O/0802/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER 1725327

DESIGNATING THE UK

IN THE NAME OF ROYAL ESTATES & BUILDINGS SRL

FOR THE FOLLOWING TRADE MARK:

MIRACOLO®
della
SORGENTE

IN CLASSES 32 AND 35

AND

IN THE OPPOSITION THERETO UNDER NUMBER 443024

BY BIG MAMMA SAS

BACKGROUND & PLEADINGS

1. Royal Estates & Buildings Srl ("the holder") is the holder of the International Registration shown on the cover page of this decision ("the contested mark"). The contested mark was registered on 16 January 2023 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol of the Madrid Agreement ("the relevant date"). The contested mark was accepted and published in the Trade Marks Journal for opposition purposes on 14 July 2023. The holder seeks protection in the UK for the following goods and services:

   Class 32: Soft Drinks

   Class 35: Advertising, marketing and promotional services

2. On 14 September 2023, the contested mark was opposed by Big Mamma SAS ("the opponent"). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed at the class 32 goods in respect of which the contested mark has been applied for. The opposition was initially directed at all of the goods and services in respect of which the contested mark had been applied for (i.e., the class 32 and 35 goods and services). However, a preliminary indication was issued by the Tribunal on 29 November 2023 stipulating that the opposition should be rejected in relation to the holder's class 35 services. The opponent was afforded until 29 December 2023 to file a form TM53 if it wished for the opposition to proceed in respect of this class of services. However, no form TM53 was filed by the opponent and, consequently, the opposition was deemed withdrawn in relation to the class 35 services. Accordingly, whilst I note that the holder has provided submissions on the similarity, or lack thereof, of the holder's class 35 services and the opponent's services, for the purposes of this opposition, I am only required to consider whether the opponent's goods are similar to the holder's class 32 goods. The holder's trade mark application can therefore proceed to registration in relation to the holder's class 35 services (namely, the holder's "Advertising, marketing and promotional services").

3. For the purposes of its opposition, the opponent relies upon the following word mark ("the earlier mark"):

MIRACOLO
Trade mark number: UK00003820948
Filing Date: 17 August 2022
Registration Date: 18 November 2022

4. The opponent relies upon the following services for which its earlier mark is registered:

Class 43
Bar and restaurant services; Bistro services; Brasserie services; Café services; Catering; Catering services for the provision of food and drink; Cafeterias; Club services for the provision of food and drink; Cocktail lounge services; Delicatessens [restaurants]; Information, advice and reservation services for the provision of food and drink; Food and drink take-away services; Food, drink, and meal preparation services; Mobile restaurant services; Provision of food and drink; Reservation and booking services for restaurants and meals; Reservation services for booking meals; Restaurant and bar services; Restaurant information services; Services for providing food and drink; Serving food and drink for guests in restaurants; Serving food and drinks; Serving of alcoholic beverages; Supplying of meals for immediate consumption; Take-out restaurant services; Information and advice relating to the preparation of food and drink; Provision of information, advice and consultancy in relation to all the aforementioned services.

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –
a registered trade mark or international trade mark (UK) 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.

6. The mark identified in paragraph 3 qualifies as an earlier trade mark under the above provisions. As the earlier mark had not completed its registration process more than five years before the relevant date, it is not subject to proof of use requirements. Consequently, the opponent may rely on all of the services highlighted in paragraph 4 for the purposes of this opposition.

7. The opponent claims that "there is a high level of similarity, including complementarity and competition" between the holder's goods and the applicant's services. The opponent submits that there is also a "very close similarity between the marks" and, consequently, "on seeing or hearing the [contested mark], the average consumer will likely be confused, whether directly or indirectly, by way of simple mistake".

8. The holder filed a counterstatement denying the claims made against it. Specifically, the holder submits that the contested mark and earlier mark "are at best similar to a low degree", and that the holder's "goods in Class 32 are different to the services in Class 43 covered by the Earlier Mark". Consequently, the holder submits that there is "no likelihood of confusion (including a likelihood of association)" within the meaning of Section 5(2)(b) of the Act. The holder therefore requests that the opposition be dismissed in its entirety, and that an award of costs be made in its favour.

REPRESENTATION

9. The opponent is represented by Springbird IP Limited.

10. The holder is represented by Stobbs IP Limited.

EVIDENCE AND SUBMISSIONS

11. Both parties have filed witness evidence in support of their respective claims, which I have discussed in further detail in paragraphs 25 to 32 below. The opponent did not file evidence in reply.

12. The opponent has filed a witness statement signed by Lisa Ormrod, dated 7 October 2024, in her capacity as a Chartered Trade Mark Attorney at Springbird IP Limited (the opponent's legal representative). This witness statement was filed with five exhibits, Exhibits WSLO1 to WSLO5.

13. The holder has filed a witness statement signed by Tanja Hofer, dated 6 August 2024, in her capacity as a Chartered Trade Mark Attorney at Stobbs IP Limited (the holder's legal representative). This witness statement was filed with two exhibits, Exhibit TH1 and Exhibit TH2.

14. No hearing was requested, but both parties filed submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.

15. 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.

DECISION

Section 5(2)(b)

16. The opponent's opposition is based upon section 5(2)(b) of the Act which stipulates the following:

"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".

17. Section 5A of the Act stipulates that where "grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,[1] *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* ("Canon"),[2] *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,[3] *Marca Mode CV v Adidas AG & Adidas Benelux BV*,[4] *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*,[5] *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,[6] *Shaker di L. Laudato & C. Sas v OHIM*[7] and *Bimbo SA v OHIM*[8]:

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 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

[1] Case C-251/95
[2] Case C-39/97
[3] Case C-342/97
[4] Case C425/98
[5] Case C-3/03
[6] Case C-120/04
[7] Case C-334/05P
[8] Case C-591/12P

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 greater 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods and Services

19. The competing goods and services are as follows:

The opponent's services	**The holder's goods**
Class 43 Bar and restaurant services; Bistro services; Brasserie services; Café services; Catering; Catering services for the provision of food and drink; Cafeterias; Club services for the provision of food and drink; Cocktail lounge services; Delicatessens [restaurants]; Information, advice and reservation services for the provision of food and drink; Food and drink take-away services; Food, drink, and meal preparation services; Mobile restaurant services; Provision of food and drink; Reservation and booking services for restaurants and meals; Reservation services for booking meals; Restaurant and bar services; Restaurant information services; Services for providing food and drink; Serving food and drink for guests in restaurants; Serving food and drinks; Serving of alcoholic beverages; Supplying of meals for immediate consumption; Take-out restaurant services; Information and advice relating to the preparation of food and drink; Provision of	**Class 32**: Soft Drinks

information, advice and consultancy in relation to all the aforementioned services.	

20. As a preliminary point, it should be noted that section 60A of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification[9], or dissimilar on the ground that they appear in different classes under the Nice Classification."

21. In *Canon*,[10] the Court of Justice of the European Union ("CJEU") stated (at paragraph 23) that, when making the comparison, "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 are complementary".

22. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case[11], for assessing similarity were:

    a. The uses of the respective goods or services;

    b. The users of the respective goods or services;

    c. The physical nature of the goods or services;

    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;

[9] "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.
[10] Case C-39/97
[11] [1996] R.P.C. 281

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 in the same or different sectors.

23. The opponent acknowledges in its submissions that the nature and method of use of the opponent's services and the holder's goods may differ. However, it submits that the intended purpose of the goods and services in issue is the same (namely, "to quench the thirst of consumers"), that there is a "clear overlap of trade channels and user", that soft drink products are essential to the opponent's services, and that they are "commonly offered by the same undertaking as the services relating to the provision of those goods". The opponent further submits that the goods and services in issue "could also be in competition with one another" as consumers have "the choice to make a retail purchase of the soft drink or visit an outlet where the beverage is made fresh for them."

24. Conversely, the holder submits that the holder's goods and the opponent's services are "different". In summary, the basis of this submission appears to be the fact that the holder does not consider there to be any link/connection between its goods and the opponent's services, and it submits that consumers would not expect a soft drink to come from the same undertaking as a food or drink service provider (i.e. the same undertaking providing the opponent's services).

The Witness Evidence:

25. As discussed above, in support of its submission regarding the lack of link/connection between the goods and services in issue, the holder has filed a witness statement signed by Tanja Hofer dated 6 August 2024.

26. Exhibit TH1 of the witness statement contains screenshots taken from the drink's menus from the websites of 17 different restaurant undertakings within the United Kingdom (including from Nando's and Pizza Express' websites). The screenshots provide evidence that all of the undertakings included in Exhibit TH1

sell third party's soft drinks (for example, from Coca Cola and Fever Tree) at their establishment, rather than their own branded soft drinks. The holder also submits that two of the restaurants referenced in Exhibit TH1 (Nando's and Pizza Express) are examples of nationwide chain restaurants with an extensive reach across the UK and, in support of this submission, the holder has filed Exhibit TH2 which contains screenshots taken on 8 July 2024 from the websites of Nando's and Pizza Express confirming that Nando's has 465 restaurants in the United Kingdom, and Pizza Express has 370 restaurants in the United Kingdom and Ireland.

27. As outlined above, in response, the opponent also filed a witness statement signed by Lisa Ormrod dated 7 October 2024. Within this witness statement it is claimed that there is, in fact a direct overlap in trade channels and users for the services covered by the earlier mark (which Lisa Ormrod notes does not just cover restaurant and pub services) and the goods applied for in the contested mark.

28. Exhibit WSLO1 of Lisa Ormrod's witness statement contains screenshots taken from Starbucks' UK website, Sainsbury's website and Tesco's website, which evidence that Starbucks does sell a number of its own branded soft drinks, and its own branded drinks are also available to purchase in other national supermarkets within the UK. It is noted that Exhibit WSLO5 of Lisa Ormrod's witness statement contains screenshots taken in October 2024 from Tesco's and Sainsbury's websites confirming that Sainsbury's has 600 supermarkets and over 800 convenience stores in the UK, and, as of 2024, that Tesco has 4,273 stores in the United Kingdom and Ireland.

29. Exhibit WSLO1 also contains a screenshot from a BBC online article dated 6 March 2023 which confirms that Starbucks "has over 1,000 outlets in the country" and "plans to open 100 new stores across the UK this year". Exhibit WSLO1 also contains some screenshots from the Office for National Statistics' website taken in October 2024 which Lisa Ormrod submits support the figures stipulated in the BBC article, albeit the version of the screenshots that has been taken from the

Office for National Statistics' website that has been filed are too small to allow me to view it.

30. Similarly, Exhibit WSLO2 of Lisa Ormord's witness statement contains screenshots taken in October 2024 from Pret's UK website which evidence that Pret does sell a number of its own branded soft drinks. Exhibit WSLO2 also contains screenshots taken in October 2024 from Tesco's website which evidence that it sells Pret branded products on its website, albeit it is noted that the Pret products on the Tesco website are limited to various pastries and smoothie mixes, not ready to consume Pret branded soft drinks.

31. Exhibit WSLO3 of Lisa Ormrod's witness statement contains screenshots taken from the menu at the Fever-Tree bar and café at Edinburgh Airport, as well as screenshots from the UK websites of Fever-Tree, Tesco and Sainsbury's evidencing the range of Fever-Tree branded soft drinks available to purchase from these undertakings.

32. Exhibit WSLO4 of Lisa Ormrod's witness statement contains screenshots taken from the website and Facebook account of Mr Fitzpatrick's Ltd. These screenshots evidence that Mr Fitzpatrick's Ltd has a bar in Rawtenstall, England, and that Mr Fitzpatrick's Ltd sells its own branded "root cordials". The screenshots also appear to show that Mr Fitzpatrick's Ltd has approximately 40 "stores and drinking establishments" in the United Kingdom, albeit the exact number of stores and drinking establishments is unclear from the evidence submitted.

Assessment of the Evidence:

33. Having considered all of the witness evidence and the submissions in lieu of the hearing that were filed by the parties, I am of the view that the opponent has clearly adduced evidence to show that cafés and bars within the United Kingdom do sell their own branded soft drinks. In any event, I find that there is an overlap in trade channels between the opponent's services and the holder's goods (whether they are own brand or not) because plainly soft drinks can reach the market through the same trade channels as services for the provision of drinks.

34. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,[12] the General Court stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

35. I find that soft drinks are important/indispensable to the provision of food and drink services (such as, restaurant, bar, café, bistro and catering services). I am also of the view that the opponent's evidence establishes that various bars and cafés within the United Kingdom do sell their own branded goods at their establishments and, in those circumstances, it is clear that the average consumer would consider that the undertaking providing the bar and café services would be the same undertaking providing the soft drinks. Consequently, I do consider the holder's goods to be complementary to the opponent's bar and café services.

36. Having said that, whilst I have found complementarity between the holder's goods and the opponent's bar and café services, *Canon*[13] made clear that the complementarity between goods and services in issue is just one of a number of factors that should be considered when undertaking an assessment of similarity between goods and services.

37. Soft drinks are, of course, different in nature to all of the opponent's services. The method of use of the respective goods and services is also manifestly different. Having said that, in terms of general purpose, it is considered that the goods and services can coincide to a degree. This is because the opponent's services include the provision of soft drinks, which aim to quench thirst, and this

[12] Case T-325/06
[13] Case C-39/97

is also true of the holder's goods. There is also an overlap in users (being members of the general public at large). However, I recognise that this is a very general level of overlap.

38. I also consider there to be a degree of indirect competition between the goods and services in issue in the sense that consumers may decide to order a soft drink at a café or bar, or purchase a soft drink for consumption elsewhere, such as from a shop or supermarket. Though, I acknowledge that this level of competition is much less than that between (say) two cafes, bars or restaurants, for example.

39. Considering all of these factors, I find the holder's soft drinks to be similar to a medium degree to the opponent's café, bar, restaurant, bistro, takeaway, drink preparation/provision of drink services.

Average consumer and the purchasing act

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 (see *Lloyd Schuhfabrik Meyer*[14]).

41. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*[15] Birss J. held:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

[14] Case C-342/97
[15] [2014] EWHC 439 (Ch)

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

42. I consider that the relevant consumers for the goods and services at issue are members of the general public. The goods are everyday consumables, likely to be purchased frequently and at a low price. However, the price and frequency of use of the opponent's services may vary more considerably, from café services which may be utilised regularly at a relatively low price, to some restaurant services, which may be utilised less frequently, and at a greater expense. As a consequence, the considerations of purchase for the holder's goods and some of the opponent's services may vary. There will be times where the consumer needs to find something to drink very quickly, and the main consideration will be the taste of the goods available and the price of the goods or services. However, the average consumer may make a slightly more considered choice in relation to some of its more expensive services, taking account of costs, what food type they offer, the range of options available/on the menu, reviews, location, atmosphere and whether the service caters for any dietary requirements that the consumer has. On balance, however, I find that the level of attention paid when purchasing the goods and services in issue will be vary from low to medium.

43. I consider that the purchasing process for the goods and services in issue will be primarily visual in nature, given that the goods and services are likely to be selected following perusal of packaging (for the goods) or signage on physical premises or websites (for the services). However, I do not discount an aural component playing a role as a result of, for example, verbal recommendations.

Comparison of marks

44. 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 *Bimbo SA v OHIM*,[16] 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."

45. It would be wrong, therefore, to dissect the trade marks artificially, 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.

46. It is noted that the holder has conceded that there is a low level of similarity between the marks ("at best"). However, in any event, I will proceed to make my own determination of the level of similarity between the marks in the usual manner.

47. The respective trade marks are shown below:

Earlier mark	Contested Mark
MIRACOLO	MIRACOLO® della SORGENTE

[16] Case C-591/12P

Overall Impression

48. The earlier mark is a word only mark of the word, “Miracolo”. There are no other elements in the mark which contribute to its overall impression, so the overall impression lies in the word itself.

49. The contested mark is a figurative mark consisting of the words “MIRACOLO della SORGENTE”, and the words are protected in a dark blue font against a white background. Each of the words in the contested mark are stacked vertically on top of each other, with “miracolo” at the top, “della” sandwiched in the middle, and “sorgente” at the bottom. The word “miracolo” is presented in uppercase in the largest bold font with some slight stylisation that is reminiscent of shadowing on the one side of each letter. The word “sorgente” is also presented in uppercase but in a smaller bold font to that of the word “miracolo” and without the stylisation. The word “della” is presented in the smallest italicised font.

50. There is also a registered trademark device in the top right hand corner of the mark, but given its size, position, and the fact that I consider the average consumer would simply understand this to be a certification that the mark has been registered, I find that this device plays very little (if any) role in the overall impression.

51. Given its size and positioning at the beginning of the mark, the word “miracolo” would play the greatest role in the overall impression, with the other two words playing a lesser role. The stylisation/colour plays a much lesser role.

Visual Comparison

52. Visually, the marks share the same word (“Miracolo”) and, for the reasons outlined above, I have determined this word to be the dominant element in both marks. The contested mark does also contain some very limited stylisation, however, I bear in mind that the earlier mark is a word only mark so could be used in any standard font. The two additional words “della sorgente”, which are not present in the earlier mark are points of visual difference. The registered trade

mark symbol will also be a point of visual difference if it is noticed (although, as noted above, I consider this to have very little, if any, impact). Taking these points of visual difference into account, I find the marks to be visually similar to a medium degree.

Aural Comparison

53. As outlined above, the marks share the same word ("Miracolo"), which is the only word in the earlier mark, and the first word in the contested mark. The contested mark also contains the words "della sorgente", and I am of the view that all of the words in both marks would be pronounced. Whilst I appreciate that there are phonetic differences between the marks, I am of the view that the beginning of the contested mark (i.e., the word "miracolo") will have more aural impact than the final two words in the earlier mark. Consequently, I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

54. 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*.[17] The assessment must, therefore, be made from the point of view of the average consumer.

55. I am also conscious of the findings of the GC in *Usinor SA v OHIM,*[18] *that "*as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him".

56. In this instance, both marks contain only foreign language words. I note that the holder has submitted that the word "miracolo", which is present in both marks,

[17] [2006] ECR I-643; [2006] E.T.M.R
[1818] Case T-189/05

would be understood by the average consumer as being Italian for the word "miracle" given that "its spelling is very close to the English word". The holder also submits that, whilst "UK consumers will be unlikely to understand SORGENTE", the average consumer would identify the word "della" as "indicating an association between MIRACOLO and SORGENTE".

57. In my view, a significant proportion of average consumers would not understand the meaning of the words "miracolo" or "sorgente". Whilst I do accept that the average consumer would identify "della" as showing an association between the words "miracolo" and "sorgente" (particularly given its positioning), I do not believe that this would assist them in attributing a meaning to the earlier mark overall, without the context being provided by the first and third word. I therefore consider that the average consumer would view all of the words in the marks to be foreign language words (possibly, recognised as Italian or Spanish words) with no clear meaning. I also do not consider that the limited stylisation in the earlier mark provides any further conceptual meaning. Consequently, I find the marks to be conceptually neutral. However, even if the average consumer did recognise that the word MIRACOLO is similar to the English word, miracle, and attribute it the same meaning for that reason, the same conceptual meaning would be attributable to both marks.

Distinctive character of the earlier trade mark

58. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49)

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

59. Whilst the distinctiveness of a mark may be enhanced as a result of it having been used in the market, in this instance the opponent has filed no evidence of use. Consequently, I have only the inherent position to consider.

60. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are "invented" words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.

61. In this instance, the earlier mark is made up of the word "miracolo", with no other elements. As outlined above, my primary finding is that the average consumer would not attribute any meaning to this word beyond identifying it as a foreign language word. Consequently, I do not consider it to have any relevance to the opponent's services, and I therefore consider it to have a medium to high level of distinctive character.

Likelihood Of Confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related.

63. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*[19]). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*[20]). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods/services, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

64. I have found the holder's goods to be similar to the opponent's services to a medium degree. I have also found that the marks are visually and aurally similar to a medium degree and conceptually neutral.

65. I have found the earlier mark to have a medium to high level of distinctive character. I have also identified that the average consumer of the goods and services would be members of the general public, who will pay a low to medium level of attention during the purchasing process for the goods and services in issue, and I have determined that the purchasing process for all of the goods/services in issue would be primarily visual in nature, although I do not discount aural considerations.

66. Considering all of the above, and specifically weighing up the visual and aural differences between the marks (i.e., the addition of two words in the contested mark), alongside the principle of imperfect recollection and the fact that consumers rarely have the opportunity to compare marks side by side, I am

[19] C-251/95, para 22
[20] C-39/97, para 17

satisfied that the differences between the marks will prevent the average consumer from mistaking one mark for the other. I make this conclusion with consideration of my finding that the average consumer will be paying a low level of attention during the purchasing process in some cases. I am of the view that the two additional words in the contested mark will not be overlooked. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

67. I will now go on to consider whether there is a likelihood of indirect confusion.

68. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[21]

"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 recognised 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'.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else

[21] BL O/375/10

but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

69. As outlined above, I consider the common element of the marks (being the word "Miracolo") to have a medium to high level of distinctive character. I am of the view that those average consumers that do not attribute any meaning to the word miracolo would deem it to be so distinctive that they would assume that no other undertaking would be using it in their mark. I am also of the view that, for those average consumers that do see the word "della" in the contested mark as referring to an association between the marks "miracolo" and "sorgente", they are likely to view "Miracolo della sorgente" as a logical sub brand or brand extension of "miracolo" (the earlier mark) or vice versa. In any event, I do consider that the average consumer would put the similarity between the marks (i.e., the word "miracolo") down to a common undertaking. Consequently, I do consider that there is likely to be indirect confusion between the marks.

Final Remarks:

70. For the avoidance of doubt, even if I am wrong in my finding that the average consumer would not understand the word "miracolo" as being Italian/Spanish for the English word "miracle", I would still have found a likelihood of indirect confusion on the part of the average consumer. This is because, if this meaning is understood, the marks would share the same conceptual meaning (increasing the likelihood of confusion), and, as the word miracle is neither descriptive nor

allusive of the opponent's services, my determination on the distinctive character of the earlier mark would not have changed. As such, my finding on likelihood of confusion would remain the same.

71. For the avoidance of doubt, I also would have found no similarity between the holder's class 35 services and the opponent's services. This is because the services differ in nature, method of use and purpose. Whilst there may be an overlap in user at a very general level, this is insufficient on its own to result in similarity. I consider it unlikely that there would be an overlap in trade channels. There is no competition or complementarity. As such, I would have found the opposition to fail in respect of these services in any event.

CONCLUSION

72. The opposition succeeds in full, and the contested mark is hereby, subject to any successful appeal of my decision, refused registration in relation to the class 32 goods.

73. As outlined in paragraph 2 above, as the opponent did not seek to challenge the preliminary indication issued by the Tribunal on 29 November 2023, its opposition was withdrawn in respect of the class 35 services. Accordingly, the holder's trade mark application can therefore proceed to registration in relation to the holder's Class 35 services (namely, the holder's "Advertising, marketing and promotional services").

COSTS

74. As the opponent has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the opponent the sum of £1,300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a notice of opposition & considering the other side's statement:	£250

Preparing Evidence	£600
Preparing submissions-in-lieu of a hearing:	£350
Total:	**£1,300**

Dated this 29th day of August 2025

B Hartland
For the Registrar