

O/0937/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003721699  
BY THAT'S SCRUMMY LTD. TO REGISTER:

**That's Scrummy**

AS A TRADE MARK IN CLASS 16

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 431932 BY  
SCRUMMY TUMMIES LIMITED

## BACKGROUND AND PLEADINGS

1. On 15 November 2021, That's Scrummy Ltd. ("the applicant") applied to register the trade mark shown on the cover of this decision ("the applicant's mark") in the UK for the following goods:<sup>1</sup>

Class 16: Printed matter; printed calendars; instructional and teaching material (except apparatus); cardboard boxes; gift boxes; corrugated boxes; printed charts; wall charts; notepads; adhesive notepads; printed guides; educational books; printed educational materials; printed stationery; printed books; printed booklets; printed cards; recipe binders; recipe books; printed recipes sold as a component of food packaging; educational publications; baby books; baby books [storybooks]; baby memory books; books for children; printed recipe cards; cookery books; children's books; story books; cook books.

2. The applicant's mark was published for opposition purposes on 17 December 2021 and, on 17 March 2022, it was opposed by Scrummy Tummies Limited ("the opponent").
3. The opposition is based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(1)(c) of the Trade Marks Act 1994 ("the Act"). In respect of the sections 5(2)(b) and 5(3) grounds, the opponent relies on the following mark:

Scrummy Tummies

UK registration no. 3719009

Filing date 8 November 2021; registration date 28 January 2022

Registered for the following goods and services:

---

<sup>1</sup> It is noted that the applicant initially sought registration for a wider specification of goods but this was subject to an amendment via a Form TM21B that was filed on 14 March 2022.

- Class 8: Cutlery; cutlery for use by babies; cutlery for use by children; table cutlery [knives, forks and spoons].
- Class 16: Diaries [printed matter]; day planners; monthly planners; weekly planners; year planners; daily planners; desk top planners; covers for weekly planners; planners [printed matter]; training manuals; printed training materials.
- Class 21: Bowls; shallow bowls; soup bowls; suction bowls; plastic bowls [basins]; plates; plastic plates; dessert plates; table plates; plastic plates [dishes].
- Class 41: Conducting workshops [training]; arranging of workshops; workshops for training purposes; arranging and conducting workshops; workshops for educational purposes; arranging of workshops and seminars; conducting courses, seminars and workshops; arranging and conducting of workshops; arranging and conducting of training workshops; workshops (arranging and conducting of -) [training]; arranging and conducting of workshops [training]; arranging, conducting and organisation of workshops; arranging and conducting of workshops and seminars; training; training and further training consultancy; practical training; conducting training seminars; written training courses; education and training; personal coaching [training]; providing of training; provision of training; training and instruction; practical training services; staff training services; organisation of training; production of training films; providing courses of training; production of training videos; training related to nutrition; organisation of training seminars; providing online training seminars; instructional and training services; provision of training courses; educational and training services; education and training consultancy; education and training services.

("the opponent's mark").

4. Under the section 5(2)(b) ground, the opponent relies only upon those goods and services I have underlined above. The opponent's claim under this ground is that the marks are similar and that the applicant's goods are identical and/or similar to its own goods and services. As a result, the opponent argues that there exists a likelihood of confusion on the part of the relevant public.
5. Under the section 5(3) ground, the opponent claims that its mark enjoys a reputation in all of the goods and services for which its mark is registered. The opponent argues that the marks are similar and that this would lead consumers to believe that they are used by the same undertaking or think that there is a connection between them. As a result, the opponent claims that use of the applicant's mark would, without due case, take unfair advantage of and be detrimental to the distinctive character and/or the reputation of its own mark.
6. Under the section 5(4)(a) ground, the opponent relies on the unregistered sign 'Scrummy Tummies' that it claims to have used throughout the UK since May 2020 on the following goods and services:

"Cutlery; Cutlery for use by babies; Cutlery for use by children; Table cutlery [knives, forks and spoons].

Diaries (printed matter); Day planners; Monthly planners; Weekly planners; Year planners; Daily planners; Desk top planners; Covers for weekly planners; Planners (printed matter); Training manuals; Printed training materials.

Bowls; Shallow bowls; Soup bowls; Suction bowls; Plastic bowls [basins]; Plates; Plastic plates; Dessert plates; Table plates; Plastic plates (dishes).

Conducting workshops [training]; Arranging of workshops; Workshops for training purposes; Arranging and conducting workshops; Workshops for educational purposes; Arranging of workshops and seminars; Conducting courses, seminars and workshops; Arranging and conducting of workshops;

Arranging and conducting of training workshops; Workshops (Arranging and conducting of -) [training]; Arranging and conducting of workshops [training]; Arranging, conducting and organisation of workshops; Arranging and conducting of workshops and seminars; Training; Training and further training consultancy; Practical training; Conducting training seminars; Written training courses; Education and training; Personal coaching [training]; Providing of training; Provision of training; Training and instruction; Practical training services; Staff training services; Organisation of training; Production of training films; Providing courses of training; Production of training videos; Training related to nutrition; Organisation of training seminars; Providing online training seminars; Instructional and training services; Provision of training courses; Educational and training services; Education and training consultancy; Education and training services.

Recipe books; cook books; recipe cards.

Cups; baby cups; cups with lids; cups with handles.

Stationery; wall charts; printed guides; printed booklets.

Bibs.

Online retail of third party products.”

7. Under this ground, the opponent claims that it has a valuable reputation and goodwill amongst the relevant public. As a result, the opponent claims that use of the opponent’s mark would constitute a misrepresentation because consumers would believe that the goods or services of the applicant were those of the opponent or had, in some way, been authorised by or were connected to the opponent. The opponent claims that this would cause loss and damage to the opponent.
8. Lastly, under the section 3(1)(c) ground, the opponent’s pleaded case is as follows:

“ ‘Scrummy’ is defined as "delicious; lovely", and is commonly used to describe foods. When combined, the phrase "That's Scrummy" can be used to describe the taste of a particular food or meal. When attached to recipe binders, recipe books, printed recipes sold as a component of food packaging, printed recipe cards, cookery books and/or cook books, the term becomes descriptive of the foods or meals contained within those products.”

9. The applicant filed a counterstatement wherein it denied the series of claims against it.
  
10. While the opponent was initially professionally represented when filing its notice of opposition, it has since conducted these proceedings without representation. The applicant has been unrepresented throughout the entirety of these proceedings. Both parties filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu. This decision is taken after a careful perusal of the papers.
  
11. 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.

## **EVIDENCE**

12. The opponent's evidence came in the form of three witness statements. They are that of Katie Shelton dated 27 February 2023, Stephanie Hyde dated 26 February 2023 and Emily Gale dated 27 February 2023. Dealing with the statements in turn, I note that Ms Shelton is the only Company Director of the opponent, a position she has held since 2020. Her statement was introduced to prove the various claims made by the opponent and is accompanied by eight exhibits which are labelled as

Exhibit EG, SM, TS, IG, MH, AA, CJ and AB. As for the statements of Ms Hyde and Ms Gale, I note that these are Instagram followers and customers of the opponent. Neither are accompanied by any exhibits but were introduced to demonstrate instances of actual confusion.

13. Having reviewed the applicant's evidence, I note that it consists of a letter addressed to the Case Work Examiner in this matter dated 24 September 2023. This letter is signed by Christopher Jenkins and Jonathan Krarup, being the applicant's Directors and co-founders. Attached to this letter are five exhibits (labelled Exhibit\_001 to 005) which introduce documents referred to in the covering letter. Because it is not accompanied by a statement of truth, the content of the letter cannot be treated as evidence but, instead, can only be deemed as written submission. As for the five exhibits provided, I note that these are all accompanied by their own statements of truth which are sworn by Mr Jenkins. These can, therefore, be accepted as evidence. I am of the view that the issue regarding the lack of a statement of truth in respect of the letter is something that should have been picked up on during the evidence rounds and rectified at that time. This did not occur and while it would now be an option for me to direct the applicant to formalise the letter into the body of an actual sworn witness statement, I will proceed on the basis that the letter is capable of forming evidence of fact. My reasons for doing so will become obvious throughout the course of this decision.

14. I do not intend to summarise the evidence or submissions filed by the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **PRELIMINARY ISSUE**

15. The parties have introduced a number of points that I consider to be of no relevance to the present decision. In such circumstances, I do not consider it serves any purpose to run through numerous pieces of evidence that offer nothing to the various assessments I must make throughout this decision. For the sake of illustrating my point, I will discuss one example from each party below.

16. Turning to the opponent's evidence first, at paragraph nine of Ms Shelton's witness statement, she points out that the applicant's director, Mr Jenkins, purchased a 'weaning bundle' from the opponent in April 2021 and then, later in 2021, the applicant released its own 'weaning bundle'. The opponent claims that the applicant did not independently derive the materials for this product itself. Firstly, I have nothing to suggest what a 'weaning bundle' is and what goods it includes. As such, it is possible that it may not even involve any of the goods at issue in the present proceedings. While such an argument may assist an opposition brought under separate grounds, it is not something that forms the basis of any of the assessments relevant to section 5(2), 5(3) or 3(1) grounds.

17. In addition, the applicant's evidence introduces an argument that both logos used by the parties "use a multi-colour handwritten font styles" and has provided a range of images showing how the companies use their marks. The 'primary' examples given are as follows:



18. For the avoidance of doubt, the assessments I must make throughout this decision in respect of the marks are notional ones based on fair use of the marks as they appear on the register and not how the parties have actually used their marks. Both parties' marks are word only marks meaning that they are both capable of being presented in any standard typeface and in any colour. However, the above examples are not what I would consider fair use of either party's mark. For example, the marks at issue, while capable of being used in any colour, are not covered for contrived colour splits which is the case for the examples shown above. As a result, the applicant's evidence on this point is of no assistance to these

proceedings and I am, instead, required to consider the marks in the ordinary way (which will be described with reference to the relevant case law and principles that I will set out later in this decision).

19. As set out above, these are two examples of irrelevant evidence; I have no intention of referencing each and every argument raised by the parties. I have given them due consideration and will, for the remainder of this decision, only discuss the points that I consider relevant to the present proceedings.

## **DECISION**

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

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

“A trade mark shall not be registered if because –

a) [...]

b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

21. Section 5A of the Act states as follows:

“5A 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.”

22. The opponent's mark qualifies as an "earlier trade mark" for the purposes of this decision since it was applied for at an earlier date than the filing date of the applicant's mark.<sup>2</sup> The opponent's mark did not complete its registration process more than five years before the filing date of the applicant's mark so it is not subject to the proof of use provisions set out in section 6A of the Act. Therefore, the opponent may rely on all of the goods highlighted in the section 5(2)(b) part of its notice of opposition.

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

---

<sup>2</sup> See Section 6(1)(a) of the Act.

(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

24. The applicant's goods as set out at paragraph one above and the opponent's goods and services are those underlined at paragraph three above.

25. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

26. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

27. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. 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 fur 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.”

28. For the avoidance of doubt, the assessment I must make in respect of the comparison of the goods and services at issue is a notional one based on the terms as they appear before me. It is not, therefore, based on how the parties use or intend to use the terms in their specifications. This is particularly relevant because a number of the terms before me are broad and capable of being used in a variety of ways. As such, my assessment will take into account any and all ways in which the parties' terms can be interpreted.

*Printed matter; printed stationery.*

29. The above terms of the applicant are very broad and can cover any and all types of printed material or stationery. This includes diaries, day planners and training manuals, all of which appear as terms in the opponent's specification. Therefore, applying the principle outlined in the case of *Meric*, I find that these goods are identical on the basis that all of the opponent's terms in class 16 can be said to fall within the applicant's broader term.

*Printed calendars; printed charts; wall charts.*

30. I note that the opponent's specification includes terms such as "monthly planners" and "planners [printed matter]". In my view, a printed calendar or chart (be that a wall chart or otherwise) can be used as a type of planner. Additionally, a planner may also come in the form of a calendar or a chart. Therefore, I consider that these goods are identical under the principle outlined in *Meric* either because the opponent's goods fall within the applicant's goods, or vice versa.

*Printed books; printed booklets*

31. All of the above terms are sufficiently broad that they can be said to cover goods such as training manuals or diaries that are produced in the form of books or booklets. Given that the opponent's specification includes the term "training manuals" and "diaries [printed matter]", I am of the view that these goods are identical under the principle outlined in *Meric* because the opponent's goods fall within the applicant's goods, or vice versa.

*Instructional and teaching material (except apparatus); educational books; printed educational materials; educational publications.*

32. Ordinarily, instruction, education and teaching materials are used to help teach students on different topics. That being said, there are educational courses that are used to train students in particular fields. For example, post-graduate law degrees are geared more towards training students how to be solicitors/barristers as opposed to educating them on legal topics (being topics more reserved for undergraduate degrees). As such, I am of the view that instructional, teaching and educational materials (such as those covered by the applicant's terms) can also cover materials used for the purpose of training students. On this point, I note that the opponent's specification includes "printed training materials". I, therefore, find that the applicant's terms and the opponent's term can all describe the same goods meaning that they are identical. Alternatively, it may be that the construction of the applicant's terms is such that the opponent's term falls within them or vice versa.

Therefore, if the goods are not self-evidently identical, then I find them to be identical under the principle outlined in *Meric*.

*Notepads; adhesive notepads.*

33. On the plain reading of the above terms, they will be understood as blank paper products on which the user will take notes. While they may be used in conjunction with “daily planners” or “training manuals” in the opponent’s specification, I do not consider them to be the same. Further, I do not consider that notepads would be used as diaries meaning that they are not the same as “diaries [printed matter]” in the opponent’s specification either. In respect of similarity of these goods, I will say that outside of being paper goods, their natures and methods of use will differ. In respect of purpose, the aim of the opponent’s goods will be to plan the user’s day or train themselves on a topic whereas the applicant’s goods will simply be to take notes. Even if those notes are for training or planning purposes, the actual purpose of the goods themselves differ. As for trade channels, I have nothing before me to suggest that a producer of a training manual, daily planner or diary would also produce and sell notepads (be that adhesive or not). That being said, notepads (be that adhesive or not) and daily planners are likely to be available via the same retailers and placed within close proximity to each other (in the same aisles or even next to one another on the same shelves). As such, there is some overlap in trade channels. The goods are not competitive in nature and while they may be used alongside each other, I do not consider them to be complementary because they are not important to one another to such a degree that consumers would believe them to originate from the same undertaking.<sup>3</sup> As for user, both goods are aimed at the general public at large meaning that there is inevitably some overlap here. Taking all of the above into account, I am of the view that the overlaps in trade channels and user are particularly strong and are not sufficient to give rise to a finding of similarity. However, if I am wrong on this point then I am of the view that, at best, the goods are similar to a very low degree and I will proceed on this basis.

---

<sup>3</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

*Printed guides.*

34. In my view, the above term is likely to cover goods such as travel guides or step-by-step 'how to' guides. These are not planners or diaries and while they may assist the user in completing a task, I do not consider that a guide is likely to be considered a training manual. I say this because a step-by-step guide will teach you how to complete a task whereas a training manual will teach you the required skills in order to train you to complete the task repeatedly in the future. Having said that, I consider that there is a degree of similarity between the above term and "training manuals" in the opponent's specification. I say this because despite what I have said above, there is a slight degree of overlap in the goods' core purpose on the basis that both aim to teach the user something. In addition, I consider it reasonable to find that a producer of a training manual on a certain topic may also produce and sell a step-by-step guide to offer users a 'quick fix' in relation to that same topic. As a result, I consider that there is an overlap in trade channels. Lastly, the user may not directly overlap because someone looking to train on a topic is unlikely to use a step-by-step guide to do so. Having said that, the goods may share a competitive relationship because a user looking to complete a task may wish to use a step-by-step guide over training themselves to complete it (which is likely to be a more onerous task). Taking all of this into account, I find that these goods are similar to a low degree.

*Baby books.*

35. While baby books may cover story books that are read to children, I consider it likely that the term may also cover goods aimed at new or expectant caregivers that offer guidance on how to raise the baby. Therefore, it can be said to be a type of guide book. While not a training manual per se, I consider that an identical comparison to that made in the preceding paragraph applies here, namely that these goods are similar to a low degree with "training manuals".

*Printed cards.*

36. In my view, and upon the plain reading of the above term, it is likely to be understood as covering printed greeting cards. Aside from an overlap in user between the above and the opponent's class 16 goods (on the basis that all goods are likely to be sought by members of the general public at large), I see no obvious reason why any of the relevant factors would overlap. I do not consider that an overlap in user is sufficient to warrant a finding of similarity meaning that these goods are dissimilar.

*Baby books [storybooks]; baby memory books; story books.*

37. Unlike the other book goods I have assessed above, I do not consider that the above can be said to be those that offer guidance or education. They are, plainly, either story books or books that a user may put photographs of their baby in in order to keep them as memories. Such goods are not educational in nature and, therefore, are not similar to the opponent's "training manuals" or "printed training materials". Further, I do not consider that these goods can be said to be planners or diaries. In considering the relevant factors, there are no obvious levels of overlap between these goods and the goods of the opponent (or, for that matter, the opponent's services). I appreciate that an overlap in user is likely due to the goods being sought by members of the general public at large, however, as explained above, this is not sufficient to warrant a finding of similarity. In addition, both parties' goods may cover books but finding similarity on that basis alone would offer far too broad a level of protection as any type of book would share a level of similarity with any other type of book. As a result, I find that these goods are dissimilar.

*Recipe binders; recipe books; printed recipe cards; cookery books; cook books; printed recipes sold as a component of food packaging.*

38. While the above terms will inevitably include step-by-step instructions to make certain recipes, they are not "training manuals" (being a term in the opponent's specification) and neither would they be considered guides in the same sense that

the opponent's term would be.<sup>4</sup> In my view, any link between such goods is too tenuous to result in a finding of similarity between them. I appreciate that I have reached findings of similarity between the applicant's other book goods and the opponent's goods/services, however, my reasons for doing so were down to the broad and undefined nature of the applicant's terms. This is not applicable here as the nature of the applicant's goods are defined as specifically covering recipes. As a result, I consider that aside from the goods being printed materials and those that are likely to be targeted at the general public at large, I consider that there is no obvious overlap in any of the relevant factors. As was the case in the preceding paragraph, I am of the view that goods being printed materials sought by the general public is not sufficient to give rise to a finding that they are similar to any degree. These goods are, therefore, dissimilar.

*Cardboard boxes; gift boxes; corrugated boxes.*

39. Clearly, the above goods are not diaries, planners or training manuals and cannot be said to be identical to the same. As for similarity, aside from a potential overlap in user, I see no reason why such goods would overlap in nature, method of use, purpose or trade channels with the opponent's goods or services and neither are they competitive or complementary with each other. As I have said throughout my assessment of the goods and services at issue, an overlap in user is not sufficient to warrant a finding of similarity, especially when the user base is broad enough so as to cover the general public at large. As a result, I find that these goods are dissimilar.

#### Conclusion on the goods and services comparison

40. Where there is no similarity of goods, there can be no likelihood of confusion under the present ground.<sup>5</sup> As a result, my findings above mean that the section 5(2)(b)

---

<sup>4</sup> To say that they were guides would result in a finding of a low degree of similarity following the reasoning I have discussed at paragraph 34 above. I consider this would require a straining of the relevant language in respect of recipe books/binders or cards. See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

<sup>5</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

opposition fails in respect of the following goods, being those that I have found dissimilar:

Class 16: Printed cards; baby books [storybooks]; baby memory books; story books; recipe binders; recipe books; printed recipe cards; cookery books; cook books; printed recipes sold as a component of food packaging; cardboard boxes; gift boxes; corrugated boxes.

41. For the avoidance of doubt, given that I have found the applicant's goods to be similar to the opponent's class 16 goods only, I see no reason to refer to the class 41 services of the opponent throughout the remainder of the section 5(2)(b) part of this decision.

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

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

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

43. It is my view that the goods at issue will be sought by members of the general public at large. I also appreciate that the broad nature of the goods is such that they may cover educational/training goods that will be sought by the professional user. The goods will, for the most part, be available from general or specialist retailers and even direct from the provider itself. The goods are likely to be displayed on shelves or racks where they will be self-selected by the consumer. In addition, the goods may also be selected via the retailer's or provider's own website where they will be selected after the consumer views an image of the same on a webpage. As such, the selection process for the goods is likely to be dominated by visual components, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales assistants.

44. Members of the general public are likely to select the goods at issue with a varying level of frequency. For example, calendars and diaries are likely to be selected relatively frequently whereas some educational/training materials may be selected less frequently. In addition, I acknowledge that some professional users who require regular education/training may seek the goods with a greater degree of frequency. The costs of the goods will vary somewhat as goods such as training manuals, for example, may cover relatively cheap booklets but may also cover more detailed textbooks for complex training courses that may be more expensive. Regardless of the cost, I am of the view that the average consumer will pay a medium degree of attention when selecting the goods at issue. I say this because the goods are, for the most part, ordinary consumer goods. As such, the consumer is likely to give consideration to relatively ordinary factors such as the content of the printed matter, materials used (are the goods recycled, for example) and whether it is suitable for their needs.

### **Comparison of the marks**

45. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

46. 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.”

47. 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.

48. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
Scrummy Tummies	That's Scrummy

49. I note that the opponent's submissions in lieu make reference to the strap line used in the applicant's original mark, being 'Good stuff for little tummies'. Such strapline is not present in the mark that the applicant has sought to register and so it is not relevant to the present proceedings.

50. Before proceeding to consider the overall impression of the marks, I wish to briefly discuss a point raised by the opponent in its notice of opposition. The opponent argued that consumers tend to focus on the beginnings of marks, thereby placing emphasis on the word 'Scrummy' in its mark. I note that this something that is supported in case law in that, as a general rule, beginnings of words tend to have more visual and aural impact than the ends.<sup>6</sup> That being said, I do not see where this gets the opponent in the present case. If I were to apply the same principle to the applicant's mark, then the emphasis will be on 'That's'. As such, if consumers were to focus on the beginnings of the marks, they will notice that they are entirely different. In any event, it is not always the case that beginnings of marks are important or decisive.<sup>7</sup> Therefore, such an argument offers the opponent no assistance and I will, therefore, say no more about it.

### Overall Impression

51. The applicant's mark is a word only mark consisting of the words 'That's Scrummy'. The opponent argues that the word 'Scrummy' is the dominant element of the applicant's mark with 'That's' either being not considered as part of the mark or as an incidental part of the same. I disagree and will explain why when considering the conceptual comparison below. For now, I will simply state that the overall impression of the applicant's mark lies in the words equally as a unit.

52. The opponent's mark is also a word only mark that consists of the words 'Scrummy Tummies'. While I do not consider that the combination of these words form a unitary meaning, I find that neither word plays a stronger role than the other. As a result, I find that the overall impression of the opponent's mark lies in the words equally.

---

<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>7</sup> *CureVac GmbH v OHIM*, T-80/08

### Visual Comparison

53. Visually, the marks share the word 'Scrummy'. This is the first element of the opponent's mark but the second element of the applicant's mark. The marks differ in the presence of the word 'Tummies' at the end of the opponent's mark and 'That's' at the beginning of the applicant's mark. Given the roles in their respective marks, these words will not be overlooked and will, instead, act as considerable points of difference. Overall, I am of the view that the shared use of 'Scrummy', albeit at different points in the respective marks, is such that the marks are visually similar to a medium degree.

### Aural Comparison

54. I consider that both marks will be pronounced in full and in the ordinary way. In considering the length of the marks, I note that the opponent's mark consists of four syllables and the applicant's consists of three. In both marks, 'Scrummy' will be pronounced identically, though this will be at different points (the beginning of the applicant's mark and the end of the opponent's mark). In my view, taking into account the point of aural identity but also noting the different location of this element together with the points of difference, I find that the marks are aurally similar to a medium degree.

### Conceptual Comparison

55. In considering the overall impression of the applicant's mark, I made reference to the arguments of the opponent. This was focused on the claim that the word 'That's' in the applicant's mark would either not be considered as part of the applicant's mark or that it would be considered an incidental part of the same. This argument is based on the fact that 'That's' operates as an identifying pronoun. In addition, the opponent argues that 'That's Scrummy' will, with an emphasis on 'That's', be understood as a statement that *'that' brand over there is Scrummy*. As above, I disagree with the arguments put forward by the opponent. In respect of the first argument, I am of the view that 'That's' will be understood as a contraction of 'That

is'. Therefore, when viewed as a whole, the mark will be understood as the statement, *that is scrummy*. In this context, 'That's' will refer to a type of food that is being/has been consumed. As for 'Scrummy', this will have an obvious meaning to consumers in the UK, i.e., '*delicious; lovely*'.<sup>8</sup> Therefore, consumers will understand the mark as a statement that *something they are eating or have eaten tastes delicious/lovely*. Such a meaning is what led me to find that the applicant's mark forms a unit. As such, it does not follow that 'That's' will be viewed as incidental or not as part of the mark. As for the second argument, I see no reason why consumers would view the opponent's mark on goods and think the mark was a self-referential indicator of the fact that the brand was called 'Scrummy'. On this point, I am of the view that for such an argument to carry any weight, it was for the opponent to provide evidence to demonstrate that this is how consumers see trade marks that are presented in this way. Without such, I am not willing to infer that they would. As a result, I see no merit in either of the opponent's arguments.

56. As for the opponent's mark, the consumer will be aware of the meanings of each word. As above, 'Scrummy' will be understood as delicious or lovely and 'Tummies' as an informal reference to stomachs.<sup>9</sup> When viewed together, I am of the view that the words will have some connection to one another on the basis that 'scrummy' is a reference to the taste of something that has been eaten and 'tummies' is where said food will be digested. That being said, I do not consider they form any sort of meaning in combination to the point that they will form a unitary phrase.

57. In comparing these concepts, there is clearly a shared reference to something being delicious or lovely. However, the points of difference created by the applicant's unitary meaning and the opponent's informal reference to a stomach are such that they act as points of conceptual difference. As a result, I find that these marks are conceptually similar to a medium degree.

---

<sup>8</sup> <https://www.collinsdictionary.com/dictionary/english/scrummy>.

<sup>9</sup> <https://www.collinsdictionary.com/dictionary/english/tummies>.

## **Distinctive character of the opponent's mark**

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

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

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

59. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. While the opponent did not plead that its mark enjoys an enhanced degree of distinctiveness, it has filed evidence of use. I remind myself that the issue of enhanced distinctiveness is capable of consideration regardless of whether it is

pleaded or not. As a result, the issue of enhanced distinctiveness is something that I am required to consider in the present case. Before doing so, however, I will assess the inherent position.

60. The opponent's mark is a word only mark consisting of the words 'Scrummy Tummies'. While the words have their own meanings (being a reference to something being delicious or lovely and an informal reference to stomachs), I am of the view that when viewed together, the mark has no obvious meaning outside of the individual meanings of those words. In considering the distinctiveness of the mark, I appreciate that, as a whole, it has no obvious meaning and it is neither descriptive nor allusive for the goods and services at issue. However, I do not consider that the combination of these two well-known words would be inherently distinctive to a high degree; they are not particularly remarkable from a trade mark perspective and would, instead, be attributed a medium degree of inherent distinctiveness.

61. The evidence before me in respect of the opponent's use is, in its evidence, referred to as evidence that demonstrates a reputation. While the present assessment is whether there exists an enhanced degree of distinctiveness, a claim of reputation can be taken as a claim of enhanced distinctive character through use. Having considered the evidence of use, I note that there were only two points raised. I will assess these below.

62. Firstly, the opponent's evidence refers to the 'Scrummy Tummies' Instagram account. The narrative evidence sets out that the opponent had 3,000 followers by the end of 2019, 25,000 by the end of 2020 and 65,000 by the end of 2021.<sup>10</sup> The opponent argues that each of its followers have seen the opponent's mark in its stories, grid posts, reels, products and website since 2020. While this claim is noted, the only evidence is an image taken from the opponent's Instagram account's landing page. There is nothing to suggest any level of engagement with

---

<sup>10</sup> See paragraph six of the witness statement of Ms Shelton and exhibit IG. It is noted that figures for 2022 are provided but the relevant date for the present assessment is 15 November 2021 (being the filing date of the applicant's mark).

the opponent's posts, especially to support a claim that *all* followers have viewed the opponent's stories, posts, reels, products and website. In addition, there is nothing to suggest any level of sales stemming from its presence on Instagram.

63. The second piece of evidence that the opponent claims to point to a reputation is in relation to public mentions of the brand from what is referred to as 'very high-profile influencers'. While referencing influencers in the plural, only one influencer account is mentioned, being @mrshinchhome. The supporting evidence on this point is two pages of screenshots (showing five images) of the @mrshinchhome account. The screenshot of the landing page for this account confirms it as being the account of a Sophie Hinchliffe<sup>11</sup> and shows that, as at the date of the screenshot, she had 4.6 million followers. In addition, the evidence shows screenshots of posts that this account has posted wherein the opponent's brand is tagged. While I appreciate that this account has a large follower base, there are multiple issues with this evidence. The first is that the evidence shows just four posts, all of which are undated. Therefore, it is possible that they stem from after the relevant date. The second issue is that even if such posts were from prior to the relevant date, there is nothing to suggest (1) the level of engagement they enjoyed and (2) how such mentions from this account translated to an actual level of awareness of the opponent's brand in the UK. In respect of this point, even if I were to accept that simply because the account has 4.6 million followers then a large amount of people viewed the post, there is nothing to suggest how many people clicked through to the opponent's page or sought any of the opponent's goods and services. Lastly, the international nature of social media platforms such as Instagram is such that the follower count of this account may include a significant number of followers from outside the UK.<sup>12</sup>

64. While there are sporadic mentions of customers and one-off sales in the narrative evidence (these are introduced in relation to a claim that there is evidence of actual confusion, which I will discuss further below), there is no evidence as to the level of sales or turnover associated with the goods and services relied upon. Further,

---

<sup>11</sup> Exhibit MH

<sup>12</sup> The UK being the relevant territory for this decision.

there is no evidence as to marketing spend and/or advertising presence. I will say at this point that in cases before the Tribunal it is not always necessary to adduce evidence of sales, turnover or marketing. However, if a party does not do so, any other evidence that is purported to demonstrate use needs to be capable of demonstrating a level of awareness across the relevant consumer base. In considering the opponent's evidence, this is simply not the case. Even if I were to ignore the issues with the evidence that I have discussed above, evidence of social media followers alongside four posts (albeit from a popular Instagram account) are not sufficient to demonstrate that the opponent has used its mark to any degree, let alone to a level that is capable of pointing to an enhanced degree of distinctive character. As a result, I find that the opponent's mark does not enjoy any degree of enhanced distinctiveness, meaning that the inherent position applies.

### **Evidence of actual confusion**

65. Before proceeding to consider the likelihood of confusion, I consider it necessary to first address the evidence of alleged actual confusion filed by the opponent. On the point of actual confusion, I note the comments of Kitchin LJ (as he then was) in the case of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220. While the relevant discussion in that case surrounded the lack of confusion in the marketplace, he did state that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion.”

66. If I am satisfied that the opponent has filed evidence of actual confusion, it is not the end of the matter but, as above, it is to be considered powerful evidence in favour of the opposition.

67. Dealing with the evidence filed, I note that there are four examples of actual confusion provided. These are primarily set out in the witness statement of Ms Shelton (being the opponent's director) wherein she explains instances wherein Ms Hyde, Ms Gale and an account called '@eatingwithelliyah' were all confused by the presence of the applicant's mark. There is also mention of the applicant itself tagging the wrong account in one of its Instagram posts. In support of these instances of confusion, the opponent has provided two separate witness statements from Ms Hyde and Ms Gale. In respect of the other two instances, this evidence is provided via screenshots appended to Ms Shelton's witness statement.<sup>13</sup>

68. Having considered the evidence, only one of the alleged instances of confusion is from prior to the relevant date. As evidence in these proceedings is to be directed at the relevant date (being the filing date for the applicant's mark on 15 November 2021), the evidence of actual confusion from after the relevant date is of no assistance to the present case. The evidence from prior to the relevant date relates to confusion on behalf of Ms Hyde. Ms Shelton's narrative evidence explains that this occurred in November 2020 when Ms Hyde shared an Instagram post with the opponent that she thought was posted by the opponent but it was actually posted by the applicant. In Ms Hyde's own statement, she refers to the instance as occurring on 1 November 2021, not 2020 as Ms Shelton's narrative evidence states. Aside from giving some details as to the nature of her conversation with the opponent's Instagram account, Ms Hyde's statement explains that she became confused between the two brands because the names, logos and products are so similar. There is nothing to suggest in what context Ms Hyde became confused (i.e. information as to what marks was she confronted with) and, further, there is nothing to suggest what goods or services she was looking to select, namely whether the marks were viewed on the actual goods at issue (or the relied upon services of the opponent).

---

<sup>13</sup> Exhibits EG, EM and TS.

69. I note that the alleged instance of confusion in relation to Ms Emily Gale is referred to by Ms Shelton in her statement as occurring in January 2021. While this is before the relevant date, I note that upon review of Ms Gale's own witness statement the instance is referred to as taking place on 27 January 2022. On this point, Ms Shelton appended an exhibit showing a screenshot of an Instagram conversation between the opponent and Ms Gale together with a printout of Ms Gale's order confirmation.<sup>14</sup> While it is not particularly clear, the order confirmation appears as though it bears a date in 2022.<sup>15</sup> Taking this into account together with Ms Gale's narrative evidence, I find that this instance of alleged confusion took place after the relevant date and is not relevant to the present case. For the avoidance of doubt, the additional two instances of alleged confusion referred to in Ms Shelton's statement are confirmed as taking place in August and October 2022, being after the relevant date.

70. The relevant evidence before me relates to just one example of confusion prior to the relevant date. Firstly, I do not consider that one example of confusion is a powerful factor in favour of a finding that a significant proportion of consumers would also be confused. Even ignoring the issue in respect of the volume of the evidence, the opponent has failed to demonstrate the context in which this confusion took place (i.e., on what goods the applicant's mark was encountered or whether the marks used by the brands were those at issue here).<sup>16</sup> Such evidence is not that which I would consider powerful evidence in favour of a finding of a likelihood of confusion. On this point, even if I were to take all instances into account, the same issue applies in that (1) four examples of confusion is not, in my view, necessarily supportive of a finding that a significant proportion of consumers would be confused and (2) there is no real context provided as to the situations in which the alleged confusion took place. So even at the opponent's very best case, the evidence is unclear and the alleged instances of confusion are not what I would consider powerful factors pointing towards confusion.

---

<sup>14</sup> Page one of Exhibit EG

<sup>15</sup> Page two of Exhibit EG

<sup>16</sup> This point is of particular pertinence because, as I have set out above, the parties have used marks that are not capable of being deemed as use of the marks as registered/applied for.

71. Taking all of the above into account, I am not satisfied that the opponent's evidence of actual confusion is a factor (let alone a powerful one) in favour of its claim that there exists a likelihood of confusion between the marks.

### **Likelihood of confusion**

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods 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 or she has retained in his or her mind.

73. I have found the parties' goods to be identical or similar to varying degrees. For the most part, I have found the average consumer to be members of the general public at large, however, I found that some of the goods will be selected by professional users. Regardless of the identity of the consumer, they will select the goods with primarily visual considerations (though I do not discount the aural component) after having paid a medium degree of attention. In respect of the similarity of the marks at issue, I have found the marks to be visually, aurally and conceptually similar to a medium degree. The opponent's mark is inherently distinctive to a medium degree.

74. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that consumers would misremember or inaccurately recall which mark was which. Even though both marks share the identical word 'Scrummy' (which is not descriptive or allusive to the goods/services at issue),<sup>17</sup> the additional points in each mark play an equal role with the common element. As a result, I find that consumers will focus equally upon those when attempting to recall the marks and, therefore, will not be confused by the common presence of 'Scrummy'. In addition, I remind myself that the two words in the applicant's mark form a unitary meaning which further distances it from the opponent's mark, being a combination of two known words that form no obvious meaning when viewed together. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

75. For the sake of completeness, I now turn to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the 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>17</sup> I say this because in the context of edible goods, such a term may be seen as laudatory to the quality of the goods (i.e. that they taste delicious or lovely). This would support an argument that shared use of such a word may be considered coincidental. However, this is not the case here.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

76. In considering the differences between the marks, I see no scenario wherein a likelihood of indirect confusion would exist. Firstly, 'Scrummy', even on goods that do not directly relate to food, is not something that would be so strikingly distinctive that consumers would only believe one undertaking would use it. Secondly, I do not consider that consumers would view the differences between 'Scrummy Tummies' and 'That's Scrummy' as alternations/additions that are logical indicators consistent with a brand extension or sub-brand. In support of this position, I remind myself that while there is a shared conceptual hook between the marks, the applicant's mark forms a unit with its own meaning that, as a whole, is distinct from that of the opponent's mark. On this point, I will say that even if there was any weight in the opponent's argument that 'That's Scrummy' will be understood as *'that brand over there is 'Scrummy'*,<sup>18</sup> this offers no assistance to the opponent. I

---

<sup>18</sup> Being an argument I dismissed at paragraph 55 above.

say this because the opponent's brand is not 'Scrummy' but is, instead, 'Scrummy Tummies'. Therefore, I am of the view that any connection to the understanding of '*that brand over there is Scrummy*' and 'Scrummy Tummies' is too tenuous for the consumer to make.

77. I appreciate that the above factors set out in *L.A. Sugar* (cited above) are not to be treated as an exhaustive list of examples wherein indirect confusion can occur, however, the opponent has offered nothing further for me to consider. As a result, I do not consider it appropriate for me to consider anything beyond the given examples. In my view, to do so would be unfair to the applicant as it would involve me formulating the opponent's case on its behalf. In any event, I cannot envisage any scenario wherein indirect confusion would occur. Consequently, I consider that there exists no likelihood of indirect confusion, even when the marks are viewed on identical goods.

78. As a result of the above, the opposition reliant upon its section 5(2)(b) ground has failed in its entirety. I will now proceed to consider the remaining grounds of this opposition.

### **Section 5(3)**

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

"5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the opponent's mark being brought to mind by the applicant's mark.

Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

82. I am of the view that I can deal with this ground relatively briefly. I appreciate that the assessment of a mark's reputation is not exactly the same as the assessment of enhanced distinctiveness. However in the present case, I consider that I can apply the finding under my enhanced distinctiveness assessment to the issue of a reputation. I say this because the relevant date and relevant territories relevant to this ground are identical to those that were applicable to the enhanced distinctiveness assessment.

83. I do not intend to go over the issues with the evidence once again. Instead, I will simply state that for reasons that I have explained above when considering enhanced distinctiveness, I find the evidence falls far short of the threshold for the existence of a reputation as at the relevant date in the UK. In short, there is no evidence of sales, turnover or marketing. The only evidence before me covers social media follower evidence and just four posts from a popular Instagram account wherein the opponent's brand is mentioned. For the same reasons I have discussed at paragraphs 61 to 64 above, I am of the view that this evidence is insufficiently solid and in no way points to a level of awareness of the opponent's brand across a significant part of the relevant public for the goods and services relied upon. As a result, the opponent's reliance upon its section 5(3) ground falls at the first hurdle.

84. I will now proceed to consider the section 5(4)(a) ground of this opposition.

## Section 5(4)(a)

85. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) .....

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

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

87. As was the case with the section 5(3) ground above, I can deal with this ground swiftly. Put simply, the evidence is insufficient to allow me to find that the opponent, by the relevant date, enjoyed any goodwill in its sign. I say this because goodwill accrues as a result of trading activities and there is no evidence before me that can speak to any level of trading activities by the opponent. I appreciate, again, that there are sporadic examples of customers and one-off sales, however, this is not at any level that would come close to proving that the opponent has generated goodwill. Even if I am wrong on this point and the opponent did enjoy a protectable

level of goodwill at the relevant date and the sign relied upon (being ‘Scrummy Tummies’) was distinctive of and/or associated with said goodwill, the present ground would still fail. I say this because while the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely that the difference between the legal tests will produce different outcomes.<sup>19</sup> In the present case, there was no confusion under the 5(2)(b) ground assessed above and, for the same reasons discussed at paragraphs 74 to 77 above, I consider that a similar finding applies here, namely that use of the applicant’s mark would not deceive a substantial number of members of the public. As a result, there is no misrepresentation and the opposition reliant upon section 5(4)(a), therefore, fails.

88. I will now proceed to consider the section 3(1)(c) ground of this opposition.

### **Section 3(1): legislation and case law**

89. Section 3(1)(c) of the Act provides as follows:

“3(1) The following shall not be registered –

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

---

<sup>19</sup> See *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501 and *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

90. The relevant date for determining whether the applicant's mark is objectionable under the above provisions is its filing date, being 15 November 2021.

91. The position under the present ground must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.<sup>20</sup> The goods subject to the opposition are class 16 goods. I have identified the average consumer for these goods under the section 5(2)(b) ground above at paragraphs 43 and 44 above. I do not intend to repeat this in full but remind myself that the average consumers for these goods are members of the general public at large and, in some cases, professional users (for educational publications). Regardless of the identity of the consumer, they will pay a medium degree of attention during the selection process for the goods at issue.

92. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z.o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

"33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004]

---

<sup>20</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or

serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

93. For the sake of completeness, I repeat the opponent's pleadings in respect of the present ground here. These are as follows:

“‘Scrummy’ is defined as ‘delicious; lovely’, and is commonly used to describe foods. When combined, the phrase ‘That’s Scrummy’ can be used to describe the taste of a particular food or meal. When attached to recipe binders, recipe books, printed recipes sold as a component of food packaging, printed recipe cards, cookery books and/or cook books, the term becomes descriptive of the foods or meals contained within those products.”

94. Having considered the opponent's case in respect of the relevant goods, I am of the view that there is one critical error in how it has been pleaded. I say this because the opponent's argument is brought on the basis that the term ‘That’s Scrummy’, when viewed on cook books (amongst other types of recipe books/materials) becomes descriptive of the *food or meals* contained within them. Put simply, the relevant test under this ground is whether the applicant's mark is descriptive of the kind, quality, quantity, intended purpose, value, geographical origin, the time of production or other characteristics of the applied for class 16 goods, not the food/meals that any recipe may yield.

95. I will say at this point that there is no reason why ‘That’s Scrummy’ would be viewed as descriptive of the quantity, value, geographical origin or time of production for the goods at issue. In addition, the opponent has offered nothing further by way of an argument in support of a claim as to any other characteristic. I will, therefore, focus on the kind, quality and intended purpose of the goods.

96. In considering any claim as to the kind or quality of the goods at issue, I see no reason why ‘That’s Scrummy’ would be viewed as being descriptive of the same. In short, printed materials are not goods that can be described as being ‘Scrummy’ because they are not edible goods.<sup>21</sup> As for the intended purpose, I am of the view that the aim of cook books (or other printed materials that may offer recipes) is to

---

<sup>21</sup> It may very well be the case that ‘That’s Scrummy’ is descriptive for actual foodstuffs in classes 29 or 30 but, again, this is not relevant here.

provide the user with lists of ingredients and step by step guides that assist the user in cooking/preparing various meals/dishes. I appreciate that consumers will understand that the mark includes a laudatory message in that 'That's Scrummy' will be viewed as a claim that the foods created by the recipes will be delicious. However, this is not directly descriptive of the purpose of the recipe book itself. Therefore, I do not consider that 'That's Scrummy' describes the purpose of the goods.

97. Aside from introducing this ground in its notice of opposition, I note that the opponent has made no further mention of it during the course of these proceedings. Therefore, I have nothing further to guide me as to why the opponent considers that the section 3(1)(c) ground should succeed. As a result, and bearing in mind what I have said above, I find that the opponent's claim under the present ground fails in its entirety. The applicant's mark is, therefore, not objectionable under section 3(1)(c) of the Act.

## **CONCLUSION**

98. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark may proceed to registration for all goods.

## **COSTS**

99. The applicant has been successful and is, therefore, entitled to its costs. The applicant was unrepresented for the entirety of these proceedings. For unrepresented parties to recover their costs in proceedings before the Tribunal, they are required to file a costs pro forma. The applicant's costs pro forma was received on 28 February 2024. The applicant claims that it spent the following amount of time on these proceedings.

Notice of Defence:	5 hours
Considering forms filed by the opponent:	5 hours
Examining the opponent's evidence:	10 hours

Preparing evidence:	12 hours
Reviewing the opponent's written submissions:	4 hours
Preparing written submissions:	3 hours
<b>Total:</b>	<b>39 hours</b>

100. I appreciate that the tasks outlined above would have required more of a time commitment by the applicant on the basis that it is unrepresented. That being said, I am of the view that the time claimed for some of the tasks is somewhat excessive and I will explain why below.

- a. I appreciate that the forms filed in these proceedings were not particularly complex, however, I am content to award the full costs claimed in respect of these on the basis that the applicant was required to deal with four separate grounds of opposition against its mark.
- b. The applicant claims 10 hours for the time associated with the examination of the opponent's evidence. The evidence filed by the opponent was just 16 pages in length and, therefore, I consider 10 hours to be somewhat excessive.
- c. As for the applicant's own evidence, I have explained throughout this decision that this was of no assistance during these proceedings. As such, I do not consider it appropriate to make any costs award in respect of the same.
- d. I note that the applicant claims costs for reviewing the opponent's written submissions. These are not costs that would ordinarily be awarded to legally represented parties in instances where costs are awarded on the published scale set out in Tribunal Practice Notice 2/2016.<sup>22</sup> As such, I see no reason to make an award in respect of the same in these proceedings.
- e. While it is not reflected in the breakdown of the costs proforma above, the applicant claimed official fees of £100. I note that, throughout these proceedings, the applicant filed a Form TM9R in order to request an extension of time to file its evidence. The filing of such a form comes at a cost of £100. For the avoidance of doubt, these are costs associated with a request for the Tribunal to utilise its discretion to grant an extension of time and are not

---

<sup>22</sup> Being the scale that would govern costs for these proceedings if the parties were legally represented.

something that the opponent had any control over. As such, these costs are not recoverable from the opponent.

101. In light of what I have said above, I consider a costs award for the following number of hours to be reasonable:

Notice of Defence:	5 hours
Considering forms filed by the opponent:	5 hours
Examining the opponent's evidence:	5 hours
Preparing written submissions:	3 hours
<b>Total:</b>	<b>18 hours</b>

102. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the opponent the sum of £342.00 (18 hours at £19 per hour) in respect of its costs proforma.

103. I hereby order Scrummy Tummies Limited to pay That's Scrummy Ltd the sum of £342. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 30<sup>th</sup> day of September 2024**

**A COOPER**  
**For the Registrar**