

O/0625/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004015846

BY ZANOTTI LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 446361

BY THREE PEARS HOLDINGS LIMITED

Background and Pleadings

1. On 19 February 2024, ZANOTTI LTD ('the Applicant') filed an application to register the following trade mark ('the Contested Mark'):



2. The application was published for opposition purposes in the Trade Marks Journal on 8 March 2024. Registration is sought in respect of the following goods, all of which are opposed:

Class 3:

Shaving lotion; Shaving cream; Shaving lotions; Shaving gel; Shaving soap; Shaving creams; Shaving sets, comprised of shaving cream and aftershave; Shaving soaps; Shaving balm; Shaving sprays; Shaving mousse; Shaving foam; Foam for use in shaving; Shaving balms; Shaving gels; Shaving oils; Shaving foams; Foams for use in shaving; Shaving preparations; Shave creams; Shave gel; Hair removal and shaving preparations; Shaving stones; After shave lotions; Preparations for use before shaving; Pre-shave creams; Hair removing cream; Shaving preparations in liquid form; Hair lotion; Hair cream; Depilatory lotions; Epilating waxes; Wax (Depilatory -); After-shave gel; Lotions for beards; Aftershave moisturising cream; After-shave creams; Facial lotion; Hair creams; Hair lotions; Hair gel; Facial cream; Hair styling gel; Hair wax; Creams for fixing hair; Cosmetic hair lotions; Creams (Soap -) for use in washing.

3. On 12 March 2024, the application was opposed by Three Pears Holdings Limited ('the Opponent') based on sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act').¹ This is a total opposition in which each of the grounds pleaded

¹ The initial pleading included claims pursuant to sections 5(3) and 5(4)(a) of the Act, which were subsequently withdrawn on 16 December 2024. The opposition now proceeds on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Act only.

is directed to the application in its entirety. The Opponent relies upon the following earlier registration in its entirety:

UK00003822524

A series of two marks:

 (i)	 (ii)
Filing date: 22 August 2022 Date of entry in register: 18 November 2022 <u>Registered for the following class 3 goods:</u> <i>Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; hair removal and shaving preparations; shaving foam; shaving balm; shaving lotion; shaving gel; shaving cream; shaving soap; pre-shaving preparations; shaving sticks; after shave lotions; moustache wax; beard oil; hair care agents; hair care preparations; hair care products; hair cleaning preparations; hair shampoo; conditioning preparations for the hair; conditioners for treating the hair; conditioners for use on the hair; conditioning liquids for the hair; hair moisturising conditioners; hair moisturisers; hair styling preparations, lotions and aids; aerosol hairspray; hair preparations in aerosol form; hair care products in the form of hair sprays; hair preparations in spray form; hair sprays in the form of spritz; hair spray; non-aerosol hairspray; hair cream, gel, balm, fixers, fixing oil, lacquer, mousse; hair styling waxes; hair protection creams, gels, lotions, mousse; beauty preparations for the hair; hair setting lotion; hair grooming preparations; hair strengthening treatment lotions; hair texturizers; hair thickeners; preparations for enriching the hair; preparations for fixing the hair; preparations for maintaining curled hair styles; preparations for the protection of the hair from the sun; preparations for use in adding volume to the hair.</i>	

4. The Opponent has elected not to include any narrative within its notice of opposition and statement of grounds (which it is entitled to do); but it has indicated pleadings pursuant to sections 5(1), 5(2)(a) and 5(2)(b) of the Act. Reliance on these grounds entails, respectively, claims that the Contested Mark is:
- identical with the earlier mark and for identical goods;
 - identical with the earlier mark and for similar goods;
 - and
 - similar to an earlier mark and for identical or similar goods.
5. The Applicant filed a Defence and Counterstatement in which it denies that there is a high degree of similarity between the marks that would lead to a likelihood of confusion.² It argues that the visual, phonetic and conceptual differences between the parties' marks are significant; in particular, the presence of the 'unique Arabic script', and such that the marks are unlikely to be confused.³
6. The Opponent is represented by Page, White & Farrer Limited. The Applicant represents itself.
7. Both parties filed evidence. A hearing was neither requested nor considered necessary; and both parties filed written submissions in lieu thereof. The following decision has been made after careful consideration of the case papers available to me.

RELEVANCE OF EU LAW

8. 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

² Counterstatement, paragraph [4].

³ As above.

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 AND SUBMISSIONS

9. The Applicant's evidence was filed before that of the Opponent; the reason being that the Opponent elected not to file evidence during the first evidence round, requesting the right to file evidence in reply should any evidence be filed by the Applicant.
10. The Applicant's evidence is by way of a Witness Statement from Tamer El Shazly, Director of the Applicant, dated 31 May 2025;⁴ and accompanied by four exhibits: 1-4. The Opponent's evidence in reply is by way of a Witness Statement from Edward Stanley Dunn, Director of the Opponent, dated 1 August 2025;⁵ and accompanied by four exhibits: ESD1-ESD4. The Applicant's written submissions in lieu of a hearing are dated 28 January 2026; those of the Opponent are dated 4 February 2026.
11. I confirm that I have read all of the evidence and submissions; and I will refer to them to the extent that they are relevant.

PRELIMINARY MATTER

A note on the matter of honest concurrent use

12. It is my view that Applicant has implicitly raised a defence of honest concurrent use in its evidence as follows:

'Zanotti Ltd has been marketing and selling Ingram-branded products in the UK since at least January 2020, and [...] our commercial activities significantly pre-date the opponent's action. Moreover, the Opponent was aware of our business

⁴ Witness Statement of T E Shazly, [1].

⁵ Witness Statement of E. S. Dunn, [1].

activities and even attempted to procure Ingram products from us prior to lodging the opposition'.⁶

13. In order to rely upon honest concurrent use as a defence, the Applicant should have pleaded it in its Form TM8.⁷ Consequently, this cannot be taken into consideration for the purposes of this decision.

14. In any event, my view is that the evidence provided does not support a finding of honest concurrent use, for reasons that I will now explain. Put simply, honest concurrent use is found where the competing marks have been used honestly and concurrently and, by virtue of such use, there is no adverse effect on the capacity of the earlier mark to function as a trade mark.^{8,9} In order for the defence to succeed, the evidence would need to show that the two marks were known to the relevant public without any confusion occurring.

15. The Applicant's evidence comprises the following:

- (i) A 'Listing Confirmation' from Amazon Marketplace, dated 16 January 2020, confirming the listing of 'Ingram Shave Lather';¹⁰
- (ii) A confirmation from Amazon Services Europe, dated 19 February 2020, in respect of an order for 'Ingram Shave Lather', placed by 'tshazly', indicating that the order was placed by the Applicant;¹¹
- (iii) A 'DHL Air Waybill dated 5 January 2020, evidencing the importation of Ingram products into the UK';¹²
- (iv) Email exchanges between the Applicant and Opponent, dated 2 November 2021, in which Opponent appears to be introducing itself as 'the new brand owner for Ingram shaving cream' and asking the Applicant whether it is interested in the Opponent's product.¹³

⁶ Witness Statement of T E Shazly, [5].

⁷ Notice of defence and counterstatement.

⁸ *Match Group LLC v Muzmatch Ltd* [2023] EWCA Civ 454, at [116].

⁹ Kerly's Law of Trade marks and Trade names, 17th Ed., at [17.087].

¹⁰ Witness Statement of T E Shazly, [4]; Exhibit 1.

¹¹ As above; Exhibit 2.

¹² Witness Statement of T E Shazly, [4]; Exhibit 3.

¹³ As above; Exhibit 4.

16. My view is that this evidence falls far short of establishing the defence of honest concurrent use.

DECISION

Earlier mark

17. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its filing date, which precedes the filing date of the application.

The proof of use provisions

18. Section 6A of the Act provides that, in opposition proceedings, where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the filing date (or priority date) of the Contested Mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged, because the earlier mark has been registered for less than 5 years at the date on which the application was filed. The Opponent is, therefore, entitled to rely on the full breadth of its registered specification.

Relevant legislation

19. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act read as follows:

'5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

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

(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.

20. I also note section 5A of the Act:

‘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.’

Relevant case law

21. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(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.

A note on fair and notional use

22. The Applicant has made references to actual use of its mark in its written submissions. Following my comments on the matter of honest concurrent use at [12] – [16], it is appropriate to clarify the correct approach in the instant case.

23. I am required to make the assessment of the likelihood of confusion notionally and objectively based on the Opponent's goods, as registered, and the Applicant's goods, in respect of which registration is sought, in accordance with the relevant

case law. That assessment requires that I must not take into account the actual way that either party might have used their marks in the marketplace or aspects of their goods which cannot be determined upon inspection of the Register. Further, I must consider all of the circumstances in which the mark for which registration is sought might be used should it become registered.¹⁴

Comparison of goods

24. The goods to be compared are set out above at [2] and [3].

25. Section 60A of the Act provides:

‘For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.’

26. I note the case of *Gérard Meric v Office for Harmonisation in the Internal Market*,¹⁵ in which the General Court (‘the GC’) held that:

‘29. ... 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 für Lernsysteme v OHIM-

¹⁴ As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

¹⁵ Case T-133/05.

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’.

27. The Court of Justice of the European Union (‘CJEU’) in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

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

28. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.¹⁶ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC described ‘complementary’ in the following terms: “[...] 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”.¹⁷ 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.

29. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281,¹⁸ identified the following factors for assessing similarity of the respective goods (and services):

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

¹⁶ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

¹⁷ Paragraph 82.

¹⁸ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

- (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.

30. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs Q. C. (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.’

31. The Opponent has submitted that all of the contested goods are identical or highly similar to the Opponent’s goods.¹⁹ However, the particular arguments that follow are couched only in terms of identity; and the Opponent has not identified where, if any, points of high similarity lie.

32. Where there are obvious points of identity, whether by reason of being frankly identical, synonymous or identical based on the principle in *Meric*, I set them out in the following table:

¹⁹ Opponent’s written submissions in lieu of a hearing, [23].

Earlier Mark:	Contested Mark:
<i>shaving lotion</i>	<i>Shaving lotion; Shaving lotions</i>
<i>shaving cream</i>	<i>Shaving cream; Shaving creams; Shave creams</i>
<i>shaving soap</i>	<i>Shaving soap; Shaving soaps</i>
<i>Shaving gel</i>	<i>Shaving gel; Shaving gels; Shave gel</i>
<i>Shaving balm</i>	<i>Shaving balm; Shaving balms</i>
<i>shaving foam</i>	<i>Shaving foam; Foam for use in shaving; Shaving foams; Foams for use in shaving</i>
<i>Shaving preparations</i>	<i>Shaving preparations; [...] shaving preparations</i>
<i>Shaving preparations</i>	<i>Shaving sprays; Shaving mousse; Shaving oils; Shaving preparations in liquid form</i>
<i>after shave lotions</i>	<i>After shave lotions</i>
<i>pre-shaving preparations</i>	<i>Preparations for use before shaving; Pre-shave creams</i>
<i>hair lotions</i>	<i>Hair lotions; Hair lotion; Cosmetic hair lotions</i>
<i>hair cream</i>	<i>Hair cream; Hair creams; Creams for fixing hair</i>
<i>hair care preparations</i>	<i>Hair gel; Hair styling gel; Hair wax</i>
<i>hair removal [...] preparations</i>	<i>Hair removal [...] preparations; Hair removing cream; Depilatory lotions; Epilating waxes; Wax (Depilatory -)</i>
<i>Soaps</i>	<i>Creams (Soap -) for use in washing.</i>

33. The remaining contested terms do not strike me as obviously identical and, therefore, warrant closer consideration.

Contested term: *shaving stones*

34. It is my understanding that a 'shaving stone' is a block or bar of alum which, when wet, is rubbed over the face after shaving to soothe the skin. The Opponent has submitted that this term is encompassed by the Opponent's broader term 'hair removal and shaving preparations'.²⁰ Strictly speaking, shaving preparations will encompass products used during the act of shaving, e.g. shaving cream or gel. *Shaving stones*, on the other hand, are used after the act of shaving, akin to after-shaves. I consider the Opponent's terms *after shave lotions* to be the most appropriate comparator. Users and trade channels will be shared. The goods will have the same purpose of soothing the skin after shaving. They are substitutable and in a competitive relationship. In terms of their physical natures, aftershaves are more often in the form of liquids. All things considered, I find the parties' goods to be highly similar.

Contested terms: *After-shave gel; Aftershave moisturising cream*

35. I compare these goods to after shave lotions. My view is that gels, creams and lotions have different physical natures in terms of their consistencies and, therefore, cannot be said to be synonymous. That said, I find a very high level of similarity between them based on clear overlaps in user, trade channel, purpose, methods of use; their similar (though not identical) physical natures; and the fact that they are in competition.

Contested term: *Shaving sets, comprised of shaving cream and aftershave*

36. The Opponent has submitted that the contested goods will be encompassed by the Opponent's broad term 'hair removal and shaving preparations'.²¹ In what they are saying is that the respective goods are identical based on *Meric*, then I respectfully disagree with this argument because whilst the shaving cream component of the contested term will be included in the Opponent's term, the aftershave component will not. The goods at stake are shaving sets and cannot be divided. I nevertheless consider the Opponent's 'shaving preparations' to be an appropriate comparator.

²⁰ Opponent's written submissions in lieu of a hearing, [24].

²¹ As above.

Users and trade channels will inevitably overlap. There is considerable overlap in purpose and methods of use. There may be competition in some instances; for example, a consumer might deliberate over whether to purchase a shaving cream or a set which includes shaving cream. I do not find complementarity; a consumer purchasing the Applicant's shaving set will not ordinarily find another shaving preparation to be important or necessary. Conversely, a consumer purchasing a shaving preparation will not find the Applicant's shaving set (which includes shaving cream) to be necessary or particularly useful. The goods will have similar physical natures to the extent that the products will likely be in liquid/foam form. However, the fact that a set comprises more than one product is a point of physical difference between the parties' goods. All things considered, I find a medium to high level of similarity between the goods. I do not consider that comparison with any other of the Opponent goods would improve the Opponent's position.

Contested terms: *facial lotion; facial cream*

37. The Opponent has submitted that the contested goods are encompassed by the Opponent's broader term *cosmetics* and that the respective goods are, therefore, identical based on the principle in *Meric*.²² I agree. 'Cosmetics' is a broad category which includes a wide range of products which are applied to the skin (or hair, lashes, brows or nails) in order to improve its condition and/or appearance. Facial lotions and creams are typically used to improve the appearance of the skin, e.g. facial moisturisers used to improve the tone and texture of the skin.

Contested term: *lotions for beards*

38. The Opponent has submitted that *lotions for beards* are encompassed by several of the Opponent's terms, giving the following examples: *hair removal and shaving preparations; hair lotions; hair care preparations; hair styling preparations, lotions and aids; hair cream, gel, balm, fixers, fixing oil, lacquer, mousse; hair styling waxes; and beauty preparations for the hair*.²³ To my mind, whilst beards are

²² Opponent's written submissions in lieu of a hearing, [27].

²³ As above, [26].

indubitably *hair*, the ordinary understanding of categories such as ‘hair care preparations’ and ‘hair styling preparations’ etc is that they relate to the hair on the head. In my experience as an ordinary member of the public, products specifically for *facial* hair are typically located with or near shaving-related or other beard/facial hair care products; they are not ordinarily found alongside hair care products such as shampoos and hairsprays for hair on the head. I consider the Opponent’s *beard oil* to be the most appropriate comparator for the contested *lotions for beards*. Users and trade channels will clearly overlap. The purpose of the respective goods will be the same, i.e. the improvement of the condition and/or appearance of the beard. Methods of use will also overlap. The respective goods are substitutable and, therefore, in a competitive relationship. I do not find complementarity, neither good being necessary nor important for the other. In the light of the foregoing, I find the goods to be highly similar.

Average consumer and the purchasing act

39. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word ‘average’ denotes that the person is typical. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average

consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

40. The Opponent has submitted that the average consumer of the relevant goods is the general public who will pay a low to moderate degree of attention during the purchasing process; with the goods in question being typically inexpensive, routine purchases, self-selected from shelves or online listings.²⁴ I agree with the Opponent's submission, to which I will add some further comment. I find that the purchasing process will be predominantly visual (this is implicit in the Opponent's submission). In physical stores, the prospective purchaser will, in any cases, pick up and examine the goods, e.g. to check the ingredients or suitability of the product. The Opponent acknowledges the aural aspect to some purchases in its submission that some goods may be purchased from manned kiosks where retail staff provide recommendations or advice.²⁵

Comparison of the marks

²⁴ Opponent's written submissions in lieu of a hearing, [30].

²⁵ As above, [32].

41. 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.’

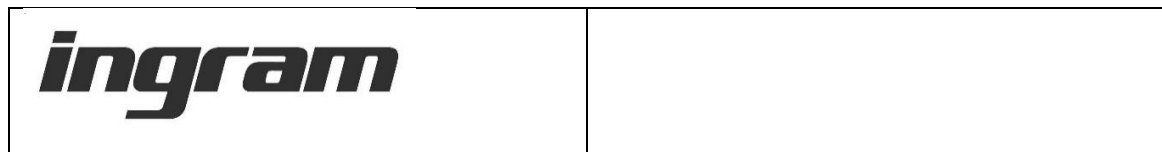
42. It is a prerequisite of both section 5(1) and section 5(2)(a) of the Act that the trade marks are identical. In *S. A. Société LTJ Diffusion v. Sadas Vertbaudet SA*²⁶, the CJEU²⁷ held that:

‘54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.’

43. The marks to be compared are as follows:

Earlier marks (series of two):  And	Contested Mark: 
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²⁶ Case C-291/00.



Overall impression of the marks

44. The Opponent's earlier right comprises a series of two marks; they are identical in form, comprising the single word element 'Ingram' presented in a fairly plain italicised typeface, albeit one mark is presented in navy blue and the other in black. For each iteration within the series, the overall impression is based solely on the single word of which it consists. I do not find the variation in colour between the iterations to affect their distinctive character.
45. The Contested Mark comprises the word element 'Ingram', with what many UK consumer would see as a figurative element, although it is identified by both parties as Arabic, presented above it. I note that the 'Ingram' element appears almost identical in form to the word as presented in the earlier mark. It is only upon close examination that slight differences in the 'tail' of the 'g' and the tittle of the 'i' can be discerned; and I consider these differences to be so tiny that they are negligible. I find that the Arabic element will be seen by most average consumers as either merely figurative or, as a non-English word whose meaning is unknown. Some average consumers may even recognise it to be Arabic, without knowing its meaning. I find that the word 'Ingram' plays the dominant visual role within the mark, with the Arabic element playing a secondary visual role.
46. The presence of the Arabic element in the Contested Mark will not go unnoticed by the average consumer, given its size and positioning. For that reason, the parties' marks cannot be said to be identical. It is at this point that the section 5(1) and 5(2)(a) grounds of the opposition fail, leaving just the section 5(2)(b) claim to be determined.

Visual comparison

47. The word element 'Ingram' is present in both marks and in a more-or-less identical form. The normal and fair use of the iteration of the earlier mark registered in black would allow it to be used in navy blue. Consequently, the difference in colour between the parties' marks as registered has no real impact in the visual comparison. The only point of visual difference between the parties' marks is the presence of the Arabic/figurative element in the Contested Mark, for which there is no counterpart in the earlier marks. I have found that the presence of the figurative element will be registered visually by the average consumer. I find the marks to be visually similar to a high degree.

Aural comparison

48. The earlier marks will be articulated 'IN-GRAM'. As to the Contested Mark, the average UK consumer would unlikely articulate the Arabic element due to perceiving it as either a word rendered a non-Latin/Roman alphabet,²⁷ or mere figurative element. Aurally speaking, therefore, I find that the parties' marks will be articulated in the same way. The marks are aurally identical.

Conceptual comparison

49. The Opponent has submitted that the word 'Ingram' 'would likely be perceived as an unusual forename or surname', in both parties' marks.²⁸ It argues that the relevant public will be unfamiliar with the Arabic language and that, therefore, the Arabic element will have no bearing on the conceptual comparison.²⁹ Whilst I agree that the average consumer will unlikely understand Arabic, that does not necessarily mean that the Arabic element plays no part in the conceptual message conveyed by the mark. In my view, some average consumers may perceive the Arabic element to be a non-English word and/or recognise it to be Arabic, albeit without knowing its meaning. I find that the 'Ingram' element will carry the same conceptual message across all of the marks, that of a name. As to the Contested Mark, I consider that the presence of the non-English and/or Arabic element

²⁷ I.e. the 'A - Z' alphabet.

²⁸ Opponent's written submissions in lieu of a hearing, [45].

²⁹ As above, [46].

above it will give the impression to some that the brand has non-English or Arabic origins. All things considered, I find the marks to have a high level of conceptual similarity.

Distinctive character of the earlier mark

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

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

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

51. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

52. I have found that the word element 'Ingram' will be perceived by the relevant public as a name. The Opponent has submitted that it will be perceived as an unusual forename or surname. In my experience as an ordinary member of the general public, I am aware of 'Ingram' as a surname. There is no evidence before me to indicate how prevalent it is as a surname (or forename, if it is a forename). It seems to me that it is neither particularly common nor terribly rare. 'Ingram' neither describes nor alludes to the goods in respect of which the marks are registered. I bear in mind that, generally speaking, given names tend to have fairly low levels of inherent distinctiveness. I find the earlier marks to be distinctive to a fairly low degree.

53. The Opponent's evidence is confined to the narrow matter of honest concurrent use raised as a defence by the Applicant, subsequently dismissed earlier in this decision at [16]. The material provided by the Opponent does not address the use of the earlier marks in such a way that I am able to make a finding in respect of enhanced distinctiveness.

Likelihood of confusion

54. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*³⁰. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*³¹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the

³⁰ Case BL O/375/10 at [16].

³¹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

goods/services are the responsibility of the same or an economically linked undertaking.

55. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [21]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

56. I will address direct confusion first. I have found all of the contested goods to have some level of similarity with those of the Opponent; ranging from ‘identical’ to a ‘medium to high’ level of similarity. Visually speaking, the marks are similar to a high degree, the only point of visual difference being the presence of the Arabic/figurative element in the Contested Mark, which has no counterpart in the Opponent’s marks. The marks are aurally identical given that the average consumer will unlikely articulate the Arabic/figurative element within the Contested Mark. Conceptually speaking, the marks are highly similar. It is my view that the presence of the Arabic/Figurative element in the Contested will not go unnoticed by the average consumer. Although the marks are aurally identical, I bear in mind that the purchasing act is predominantly visual in nature. It is my view that the visual difference between the marks is sufficient to prevent one mark from being mistaken for the other. I find that there is no likelihood of direct confusion. However, for reasons that I will now explain, I do find a likelihood of indirect confusion.

57. In the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said the following 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’.

58. Arnold LJ emphasised 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’.³²

59. I have borne in mind *Whyte and Mackay*³³ in which it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. To the extent that the Contested Mark is composed of two elements, it can be said to be a composite mark. I find that, in the instant case, the presence of the Arabic/figurative element neither changes the meaning of, nor disturbs the distinctive character of the common element ‘Ingram’.

60. I also note that, in *L.A. Sugar Limited v Back Beat Inc*³⁴ Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that:

‘17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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.).

³² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

³³ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

³⁴ Case BL O/375/10

(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)'.

61. I acknowledge that these categories are not intended to be exhaustive. I consider that the instant case does not fall squarely within any of the aforesaid three categories. However, it, perhaps, most closely aligns with the third of Mr Purvis' categories. My view is that a significant proportion of average consumers would notice the visual difference between the marks (i.e. the Arabic/figurative element) and presume that this difference was due to the marks being alternative marks under the same overarching brand 'Ingram'; one version with the Arabic/figurative element and the other without. The former might be seen as a version of the mark conveying that the goods have an Arabic or non-English connection/origin, for example. For those who perceive the 'Arabic' element as merely figurative, the Contested Mark might be seen as a more embellished/decorated version of the earlier marks. I find that the average consumer will likely see the marks as originating from the same or economically-related undertakings. I find this to be the case even where a medium level of attention might be paid during the purchasing act. My finding of a likelihood of indirect confusion applies to all of the contested goods. I have reminded myself of the interdependency principle according to which 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. I do not think that it comes into play in the instant case, because: i. even the lowest level of similarity between the goods is in the medium to high range; and ii. the marks are aurally identical, and visually and conceptually speaking, highly similar.

COSTS

62. The section 5(2)(b) opposition has succeeded in full.

63. The Applicant has submitted that, based on Tribunal Practice Notice ('TPN') 4/2007, an opponent who fails to file a TM7A³⁵ is generally ineligible for a cost award.³⁶ With respect, this is incorrect, for the reasons that follow.

64. The relevant part of the TPN 4/2007 states the following:

'Costs in undefended actions

9. In the past costs have been awarded against rights owners or applicants when an opposition, revocation or invalidity action has been brought without prior notice, even if the action was then undefended and the application or rights in question were immediately withdrawn or surrendered. Unless factors exist which suggest otherwise, as from 3 December 2007 costs will not be awarded against rights holders or applicants who do not defend an action in such situations.'

65. I also note the following from the Manual of trade marks practice:³⁷

'5.8 Notification of intention to commence proceedings

If the first a party receives of the action against their mark is the receipt of the notification that proceedings have been launched and the application is subsequently withdrawn, or the mark surrendered, before a counter-statement is filed, the Tribunal will decline to make any award at all.

However, if the applicant files a counter-statement this will be taken as an intention to defend the attack. If the application is then withdrawn or the registration is voluntarily cancelled a deduction will not usually be made to any costs award.'

66. In the light of the foregoing, the Opponent, as the successful party, is therefore entitled to a contribution to its costs based on TPN 1/2023, calculated as follows:

³⁵ Notice of threatened opposition.

³⁶ Applicant's written submissions in lieu of a hearing, [2].

³⁷ Last updated 15 October 2025.

Official fee for filing of Opposition:	£100
Preparing a statement and considering the other side's statement:	£300
Preparing of evidence and considering and commenting on the other side's evidence:	£300*
Preparing written submissions in lieu of a hearing:	£350
Total:	£1,050

*I have awarded a sum below the minimum threshold in respect of the preparation and consideration of evidence for the reason that, strictly speaking, the matter of honest concurrent use was not properly in issue. That said, it is appreciated that, even though the Applicant sought to introduce the issue at an unacceptably late stage, it was not unreasonable for the Opponent to file some evidence to address the matter.

67. I therefore order ZANOTTI LTD to pay to Three Pears Holdings Limited the sum of £1,050. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of July 2026

N. R. Morris

**For the Registrar,
the Comptroller-General**