in the present proceedings. Consequently, this has no impact on my assessment, and I will proceed based on what the opponents have exhibited.

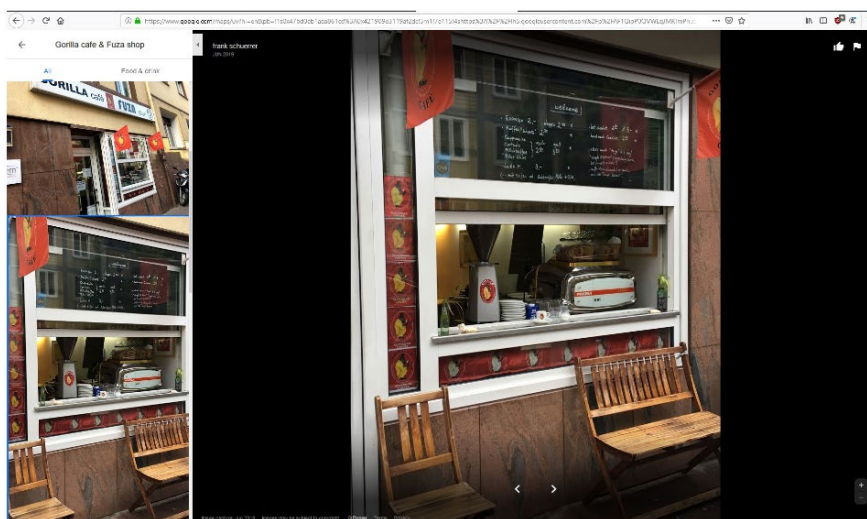
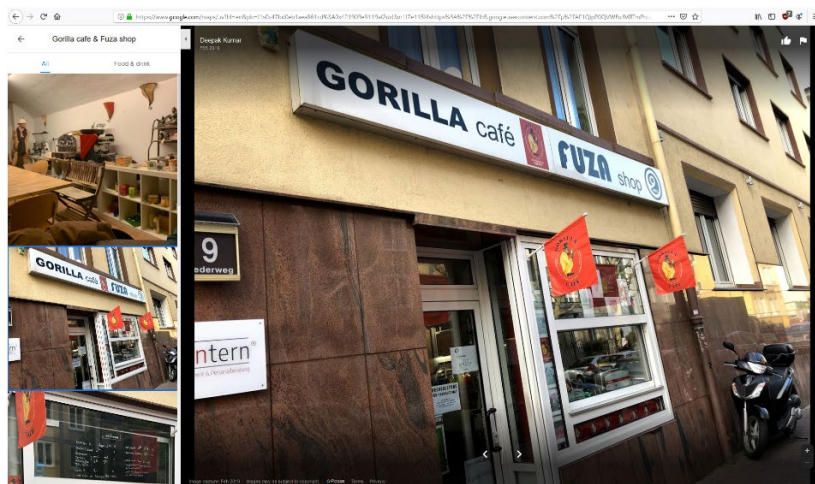
### The evidence

35. In his witness statement, Mr Roman Hühsam states that:

“1. I am the CEO of Kaffeegroßrösterei A. Joerges GmbH, of 63179 Obertshausen und Hausen, Germany. In a contract dated 01 January 2013, Andreas Hühsam and Peter Hühsam, the owners of the EU Trade Mark Registration 011114824 GORILLA Logo granted a licence to the company Kaffeegroßrösterei A. Joerges GmbH, represented by myself as the CEO of Kaffeegroßrösterei A. Joerges GmbH to use the EU Trade Mark Registration 011114824 GORILLA Logo.”

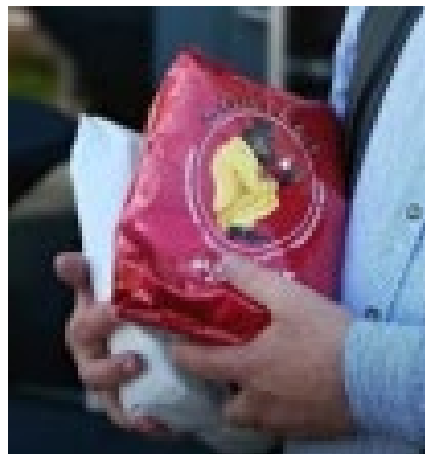
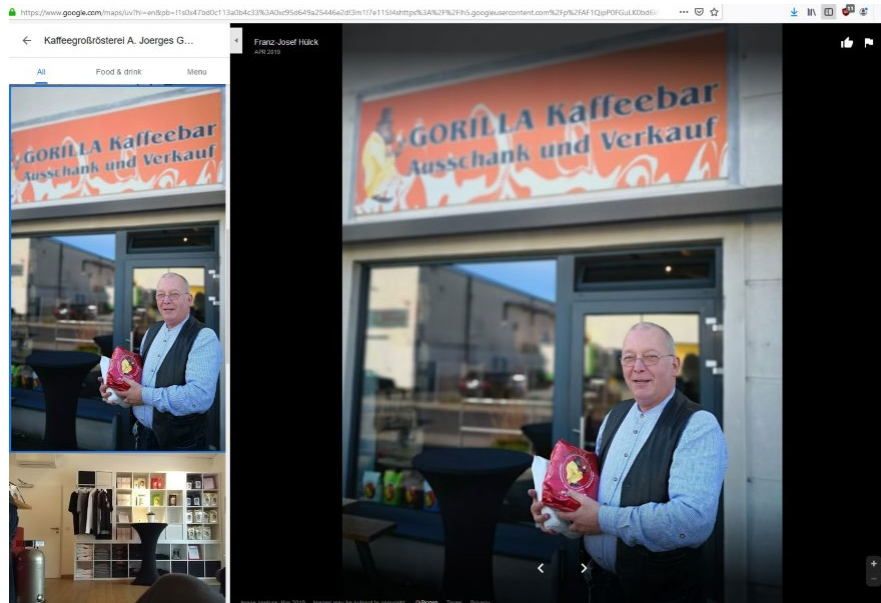
36. **Exhibit PH-1** consists of a printout of the contested mark demonstrating the pertinent details of the mark.
37. **Exhibit PH-2** contains two redacted invoices (in German) from 2019 and 2020, which fall within the relevant period, showing a total sale of 1,596kg of coffee products bearing an acceptable variant of the mark at the top of the invoices. Although Mr Hühsam highlights that the names and addresses of the customers have been redacted for confidentiality reasons, he states that the goods were delivered in Germany. However, the applicant submitted that there is no territorial information left on the invoices to indicate where the goods were delivered. In response, the opponents in their submissions in lieu of a hearing have asserted that the redaction was necessary due to GDPR regulations in the EU and that the invoices include the address of the licensee. I note that, although the invoices are heavily redacted, they can still be considered for the purposes of genuine use.
38. **Exhibit PH-3** includes an affidavit dated 30 March 2020, signed by one of the opponents, Peter Hühsam, who, at that time, served as the CEO of Kaffeegroßrösterei A. Joerges GmbH. The affidavit confirms that the owners of the EUTM 011114824 (the opponents in these proceedings) granted a licence to the company Kaffeegroßrösterei A. Joerges GmbH (“licensee”) for trade mark use. It also states that since 2013, the EUTM has been in continuous use by the licensee in Germany for the goods and services previously outlined in this decision. I note that it can safely be inferred that with the licence agreement, the opponents have provided the necessary consent as per Section 6A(3)(a) of the Act for the licensee to use the registered mark.
39. **Exhibit PH-4** contains undated screenshots of Google maps on pages 2-5 and dated screenshots from 2019 on pages 6-10. I note two of the images (reproduced below) capture the storefront of a café where the earlier mark can be seen on a set of flags. Another image features what

appears to be a coffee bag<sup>5</sup> that prominently displays the registered mark. The applicant in its submissions argued that there is “no indication whether these cafes were operating under licence from the Opponents or the Business and whether the goodwill from any use of the Opponents’ Mark would belong to the Opponents.” However, the opponents responded by denying that such a license is necessary and asserting that goodwill is not a requirement for demonstrating genuine use.<sup>6</sup> I agree with the opponents and consider that they can rely on these materials to show use of the registered mark.



<sup>5</sup> See Exhibit PH-5 in this regard.

<sup>6</sup> I note that the opponents in their submissions inadvertently refer to this exhibit as Exhibit PH-2.



*Zoomed in version*

40. **Exhibit PH-5** consists of undated screenshots demonstrating Amazon listings of the opponents' goods. The opponents admit that these are undated. Thus, the lack of a date on this exhibit limits its evidential value.
41. **Exhibit PH-6** comprises screenshots taken from the WayBack Machine Internet archive. These are dated 15 December 2018 and 24 November 2020 and demonstrate the landing page of the website, *kaffee-joerges.de*. Although the opponents assert that *"this evidence assists in contextualising the extent to which the Earlier Mark was advertised/promoted to consumers in Germany in the Relevant Period"*, I have already made a finding earlier in this decision that this exhibit

contains an unacceptable variant form of the mark. As a result, this exhibit does not assist the opponents.

#### Assessment of evidence

42. I have given close consideration to the evidence provided by the opponents in order to demonstrate that the use of their earlier mark, in respect of the goods/services relied upon, during the relevant period, meets the requirements for genuine use as per *easyGroup*, set out earlier in this decision. I also have in mind the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails to “show” and what might reasonably have been conclusively shown. In my analysis in the paragraphs above, I have highlighted the deficiencies in the evidence.
43. I remind myself that the responsibility is on the opponents to provide sufficiently solid evidence. Throughout these proceedings, the applicant made a series of points about the inadequacies and deficiencies of the evidence filed. It is worth noting that even though the opponents have responded to the applicant’s criticisms, they also had the opportunity to file evidence in reply but elected not to do so. I concur with the majority of the applicant’s submissions and note that the body of evidence adduced is rather thin. Its evidential value is limited due to the various notable shortcomings I delineated earlier in this decision, and, thus, I will come to explain below, it is not possible to deduce from the evidence whether the goods/services relied upon were sold/provided throughout the relevant period and particularly post IP Completion Day.
44. The evidence that falls within the relevant period are two heavily redacted invoices in German and images of a storefront and products bearing acceptable variants of the mark. I note that the opponents have not disclosed any turnover figures or revenue information, such as royalty payments or licence fees, that the opponents have generated from the sales of the registered goods or the commercial use of the registered mark

through the grant of the licence. The coffee industry in the EU/UK is undoubtedly substantial, and the opponents have not provided any evidence of the market share they possess. Although the invoices indicate sales of 1,596 kg of the registered goods, both the delivery details and the sums have been redacted. Consequently, it is not possible for me to ascertain the significance of these figures, or the amounts involved. At the same time, I note that it is fairly common for only a sample of invoices to be filed in proceedings such as these for various reasons, including to limit the volume of evidence. Nevertheless, in the case before me, the significantly small sample provided has not served to assist the opponents' position. It was open to, and presumably entirely possible for, the opponents to have filed more than two invoices. Such information should have been available to the opponents and relatively easy to provide. Thus, the evidential picture is silent in crucial aspects.

45. Furthermore, although the opponent's witness statement indicates that the goods were distributed within Germany, there is no corroborating evidence regarding the scale, frequency, and territorial extent of the use in the specified area of the EU. At this point, I remind myself that the earlier mark is a UK comparable mark, and the use requirement covers both the EU and the UK territories (prior to and post IP Completion Day, respectively). As noted above, no evidence has been presented for the relevant period following the IP Completion Day, during which use must be demonstrated in the UK, which is significant as it accounts for more than half of the relevant period.
46. In addition to the above, there is no evidence of any marketing and promotional materials/activities, nor of the opponents' marketing expenditure throughout the relevant period. This is evidence which would have been readily available and easy for the opponents to provide. However, it is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponents is sufficient to show that there has been a real attempt to exploit the mark in the sector. Nevertheless, there is no evidence of other activity in this case.

47. In light of the above and after careful consideration, the evidential picture as a whole is not sufficient to demonstrate genuine use. It is, therefore, my view that the evidence is not sufficiently “*solid or specific to enable proper and fair evaluation of the scope of protection to which the opponent[s] [are] legitimately entitled to be properly and fairly undertaken, having regard to the interests of the [applicant], the opponent[s] and, it should be said, the public.*”<sup>7</sup> Consequently, the above evidence fails to show real commercial exploitation of the mark to create and maintain a share of the UK and EU markets for the goods/services relied upon.
48. However, for reasons that will become apparent, and in case I am wrong in my finding of no genuine use, I will briefly assess the 5(2)(b) ground of opposition.

### **Section 5(2)(b)**

49. Section 5(2)(b) of the Act is as follows:

“5(2) 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”.

50. 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),

---

<sup>7</sup> See *Awareness Limited v Plymouth City Council*, Case BL O/230/13.

*Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 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 and Services**

51. When making the comparison, all relevant factors relating to the goods or services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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.”

52. 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.”

53. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

54. The competing goods are as follows:

Opponents' goods & services	Applicant's goods
<p><b>Class 30:</b> Coffee</p> <p><b>Class 43:</b> providing of food and drink; catering; bar services.</p>	<p><b>Class 30:</b> Coffee and substitutes therefor.</p>

55. The applicant admitted that the competing goods are identical. I agree, the term “*coffee*” appears in both specifications, and it is self-evidently identical.
56. The applicant’s “*coffee substitutes*” are plant-based alternatives to coffee products. They overlap in purpose and nature with the opponents’ coffee products, as they are used to make drinks that imitate coffee usually without caffeine. The goods coincide in the method of use and relevant public, are clearly in competition, and are likely to be found in close proximity in supermarkets. These goods are similar to a high degree.

**Average Consumer and the Purchasing Act**

57. 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 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.”

58. The goods at issue will be purchased and consumed by the general public. These are inexpensive goods purchased through primarily visual means, most often selected from traditional bricks and mortar establishments or their online equivalents. In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the purchase takes place online, the goods will be selected after viewing an image 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.

### **Comparison of Trade Marks**

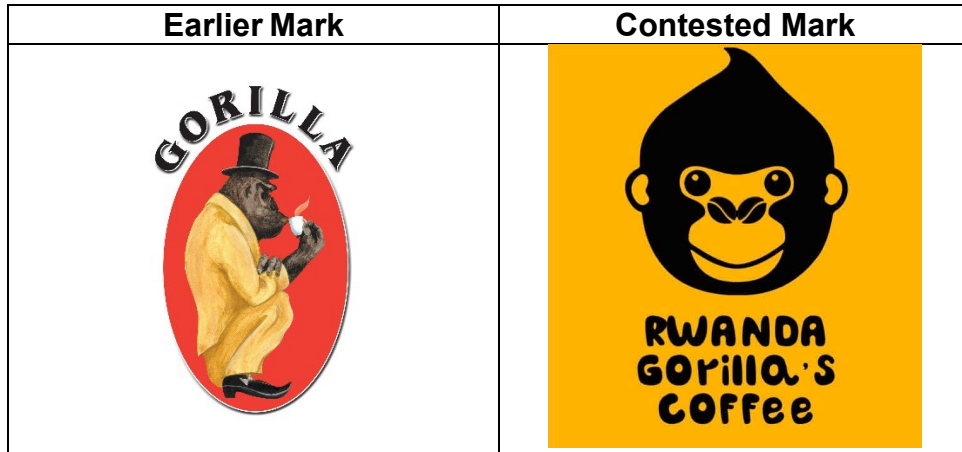
59. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference 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.”

60. 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.

61. The marks to be compared are:



### Overall Impression

62. The earlier mark is a composite mark. At the top of the mark, the word element “GORILLA” appears in a standard typeface, set in upper case black font, with a white outline and a shadow effect on a white background. Underneath it, there is a red oval device that contains a realistic side profile drawing of a full body seated gorilla. The gorilla is dressed in a yellow suit, complete with a top hat and pointy shoes, and is sipping from a small white cup. The figurative element and the verbal element “GORILLA” make a roughly equal contribution and have the greatest weight in the overall impression, with the stylisation, colour and background all playing lesser roles in the mark. However, I note that the eye will be drawn to the verbal element of the mark, “GORILLA”, as the average consumer more easily refers to marks by the word than by describing a figurative element.<sup>8</sup>

63. The contested mark is a composite mark consisting of word and figurative elements, presented in black against a yellow background. At the top, there is a figurative element of a cartoon-style gorilla head that faces forward, with two coffee beans used as its nostrils. The stylised word

---

<sup>8</sup> *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

elements, “RWANDA GORILLA’S COFFEE”, appear below the figurative element in a stacked format and comic-style script, employing a mix of upper case and lower case letters. While I note that the word “RWANDA” might be allusive, and the word “COFFEE” is descriptive of the goods, the words of the contested mark create a phrase which will be perceived as a unit, and it would be an artificial dissecting of the mark to say that the average consumer would focus only on the word “GORILLA’S” and the rest of the words play no role in the overall impression of the mark as a whole.<sup>9</sup> I will return to this point in the conceptual comparison, but where the elements hang together to form a unit, it is not appropriate for me to determine that “GORILLA’S” solus is the dominant or co-dominant element of the mark. Again, in this case, the figurative element and the verbal elements make a roughly equal contribution and have the greatest weight in the overall impression, with the stylisation, colour and background all playing lesser roles. For the same reasons explained above, the eye will be drawn to the verbal elements of the mark.

### Visual Comparison

64. The verbal elements of the competing marks have different lengths, with the earlier mark consisting of seven letters, as opposed to the contested mark, which has 21 letters. The competing marks share the same seven letters “GORILLA”, but they diverge in the remaining letters. Although the marks contain a figurative representation of a gorilla, this does not automatically result in a finding of visual similarity between them.<sup>10</sup> While I remind myself that the average consumer would not proceed to analyse the various details of a mark, it is my view that there are significant stylistic differences between the marks. The contested mark depicts a front view of a gorilla’s head, in contrast to the earlier mark, which depicts a side profile of a full body gorilla in a suit with a hat and pointy shoes, sipping

---

<sup>9</sup> See *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, O/115/22.

<sup>10</sup> See *The Royal Academy of Arts v Errea Sport S.p.A*, BL O/010/16.

from a cup. These are all points of difference. In addition, the marks differ in stylisation, colours, and their presentation. Overall, taking into account the overall impressions and weighing the various points of similarity and difference, I consider that the marks are visually similar to a low degree.

#### Aural Comparison

65. The competing marks overlap in the articulation of the first two syllables of the common word 'gorilla', which will be pronounced in the ordinary way, albeit they will be dissimilar in the last syllable due to the possessive form found in the contested mark. The contested mark also contains the verbal elements 'RWANDA' and the common word 'COFFEE' which will be verbalised by the average consumer. Further, I do not consider that the average consumer will attempt to articulate the figurative elements of the competing marks. Aurally the marks are similar to a low degree.

#### Conceptual Comparison

66. 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.
67. The average consumer will immediately understand the dictionary word "GORILLA" in the competing marks, bringing to mind the concept of the said animal. The presence of this word in the competing marks will reinforce the concept of the figurative element. In terms of the contested mark, the word "RWANDA" will be understood as referring to the country in central Africa, which may be suggestive of the origin of the goods. The word "COFFEE" will be readily understood and is descriptive of the goods. From a grammatical standpoint, the words in the contested mark create a noun phrase "RWANDA GORILLA'S COFFEE", where the word "RWANDA" acts as an adjective, "GORILLA'S" is the possessive modifier, and "COFFEE" is the head noun. In this context, I consider that the phrase

in its entirety will be seen as coffee that belongs to a gorilla from Rwanda. I also note that the two coffee beans replacing the gorilla's nostrils further reinforce the interplay between the word elements in the contested mark. Taking into account all of the above, including the overall impressions, I find that the degree of conceptual similarity falls between low and medium insofar as the figurative elements in both marks convey the concept of a gorilla, reinforced by the word element "GORILLA/GORILLA'S" in the marks.

### **Distinctive character of the earlier trade mark**

68. 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)."

69. 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.
70. As described above, the earlier mark consists of the commonplace word element "GORILLA", and the figurative element depicting a full body gorilla, having no suggestive/allusive meaning in relation to the goods. In this instance, the combination of the word element and the figurative element renders the mark as a whole distinctive to a medium to high degree.

#### Enhanced Distinctiveness

71. I now turn to consider whether the distinctiveness of the earlier mark has been enhanced through use. I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the relevant goods. I have no information about its market share or overall advertising expenditure within the coffee sector, the size of which is likely to be very significant. Also, there is no evidence of promotional material that would indicate any extensive media coverage nor intensive advertising or promotional activities in the UK. Consequently, the evidence is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced through use.

#### **Likelihood of confusion**

72. 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.<sup>11</sup> It is essential to keep in mind the distinctive character of the opponents' trade mark since the more distinctive the trade mark, the greater may be 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.<sup>12</sup>

73. 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.
74. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), 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.”

---

<sup>11</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>12</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

75. 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.”

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 for wine and whisky. Consequently, the case law set out in *Medion v Thomson* did not apply.

76. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) 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.”

77. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), 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.

78. 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.”

79. Earlier in this decision I have concluded that:

- the competing terms at issue are identical and highly similar;
- the average consumer of the goods will be members of the public. The selection process is predominantly visual without discounting aural considerations, and the degree of attention will be no more than medium;
- the competing marks are visually and aurally similar to a low degree, while there is conceptual similarity to between a low and medium degree;

- the earlier mark has a medium to high degree of inherent distinctive character. The use is not sufficient to establish enhanced distinctiveness of the mark.

80. Considering all the above, I am persuaded that there is no likelihood of direct confusion for identical goods. The average consumer will notice the stylistic differences between the figurative elements and the presence/absence of the additional word elements in the competing marks. Given that direct confusion involves no process of reasoning, I consider that the average consumer will not overlook the differences between the competing marks, and, thus, it is unlikely to mistake one mark for the other.

81. Turning now to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. Even if the average consumer recalls the points of similarity between the marks, such as that both contain the word element “GORILLA” and a figurative element of the given animal, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,<sup>13</sup> James Mellor QC stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining<sup>14</sup> in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

---

<sup>13</sup> See *Duebros Limited*.

<sup>14</sup> In *L.A. Sugar*.

I also bear in mind the comments of Professor Ruth Annand, sitting as the Appointed Person in *BARKERS BREW*, O/476/14, where she stated:

“26. On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE* Trade Mark, BL O/339/04<sup>3</sup> [fn<sup>3</sup> *CARDINAL PLACE* geographical whereas *CARDINAL* religious] and *CANTO* Trade Mark, BL O/021/06, as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.” [Footnotes omitted]

In accordance with the rationales cited above, the word elements of the contested mark, “RWANDA GORILLA’S COFFEE”, form a cohesive whole. That blend of meaning emanating from the combination of the said words will conjure up the idea of coffee belonging to a gorilla from Rwanda that goes beyond the meaning of the shared word “GORILLA” alone. I note here that the overall impression lies within the unit of these words. As a result, the word “GORILLA’S” does not retain an independent distinctive role within the contested mark. To my mind, the coincidence of the “GORILLA” element in both marks is not likely to lead the consumer to believe there is a trade connection. It is not so strikingly distinctive that consumers would assume only one undertaking uses it, and the additional elements in the contested mark are not consistent with a brand extension, rebranding, or sub-brand. Furthermore, the visual representation of the figurative elements in the competing marks is fundamentally different, and the fact that the marks are conceptually similar will not suffice.<sup>15</sup> I do not consider that the average consumer would find it logical that the opponent,

---

<sup>15</sup> See for example Case C-251/95, *SABEL BV v Puma AG*.

for example, would redesign their mark so significantly that it might no longer be recognisable as a clear representation of the earlier mark. If the opponents' mark is brought to mind, this will be a mere association, not confusion. I see no other reason why a common origin or an economic connection would be assumed and so I find that, even where the goods are identical, there is no likelihood of indirect confusion.

82. The above findings extend to the competing goods which I found to be similar at a high degree.

## **OUTCOME**

83. The opposition has been unsuccessful. **There is no likelihood of confusion. The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to any successful appeal, the application can proceed to registration.

## **COSTS**

84. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	<b>£300</b>
Preparing evidence and considering and commenting on the other side's evidence	<b>£600</b>
Preparing submissions-in-lieu	<b>£500</b>
Total	<b>£1,400</b>

85. I, therefore, order Andreas Hühsam and Peter Hühsam, being jointly and severally liable, to pay to Rwanda Coffee Farmers Company Ltd the sum of £1,400. 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 28<sup>th</sup> day of August 2025**

**Dr Stylianos Alexandridis**

**For the Registrar,**

**The Comptroller General**