

O/1155/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3907945

IN THE NAME OF

GERARD MCADOREY

TO REGISTER THE FOLLOWING TRADE MARK:

NUDE

IN CLASSES 29 & 30

AND

OPPOSITION THERETO (UNDER NO. 442969)

BY

NUDE COFFEE ROASTERS LIMITED

BACKGROUND

1) On 04 May 2023, Gerard McAdorey ('the applicant') applied to register the trade mark, NUDE, in the UK, in respect of the following goods:

Class 29: Prepared and ready cooked meals consisting wholly or substantially of vegetables, meat, poultry, game, seafood or eggs; bouillons; soups; snack foods; jellies; jams; compotes; dairy and dairy products; soups; potato crisps.

Class 30: Prepared and ready cooked meals consisting wholly or substantially wholly of pasta, rice or noodles; seasonings, flavourings, condiments; pastes for making sauces; sauces; snack foods; gravies; flour and preparations made from cereals; bread; pastry and confectionery; marshmallows; chocolate; bakery goods; biscuits (cookies); desserts; pizzas; pies.

2) The application claims a priority date of 16 November 2022 from the European Union Intellectual Property Office.

3) The application was published in the Trade Marks Journal on 09 June 2023 and subsequently opposed by Nude Coffee Roasters Limited ('the opponent'). It is claimed that the trade mark application offends under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ('the Act').

4) In support of its grounds under sections 5(2)(b) & 5(3) of the Act, the opponent relies upon the following trade mark registration and all of the goods and services for which it is registered:

- **UKTM 910625341**



Class 29: Milk and milk products; dairy produce; beverages made from or containing milk; milk shakes; cream; whipped cream; butter; jams; preserved, frozen, dried and cooked fruits and vegetables; meat, fish, poultry and game; prepared salads; fruit salads; dried fruit; prepared meals.

Class 30: Coffee; ground coffee; coffee beans; coffee drinks; iced coffee; espresso; tea; beverages made of tea; fruit teas; iced tea; ice for refreshment; fruit ices; cocoa; cocoa beverages; flavourings for beverages; flavouring syrups; breakfast cereals; cereal bars; oat porridge; sandwiches; toasted sandwiches; chilled ready meals; prepared snack foods; bakery goods; bread; biscuits; cakes; cheesecakes; cookies; muffins; scones; brownies; pastries; shortbreads; confectionery; chocolate.

Class 43: Services for providing food and drink; catering of food and drinks; cafés; coffee shops; snack bar services.

Filing date: 08 February 2012

Date of entry in register: 06 June 2012

5) It is claimed that the respective goods and services are either identical or highly similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b).

6) Under section 5(3) of the Act, it is claimed that the earlier mark has a reputation in the UK in relation to all the goods and services for which it is registered. It is said that use of the contested mark will result in the relevant public believing that there is an economic connection between the undertakings using the respective marks and that use of the contested mark will lead to unfair advantage being taken of the earlier mark and/or will cause detriment to the reputation and/or distinctive character of the earlier mark.

7) The registered trade mark relied upon by the opponent is a comparable mark which is an earlier mark, in accordance with section 6 of the Act¹. As the earlier mark completed its registration procedure more than five years prior to the priority date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in relation to all the goods and services relied upon.

8) Under section 5(4)(a) of the Act, the opponent relies upon use of the following four signs:

- i) NUDE
- ii) NUDE COFFEE ROASTERS
- iii) NUDE ESPRESSO
- iv)



All four of the above signs are said to have been used throughout the UK since 2008 in relation to the same goods and services as those covered by the opponent's registered mark, shown at paragraph 4, above. It is claimed that the opponent has generated goodwill, of which each of the four signs above are distinctive, and that use of the contested mark will result in misrepresentation and damage to that goodwill.

9) The applicant filed a counterstatement in which it requests proof of use of the earlier registered mark. The applicant admits that the verbal element, NUDE, in the earlier registered mark is identical to its mark. However, it denies that its mark is sufficiently similar to the earlier mark to give rise to a likelihood of confusion. It does not admit or

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs and IR (EU) TMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)/IR(EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM/EU(IR)TM from which it derives.

deny the claimed similarity between any of the respective goods and services because, it states, it is unable to do so until proof of use has been filed to show which goods and services the earlier mark has been put to genuine use for in the relevant period. The applicant puts the opponent to proof of its claimed reputation and that use of its mark would be contrary to section 5(3) of the Act. It also puts the opponent to proof of the claimed goodwill in all the signs relied upon and denies that its mark offends under section 5(4)(a) of the Act.

10) The opponent is represented by Humphreys & Co. The applicant is represented by Maclachlan IP (formerly known as Ansons). Both parties filed evidence. The opponent's evidence consists of a witness statement from Mr Richard Reed ('Mr Reed'), dated 24 January 2024, with Exhibit RR1. The applicant's evidence consists of a witness statement from Mr Gerard William McAdorey, dated 25 March 2024, with exhibits GWM1-GWM2. Neither party requested a hearing; both filed written submissions in lieu.²

DECISION

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.

Proof of use

12) Section 6A of the Act states:

“(1) This section applies where -

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

² Both are dated 04 July 2024

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

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

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5) – (5A) [Repealed]

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

13) Section 100 is also relevant, which reads:

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

Consequently, the burden lies with the opponent to prove it has made genuine use of its mark.

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

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

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

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

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

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

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

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

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

Ansul at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

16) In relation to framing a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was), sitting as the Appointed Person, summed up the law on this matter as follows:

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

17) Further, in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal stated, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which

is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

18) The relevant period in which genuine use must be established is the five-year period ending on the date of priority of the contested mark. In the case before me, that period is **17 November 2017 to 16 November 2022**.

Mr Reed's evidence

19) I have carefully considered all of Mr Reed's evidence. I will now summarise the most pertinent parts of it.

20) Mr Reed is one of two directors and shareholders at the opponent, which was incorporated in 2008.

26 Hanbury Street

21) Mr Reed states that the opponent has been operating a NUDE ESPRESSO café at 26 Hanbury Street, London since 2008, 'specialising in small batch roasted coffee and top end brunch food'. It is said that, between 2008 and 2020, this café was extremely busy and only ever closed on Christmas Day and New Year's Day. It is said that the sign, NUDE ESPRESSO, appeared on signage outside the premises and on menus, menu boards, cups and coasters inside the premises. There has also consistently been a NUDE ESPRESSO logo on the back wall inside the café.

22) This café has provided a variety of drinks and food including coffee, and syrups and flavourings therefor, tea, hot chocolate, milkshake, prepared meals, salads, sandwiches, bakery goods (cookies, biscuits, cakes), muffins, scones, pastries, confectionery, bread, focaccia, croissants and soup. Some of the café's bestsellers were eggs benedict, smashed avocado on toast and the NUDE chocolate chip cookie. The opponent's food is not sold in packaging. However, Mr Reed states, it is sold under the NUDE ESPRESSO and/or NUDE COFFEE ROASTERS names and logos and that there is no other name or mark associated with that food.

Soho Square

23) In 2011, the opponent opened a second outlet in Soho Square, London. It is said that between 2011 and 2020 this café displayed the NUDE ESPRESSO name and logo outside the café and on the wall within the café. The NUDE COFFEE ROASTERS logo is said to have been used only on bags of coffee sold at this café. Mr Reed

explains that this café provided the same kinds of food and drink as those provided at the café at 26 Hanbury Street.

25 Hanbury Street

24) In 2014, another café was opened from the opponent's new 'coffee roastery' premises at 25 Hanbury Street, London. Mr Reed states that this café has always displayed the NUDE COFFEE ROASTERS name and logo prominently outside the café, as well as on menus, cups, coasters etc, within the premises. This café is also said to have provided the same kinds of food and drink as those provided at the café at 26 Hanbury Street.

Bell Lane

25) In 2015, a further café was opened by the opponent at 8 Bell Lane, London, comprising a small café area at the front and a 'coffee training school' at the back. It is said that between 2015 and 2020 this café has prominently displayed the mark NUDE COFFEE ROASTERS (alone and with the logo) both outside on signage and within the premises. This café also provided the same kinds of food and drink as those provided at the café at 26 Hanbury Street.

Spitalfields

26) In 2016, the opponent opened another café at 4 Market Street, Spitalfields, London. Between 2016 and 2020, this café is also said to have displayed the mark NUDE COFFEE ROASTERS (alone and with the logo) both outside on signage and within the premises. This café also provided the same kinds of food and drink as those provided at the café at 26 Hanbury Street.

Pop-ups

27) In 2010, the opponent teamed up with Rapha HQ to set up their first café concept store, a meeting place for cyclists to immerse themselves in the sport. The opponent provided them with coffee, 'equipment' and all 'coffee solutions' for the next eight

years. The relevant article in evidence shows a photograph of the relevant premises with the following mark shown on the window: ³



28) In 2013, the opponent teamed up with the Guardian to open a pop-up tech café in BoxPark, Shoreditch. The relevant Guardian article in evidence states that; “Nude Espresso, London’s leading micro-roastery, is the coffee partner for the venture...”.⁴

29) In 2020, NUDE ESPRESSO partnered with Piers Morgan for the launch of his new book, blending a speciality ‘Piers Blend’ coffee for him. It is said that this coffee was sent as part of a gift box to 100 of his famous friends, including David Hasselhoff.

Coffee beans

30) Mr Reed states that the opponent has, from 2008 to the date of his witness statement, sold coffee beans to retail and wholesale customers throughout the UK under the following marks: NUDE ESPRESSO (alone and with logo) and NUDE COFFEE ROASTERS (alone and with logo). These are sold through the opponent’s cafés and website, www.nudeespresso.com. I note that an image in evidence from the opponent’s social media page, dated 10 May 2018, shows the following packets of coffee beans:⁵

³ Exhibit RR1, pages 220-221

⁴ Exhibit RR1, page 210

⁵ Exhibit RR1, page 102



31) A further social media post from 5 April 2022 shows the following packet of coffee beans bearing the mark shown at my paragraph 37:⁶



⁶ Exhibit RR1, page 113

COVID

32) Mr Reed explains that, in early 2020, the opponent's café sales dropped by 50% overnight due to the COVID pandemic. Sales dropped by another 40% after the government advised everyone to work from home.

33) After the lockdowns were announced in March 2020, the only one of the opponent's locations which remained open was the premises at 26 Hanbury Street.

34) It is said that, during 2021/22, most of the opponent's cafés remained closed because of the pandemic and a consequent lack of customer footfall.

Turnover

35) Mr Reed states that the figures in the tables below are broken down, as follows: sales of drinks in the cafés; sales of food in the cafés; retail sales to consumers via the opponent's website and outlets (mainly bags of coffee beans, merchandise, coffee equipment), wholesale sales of coffee beans and revenue generated from office catering.

<u>2017/18</u>	
Drinks	£500,249
Food	£367,804
Retail (coffee,merchandise)	£416,594
Wholesale coffee beans	£662,521
Office catering	£28,148
TOTAL	£1,975,316

<u>2018/19</u>	
Drinks	£552,501
Food	£400,005
Retail (coffee,merchandise)	£460,109
Wholesale coffee beans	£731,724
Office catering	£31,088
TOTAL	£2,175,427

<u>2019/20</u>	
Drinks	£479,067
Food	£352,230
Retail (coffee,merchandise)	£398,954
Wholesale coffee beans	£634,468
Office catering	£26,956
TOTAL	£1,891,675

<u>2021/22</u> (COVID aftermath)	
Drinks	£120,074
Food	£42,026
Wholesale coffee beans	£588,361
TOTAL	£750,461

Advertising/promotion

36) It is said that, since 2011, the opponent has regularly advertised all its NUDE ESPRESSO/NUDE COFFEE ROASTERS goods and services at the London Coffee Festival which attracts around 7,000 visitors annually.

37) Mr Reed also states that the opponent's goods and services have been advertised online since 2008 at the opponent's website www.nudeespresso.com. Sample dated

screenshots from that website are provided spanning the period of 2010 - 2022.⁷ During the relevant period for proving genuine use, the following mark is shown on the website:



38) The website provides the option of buying coffee beans and lists the locations of the opponent's cafés at 26 Hanbury Street (which indicates that a full brunch menu is served seven days a week), Bell Lane (serving light brunch) and Spitalfields (serving cakes, salads and rolls) and a coffee roastery at 25 Hanbury Street.

39) The opponent also uses Social Media platforms such as Facebook, Twitter, Instagram, TikTok, LinkedIn and YouTube. Prints from those accounts are provided spanning the period of 2012 – 2022. (There are also later examples but these fall after the filing date of the contested mark).⁸ I note that a post from 9 march 2018, on Instagram, shows the following frontage of a café at 26 Hanbury Street:⁹



⁷ Exhibit RR1, pages 1-51

⁸ Exhibit RR1, pages 52 - 185

⁹ Ibid, page 101

40) Another post on Instagram, dated 21 June 2018, shows the frontage of the opponent's Spitalfields premises, as follows:¹⁰



41) A further post from 26 July 2018, shows the following frontage of the Bell Lane premises:¹¹



42) The opponent regularly sends out newsletters and, occasionally, issue press releases. The opponent has nearly 1,500 people on its mailing list. Sample newsletters and press releases are provided.¹²

43) According to Mr Reed, the opponent's NUDE ESPRESSO and NUDE COFFEE ROASTERS names and logos have featured regularly in online press articles. Examples are provided dated 2010, 2013 and March 2023. None of these are from within the relevant period for showing genuine use.¹³

¹⁰ Ibid, page 103

¹¹ Ibid, page 104

¹² Exhibit RR1, pages 227-234

¹³ Exhibit RRA, pages 186-209

44) It is said that the opponent undertook a sponsorship deal with a professional British cycling team. However, I note that this took place in 2023 and 2024, being after the priority date of the contested mark; this is, therefore, not relevant to any of the matters before me.

Awards

45) Mr Reed provides details of the following awards which he states the opponent has received over the years:

- 2021 M&A Global Award for Best Micro Roastery UK
- 2020 M&A Global Award for Best Micro Roastery UK
- 2019 M&A Global Award for Best Micro Roastery UK
- 2018 Lux Life Food and Drink Award for Coffee Roastery of the Year. London
- 2016 London Lifestyle Award for Best Cafe in London Finalist
- 2015 Global Product & Service Award, Winner Best Micro Roastery UK
 - London Lifestyle Awards Best Cafe in London Runner Up
 - Best Signature Drink Award , London Coffee festival
- 2014 Gold award for Independent Cafe of the Year UK awarded by Cafe Life
- 2013 Winner of Independent Cafe of the Year UK awarded by Cafe Society
- 2010 Winner of Independent Cafe of the Year UK awarded by Cafe Society

Does the evidence establish genuine use within the relevant period?

Form of the mark in use

46) I remind myself that the opponent's earlier registered mark looks like this:



47) The evidence before me includes use of the above mark, as registered. However, it also includes other forms of the mark, as shown below:

i)



ii)



iii)



iv)



48) The applicant contends that the forms shown at i) – iii) above do not constitute acceptable variant forms of use of the earlier registered mark. I disagree. The distinctiveness of the mark, as registered, rests overwhelmingly in the word ‘nude’, with the red circular background merely acting as a backdrop and the word ‘espresso’ being entirely descriptive. In respect of marks i) and ii), the omission of the red circular device and different stylisation of the marks does not, in my view, alter the distinctiveness of the mark, as registered. As regards mark iii) the substitution of the entirely descriptive and non-distinctive word ‘espresso’ for the equally descriptive and non-distinctive words ‘coffee roasters’ also does not alter the distinctiveness of the mark, as registered. Similar reasoning applies to mark iv) bearing in mind, also, my earlier comment as regards the red circular background merely serving as a backdrop and therefore its omission in mark iv) does not affect the distinctive character of the mark, as registered.

49) I find that the differences between the mark, as registered, and all of the marks at i) – iv) above are ones which do not alter the distinctiveness of the registered mark and they are all acceptable variants upon which the opponent may rely.¹⁴

Sufficiency of use

50) Bearing in mind all of the above and considering the evidence in the round, I am satisfied that the opponent has put its earlier mark, and/or acceptable variants thereof, to genuine use during the relevant period in relation to ‘coffee beans’ and ‘coffee shops/café’s’ throughout the relevant period. Turnover for the opponent’s coffee beans and café/coffee shop services has been steady and healthy over the relevant period, despite the dip in sales post-2020 and the closure of some of its

¹⁴ As per the principles set out by Professor Phillip Johnson in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

cafés, which I accept were likely to have been largely attributable to the COVID pandemic.

51) I am not satisfied that the nature of the use is sufficient to justify finding genuine use for any foodstuffs or drinks per se (other than coffee beans). This is because, while I accept that the opponent's cafés/coffee shops provided various foodstuffs (none of which bore any third-party branding), this is, nevertheless, to my mind, a café/coffee shop service rather than use in relation to goods as such and is also how the average consumer would perceive and describe such use.

52) I also find no genuine use for any of the other services in class 43, including 'catering of food and drinks'. Whilst I accept that turnover figures for the latter services are in evidence, the figures are small and there is very little else in the evidence showing the nature of the use of the earlier mark in relation to those services. There is also nothing before me to show use in relation to what could be described as 'snack bar services'.

A fair specification

53) I must now determine a fair specification which reflects the nature of the genuine use that has been shown. In approaching the matter, I bear in mind that there is likely to be a substantial proportion of consumers who would perceive, and naturally describe, the opponent's service as a 'café' and another substantial proportion who would perceive, and naturally describe, it as a 'coffee shop'. Both types of establishments will serve a selection of hot and cold beverages, snacks and prepared meals of some sort, for consumption on or off the premises. I note the applicant itself appears to sit in the former camp, as it describes the nature of the opponent's use as being a café. Bearing all of this mind, and that the opponent's registered specification covers both terms, I consider it appropriate to allow it to rely upon both. It is not, however, permissible to allow the opponent to retain the very broad term 'services for providing food and drink' when the nature of the use before me is confined, specifically, to cafés and coffee shops. In respect of use in relation to 'coffee beans', plainly the opponent is entitled to rely upon that specific category of goods only.

54) I find that a fair specification is 'cafés; coffee shop services' in class 43 and 'coffee beans' in class 30. I will assess the grounds under section 5(2)(b) and 5(3) of the Act on that basis.

Section 5(2)(b)

55) This section of the Act states:

“5. - (2) A trade mark shall not be registered if because –

(a)....

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

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

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.”

56) The leading authorities which guide me are from the CJEU: *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 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.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

57) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

58) Guidance on this issue has also come from Jacob J, where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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.

59) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

60) In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

61) I also bear in mind that in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch) (*'YouView'*), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

62) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05), where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-

104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42.”

63) The goods and services to be compared are:

Opponent’s goods and services	Applicant’s goods
<p>Class 30: Coffee beans.</p> <p>Class 43: Cafés; coffee shops.</p>	<p>Class 29: Prepared and ready cooked meals consisting wholly or substantially of vegetables, meat, poultry, game, seafood or eggs; bouillons; soups; snack foods; jellies; jams; compotes; dairy and dairy products; soups; potato crisps.</p> <p>Class 30: Prepared and ready cooked meals consisting wholly or substantially wholly of pasta, rice or noodles; seasonings, flavourings, condiments; pastes for making sauces; sauces; snack foods; gravies; flour and preparations made from cereals; bread; pastry and confectionery; marshmallows; chocolate; bakery goods; biscuits (cookies); desserts; pizzas; pies.</p>

64) Before I consider the degree of similarity between the respective goods and services, I note that, in its counterstatement, the applicant did not deny the opponent’s

claims regarding the respective goods and services being identical/highly similar, Instead, the applicant said this:

“Since it is not clear whether use of the registered mark has been made in respect of the goods and services relied upon, we are not able to comment upon whether the class 29 and 30 goods covered by the subject Application are “identical and/or highly similar” to goods for which the Opponent’s earlier registered mark has been put to use within the relevant five-year period.”¹⁵

65) Later in the proceedings, once the applicant was in receipt of the opponent’s evidence of use, again there was no denial from the applicant as regards the claimed similarity between the respective goods and services. Instead, the applicant said this:

“It is well established in case law that there is only **a very low degree of similarity** between different foodstuffs and drinks, on the one hand, and services for providing food and drinks, on the other.”

66) I therefore proceed on the basis that the applicant has, at no point, denied any similarity between the respective goods and services and that the applicant’s position appears to be that the relevant respective goods and services are similar, but only to a very low degree. That being so, it is still necessary to determine whether there is any greater degree of similarity than contended by the applicant. In this connection, I also bear in mind that, although the applicant contends that there is only a very low degree of similarity between all of its goods and the opponent’s services as per, in its submission, ‘well-established case law’, it does not provide any details of any such case law to support this statement.

67) I consider it appropriate to group certain of the applicant’s goods together, from both classes, for the purpose of the comparison where they are essentially of the same ilk, as follows:

¹⁵ Counterstatement, paragraph 3

Prepared and ready cooked meals consisting wholly or substantially of vegetables, meat, poultry, game, seafood or eggs; Prepared and ready cooked meals consisting wholly or substantially wholly of pasta, rice or noodles; pizzas; pies; soups; desserts; compotes.

68) All of the goods listed above are prepared meals/desserts. There is a shared purpose between these goods and the opponent's café and coffee shop services because both will be used to satiate hunger (although the opponent's services will also be used to satiate thirst). Although the goods differ in nature and methods of use to the opponent's services in class 43, the trade channels and users will be the same and there is a complementary relationship in play given that the applicant's goods are important to the provision of the opponent's services in such a way that the average consumer is likely to believe that they come from the same source. There is also some degree of competition in play with the average consumer choosing between purchasing a prepared meal to cook at home or visiting a café/coffee shop to be served a prepared meal, for example. I find that there is, at least, a medium degree of similarity between the respective goods and services.

pastry and confectionery; bakery goods; biscuits (cookies); preparations made from cereals; snack foods (in class 29); snack foods (in class 30); potato crisps.

69) Similar considerations as those expressed in the preceding paragraph are applicable to the assessment of the similarity between the above goods with the opponent's café and coffee shop services. The respective nature and method of use differs. However, the users and trade channels will be the same and there is, again, a shared purpose between them to satiate hunger. There is also a complementary relationship and some degree of competitive relationship in play. I find that there is, at least, a medium degree of similarity between the respective goods and services. In reaching this finding, I have borne in mind that the term 'pastry' not only covers dough but also covers items collectively described as pastries i.e. items of food consisting of sweet pastry, often filled with cream, jam or fruit. Further, the term 'preparations made from cereals' is a broad term which would cover some of the other terms listed above such as bakery goods and snack foods.

dairy and dairy products.

70) The applicant's term above is a broad one which covers goods such as milk, cream, yoghurt and cheese. In this connection I am mindful of the decision in *Foundation for the Protection of the Traditional Cheese of Cyprus Named Halloumi v Fontana Food Ab* [2024] EWHC 2311 (Ch), paragraph 18 -24. In that decision, the High Court upheld the decision of the relevant Hearing Officer that there was a low degree of similarity between 'cheese' and 'services for providing food and drink; coffee shop services; restaurants' (it disagreed with the Hearing Officer's primary finding of complete dissimilarity between those goods and services). Bearing that case in mind, I find that there is a low degree of similarity between the applicant's term above and the opponent's café and coffee shop services due to shared channels of trade and a degree of complementarity.

bread.

71) The applicant's bread is not similar in nature or method of use to the opponent's café or coffee shop services. However, the users and trade channels will overlap and there is a degree of complementarity in play, although they are not really in competition. I find a low degree of similarity between the applicant's 'bread' and the opponent's café and coffee shop services.

Sauces; gravies; Jellies; jams; marshmallows; chocolate; seasonings, flavourings, condiments.

72) These are all goods which are/may be served as an accompaniment to prepared meals/desserts. In my view, this, in turn, means that the trade channels between the opponent's café and coffee shop services (both of which will serve prepared meals) and the above goods will be the same. There is also a degree of complementarity in play (although not as strong as between the opponent's services and prepared meals per se). I find a low degree of similarity between the above goods and the opponent's café and coffee shop services.

Bouillons; pastes for making sauces; flour.

73) My understanding of the term 'bouillons' is that these are a kind of stock and there is nothing in the either party's submissions or evidence to satisfy me otherwise. All of the goods above are, therefore, foodstuffs which are neither prepared meals or snacks nor accompaniments to the same. They are also not 'ready to eat'. All of them require further processing/preparation/mixing with other ingredients before they will be consumed. The respective nature, methods of use and purpose of the respective goods and services is different and they are not in competition or complementary in the sense described in the case law. Any overlap in trade channels is likely to be limited. The users will, however, be the same. At this point, I remind myself that the applicant has, at no point, denied that there is similarity between any of the respective goods and services. Rather, it submits that there is a very low degree of similarity in play. I cannot see that there is any greater degree of similarity in play than that submitted by the applicant. I will therefore proceed on the basis that these goods are similar to the opponent's café and coffee shop services to a very low degree. It is not obvious to me that there is any greater degree of similarity between the relevant goods with the opponent's 'coffee beans' owing to the obviously different nature, methods of use and purpose of the respective goods and that there is no competitive or complementary relationship in play.

Average consumer and the purchasing process

74) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

75) The average consumer for the relevant goods and services is the general public. The purchasing act will be primarily visual; all the goods and services being sought out by eye on the high-street, from the shelves of food retailers or on Internet websites. That is not to say, though, that the aural aspect should be ignored because the goods and services may sometimes be the subject of discussions with sales representatives, for example. In terms of the goods at issue, I would expect the average consumer to take in to account various factors such as ingredients/flavour, portion size and/or allergens etc. As for the opponent’s ‘cafés; coffee shops’, I would expect the average consumer to consider factors such as the selection of food and drinks on offer and the comfort/ambience of the establishment. Bearing all of this in mind, I find that the level of attention paid during the purchase for all the relevant goods and services is, generally speaking, likely to be medium.


Comparison of marks

76) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

77) The marks to be compared are shown in the table below:

Opponent's mark	Contested mark
	<p data-bbox="1015 891 1182 943">NUDE</p>

Overall impressions

78) The contested mark consists of a single word, NUDE, absent any stylisation or embellishments; its overall impression lies solely in that word.

79) The opponent's mark naturally breaks down into three identifiable elements. The first element is the word 'nude', the second is the word 'espresso' and the third is the red circular device. Of all three elements, it is the distinctive word 'nude' which strongly dominates the overall impression of the mark. The red circular device merely acts as a backdrop for the words in the mark and plays a lesser role than the word 'nude'. The word 'espresso' takes up the smallest proportion of the mark from a visual perspective and will be perceived as entirely descriptive, for obvious reasons, and therefore non-

distinctive; it plays the least role out of all three elements in the mark's overall impression.

80) Visually, both marks include the word 'nude'. The differences between the marks arise due to the presence of the red circular device and the word 'espresso' in the opponent's mark which are both absent from the contested mark. Notwithstanding the latter differences, I find a high degree of visual similarity between them.

81) Aurally, the marks coincide in the pronunciation of the word 'nude'. They differ due to the pronunciation of the additional word, 'espresso', in the earlier mark, after the word 'nude', which is absent from the contested mark. Bearing in mind that it is the beginnings of marks that tend to have the greatest impact upon the perception, I find an above-medium degree of aural similarity between the marks.

82) The concept that will immediately be perceived from the word 'nude' will be of something naked or bare. Whilst that is a concept which may have some mild allusive qualities (I will say more about this later when I come to assess the level of distinctiveness of the earlier mark), it is not descriptive of any of the relevant goods/services; it is a distinctive concept which is shared by the marks. The word 'espresso' in the earlier mark also provides the additional concept of a well-known type of coffee. However, the latter concept will be perceived as entirely descriptive and non-distinctive for obvious reasons and, therefore, has little role to play in distinguishing the marks from a conceptual perspective. Conceptually, I find the marks to be very highly similar.

Distinctive character of the earlier mark

83) The distinctive character of the opponent's mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion between it and the contested mark (*Sabel BV v Puma AG*). 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).”

84) The applicant makes no submissions about the level of distinctiveness of the earlier mark. The opponent submits that its mark is, inherently, high in distinctiveness. The word ‘nude’ will, as I have already stated, be perceived as meaning naked or bare. Whilst that word has some mild allusive qualities in relation to the opponent’s services i.e. alluding to cafés or coffee shops which serve simple, stripped back food and drink, the mark is not descriptive of the same. The word ‘espresso’ will be perceived as entirely descriptive in the context of the relevant earlier services and the red circular background merely acts as a backdrop for the words in the mark and does not, in my view, elevate the distinctiveness of the mark to any material degree. I find that the word ‘nude’ itself, and the mark as a whole, has around a medium degree of inherent distinctiveness.

85) I now turn to the question of whether the inherent distinctiveness of the earlier mark has been enhanced through use, as contended by the opponent.

86) Whilst I accept that the opponent's evidence is sufficient to show that there has been genuine use of the earlier mark in the UK in respect of some of the goods and services relied upon, I find that it is not sufficient to show that the earlier mark also enjoyed enhanced distinctiveness at the relevant date. I come to this conclusion having regard to the modest sales figures, the limited geographical scope of the opponent's services (being based in certain areas of London), the lack of any substantial UK advertising or promotional spend and the limited promotional material before me showing exposure of the mark the UK. Accordingly, I will proceed on the basis of the earlier mark's inherent degree of distinctiveness which is, as noted above, around medium.

Likelihood of confusion

87) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

88) The similarity between the various goods and the earlier services is medium, low or very low. The earlier mark also has around a medium degree of inherent distinctiveness. The marks are visually highly similar, aurally similar to an above-medium degree and conceptually very highly similar. Weighing all these factors, I find that there is a likelihood of direct confusion between the marks, on the part of an average consumer paying a medium degree of attention in relation to the applicant's goods which are similar to the opponent's services to at least a low degree. I do not consider there to be a likelihood of direct confusion where the similarity between the goods and services is very low, even bearing in mind the interdependency principle. I

would have come to same conclusions had I found the distinctiveness of the earlier mark to be below-medium.

89) In case I am wrong to find that the marks will be mistaken as being the same, I will also consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

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

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)".

90) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

91) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

92) I find that, in the event the average consumer recognises that the respective marks are not the same, they are still likely to believe that the respective goods and services come from the same or linked undertaking(s) where they are similar to at least a low degree. I make this finding bearing in mind that both marks share the same distinctive word 'nude', the word 'espresso' in the opponent's mark is an entirely descriptive word and the red circular background is an addition of the kind one would expect to see in a brand variant/extension. There is, therefore, also a likelihood of indirect confusion in respect of all of the applicant's goods which are similar to the opponent's services to at least a low degree. I do not consider that the same applies where the respective goods and services are similar to only a very low degree. In those circumstances, and bearing in mind that the earlier mark is not strikingly distinctive, the common use of the word 'nude', is likely to be put down to mere coincidence. Again, I would have come to the same conclusions had I found the distinctiveness of the earlier mark to be below-medium. **The opposition under Section 5(2)(b) of the Act succeeds against all of the applicant's goods except 'bouillons; pastes for making sauces and flour'.**

Section 5(3)

93) Section 5(3) of the Act provides, as follows:

“(3) A trade mark which-

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

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.” (my emphasis)

94) The relevant case law can be found in the following judgments of the CJEU: *General Motors Corporation v Yplon SA*, C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel Corporation, Inc. v CPM United Kingdom Limited*, 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.*, C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L’Oréal & Ors v Bellure & Anor*, C-487/07, EU:C:2009:378, [2009] ETMR 55; *Interflora & Anor v Marks & Spencer & Anor*, C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, C-383/12P, EU:C:2013:741. 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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the

earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

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

Reputation

95) The first hurdle that the opponent must overcome under section 5(3) of the Act is to show that the earlier mark had a reputation in the UK on the priority date of the contested mark. The relevant date in these proceedings is, therefore, **16 November 2022**. If the evidence does not establish the existence of such a reputation, the opponent's case must fail. This is because, without a qualifying reputation in the UK, there can be no link made in the consumer's mind between the respective marks and no unfair advantage taken of, or damage caused to, the earlier mark.

96) In *General Motors*, the CJEU gave guidance on what is required to establish the necessary reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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

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

97) I have already summarised Mr Reed’s evidence of use earlier in this decision when I considered the matter of genuine use. I also referred to it again when I considered whether the distinctiveness of the earlier mark had been enhanced through use from the perspective of the average UK consumer; I found that it had not. Bearing in mind my earlier comments in that regard I find that, although there have clearly been sales in the UK prior to the relevant date in relation to café/coffee shop services and coffee beans and the opponent has received some awards prior to the relevant date, there is insufficient evidence to satisfy me that the scale of UK use has been such as to acquire the necessary reputation. In reaching this conclusion, I have borne in mind, in particular, the modest sales figures, the limited geographical scope of the opponent’s services (being based in certain areas of London), the lack of any substantial UK advertising or details about promotional spend and the limited promotional material before me showing exposure of the mark the UK. Without a reputation, the necessary link cannot be established in the average UK consumer’s mind and there can be no damage. **The opposition under section 5(3) of the Act fails.**

Section 5(4)(a)

98) Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

99) 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.”

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

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

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

Relevant date

101) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TMO-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

In the instant case, the opponent must show that it had the necessary goodwill at the priority date of the contested mark, namely **16 November 2022**.

What is Goodwill?

102) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

103) In terms of the evidence that is required to establish the existence of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

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

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

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

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

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

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

106) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

107) Bearing in mind my earlier comments about Mr Reed’s evidence and the nature of the use shown therein, I accept that the opponent had the requisite level of goodwill in a business selling coffee beans and providing café/coffee shop services at the relevant date and that the following signs were distinctive of that goodwill:

- i) NUDE COFFEE ROASTERS
- ii) NUDE ESPRESSO
- iii)



I also accept that, given the word ‘nude’ is commonly used with entirely descriptive words (‘espresso’ or ‘coffee roasters’) and/or a banal red circular device, the word ‘nude’ alone was also distinctive of the opponent’s goodwill. The opponent’s goodwill was local in nature, confined to certain areas in London.

Misrepresentation and Damage

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

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

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

109) If the contested mark were granted registration, it would be a national right which includes the locality in London in which the opponent enjoys goodwill. The contested mark and the earlier word sign, ‘nude’, are identical. The other three earlier signs are patently highly similar to the contested mark owing to the common presence of the distinctive word ‘nude’, notwithstanding the visual, aural and conceptual differences created by the descriptive words, ‘espresso’/‘coffee roasters’/‘coffee roasters’ plus red circular device. The goods covered by the registration are all food items and the applicant has not denied that there is any similarity between them and the opponent’s services. The parties are in a similar field of activity. However, there is very little similarity in respect of the applicant’s ‘bouillons; pastes for making sauces and flour’ and the opponent’s services (and no greater degree of similarity with coffee beans). Bearing all of this in mind, I find that those familiar with the opponent’s business will assume that most of the goods provided under the contested mark are the responsibility of the opponent with the exception of ‘bouillons; pastes for making sauces and flour’, leading to damage in the form of lost sales for the opponent. Damage can also be wider than simply loss

of custom.¹⁶ The reputation of a café/coffee shop business is no doubt very important. Placing that reputation in the hands of another could have a serious negative impact on the opponent's business and is another form of damage that must be guarded against.

110) The applicant is liable to be prevented from use of the trade mark under the law of passing-off. **The ground under section 5(4)(a) of the act therefore succeeds against all the applicant's goods, except against 'bouillons; pastes for making sauces and flour'.**

OVERALL OUTCOME

111) The opposition succeeds against the following goods:

Class 29: Prepared and ready cooked meals consisting wholly or substantially of vegetables, meat, poultry, game, seafood or eggs; soups; snack foods; jellies; jams; compotes; dairy and dairy products; soups; potato crisps.

Class 30: Prepared and ready cooked meals consisting wholly or substantially wholly of pasta, rice or noodles; seasonings, flavourings, condiments; sauces; snack foods; gravies; preparations made from cereals; bread; pastry and confectionery; marshmallows; chocolate; bakery goods; biscuits (cookies); desserts; pizzas; pies.

112) The opposition fails against the following goods:

Class 29: Bouillons.

Class 30: Pastes for making sauces; flour.

¹⁶ See, for instance, *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), where Warrington L.J. stated that: "To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

COSTS

113) The opponent has been largely successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 1/2023, and allowing for the applicant's small degree of success, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£250
Preparing and filing evidence	£800
Written submissions in lieu of a hearing	£350
Applicant's degree of success	- £210
Total:	£1190

114) I order Gerard McAdorey to pay Nude Coffee Roasters Limited the sum of **£1190**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of December 2025

Beverley Hedley
For the Registrar