

O/1189/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3824507
IN THE NAME OF OZGUR TASCI
TO REGISTER THE FOLLOWING TRADE MARK:**



ROASTERY CLUB
LONDON

IN CLASSES 21, 30 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 440005
BY ENSCO 1399 LIMITED**

Background and pleadings

1. On 29 August 2022, Ozgur Tasci (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK, under number 3824507 (“the applicant’s mark”). Details of the application were published for opposition purposes on 18 November 2022. Registration is sought for the following goods and services:

Class 21: Coffee cups; coffee stirrers; coffee mugs; coffee pots; coffee scoops; non-electric coffee drippers for brewing coffee; coffee services [tableware].

Class 30: Roasted coffee beans; coffee [roasted, powdered, granulated, or in drinks]; coffee; coffee substitutes; ground coffee; decaffeinated coffee; coffee pods; coffee mixtures; flavoured coffee; unroasted coffee; iced coffee; coffee bags; substitutes (coffee -); coffee concentrates; coffee oils; instant coffee; coffee capsules; coffee beverages; coffee drinks; coffee beans; coffee extracts; coffee (unroasted -); chocolate coffee; prepared coffee and coffee-based beverages; coffee based beverages; freeze-dried coffee; coffee based drinks; mixtures of coffee; ground coffee beans; coffee-based beverages; drip bag coffee; caffeine-free coffee; prepared coffee beverages; beverages made from coffee; coffee in ground form.

Class 43: Coffee shops; coffee shop services; coffee bar services.

2. On 20 February 2023, Ensco 1399 Limited (“the opponent”) opposed the application in full under ss.5(2)(b) and 5(4)(a) of the Trade Marks 1994 (“the Act”).

3. Under s.5(2)(b), the opponent relies upon the trade marks shown below (collectively, “the opponent’s marks”).



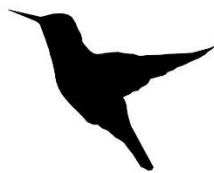
(i)

UK registration no. 908734279

Filing date: 4 December 2009

Registration date: 2 June 2010

("the opponent's first mark")



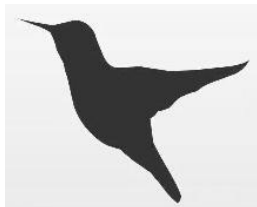
(ii)

UK registration no. 913845151

Filing date: 17 March 2015

Registration date: 10 November 2015

("the opponent's second mark")



(iii)

UK registration no. 907361595

Filing date: 3 November 2008

Registration date: 19 August 2009

("the opponent's third mark")¹

4. The opponent's marks stand registered for a range of goods and services in classes 2, 4, 7, 8, 9, 11, 16, 20, 21, 24, 25, 30, 35 and 43. Only some of these in classes 16,

¹ This mark was set out in the opponent's pleadings but is not referenced in its final written submissions. Reliance on this mark does not appear to have been expressly withdrawn. It is unclear whether the opponent's intention in excluding it from its submissions should be taken as such a withdrawal. However, nothing in this decision turns on this.

30, 35 and 43 are relied upon for the purposes of the opponent's claim, as set out in the annex to this decision.

5. Each of the opponent's marks qualifies as an 'earlier trade mark' in accordance with s.6 of the Act.² Although they had all been registered for more than five years at the filing date of the applicant's mark, the applicant has not required the opponent to provide proof of use. As such, the opponent may rely upon all the goods and services identified.

6. The opponent contends that the applicant's mark is similar to each of its marks and that the parties' goods and services are identical or similar. On this basis, the opponent submits that there is a likelihood of confusion.

7. As for s.5(4)(a), the opponent claims that it has substantial goodwill in its business in relation to which it has used a sign identical to its second/third mark in London since 2004, and its first mark in London since 2009 ("the device only sign" and "the composite sign", respectively). The signs are said to have been used in relation to *coffee cups, cake, baked goods, coffee, the retail of cake, coffee and baked goods, café services, bakery services, and takeaway food and drink services*. The opponent argues that use of the applicant's mark would constitute passing off.

8. The applicant filed a counterstatement denying the grounds of opposition.

9. Both parties are professionally represented; the opponent by Appleyard Lees IP LLP and the applicant by Briffa. Both parties filed evidence. No hearing was requested but both parties filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

² The opponent's marks are comparable trade marks based upon pre-existing EU trade mark numbers 8734279, 13845151 and 7361595. On 1 January 2021, in accordance with article 54 of the Withdrawal Agreement between the UK and EU, comparable UK trade marks were automatically created. They are now recorded on the UK register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

Relevance of EU law

10. 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, s.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

11. The opponent's evidence is given in the witness statement of Vinod Pragji Gordhan Vaghadia, filed together with 14 exhibits (VV1EX1-VV1EX14), and the witness statement of Daniel James Bailey, filed with two exhibits (DJB1EX1-DJB1EX2). Mr Vaghadia is the Finance Director of the opponent, a position he has held since 29 January 2021. He provides evidence of use of the opponent's marks/signs, the meaning of the word 'roastery', third-party use of coffee, tea and takeaway beverage brands, and an image said to show similarity between the parties' respective "bird devices". Mr Bailey is a Chartered Trade Mark Attorney and Solicitor with the opponent's representatives. His statement serves as a vehicle for introducing the witness statement of Tarek Malouf into the proceedings. Mr Malouf was a Director of The Hummingbird Bakery Limited ("HBB"), the opponent's predecessor in title. He provides evidence as to HBB's use of the opponent's marks/signs.

12. The applicant's evidence consists of a witness statement from Shamina Knights and seven exhibits (1-7). Ms Knights is a Solicitor with the applicant's representatives. She criticises the opponent's evidence and provides her own evidence on similar issues.

13. The opponent filed evidence in reply in the form of a second witness statement from Mr Vaghadia and a further four exhibits (VV2EX1-VV2EX4). This evidence consists of images showing how third parties apply their brands to coffee and coffee cups, as well as printouts from Google.

14. I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

Section 5(2)(b)

Legislation and case law

15. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

“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.”

16. 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 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;

(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.

My approach

17. As noted above, the opponent relies on three earlier marks. However, the opponent's second and third marks are clearly more similar to the applicant's mark than its first. This is because they do not contain the additional (differing) verbal elements. Moreover, the goods and services of the opponent's second mark appear to be more similar to the applicant's goods and services than those of its third mark, overall. The opponent's third mark is also no more similar to the applicant's mark. Accordingly, I will assess the opponent's claim on the basis of its second mark, returning to consider the opponent's reliance on its first and third marks if it becomes necessary to do so.

Comparison of goods and services

18. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated, at paragraph 23 of its judgment, that:

"In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

19. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 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.

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated 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

are very different. 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 QC noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/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.”

22. In *Oakley, Inc v OHIM*, Case T-116/06, the GC held (at paragraphs 46 to 57) that, although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

23. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning retail services and goods. He said that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

24. However, on the basis of the judgments in *Sanco SA v OHIM*, Case C-411/13P, and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs 30 to 35 of the judgment, upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07P, Mr Hobbs concluded that:

(i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking.

(ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark.

(iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered 'for goods X'.

(iv) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

25. In *Gérard Meric v OHIM*, Case T- 133/05, the GC 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."

Class 21

Coffee cups; coffee stirrers; coffee mugs; coffee pots; coffee scoops; non-electric coffee drippers for brewing coffee; coffee services [tableware]

26. The above goods can all fairly be described as household or kitchen utensils, household or kitchen containers, or tableware. Although the nature, method of use and intended purpose of these goods and *retail services connected with [...] household or kitchen utensils and containers, [...] tableware [...]* in class 35 of the opponent's second mark are different, the respective goods and services reach the market through the same trade channels and are likely to be offered by the same undertakings. The respective goods and services also share users. Moreover, the applicant's goods are important to the provision of retail services relating to those goods and consumers are likely to believe that responsibility for both lies with the same undertaking. As such, they are complementary. Overall, I find that there is a medium degree of similarity between the respective goods and services.

Class 30

Roasted coffee beans; coffee [roasted, powdered, granulated, or in drinks]; coffee; ground coffee; decaffeinated coffee; coffee pods; coffee mixtures; flavoured coffee; unroasted coffee; iced coffee; coffee bags; instant coffee; coffee capsules; coffee beverages; coffee drinks; coffee beans; coffee (unroasted -); chocolate coffee; prepared coffee and coffee-based beverages; coffee based beverages; freeze-dried coffee; coffee based drinks; mixtures of coffee; ground coffee beans; coffee-based beverages; drip bag coffee; caffeine-free coffee; prepared coffee beverages; beverages made from coffee; coffee in ground form

27. These goods are identical to *coffee* in class 30 of the opponent's second mark. Some, such as *coffee*, are literally identical. Others consist of various types or forms of coffee which are encompassed by the opponent's goods and are, therefore, to be regarded as identical in accordance with the principle outlined in *Meric*.

Coffee substitutes; substitutes (coffee -)

28. Whilst they are worded slightly differently, it is my view that these terms and *artificial coffee* in class 30 of the opponent's second mark describe the same goods. They are identical.

Coffee concentrates; coffee oils; coffee extracts

29. I do not consider the above terms to be identical to *coffee* in class 30 of the opponent's second mark. These goods are not coffee per se but, rather, goods which derive from coffee. They are not typically consumed as they are or used as the base of beverages in the way that, for example, instant coffee would be. Rather, it is my impression that they may be ingredients used in small quantities in drinks or foods. However, there is a broad overlap in nature insofar as the applicant's goods derive from the opponent's goods. Moreover, there is an overlap in purpose, given the respective goods could both be used to add flavour to other foods or beverages. Users are likely to overlap on a general level. It is possible that the producers of coffee may also produce coffee extracts and the like. However, there is no evidence of this, and I am disinclined to take judicial notice of it being typical in trade. I do not consider the respective goods to be in competition since they are not substitutable; a consumer is unlikely to purchase the applicant's goods over coffee, or vice versa. The goods are not complementary in the sense outlined in the authorities. Taking all the above into account, I find that there is a low degree of similarity between the respective goods.

Class 43

Coffee shops; coffee shop services; coffee bar services

30. Although the nature and method of use of these services and *coffee* in class 30 of the opponent's second mark are clearly different, there is an overlap in the ultimate intended purpose (to provide the consumer with coffee to drink). Users are shared. The respective goods and services may reach the market through shared trade channels. There is also a degree of competition between the respective goods and services, since a consumer could choose to visit a coffee shop to purchase a coffee

over making one themselves at home, or vice versa. Overall, I find that there is a medium degree of similarity between the respective goods and services.

The average consumer and the nature of the purchasing process

31. As the case law indicates, I must determine who the average consumer is for the parties' goods and services and the manner in which they are likely to select those goods and services. The average consumer has been described in the following terms:³

“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 [...] 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.”

32. On the issue of the average consumer, the opponent has submitted as follows:

“The average consumer of the [goods and services] will be a member of the general public. [The goods and services], being coffee and related products and coffee shop services are everyday purchases, that are not particularly high value. Accordingly we submit that the average consumer will pay a low to moderate degree of attention.

The goods and services are likely to be selected visually following consumers viewing of signage on the products or on the frontage of premises and menus. Accordingly, the way the marks look will play the most important role in the selection process.”

³ *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), paragraph 60

33. Conversely, the applicant has submitted that:

“The average consumer’s attention in relation to the goods and services in classes 21, 20 and 43 are likely to be vary between average and high. Given the nature of the goods and services in question, the average consumer is reasonably well informed and reasonably circumspect and observant.”

34. I broadly agree with the opponent’s position. However, I would add that aural considerations cannot be excluded entirely, since the average consumer may receive word-of-mouth recommendations or place verbal orders in hospitality settings. Moreover, overall, I would characterise the level of attention as being medium (rather than ranging from low to medium) because, whilst the goods and services are ordinary purchases which are not likely to be very expensive, they are not merely casual purchases made with little attention being paid. Consumers will consider certain factors when making their selection, such as, for example, taste, quality, the range of goods offered, location and cleanliness. I do not agree with the applicant that the level of attention would rise to a high level. The goods and services at issue do not appear to be of the kind where the average consumer’s attentiveness would be heightened and the applicant has not explained why that would be the case.

Distinctive character of the earlier mark

35. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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 *WindsurfingChiemsee*, paragraph 51).”

36. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

37. The opponent’s second mark consists of a device being a silhouette of a bird. Some consumers may appreciate that it is that of a hummingbird (as the opponent contends), whilst others may not. There are no other elements in the mark which could contribute to its distinctiveness. The device is neither descriptive nor allusive of the goods and services relied upon. Overall, I find that the opponent’s second mark possesses a medium level of inherent distinctive character.

38. Evidence has been filed by the opponent and I am now required to assess whether it has demonstrated that its mark had an enhanced distinctive character at the relevant date of 29 August 2022.

39. HBB was incorporated on 13 May 2002.⁴ Mr Malouf says that, as at the date of his statement (January 2010), the bird device had been in continuous use by HBB since

⁴ Exhibit VV1EX1

January 2004.⁵ The first of HBB's "retail bakery shops" is said to have opened in January 2004 in London, selling cakes, coffees and teas. He provides the following turnover figures:

Year	Turnover (£)
2004	73,115
2005	212,181
2006	282,295
2007	472,496
Total	1,040,087

40. Mr Malouf says that two further shops were opened in London in March 2007 and December 2009, respectively. He says that, in 2008 and 2009, the business had a combined turnover of £2,895,744.

41. According to Mr Malouf, HBB used a PR agency from 2007 onwards. Between then and the end of June 2009, HBB's advertising expenditure is said to have been £71,176. Prior to this, HBB's promotion is said to have been by articles with newspapers and periodicals, telephone sales, point of sale materials at the shops and via hummingbirdbakery.com ("the website"). Promotional materials are also said to have been distributed through HBB's delivery service.

42. Mr Malouf refers to numerous documents throughout his statement. However, none has been filed as evidence in these proceedings.

43. Mr Vaghadia says that, following the execution of an Asset Purchase Agreement dated 13 February 2021 and a Confirmatory Assignment dated 8 November 2021, the opponent acquired HBB's trade mark rights. He confirms that the opponent has continued to use the marks since the acquisition.

44. Mr Vaghadia states that the opponent operates the website, three bakeries/retail bakery shops, and two franchised bakeries/retail bakery shops under the marks,

⁵ Mr Malouf's narrative can be found in Exhibits VV1EX2 and DJB1EX2.

selling, *inter alia*, cakes, cupcakes, brownies, cookies, pies, cheesecakes, desserts, hot beverages, hampers, and cookbooks. These goods can be seen in printouts of the website.⁶ However, the printouts are from 12 September 2023, i.e. after the relevant date. Examples of products sold by the opponent under the marks have also been provided, but the photographs are not dated.⁷ Mr Vaghadia says that the opponent's products are also available for delivery (nationwide), through its own delivery vehicles, as well as Deliveroo, Uber Eats and Supper. Details of the five locations in London have also been provided, as have photographs of the shop fronts obtained via Google Streetview.⁸ I also note an article on the website of *This Is Local London* regarding the opening of one of the shops.⁹ However, the printouts were obtained on 12 September 2023 and the article is dated 26 November 2022, i.e. after the relevant date.

45. Mr Vaghadia provides the following turnover figures:

Year to	Turnover (£millions)
30 June 2012	4.8
30 June 2013	5.5
30 June 2014	6.2
28 June 2015	6.5
26 June 2016	6.6
25 June 2017	6.8
24 June 2018	7.1
23 June 2019	6.7
28 June 2020	5.0
12 February 2021	2.9
31 December 2021	3.8
31 December 2022 ¹⁰	4.2
Total	66.1

⁶ Exhibit VV1EX3

⁷ Exhibit VV1EX5

⁸ Exhibit VV1EX4

⁹ Exhibit VV1EX4

¹⁰ I bear in mind that a significant proportion of these sales are likely to have occurred after the relevant date.

46. The turnover figures up to and including 28 June 2020 relate to HBB's activities, whereas the remainder relate to the opponent's activities. The majority of the figures are supported by extracts of financial reports from Companies House.¹¹

47. Mr Vaghadia says that the following sums have been invested by the opponent and HBB in marketing the business:

Year	Marketing spend (£)
2016	25,058
2017	64,287
2018	62,668
2019	51,133
2020	29,223
2021	70,777
2022	121,476
Total	424,622

48. Printouts from the opponent's Instagram account have been provided.¹² The account has 145,000 followers. The opponent's second mark can be seen in the printouts. For instance, the mark is the account's profile picture and can be seen in photographs of ice creams and cakes. However, the printouts are from 12 September 2023, i.e. after the relevant date. I also note the posts about the opponent and its products from other Instagram users, but these are undated.

49. Finally, a number of articles referring to the opponent and its cakes have been evidenced.¹³ There are three which are clearly from before the relevant date: *London Perfect* (14 June 2012), *Luxury Hospitality Magazine* (7 December 2021) and *Hot Dinners* (1 June 2022). Two others also refer to a new vegan cupcake being released in January 2018 and are, therefore, more likely than not to be from before the relevant date: *Surrey Live* and *Good Web Guide*. Another *Surrey Live* article is not dated. The

¹¹ Exhibit VV1EX6

¹² Exhibit VV1EX7

¹³ Exhibit VV1EX8

opponent's second mark can only be seen in the *Good Web Guide* and *London Perfect* articles, and largely in conjunction with the words 'the hummingbird bakery'.

50. The evidence suggests that use of the opponent's mark had been relatively longstanding prior to the relevant date. Turnover figures have been provided for each year since 2004 (albeit with a gap in 2010-2011). Some are supported by financial reports. The turnover totalled around £70million. Even accounting for a proportion which may have been accrued after the relevant date, this sum is clearly significant. However, no details as to the size of the relevant market have been provided and there is no evidence to that effect. Moreover, the opponent has not given any indication as to what share of the market was held by its goods or services at any time before the relevant date. Without this information, it is difficult to contextualise the turnover figures that have been provided. My own impression is that the relevant market is likely to be very large. The evidence demonstrates that the opponent operates stores in London. The absence of any evidence relating to purchases from other locations leads me to conclude that use has been confined to this area. There is also no evidence of orders for delivery being placed or fulfilled (though the nature of the goods appears to be more suited to local delivery services in any event). Whilst London is, of course, a very large population centre in the UK, the evidence is not indicative of geographically widespread use. Moreover, evidence of the marks actually in use before the relevant date is extremely limited. For instance, the printouts from the website are all from after the relevant date. There is also no evidence of purchases made by customers or orders for delivery. From the evidence, it is difficult to ascertain how significant the opponent's trade under its second mark was, as opposed to all trading (including that under the name 'the hummingbird bakery' alone). The opponent is said to have spent around £470,000 on marketing before the relevant date. Although this is not insignificant, there is no evidence of the promotional or marketing activities conducted. The social media evidence is either undated or from after the relevant date. The opponent's business was referred to in five articles before the relevant date. However, it is difficult to ascertain how much exposure the opponent's mark would have achieved through the articles because no circulation or website visit figures have been provided. On the balance of the evidence, I am unable to conclude that the distinctive character of the opponent's second mark had been enhanced at the relevant date.



Comparison of trade marks

51. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* 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.”

52. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

53. The marks to be compared are as follows:

The opponent's second mark	The applicant's mark
	

Overall impressions

54. The opponent's second mark is figurative and consists of a device being a silhouette of a bird. There are no other elements which contribute to the overall impression, which lies in the device itself.

55. The applicant's mark is figurative and comprises three elements. At the top of the mark is a bird device. At the centre of the mark are the words 'ROASTERY CLUB' in a basic font. Underneath is the word 'LONDON' in the same basic font.

56. The opponent has submitted that each of the words contained in the mark are non-distinctive and/or descriptive, as is the combination of the words, and argues, therefore, that the device is the dominant element. This is on the basis of the following:

(i) A dictionary definition which states that the word 'ROASTERY' means "a place where coffee beans are roasted (= heated so that they become drier and browner) before being crushed to make coffee".¹⁴

(ii) Printouts from the websites/social media accounts of several third parties in the UK which use the word 'ROASTERY' in connection with providing coffee, including, *inter alia*, 'Dragon Roastery', 'Allpress London Roastery & Café', and 'Round Hill Roastery'.¹⁵

(iii) Google search results for the terms "COFFEE "ROASTERY" birmingham", "COFFEE "ROASTERY" leeds", "COFFEE "ROASTERY" LONDON", and "COFFEE "ROASTERY" manchester".¹⁶

(iv) Google search results for the terms "coffee club birmingham", "coffee club leeds", "coffee club london", and "coffee club manchester".¹⁷

¹⁴ Exhibit VV1EX9

¹⁵ Exhibit VV1EX10

¹⁶ Exhibit VV2EX2

¹⁷ Exhibit VV2EX3

(v) An extract from a previous decision of this Tribunal, in which the Hearing Officer stated that 'LONDON' as a geographic location lacked distinctive character and had limited relative weight in the overall impression of the mark that was under consideration.¹⁸

57. Firstly, it is well-established that I am not bound by prior decisions of this Tribunal. Moreover, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history; search results will also vary over time and are dependent upon who is doing the search. Therefore, I do not place any material weight on the evidence described at points (iii) and (iv) above. However, I accept the dictionary definition of the word 'ROASTERY', which confirms, rather than contradicts, my own understanding of the word. I also acknowledge that, unsurprisingly, multiple third parties have used this word when referring to their establishments where coffee is prepared. I agree with the opponent to the extent that the words in the applicant's mark are not particularly distinctive. In combination, they strongly allude to the goods and services (rather than being directly descriptive thereof). Nevertheless, that does not automatically result in them playing little to no role in the overall impression of the mark. It is my view that the words 'ROASTERY CLUB' and the bird device dominate the overall impression of the mark in roughly equal measure. This is because of their relative sizes and positions within the mark. The geographical location 'LONDON' is much smaller and is presented below. It plays a much lesser role in the overall impression.

Visual comparison

58. Before proceeding with the visual comparison, I note that the opponent has filed an image in which the parties' respective devices overlay one another, as shown below.¹⁹ The opponent submits that this was provided to assist with visually comparing the devices. I have read the opponent's written submissions on the point and will take them into account in the following comparison. Moreover, I will, of course, assess the similarities and differences between the devices (in the context of the marks as

¹⁸ BL O/0971/23

¹⁹ Exhibit VV1EX14

wholes). However, I must clarify that my comparison will not be based upon this image. Nor will it be used as a point of reference. This is because it appears to me to represent a dissection of the competing trade marks and presenting them in a way in which the average consumer would never encounter them.



59. The competing marks are visually similar in that they both include bird devices. The bird devices are not identical, but both are side profiles and face to the left. They also both show the bird in the same position, i.e. in flight, with the body nearly vertical and a wing outstretched behind. The device is the only element of the opponent's mark and co-dominates the overall impression of the applicant's mark. Clearly, the competing marks are visually different in that the applicant's mark contains the words 'ROASTERY CLUB LONDON'. The first two words co-dominate the applicant's mark, whereas the opponent's mark does not include any words. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

60. I agree with the applicant that consumers will make no attempt to articulate the devices in the competing marks.²⁰ There are no verbal elements in the opponent's mark. The words in the applicant's mark will be given their ordinary English

²⁰ *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, paragraph 46

pronunciations. Whether or not the word 'LONDON' in the applicant's mark is pronounced,²¹ there is no aural similarity between the competing marks.

Conceptual comparison

61. The words in the applicant's mark will be understood as referring to an organisation or association in London dedicated to the roasting and processing of coffee beans. This meaning, albeit strongly allusive of the goods and services, is not replicated in the opponent's mark. However, both marks contain a bird device, which creates a conceptual overlap. Overall, I find that there is a medium degree of conceptual similarity between the competing marks.

Likelihood of confusion

62. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As 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 services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

63. 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.

²¹ In *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, BL O/115/22, Mr Philip Harris, sitting as the Appointed Person, stated that descriptiveness does not, of itself, render an element "aurally invisible".

64. Earlier in this decision, I concluded that:

- The parties' goods and services are identical or similar to at least a low degree.
- The average consumer is likely to be a member of the general public, who will demonstrate a medium level of attention.
- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted.
- The opponent's second mark possesses a medium level of inherent distinctive character.
- The device dominates the overall impression of the opponent's second mark.
- The overall impression of the applicant's mark is dominated by the device and the words 'ROASTERY CLUB' in roughly equal measure, whereas the word 'LONDON' plays a much lesser role.
- There is a medium degree of visual and conceptual similarity between the competing marks, but no aural similarity.

65. I confirm that I have taken into account the parties' evidence and comments on notional and fair use of the competing marks, such as them being presented on packaging and coffee cups, as well as third-party placement of trade marks on coffee products.²² These are not determinative, however, since I must take into account all the circumstances in which the mark applied for might be used if it were registered.²³

66. The applicant submits that "there are countless bird images / silhouettes being used in relation to the food and drink sector". On this basis, the applicant argues that there can be no confusion between its mark and the opponent's second mark. Whilst

²² Exhibit VV1EX13, Exhibit 5, Exhibit 6 and Exhibit VV2EX1

²³ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

there are circumstances in which the existence and prominence on the market of other similarly themed brands may mean that the average consumer is unable to rely on certain imagery as reliably indicating trade origin,²⁴ it is my view that the evidence provided by Ms Knights falls a long way short of establishing that this is the case in respect of bird-related imagery in the context of the goods and services at issue.²⁵ Although third-party websites use bird-related imagery or wording in respect of coffee and bakery products, and at least some of them appear to target the UK, the printouts are all undated. The evidence does not establish that any of the branding has been in use for any significant amount of time. Nothing else has been provided which could indicate that there is a 'crowded market' or that the average consumer is unable to rely on bird-related imagery as reliably indicating trade origin. As such, I reject this line of argument.

67. The competing marks coincide in their inclusion of highly similar bird devices. This is the only element of the opponent's second mark and co-dominates the overall impression of the applicant's mark. However, the applicant's mark contains words which are not present in the opponent's mark. Although the words in the applicant's mark are strongly allusive of the goods and services at issue, they are not negligible and are unlikely to be overlooked by the average consumer. This is particularly the case for the words 'ROASTERY CLUB', which co-dominate the overall impression of the applicant's mark. Taking all the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer to distinguish between them and avoid mistaking them for one another. Consequently, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

²⁴ See, for example, *Lifestyle Equities C.V. v Royal County of Berkshire Polo Club Ltd* [2023] EWHC 1839 (Ch), paragraph 213.

²⁵ Exhibit 4

68. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

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).”

69. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.²⁶

70. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

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

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

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the

²⁶ As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

71. I recognise that indirect confusion has its limits and that such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.²⁷ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.²⁸

72. Whilst the average consumer is likely to notice and recall the differences between the competing marks, they will also identify the highly similar bird devices. This is the only element of the opponent’s mark and co-dominates the overall impression of the applicant’s mark. The average consumer tends to perceive trade marks as wholes and I am conscious that I should not artificially dissect the applicant’s mark. However, the device plays an independent distinctive role within the applicant’s mark, i.e. it has a distinctive significance which is independent of the significance of the whole; it does not combine with the verbal elements in any way. The mark is likely to be perceived by the average consumer as consisting of two separate and seemingly unconnected elements. Due to the previously outlined visual and conceptual similarities between the devices, it is likely that they will be misremembered or imperfectly recalled as one another, the minor differences being insufficient for the purposes of distinguishing

²⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

²⁸ See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

between them. Whilst I acknowledge that it does not automatically follow that there is a likelihood of confusion where an independent distinctive element of a mark is identical or similar to another mark, it is my view that the similarities between the bird devices in the competing marks may cause the average consumer to believe that the user of the applicant's mark is the same or economically connected to the owner of the opponent's second mark. Taking all the above into account, I am satisfied that the average consumer, paying no more than a medium level of attention, would assume a commercial association between the parties due to the highly similar bird devices. Consequently, I find that there is a likelihood of indirect confusion, even in relation to the goods and services which are only similar to a low degree.

Conclusion

73. The opponent's claim under s.5(2)(b) is successful.

Section 5(4)(a)

Legislation and case law

74. Section 5(4)(a) of the Act 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.”

75. Subsection (4A) of s.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.”

76. 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).”

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

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

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

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

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

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

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

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

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

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

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

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

78. There is no evidence that the applicant's mark was used before its filing date or the earliest claimed use of the opponent's signs. As such, the relevant date for

assessing this ground of opposition is the filing date of the applicant's mark, namely 29 August 2022.²⁹

Goodwill

79. The first hurdle for the opponent is to show that it had the necessary goodwill resulting from the trading activity relied on under its signs at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

“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.”

80. Goodwill arises from trading activities. The evidence has been summarised at paragraphs 39-49, above. Whilst it is not without its limitations, the evidence demonstrates that a bakery shop business was in operation for around 18 years by relevant date. Through operating several stores, around £70million was accrued in turnover. This business was referred to in several articles before the relevant date. Around £470,000 was spent on marketing the business before the relevant date. Earlier in this decision, I concluded that the evidence was not sufficient for the purposes of demonstrating that the distinctive character of a mark identical to the opponent's device only sign had been enhanced through use. Nevertheless, that does not preclude a finding of goodwill since 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 goodwill and reputation may be small.³⁰ On the balance of the evidence, I am satisfied that the opponent has demonstrated a moderate level of

²⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, paragraph 43.

³⁰ See, for instance, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

goodwill in the London area in its bakery business.³¹ That bakery business appears to have incorporated the following claimed goods and services: *cake, baked goods, coffee, café services, bakery services*.

81. I do not consider that the opponent's goodwill extends to *coffee cups, the retail of cake, coffee and baked goods or takeaway food and drink services*. Firstly, whilst it is clearly typical for beverages such as coffee to be served in mugs or coffee cups within cafés and the like, there is no evidence that the opponent offered coffee cups for sale to consumers before the relevant date. Neither Mr Vaghadia nor Mr Malouf state how many (if any) coffee cups were sold, and the only documentary evidence showing coffee cups consists of undated photographs, undated third-party Instagram posts, and printouts of the opponent's Instagram page from after the relevant date. Moreover, Mr Vaghadia describes the opponent's activities as a "retail bakery business". He does not comment on whether that incorporates a takeaway service. Whilst, in my experience, products purchased in bakeries or cafés can often be taken off premises for consumption, neither Mr Vaghadia nor Mr Malouf comment on this at all. There is also very little documentary evidence specifically going to the point from before the relevant date; this is confined to one or two references in press articles (for example, "[...] ask them to package it to go to enjoy back home [...]"). I do not consider it appropriate to infer that such services were provided by the opponent in the absence of sufficiently solid supporting evidence. As for the claimed retail services, I am satisfied that the opponent sold goods such as cakes before the relevant date. I also acknowledge how Mr Vaghadia describes the opponent's business. However, an undertaking merely selling its own goods does not constitute providing a retail service.³² There is no evidence that the opponent provided any services relating to the sale of its goods which did not form an integral part of the offer for sale.

82. As for ownership of the goodwill, I note that much of the evidence relates to the activities of HBB, not the opponent. However, Mr Vaghadia states that the opponent acquired the goodwill in HBB's business and name after the execution of agreements

³¹ The localised nature of the goodwill does not hinder the opponent's case since registration of the applicant's mark would be valid throughout the entirety of the UK. See, for example, *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874.

³² *Apple Inc. v Deutsches Patent- und Markenamt*, Case C-421/13

in February and November 2021. Although copies of those agreements have not been provided, I accept Mr Vaghadia's unchallenged narrative evidence on the point and conclude that the opponent is the owner of the goodwill that had accrued prior to the acquisition.

83. There is evidence of use of the signs relied upon. For instance, the signs appear in printouts from the website, on the exterior of the physical bakeries, on images of various products and their packaging, and on the opponent's Instagram page. However, all this evidence is either undated or from after the relevant date. As such, it cannot be relied upon as establishing that the signs relied upon were distinctive of the goodwill at the relevant date. There is no evidence of the signs being used in any promotional activities and very little in the way of establishing that the opponent's turnover was generated through its customers encountering the signs. It seems to me that the only evidence showing the signs relied upon before the relevant date are the articles from *Good Web Guide* and *London Perfect*. In the former, the device only sign can be seen on cake display labels in a store (location unknown) and on a paper bag next to the cake display stand (with the words 'the hummingbird bakery'). The composite sign can be seen in an image of the opponent's website within the article. In the latter, the device only sign can be seen on the exterior of stores in Notting Hill and Kensington (above and below the words 'the hummingbird bakery') and on a wall in the Kensington store's interior. There is no information about how much of the opponent's turnover was generated through these particular stores, how many customers visited them, how many views the articles had, or how many visits the opponent's website itself had. To my mind, the evidence falls a long way short for the purposes of demonstrating that either sign had become distinctive of the opponent's goodwill at the relevant date. There is simply not enough evidence of the signs having been used.

Conclusion

84. The opponent's claim under s.5(4)(a) is dismissed.

Overall outcome

85. The opposition under s.5(2)(b) of the Act has been successful. Subject to a successful appeal against this decision, registration of the applicant's mark will be refused.

Costs

86. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£1,400**, which is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£300
Preparing evidence and considering the applicant's evidence	£600
Preparing written submissions	£400
Official fees ³³	£100
Total	£1,400

³³ Although the opponent paid £200 in official fees when filing its Form TM7, it only succeeded on the basis of its claim under s.5(2)(b). As such, I have awarded official fees in line with filing an opposition under this ground only.

87. I hereby order Ozgur Tasci to pay Ensco 1399 Limited the sum of **£1,400**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 17th day of December 2024

**James Hopkins
For the Registrar**

Annex

Goods and services of the opponent's first mark relied upon under s.5(2)(b)

Class 16: Paper, cardboard and goods made from these materials, not included in other Classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other Classes); printers' type; printing blocks; books; cookbooks; recipe books; address books; notebooks; paper bags; greaseproof paper; menus; adhesive stickers; printed stickers; stickers; packaging boxes, bags, containers and materials of paper, card, cardboard or plastic, including for use with food and drink items; cards; greeting cards; gift cards; notelets.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; bakery products; bakery goods; preparations made from cereals, bread, pastry and confectionery; cakes; pastries; pies; cupcakes; biscuits; brownies; cookies; desserts; bakery desserts; bread; bread rolls; buns; chocolate; chocolate-based drinks; confectionery; ice-cream; frozen yoghurt; ice cream desserts; ice desserts; prepared desserts [chocolate based]; prepared desserts [confectionery]; prepared desserts [pastries].

Class 35: The bringing together, for the benefit of others, of a variety of bakery products and beverages, enabling customers to conveniently view and purchase those goods; retail bakery services in the nature of the sale of bakery products and beverages; retail services connected with the sale of bakery products and beverages; business consultancy services relating to franchising; services of a franchisor and services rendered by a franchisor, namely, assistance in the running or management of commercial enterprises; business advisory services relating to franchising, particularly a franchisor in the field/area of bakery products, retailing of bakery products, and catering services, and the provision thereof; services of a franchisor

and/or rendered by a franchisor, namely, conveying commercial know-how to franchisees (franchising), the administration of the business affairs of franchises, advisory services relating to publicity for franchisees, business advice and the provision of business advice and information by a franchisor to franchisees relating to franchising, business consultation services to franchisees and business consultancy by a franchisor to franchisees relating to franchising, business consultancy services relating to franchising, business assistance provided by a franchisor to franchisees relating to franchising and to the establishment and operation of franchises, provision of business assistance provided by a franchisor to franchisees in the establishment of franchises; provision of business assistance provided by a franchisor to franchisees in the operation of franchises; consultancy, advisory, and information services for or in relation to any or all of the aforesaid services in this Class.

Class 43: Services for providing food and drink; temporary accommodation; catering services; restaurant services; self-service restaurants; cafeteria services; cafes; self-service cafeterias; bar services; snack-bar services; bakery services; consultancy, advisory and information services for or in relation to any or all of the aforesaid services in this Class.

Goods and services of the opponent's second mark relied upon under s.5(2)(b)

Class 16: Paper, cardboard; printed matter; photographs; stationery; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other Classes); books; cookbooks; recipe books; address books; notebooks; paper bags; greaseproof paper; menus; adhesive stickers; printed stickers; stickers; packaging boxes, bags, containers and materials of paper, card, cardboard or plastic, including for use with food and drink items; bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic; cards; greeting cards; gift cards; notelets; partworks, being items of printed matter in the form of publications, typically magazines, that publish on a regular basis over a period of time, to build into a set; magazines published over time to make a completed set; cake cases of paper or cardboard; food cases of paper or cardboard; paper bunting; bunting included in Class 16; place cards; stencils; stencils for food;

serviettes; paper serviettes; paper cake decorations; cake decorations included in Class 16.

Class 30: Coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; bakery products; bakery goods; preparations made from cereals, bread, pastry and confectionery; cakes; pastries; pies; cupcakes; biscuits; brownies; cookies; desserts; bakery desserts; bread; bread rolls; buns; chocolate; chocolate-based drinks; hot chocolate; confectionery; ice-cream; frozen yoghurt; ice cream desserts; ice desserts; prepared desserts [chocolate based]; prepared desserts [confectionery]; prepared desserts [pastries]; cake toppers; sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations; toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations; cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations; cake mixes, including chilled cake mixes; icing; prepared icing; baked goods; baked goods in the nature of buns, cake bars, flapjacks; sauces.

Class 35: Advertising; business management; business administration; office functions; business consultancy services relating to franchising; services of a franchisor and services rendered by a franchisor, namely, assistance in the running or management of commercial enterprises; business advisory services relating to franchising, particularly a franchisor in the field/area of bakery products, retailing of bakery products, and catering services, and the provision thereof; services of a franchisor and/or rendered by a franchisor; conveying commercial know-how to franchisees (franchising); the administration of the business affairs of franchises; advisory services relating to publicity for franchisees; business advice and the provision of business advice and information by a franchisor to franchisees relating to franchising; business consultation services to franchisees and business consultancy by a franchisor to franchisees relating to franchising; business consultancy services relating to franchising; business assistance provided by a franchisor to franchisees relating to franchising and to the establishment and operation of franchises; provision of business assistance provided by a franchisor to franchisees in the establishment of

franchises; provision of business assistance provided by a franchisor to franchisees in the operation of franchises; the bringing together, for the benefit of others, of a variety of food colourings, colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated), cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags, containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published over time to make a completed set, printworks, cake cases, food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware, cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons,

cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces, enabling customers to conveniently view and purchase those goods; the bringing together, for the benefit of others, of a variety of food and drink items, including bakery products/goods, enabling customers to conveniently view and purchase those goods; retail services connected with a variety of food colourings, colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated), cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags,

containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published over time to make a completed set, printworks, cake cases, food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware, cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons, cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces; retail services connected with a variety of food and drink items, including bakery products/goods; retail services connected with the sale of a variety of food colourings,

colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated), cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags, containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published over time to make a completed set, printworks, cake cases, food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware, cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons, cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry

and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces; retail services connected with the sale of a variety of food and drink items, including bakery products/goods; mail order retail services connected with a variety of food colourings, colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated), cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags, containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published

over time to make a completed set, printworks, cake cases ,food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware, cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons, cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces; mail order retail services connected with a variety of food and drink items, including bakery products/goods; electronic retail services connected with a variety of food colourings, colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated),

cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags, containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published over time to make a completed set, printworks, cake cases, food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware, cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons, cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread

rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces; electronic retail services connected with a variety of food and drink items, including bakery products/goods; the bringing together, for the benefit of others, of a variety of food colourings, colouring agents, preparations for colouring food, candles and wicks for lighting, candles, cake decoration candles, electric mixers, electric blenders, electric beaters, electric mixers, blenders and/or beaters, for use in the kitchen and/or in cookery, electric knives, electric kitchen knives, hand tools and implements (hand-operated), cutlery, knives, spatulas, cutlery made of melamine, piping sets, icing sets, disposable tableware of plastic, disposable cutlery of plastic, weighing and measuring apparatus and instruments, weighing scales, weighing scales for the kitchen, electric weighing scales, instruments for weighing, timers, kitchen timers, electronic timers, thermometers, thermometers for cooking, apparatus for lighting, heating, steam generating, cooling, refrigerating, cooking utensils, electric cooking utensils, baking ovens, cupcake makers, bread makers, home bread makers, paper, cardboard, printed matter, photographs, stationery, adhesives for stationery or household purposes, instructional and teaching material (except apparatus), plastic materials for packaging, books, cookbooks, recipe books, address books, notebooks, paper bags, greaseproof paper, menus, adhesive stickers, printed stickers, stickers, packaging boxes, bags, containers and materials of paper, card, cardboard or plastic for use with food and drink items, bags, boxes and other articles for packaging, wrapping and storage of items, including food and drink items, and made of paper, cardboards or plastic, cards, greeting cards, gift cards, notelets, partworks, magazines published over time to make a completed set, printworks, cake cases, food cases, paper bunting, bunting, place cards, stencils, stencils for food, serviettes, paper serviettes, paper cake decorations, cake decorations, book stands, plastic cake decorations, household or kitchen utensils and containers, glassware, porcelain and earthenware, bakeware,

cookware, tableware, baking accessories, chinaware, ceramics, cake stands, cardboard cake stands, non-electric mixers for use in the kitchen and/or in cookery, non-electric blenders, for use in the kitchen and/or in cookery, non-electric beaters for use in the kitchen and/or in cookery, pie holders, cake baking set, cake cases, flour dredgers, kitchen textiles, oven gloves, food cutters, biscuit cutters, storage tins, food storage tins, cake storage tins, spatulas, paper plates, cups, paper cups, plastic cups, plastic tableware, dispensers for serviettes, picnicware, picnicware of melamine, textiles and textile goods, table covers, towels, kitchen textiles, tea towels, bunting, cloth bunting, fabric bunting, serviettes of textile, clothing, footwear, headgear, aprons, cooking aprons, hats, chefs' hats, coffee, tea, flavoured teas, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, bakery products, beverages, bakery goods, preparations made from cereals, bread, pastry and confectionery, cakes, pastries, pies, cupcakes, biscuits, brownies, cookies, desserts, bakery desserts, bread, bread rolls, buns, chocolate, chocolate-based drinks, hot chocolate, confectionery, ice-cream, frozen yoghurt, ice cream desserts, ice desserts, prepared desserts [chocolate based], prepared desserts [confectionery], prepared desserts [pastries], cake toppers, sprinkles for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, toppings for food and cakes, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake sparkles, being dessert toppings, sugar strands/shapes, candy pieces, and other edible cake decorations, cake mixes, chilled cake mixes, icing, prepared icing, baked goods, baked goods in the nature of buns, cake bars, flapjacks and sauces, enabling customers to conveniently view and purchase those goods from an Internet website specialising in the same, or by mail order, or by means of telecommunications; the bringing together, for the benefit of others, of a variety of food and drink items, including bakery products/goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in the same, or by mail order, or by means of telecommunications; consultancy, advisory, and information services for or in relation to any or all of the aforesaid services in this Class.

Goods and services of the opponent's third mark relied upon under s.5(2)(b)

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; bakery products; bakery goods; preparations made from cereals, bread, pastry and confectionery; cakes; pastries; pies; cupcakes; biscuits; brownies; cookies; desserts; bakery desserts; bread; bread rolls; buns; chocolate; chocolate-based drinks; confectionery; ice-cream; frozen yoghurt; ice cream desserts; ice desserts; prepared desserts [chocolate based]; prepared desserts [confectionery]; prepared desserts [pastries].

Class 35: Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of bakery products and beverages, enabling customers to conveniently view and purchase those goods; retail bakery services in the nature of the sale of bakery products and beverages; retail services connected with the sale of bakery products and beverages; business consultancy services relating to franchising; services of a franchisor and services rendered by a franchisor, namely, assistance in the running or management of commercial enterprises; business advisory services relating to franchising, particularly a franchisor in the field/area of bakery products, retailing of bakery products, and catering services, and the provision thereof; services of a franchisor and/or rendered by a franchisor, namely, conveying commercial know-how to franchisees (franchising); the administration of the business affairs of franchises; advisory services relating to publicity for franchisees; business advice and the provision of business advice and information by a franchisor to franchisees relating to franchising; business consultation services to franchisees and business consultancy by a franchisor to franchisees relating to franchising; business consultancy services relating to franchising; business assistance provided by a franchisor to franchisees relating to franchising and to the establishment and operation of franchises, provision of business assistance provided by a franchisor to franchisees in the establishment of franchises; provision of business assistance provided by a franchisor to franchisees in the operation of franchises; consultancy, advisory, and information services for or in relation to any or all of the aforesaid services in this Class.

Class 43: Services for providing food and drink; temporary accommodation; catering services; restaurant services; self-service restaurants; cafeteria services; cafes; self-service cafeterias; bar services; snack-bar services; bakery services; consultancy, advisory and information services for or in relation to any or all of the aforesaid services in this Class.