O/1221/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 4042190 BY FOOD BRUT LIMITED TO REGISTER THE TRADE MARK:

IN CLASSES 30, 40 & 43

AND

OPPOSITION THERETO UNDER NO. 449032 BY JOLENE, LLC

BACKGROUND & PLEADINGS

1. Food Brut Limited ("the applicant") applied to register the trade mark shown on the front page of this decision in the United Kingdom on 22 April 2024. It was accepted and published in the Trade Marks Journal on 10 May 2024 for various goods and services in Classes 30, 40, and 43. However, this partial opposition is directed against the goods "*coffee, tea, cocoa and artificial coffee; chocolate*" in Class 30.

2. On 9 August 2024, Jolene, LLC ("the opponent") partially opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1]. For the purposes of these opposition proceedings, the opponent relies upon the following registered (comparable)[2] mark:

Trade Mark no.	UK00918062532
Trade Mark	JOLENE
Goods for which the mark is registered	Class 30: Coffee and tea.
Filing date	8 May 2019
Date of entry in register	27 August 2019

[1] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

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

3. Under Section 6(1) of the Act, the opponent's mark clearly qualifies as an earlier trade mark. The earlier mark has not been registered for five years or more before the filing date of the application, and as a result it is not subject to the proof of use requirements.

4. The opponent in its notice of opposition claims that the competing marks are confusingly similar due to the visual and aural similarity/identity, and the respective goods are identical and/or similar.

5. The applicant filed a counterstatement, denying there is a likelihood of confusion. However, it admits that the competing marks are visually, aurally, and conceptually similar, and the goods are identical and similar. Further, the applicant argues that there have been no instances of confusion since it commenced its business operations. Lastly, the applicant requested that the opposition be refused in its entirety and that costs be awarded in its favour.

Papers Filed and Representation

6. The applicant filed evidence in these proceedings. This comes in the form of a witness statement from David John Gingell, the director of the applicant. His witness statement is dated 11 March 2025 and is accompanied by one exhibit, namely DG1. The evidence goes to the conception and use of the contested mark since at least September 2018. I note that Exhibit DG1 contains various materials, including social media posts, news media articles, and photographs, ranging from 2018 to 2024 demonstrating use of its stylised logo for goods and services in its specification.

7. Both parties filed written submissions in lieu of a hearing ("final submissions"). I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

8. No hearing was requested and so this decision is taken following a careful consideration of the papers.

9. In these proceedings, the applicant is represented by Herrington Carmichael LLP and the opponent by Venner Shipley LLP.

Preliminary Issues

10. Throughout these proceedings, the applicant claimed that it has a known and established reputation by making use of the JOLENE brand, including the stylised logo, since 2018 and that the applicant's JOLENE restaurants have a significant goodwill associated with it. The applicant has filed evidence that it considers to be sufficient to support these contentions. I note that the General Court ("GC") has consistently held that the reputation of the later mark is in principle irrelevant to the assessment of the likelihood of confusion with an earlier mark.[3] In *Associazione Calcio Milan SpA (AC Milan) v EUIPO*, T-353/20, the GC upheld a decision of the Board of Appeal of the EUIPO to refuse registration of a composite trade mark which included the word MILAN. It rejected the applicant's argument that the Board of Appeal had failed to take into account in the context of the assessment of the likelihood of confusion, the high reputation of the sign constituting the mark applied for and of the football club AC Milan. The GC stated that:

> "113. […] with regard to the applicant's argument based on the reputation of the mark applied for in Germany, it should be noted, as EUIPO rightly pointed out, that only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account in order to assess whether the similarity of the goods designated by the two marks is sufficient to give rise to a likelihood of confusion (see, to that effect, judgment of 3 September 2009, *Aceites del Sur-Coosur v Koipe*, C-498/07 P, EU:C:2009:503, paragraph 84 and the case-law cited). That case-law is in line with the objective of Article 8(1)(b) of Regulation No 207/2009, which is to provide adequate protection for the proprietors of earlier rights against subsequent applications for

[3] *The GB Foods SA v OHIM*, Case T-336/17, *Mayer Naman v OHIM*, Case T-498/10 and *Agatha Ruiz de la Prada de Sentmenat v OHIM*, Case T-522/08.

identical or similar European Union trade marks (judgment of 29 January 2019, *The GB Foods v EUIPO – Yatecomeré (YATEKOMO)*, T-336/17, not published, EU:T:2019:840, paragraph 49).

114. Therefore, the applicant's argument based on the alleged reputation of the mark applied for is entirely irrelevant." (Emphasis added)

11. However, in *Lionel Andrés Messi Cuccuttini v EUIPO*[4] the Court of Justice of the European Union ("CJEU") rejected the argument that the GC was wrong to take into account the notoriety of Lionel Messi as a factor in the assessment of the likelihood of confusion. In rejecting the submissions, it stated:

"44. In so far as JM-EV criticizes the General Court for disregarding Article 8(1)(b) of Regulation No 207/2009 by considering, in paragraph 62 of the judgment under appeal, that there was account of the notoriety of Mr Messi Cuccittini in the context of the assessment of the likelihood of confusion, within the meaning of that provision, it should be recalled that, according to settled case-law of the Court, the existence of a likelihood of confusion in the mind of the public must be assessed globally taking into account all the relevant factors of the case.

45. According to equally settled case-law, the overall assessment of the likelihood of confusion must, as regards the visual, phonetic, or conceptual similarity of the signs at issue, be based on the overall impression produced by them, taking into account, in particular, of their distinctive and dominant elements.

[4] Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini* and *J.M.-E.V. e hijos v Messi Cuccittini.*

46. In the context of that overall assessment, the reputation of the earlier mark is, admittedly, a relevant factor for the purposes of assessing the likelihood of confusion.

47. However, as the Court has held, account must also be taken of the possible notoriety of the person applying for his name to be registered as a trade mark, since that reputation may obviously , have an influence on the perception of the mark by the relevant public (see, to that effect, judgment of 24 June 2010, Becker v Harman International Industries, C-51/09 P, paragraph 37).

48. It follows that the General Court was right to consider, in paragraph 62 of the judgment under appeal, that the notoriety of Mr Messi Cuccittini constituted a relevant factor in order to establish a difference at the conceptual level between the term 'Messi' and the term 'Massi'."

12. The relevance of the later mark's reputation was discussed by Mr Allan James, the Registrar's Hearing Officer, in *Extinction Rebellion*[5] where he stated:

"52. As Mr Phillip Harris, as the Appointed Person, explained in *Retail Royalty Company v Harringtons Clothing Limited* the reputation of a sign as a trade mark is not usually relevant to its conceptual meaning, which is to be derived from the ordinary meaning(s) of the word(s) or sign at the relevant date, i.e. the meaning(s) that can usually be found in dictionaries. This applies to the earlier mark as well as the later mark. So, for example, when comparing the conceptual similarity between BATMAN and BATSMAN (both for printed publications) it was appropriate to take into account that BATMAN is a well-known fictional character from Gotham City, whereas BATSMAN historically describes what is now called a batter in cricket. There was no suggestion that the secondary meaning of BATMAN as a trade mark

[5] See O/214/22.

for comic books was relevant to the conceptual similarity between the marks. There are two reasons why the acquired reputation of a sign as a trade mark is irrelevant. Firstly, taking account of the trade mark meaning of the earlier mark when assessing the degree of conceptual similarity between it and the later mark would be 'double counting'. This is because the reputation of the earlier mark is already taken into account as a factor which may increase the likelihood of confusion as part of the required evaluation of its distinctive character. Secondly, and more fundamentally, the assessments required under sections 5(2) and 5(3) of the Act necessarily requires the tribunal to assume that both marks will be used as trade marks and that average consumers will recognise them as such. Therefore, the public's existing recognition of one or both of the marks as trade marks adds nothing to the evaluation of the conceptual similarity between them."

13. The decision in *Messi* appears to suggest a narrow exception to the rule in *Associazione Calcio Milan*, namely that the reputation of the later mark only comes into play in the confusion assessment, in such cases where the notoriety of a famous person may influence the perception of the later mark by the relevant public. However, the *Messi* case set a high bar in respect of a name being well-known as it applied to people whose names were "notorious" – famous. I do not consider the evidence that has been filed shows that that bar has been reached such that my conceptual comparison should be affected.

14. In addition, the applicant claimed that the earlier mark has not been put in genuine use. This was also iterated in the witness statement of Mr Gingell who stated that the opponent is not "*actively trading in the UK or [has] done at any relevant time*"[6]. However, as delineated above, the opponent's mark is not subject to the proof of use requirements, and it is entitled to protection in relation to all the goods for which it is registered. Therefore, I must consider the matter based on the terms that the parties have

[6] See paragraph 30 of the witness statement.

registered, and the assessment that I will undertake between the competing specifications is a notional and objective one rather than a subjective one.[7]

15. Further, the applicant submits that the opponent did not challenge the evidence, and this should be considered as an admission and the opposition should fail.[8] However, I disagree. The opponent in its final submissions stated that:

> "**4. Likelihood of Confusion**
>
> […]
>
> b) The Opponent does not dispute that the Applicant has operated a bakery and restaurant business since 2018. However, the Applicants did not seek registration of their JOLENE mark in respect of the goods coffee, tea, cocoa and artificial coffee; chocolate" in Class 30 until 2024.
>
> c) The Opponent submits that even if the Applicants sold tea and coffee at their bakeries and restaurants, this would not in itself prove that the mark JOLENE was used in relation to tea and coffee. Indeed, the Applicant's earlier registration No. 3384484 JOLENE did not cover tea and coffee in Class 30, but rather covered the following goods in Class 30: -
>
> "Bread; bread doughs; breads"
>
> Furthermore, the other two registrations of the marks JOLENE and JOLENE Logo of the Applicants did not cover goods in Class 30 at all but rather covered dissimilar goods in Classes 18, 25 and 35.

[7] See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

[8] See paragraph 9 of the applicant's final submissions.

d) It is submitted that if the Applicants had believed that confusion would arise with their mark JOLENE for the goods "Coffee and tea" in Class 30, they would have opposed registration of the Opponent's mark No. 918062532 JOLENE when the mark was originally applied for in 2019.

e) The Applicant has stated that they will apply to revoke the Opponent's earlier mark Registration No. 918062532 JOLENE for non-use. No application has been filed.

In any event, the Opponents submit that this is irrelevant to the present proceedings, as the earlier mark Registration No. 918062532 JOLENE was less than five years old at the time the opposition was filed and therefore the Opponents do not need to file proof of use of the mark.

f) […]

The Opponent does not intend to submit arguments against the Applicant's allegations as set out in points 10-15 of their Counterstatement except to say that no application for invalidation of UK Trade Mark Registration No. 918062532 has been filed by the Applicants, and as such the Opponents submit that the defence as set out by the Applicants in their Counterstatement is irrelevant to these proceedings and should be disregarded.

5. Conclusion

The marks are highly similar, and the goods are identical and/or similar and sold through the same trade channels. There is a likelihood of confusion on the part of the public between the Applicant's goods sold under the mark applied for and the Opponent's goods. The grounds for refusal under Section 5(2)(b) have been established. The opposition should be upheld and the Applicant refused." (sic)

From the above, it is my view that the opponent has clearly defined its position with its final submissions. While the opponent has refrained from making direct reference to or challenging the applicant's evidence, this alone does not imply that the opposition is bound to fail. This is because, under Section 5(2)(b) of the Act, the applicant is not required to prove use of the contested mark. For the avoidance of doubt, even if the applicant's evidence was to be taken to be offered in support of an argument that the applicant has an earlier unregistered right (or a superior right to registration and use of the mark), that is not a valid defence.[9] If that was the intention of the applicant in filing evidence, the proper course of action would be to seek to invalidate the earlier mark (which it later did, and I will return to this matter in the following paragraph).

16. Lastly, I note that the applicant has also highlighted throughout these proceedings that it holds other "JOLENE" registered and unregistered signs that it has used since 2018, reserving the right to seek the revocation and/or invalidation of the earlier mark. I agree with the opponent that reliance on other rights is irrelevant to these proceedings, as I must determine the matter based on the trade marks before me, and any comparison between other signs or trade marks that the parties may use in their business activities is of no relevance in these proceedings. That said, it is noted that the applicant has subsequently initiated cancellation proceedings[10] under number CA000508959 before the Tribunal to invalidate the earlier mark in question, requesting the consolidation of the cancellation proceedings with the current opposition proceedings. However, the Tribunal, in its unchallenged preliminary view dated 16 October 2025, refused the applicant's request to consolidate the proceedings, primarily due to the differing stages of each case.

[9] The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O/211/09. Ms Carboni rejected the defence as being wrong in law.

[10] The applicant filed form TM26I on 29 May 2025.

Consequently, my decision will be issued on a provisional basis with an assessment based on the merits of this present case.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act states:

> "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."

18. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect

and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of Goods

19. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, the CJEU stated that:

> "23. In assessing the similarity of the goods or services concerned, […], all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary."

20. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

> "(a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

21. In *YouView TV Ltd v Total Ltd,* [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

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

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

> "[…] 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."

23. The competing goods to be compared are shown in the following table:

Earlier Goods	Contested Goods
Class 30: Coffee and tea.	**Class 30:** coffee, tea, cocoa and artificial coffee; chocolate.

24. The applicant has admitted that the competing terms "*coffee, tea, […] and artificial coffee*" are identical and the terms "*cocoa; chocolate*" are similar. Given the applicant's admission, strictly speaking, there is nothing for me to decide. That said, I will need to assess the degree of similarity between the goods.

25. The contested terms "*cocoa"* and *"chocolate*" are commonly used to make both hot and cold drinks, and as such, they are similar in nature to the earlier terms "*coffee and tea*", with the same purpose of quenching thirst, and they share the same channels of trade. I also consider the respective goods to be in competition with each other, as the consumer may be one and the same, and who may choose on any given occasion which drink they prefer to partake, be that tea, coffee, or cocoa/chocolate. Therefore, the competing goods are similar to a high degree.

Average Consumer and the Purchasing Act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

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

27. The goods at issue are various drink items, all of which would be purchased and consumed by the general public. These are inexpensive goods purchased through primarily visual means, most often selected from shops or supermarket shelves or on their online equivalents. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Whilst the average consumer will predominantly purchase them following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing them will be no more than a medium degree as the average consumer is likely to consider dietary requirements, flavour and/or nutritional information.

Comparison of Trade Marks

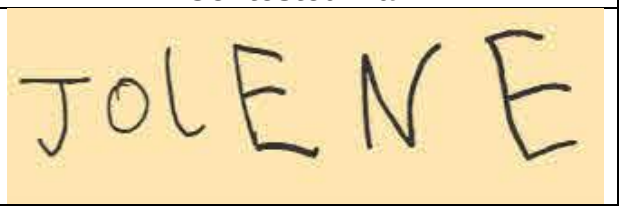
28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant

to the circumstances of the case, to assess the likelihood of confusion."

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

30. The marks to be compared are:

Earlier Mark	Contested Mark
JOLENE	

Overall Impression

31. The earlier mark "JOLENE" is a word mark. Registration of a word mark protects the word itself.[11]

32. The contested mark is a figurative mark consisting of the verbal element "JOLENE" in black on a yellow background. The word "is presented such that it gives the appearance that it has been handwritten in lower and upper case. I find the stylisation is not negligible and does contribute to the overall impression, but it is the word element that dominates. The yellow background will have a minimal (if any) impact on the overall impression.

33. Even though the applicant has admitted that the marks are visually, aurally, and conceptually similar, I will conduct my comparison of the competing marks below to identify the level of similarity or identity between them.

[11] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

Visual Comparison

34. The competing marks share the common word element "JOLENE". Although it is not legitimate to perform a comparison between a word mark and a stylised mark by considering specific ways in which the words might be presented, the typeface[12] and colour[13] in which the contested mark is presented in this case do not provide a point of distinction in themselves. That said, I note that the presence/absence of the stylisation in the competing marks will be a point of difference. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a high degree.

Aural Comparison

35. Both marks will be pronounced as "JO-LENE". Therefore, I find that they are aurally identical.

Conceptual Comparison

36. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

37. The applicant made no submissions as to the conceptual meaning of either mark. Nevertheless, I agree with the opponent's submissions that the verbal element of the marks will be seen as a name. As a result, I find that the marks are conceptually identical.

[12] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

[13] See *Specsavers* [2014] EWCA Civ 1294; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290.

Distinctive Character of the Earlier Trade Mark

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

39. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

40. The opponent has not filed evidence, and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent

distinctiveness of the earlier mark to consider. The word "JOLENE" will be seen as a name having no suggestive or descriptive relevance to the registered goods. I find the mark to be inherently distinctive to no more than a medium degree.

Likelihood of Confusion

41. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[14] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[15]

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

43. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, 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

[14] See *Canon Kabushiki Kaisha*, paragraph 17.

[15] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[16]

[16] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

44. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

45. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

46. Earlier in this decision I have concluded that:

- the competing goods are identical and similar to a high degree;
- the average consumer for the goods at issue will be a member of the general public, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid will be no more than a medium degree;
- the competing marks are visually similar to a high degree, and aurally and conceptually identical;
- the earlier mark has a no more than a medium degree of inherent distinctive character.

47. Taking into account the above factors, I find that there is a likelihood of direct confusion for identical and highly similar goods. I bear in mind that consumers rarely have a chance to compare marks side by side, and thus the presence/absence of the stylisation is likely to be overlooked or misremembered due to the principle of imperfect recollection. Put simply, both marks are “JOLENE” marks, and it is this that the average consumer will have in mind. When they encounter one mark, for example, for coffee goods and then encounter another “JOLENE” mark for identical goods, they will mistakenly believe that the goods originate from the same undertaking.

48. Even when the average consumer recalls that one mark has a different stylisation from the other with a yellow background, I still consider that the marks would be indirectly confused for identical and highly similar goods. This is because both marks contain the identically shared word element, “JOLENE”, which is the dominant element in both marks with the greatest weight in the overall impression, and the differences in the stylisation and background will be put down to the use of a brand/sub-brand variant. Consequently, I find there to be a likelihood of indirect confusion between the marks where the average consumer would assume a commercial association between the parties.

Final Remark

49. I note that the applicant argued that there are no instances of actual confusion since at least 2018. Although evidence of actual confusion may be persuasive where it exists, the absence of confusion on the marketplace is rarely significant[17] as that may be a result of a wide variety of different factors.[18] I also keep in mind the recent decision BL O/0662/25 of Mr Phillip Johnson, sitting as the Appointed Person, where he stated that:

> "29. To establish co-existence it is necessary for there to be evidence that both the earlier and later mark are used in the same marketplace at the same time in a way which would (in the absence of evidence) be seen as giving rise to a likelihood of confusion.
>
> 30. Accordingly, it is not possible to establish peaceful co-existence with an earlier mark which has not been used (ie where it is less than 5 years old; and so attracts no requirement to prove use). […]"

50. Against this background, and given the outcome of the opposition, such a defence would not have assisted or put the applicant in any better position, and I will say no more.

PROVISIONAL OUTCOME

51. This partial opposition is provisionally successful in respect of "*coffee, tea, cocoa and artificial coffee; chocolate*".

STATUS OF THIS DECISION

52. As mentioned earlier, the mark upon which the opponent's success is based is currently the subject to an application for invalidation. If

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[17] See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, at paragraph 80.

[18] See *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, at [291].

successful, the earlier mark upon which the success of this opposition relies will not have been validly registered at the date on which the application was filed. **As such, this is a provisional decision, which will be made final only once the cancellation proceedings have ended**. These proceedings are suspended until such time.

53. An appeal deadline will be set only after my final decision has been issued.

COSTS

54. As this decision is yet to be made final, there will be no award of costs made at this time. Costs will be awarded along with the issuance of the final decision.

Dated this 30th day of December 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General