

O/0706/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NOS. 3935203 & 3890301

IN THE NAME OF VENTURE FOODS (UK) LIMITED

IN CLASSES 29 & 30

AND

APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO

UNDER NOS. 508272 & 508273

BY WINDMILL ORGANICS LIMITED

BACKGROUND AND PLEADINGS

1. Venture Foods (UK) Limited (“the proprietor”) is the registered proprietor of the following trade marks (collectively, “the proprietor’s marks”):



(Series of four marks)

UK registration no. 3890301

Filing date: 17 March 2023

Registration date: 8 September 2023

Class 29: Preserved, dried, cooked or processed fruit and vegetables; jellies, jams, compotes, fruit sauces; eggs, milk and milk products; dairy products; mousses, chilled desserts; milk drinks, flavoured milk drinks; drinks made from dairy products; soups; sweet spreads, savoury spreads; salads; drinks, fillings, snack foods; potato crisps; nuts; prepared meals and constituents for meals; dips; foodstuffs made from goods in this class; all being organic produce, organic products or products composed of organic ingredients.

Class 30: Coffee, tea, cocoa, drinking chocolate, artificial coffee; sugar, rice, tapioca, sago, cous cous, pasta; flour and preparations made from cereals, pasta, cereals, breakfast cereals, bread, pastries, cakes, biscuits, croutons; confectionery; non-medicated confectionery; chocolate; chocolates; ices, ice cream, ice cream products, frozen yoghurt, frozen confections, chilled desserts, mousses, sorbets; sweet spreads, savoury spreads; honey, treacle; yeast, baking powder; salt, mustard, vinegar, sauces (condiments), chutney, relishes; spices; snack foods, prepared

meals and constituents for meals, chocolate, pizzas, pizza bases, sauces and toppings for pizzas; sauces for pasta and rice; curry paste; salad dressings, mayonnaise, dips, tomato ketchup; spices, seasonings, marinades; custard; pickle relish; foodstuffs made from goods in this class; all being organic produce, organic products or products composed of organic ingredients.

("the proprietor's first mark")



(ii)

(Series of four marks)

UK registration no. 3935203

Filing date: 18 July 2023

Registration date: 22 December 2023

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other milk products; oils and fats for food.

Class 30: Coffee, tea, cocoa and substitutes therefor; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

("the proprietor's second mark")

2. On 6 January 2025, Windmill Organics Limited (“the applicant”) made applications for declarations of invalidity in respect of the proprietor’s marks. The applications are based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its claims under section 5(2)(b), the applicant relies upon the following trade marks:



(i)

UK registration no. 908527004

Filing date: 12 August 2009

Registration date: 2 November 2010

Class 29: Edible oils and fats, milk products, canned beans, butter, margarines and spreads, nut butters, canned tomatoes, pickled vegetables, olives, tofu, creamed coconut, tomato concentrate, bouillons, prepared soups, tahini, vegetarian sausages and burgers, hummus, potato crisps, peanut butter, pates and spreads, yogurts, snack bars, savoury snacks, coconut milk; edible seeds; pulses; canned vegetables; canned fruits; fruit in jars; vegetables in jars; cheese; cheese containing herbs; dried fruits; all of the above exclusively for human consumption.

Class 30: Coffee, cocoa, tea, rice, artificial coffee, flour and preparations made from cereals, bread, pastries, cookies, desserts, honey, yeast, mustard, vinegar, sauces, relishes, dried herbs, herb salt, boiled sweets, cereal food bars, chocolate bars, chutneys, herb teas, crispbread, flapjacks, mayonnaise, pasta, pizza bases, pretzels, rice cakes, pasta sauces, ketchup, marinades, marzipan, muesli bars, peppermint sweets, pesto sauce, cakes, cereal based snacks, curry sauces, salad dressings, muesli,

candy bars, puffed rice; waffles; sugar; condiments; all of the above exclusively for human consumption.

Class 32: Beers, bottled waters, vegetable juices; fruit juices; malt based preparations for making beverages; all of the above exclusively for human consumption.

("the applicant's first mark")¹



(ii)

UK registration no. 3911597

Filing date: 15 May 2023

Registration date: 25 August 2023

Class 29: Edible oils and fats, milk products, canned beans, butter, margarines and spreads, nut butters, canned tomatoes, prepared soups, vegetarian sausages and burgers, hummus, potato crisps, peanut butter, yoghurts, snack bars, savoury snacks, edible seeds, pulses, canned vegetables, canned fruits, fruits in jars, vegetables in jars, cheese, dried fruits, all of the above exclusively for human consumption; all the aforesaid goods being organic.

Class 30: Cocoa, tea, rice, flour and preparations made from cereals, bread, pastries, cookies, desserts, honey, sauces, dried herbs, boiled sweets, confectionary, cereal food bars, chocolate bars, herb teas, crispbread, flapjacks, mayonnaise, pasta, pizza bases, pretzels, rice cakes, pasta sauces, ketchup, marinades, muesli

¹ The applicant's first mark is a comparable mark based upon its EU trade mark no. 8527004. This mark was automatically created on 1 January 2021 in accordance with article 54 of the Withdrawal Agreement between the UK and EU.

bars, peppermint sweets, pesto sauce, cakes, cereal based snacks, curry sauces, salad dressings, muesli, candy bars, puffed rice, waffles, sugar, condiments, all of the above exclusively for human consumption; all the aforesaid goods being organic.

Class 32: Bottled waters, vegetable juices, fruit juices, malt based preparations for making beverages, all of the above exclusively for human consumption; all the aforesaid goods being organic.

("the applicant's second mark")

4. In its statements of grounds, the applicant contends that the proprietor's marks are similar to its marks and that the parties' goods are identical or similar. On this basis, the applicant submits that there is a likelihood of confusion.

5. Under section 5(4)(a), the applicant claims that it has goodwill in relation to which it has used a sign identical to its first mark throughout the UK since September 2022. The sign is said to have been used in connection with the goods of its second mark. The applicant contends that use of the proprietor's marks would constitute passing off.

6. The proprietor filed counterstatements denying the grounds of invalidity. Whilst it accepts that some of the parties' goods are similar, it denies that the competing marks are similar, such that there is no likelihood of confusion. It also put the applicant to proof of goodwill and denies that its marks are similar to the applicant's sign, such that there would be no misrepresentation or damage.

7. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 7 July 2026. The applicant was represented by Joshua Marshall of counsel, instructed by Russell-Cooke LLP. The proprietor was represented by Henry Edwards of counsel, instructed by Burley Law Limited.

EVIDENCE

8. The applicant's evidence is given in the witness statement of Donata Berger and one exhibit (DB1). Ms Berger is a co-founder and director of the applicant. She provides evidence of use of the applicant's marks and sign, as well as alleged actual confusion between the competing marks.

9. The proprietor's evidence came in the form of a witness statement from Venkata Krishna Yadlapalli. Mr Yadlapalli is the director and owner of the proprietor, a position he has held since 2022 when he acquired the business. He responds to Ms Berger's claims regarding the circumstances leading to the alleged actual confusion.

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

DECISION

11. Sections 5(2)(b) and 5(4)(a) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, the relevant parts of which read as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

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

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

[...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

12. In terms of its application against the proprietor’s second mark, both of the applicant’s marks qualify as earlier trade marks in accordance with section 6 of the Act. In respect of its application against the proprietor’s first mark, only its first mark does. Its second mark has a later filing date than the proprietor’s first mark and, therefore, cannot be relied upon.

13. The applicant’s second mark had not been registered for five years at the date on which the applications for declarations of invalidity were filed. Therefore, it is not subject to the use provisions set out above.

14. The applicant's first mark had completed its registration process more than five years before that date and, as such, it is subject to the use provisions. However, for reasons that will become apparent, I will proceed on the basis that the applicant's first mark has been put to genuine use during all applicable relevant periods (those being 7 January 2020 to 6 January 2025, 18 March 2018 to 17 March 2023 and 19 July 2018 to 18 July 2023) for all the goods relied upon.

Section 5(2)(b)

Legislation and case law

15. Sections 5(2)(b) and 5A of the Act state 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 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.

My approach

17. At the hearing, Mr Marshall submitted that the applicant's first mark represents its best case. He accepted that, if the application fails based upon this mark, its second mark will not improve its position since it is less similar to the proprietor's marks. I agree and will proceed to determine the present ground on the basis of the applicant's first mark only.

Comparison of goods

18. Some of the parties' goods, such as, for example, *coffee*, *tea* and *cocoa*, are clearly identical. As such, I will proceed on the basis that all the parties' goods are identical. If the applicant's claims under section 5(2)(b) fail where the goods are identical, it follows that they will also fail where the goods are only similar.

Average consumer

19. As the authorities indicate, I must determine who the average consumer is for the parties' goods and how they are likely to be selected. The average consumer is

deemed to be reasonably well informed, observant and circumspect.² In *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, Arnold LJ explained that:³

- (i) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (ii) 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;
- (iii) 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;
- (iv) 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;
- (v) The average consumer's level of attention varies according to the category of goods or services in question; and
- (vi) 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.

² *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)

³ Approved by the Supreme Court in *Iconix* (cited above).

20. The goods at issue in these proceedings consist of a range of ordinary food and beverage products. They will be purchased by the general public. In respect of alcoholic beverages, those individuals will necessarily be adults. The goods are relatively inexpensive and are likely to be purchased relatively frequently. The average consumer is likely to consider factors such as taste, ingredients, nutritional content, dietary requirements and potentially whether the goods are organic. However, these are ordinary purchasing considerations, and some of the goods may be purchased ‘on the go’, attracting a lower level of attentiveness. Overall, it is my view that the average consumer will demonstrate between a low and medium level of attention during the purchasing process. The goods are typically sold in retail environments, such as supermarkets, and their online equivalents. They will be self-selected by the average consumer after being viewed on shelves, displays, or in images on websites. Therefore, the purchasing process is likely to be predominantly visual in nature. However, I do not discount aural considerations entirely, given that the average consumer may seek advice from sales assistants or receive word-of-mouth recommendations.

Distinctive character of the earlier mark

21. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, the Court of Justice of the European Union (“CJEU”) stated that:⁴

“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).

⁴ 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.

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)."

22. Registered trade marks possess varying degrees of inherent distinctive character. 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.

23. The applicant's first mark is a composite mark. At its centre appears the word 'biona'. Underneath, in a smaller font, is the word 'ORGANIC'. Surrounding the word elements are a range of food-related silhouette devices which form a rough circle. The word 'biona' appears to be an invented word. That said, the average consumer is likely to recognise the 'bio-' prefix, which indicates a connection with life and living things.⁵ Whilst the precise meaning of the word as a whole will remain unknown, it loosely evokes the meaning associated with the prefix. This has some connection to the goods relied upon, though only at a relatively high level of generality. The word 'ORGANIC' will be readily understood as an indication that the goods sold under the mark have been produced without the use of artificial chemicals.⁶ The devices depict items of natural produce and gardening equipment. In my view, the distinctive character of the mark overwhelmingly rests in the word 'biona'. It is an invented word (albeit which loosely evokes a known meaning) which appears at the centre of the mark in the largest font. The devices and their particular presentation also provide a contribution. However, since the devices pictorially describe or allude to the goods relied upon, this

⁵ <https://dictionary.cambridge.org/dictionary/english/bio>

⁶ <https://dictionary.cambridge.org/dictionary/english/organic>

is a much smaller one. Whilst the word 'ORGANIC' would not go unnoticed, it is a purely descriptive or strongly allusive word. It does not add any distinctive character to the mark over and above that produced by the word 'biona' and the devices. Overall, I find that the applicant's first mark possesses between a medium and high level of inherent distinctive character.

24. I have not yet considered the applicant's evidence, having so far proceeded on the basis of genuine use having been demonstrated. I do so here to consider whether, at the relevant dates of 17 March 2023 and 18 July 2023, the distinctive character of the applicant's first mark had been enhanced through use.

25. Before doing so, I would like to point out that the documentary evidence is rather unfocused and difficult to follow. It does not appear to adhere to any particular order, and many of the references in Ms Berger's statement to the page numbers of the single 296-page exhibit do not appear to match correctly. Mr Marshall helpfully provided correct references to some page numbers at the hearing, though for much of the evidence I must simply do my best with the materials before me.

26. Ms Berger gives evidence that the Biona brand was established in 1992. Although the applicant operates six different brands, she says that Biona accounts for 90% of its turnover. According to Ms Berger, the applicant's first mark has been in use since December 2010.⁷

27. Ms Berger explains that the UK and Ireland is the brand's main market. In 2024, sales in the UK and EU are said to have been £39.2million, with €7.7million of those being in the EU. However, no figures are provided for any time before the relevant dates. Similarly, Ms Berger points to adverts placed in *Shelflife* in Ireland and *The Grocer* in the UK, in which the applicant claimed that Biona was the largest branded organic range in the UK and Ireland.⁸ However, the relevant territory for this

⁷ In Ms Berger's statement, she explains that the exact form of the mark has varied over the years. Updated versions of the mark as registered have been used since August 2020 and November 2024. In my view, none of the differences between the updated marks and the mark as registered alters the distinctive character of the latter. I shall take all forms of the mark into account.

⁸ Exhibit DB1, pages 1-3

assessment is the UK (not Ireland) and Ms Berger claims that the advert which ran in *The Grocer* is from March 2025, i.e. after the relevant dates.

28. Ms Berger says that, at the date of her statement, Biona had a range of over 360 organic products. At that date, Ocado is said to have stocked 312 of these on its website. She provides data from Ocado which, she says, shows that Biona is the largest organic food range under one brand in the UK.⁹ However, all the foregoing reflects the position after the relevant dates. In addition to Ocado, Ms Berger states that Biona has listings in Tesco and Morrisons, and does an increasing amount of business via Amazon. She provides printouts from these websites.¹⁰ These show a range of organic food products offered under the Biona brand, but Ms Berger says that they were obtained on 20 May 2025, i.e. after the relevant dates.

29. In addition to sales via third parties, Ms Berger says that the applicant has a significant direct-to-consumer business, conducted mainly through its website (biona.co.uk). She provides printouts from the website, which show multiple listings for Biona products.¹¹ The applicant's first mark appears throughout. However, the printouts were obtained on 20 May 2025, i.e. after the relevant dates. Ms Berger also exhibits search traffic data in respect of the website.¹² Whilst much of the data reflects the position after the relevant dates, it shows that the website had around 12,000 organic visits each month between May and July 2023. This is before the second relevant date and a short time after the first. Further, Ms Berger provides a Google Trends report, which shows that 'Biona' was searched between 25,000 and 100,000 times per month in the UK between May 2020 and the relevant dates.¹³ She also provides search traffic, keyword search and backlinks data, obtained via search engine optimisation platform SemRush.¹⁴ However, it reflects the position for April 2025, i.e. after the relevant dates.

⁹ Exhibit DB1, pages 116-130

¹⁰ Exhibit DB1, pages 41-42, 47-49 and 111-115

¹¹ Exhibit DB1, pages 50-86

¹² Exhibit DB1, page 131

¹³ Exhibit DB1, page 98

¹⁴ Exhibit DB1, page 228

30. In terms of actual sales, Ms Berger provides an example of an invoice.¹⁵ It is dated 5 March 2020 and was addressed to a distributor based in Southampton. Biona products can be seen in the product descriptions; these cover goods such as burgers, falafel, spreads, spring rolls, pasta and cheese. The quantity of each multipack product that was sold ranges, the highest being 80. Ms Berger states that this invoice is one of 18 covering 36,676 products. However, I bear in mind that some of these sales are likely to have been after the relevant dates, given that her narrative reflects the position at the date of her statement.

31. Ms Berger also exhibits a spreadsheet containing a list of products in relation to which the marks were used at the date of her statement.¹⁶ It is of little probative value, since this was after the relevant dates and the products are simply listed (as opposed to evidence of use actually being shown). Nevertheless, I acknowledge that the spreadsheet does include essentially narrative evidence that use of the marks in relation to a number of Biona products has been longstanding. For instance, over 20 years for the applicant's tinned chopped tomatoes.

32. Ms Berger claims that Biona has a substantial presence on social media, with 62,000 and 17,000 followers on Instagram and Facebook, respectively. These figures represent the position at the date of her statement, i.e. after the relevant dates. Printouts from various social media channels are in evidence, though it is all either undated or from after the relevant dates.¹⁷ Ms Berger says that the applicant has a paid social advertising budget of approximately £30,000 which is spent on targeted ads. However, she does not confirm whether this was the case prior to the relevant dates, the amounts actually spent on advertising at any point before those dates, or that this budget is only for the Biona brand.

33. Ms Berger says that the applicant tends to advertise in *The Grocer* two or three times per year. Moreover, she says that it is also referenced in third-party articles. Printouts of examples thereof have been provided. Of these, only one is clearly from

¹⁵ Exhibit DB1, pages 35-37

¹⁶ Exhibit DB1, pages 260-264

¹⁷ Exhibit DB1, pages 45-46, 91-97, 100, 105-110 and 226-227

before the relevant dates, namely *The Grocer* (November 2022).¹⁸ No readership or circulation figures have been provided, and the article was a profile piece on an employee of Biona. Ms Berger also says that Biona appeared in *Daily Express* in December 2017. However, the article in the evidence to which she appears to refer is not dated and talks about “[p]ost-pandemic health awareness”.¹⁹ This must mean that it is from some (unspecified) time in 2020 at the earliest. Even though the article in *This Is Money* is from after the relevant dates, it stated that Biona had gross sales of £24million in 2023 and had become “synonymous with the organic market”.²⁰

34. According to Ms Berger, Biona reaches millions of UK shoppers each year via advertising. However, there is very little with which to substantiate that assertion. She says that it works with some of the most popular UK food and drink influencers, but the printouts from social media she has provided in support (including those already discussed) are from after the relevant dates. She also states that the advertising budget in the UK is approximately £2.5million per year, which is predominantly spent on digital advertising. However, she does not say whether that was the case at the relevant dates or how much was actually spent on advertising before those dates. There is also very little in the way of direct evidence of any such advertising taking place; the one example referred to by Ms Berger is an undated advertisement with no indication as to where it appeared or how many UK consumers would have been exposed to it.²¹

35. According to Ms Berger, Biona products have won 80 Great Taste awards, as well as other awards, including the Natural & Organic Innovation award (2023).

36. Finally, I note that Ms Berger has included a brand survey prepared by Pollfish.²² Whilst this evidence is noted, I place no weight on it. Aside from no permission being sought to file survey evidence, it is dated 16 December 2024, i.e. after both relevant dates. Moreover, whilst the proportion of respondents who were aware of Biona was significant, namely 26.8%, there were only 1,000 respondents in total. I do not consider

¹⁸ Exhibit DB1, pages 254-257

¹⁹ Exhibit DB1, pages 4-9

²⁰ Exhibit DB1, pages 10-16

²¹ Exhibit DB1, page 43

²² Exhibit DB1, pages 134-224

this to be representative of the average consumer. In addition, this figure reflects prompted awareness, i.e. respondents were asked directly whether they were aware of the brand. The answers to the unprompted question record only 16 instances, at best, of Biona being mentioned.²³

37. As can be discerned from the above, the evidence is certainly not without its limitations. A very large proportion of it cannot be relied upon as showing the position at the relevant dates as it is either undated or from after those dates. There are no sales figures or details of market share from before the relevant dates. The evidence shows that Biona generated a turnover of £24million in 2023 and around £30million in 2024.²⁴ Although much of this is likely to be from sales after the relevant dates, it is unlikely that such business materialised overnight. That said, according to the 2025 report on the organic market produced by the Soil Association, the total organic food and drink market in the UK was worth £3.4billion in 2023 and £3.7billion in 2024.²⁵ In this context, the turnover figures, such as they are, suggest that Biona products only held a small share of the market. Only one invoice has been provided, meaning that it is difficult to determine how intensive, geographically widespread, or longstanding use of the marks has been. The evidence of the amounts expended on advertising and social media advertising is imprecise. The survey evidence is flawed for the reasons already given.

38. However, the evidence does indicate that the Biona brand was established over 30 years ago and the applicant's first mark has been used for a number of years in connection with organic food products, which are stocked in some major supermarkets. Ms Berger's unchallenged narrative evidence is that the brand and its products won several awards prior to the relevant date. The Biona website had approximately 12,000 organic visits each month around the relevant dates, and the brand was searched in the UK at least 25,000 times each month for around three years prior to the relevant dates. The turnover figures are not economically insignificant, and *This Is Money* described Biona the year after the relevant dates as being synonymous

²³ This figure includes instances where the respondent may have misspelt 'Biona'.

²⁴ The latter figure is an approximation based on Ms Berger having used two different currencies when providing the combined figure for 2024. I have not calculated a precise figure; any such calculation is unlikely to be correct, given that exchange rates vary over time and none has been provided for 2024.

²⁵ Exhibit DB1, pages 265-296

with the organic market. I have strong reservations as to whether the evidence is sufficient for the purposes of the present assessment. Nevertheless, bearing in mind these aspects of the evidence, and for reasons that will become apparent, I will proceed on the basis that the distinctive character of the applicant's first mark had been enhanced to a high level at the relevant dates for all the goods relied upon.

Comparison of trade marks

39. It is clear from *Sabel BV v Puma AG*, Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This 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. In *Bimbo SA v OHIM*, Case C-591/12P, the CJEU stated (at paragraph 24 of its judgement) 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.”

40. Therefore, it would be wrong to artificially dissect the marks. However, 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 hence contribute to the overall impressions created by the marks.

41. The marks to be compared are as follows:

The applicant's first mark	The proprietor's first mark
	
	The proprietor's second mark 

Overall impressions

42. The applicant's first mark is a composite mark. At its centre appears the word 'biona' in a basic typeface. Underneath is the word 'ORGANIC', also in a basic typeface. Surrounding the word elements are a range of food-related silhouette devices which form a rough circle. Due to its relative size and positioning, as well as it being an invented word, the overall impression of the mark is dominated by the word 'biona'. The devices also provide a contribution. However, given that they pictorially describe or strongly allude to the goods at issue and form a decorative surround to the

words, they play a lesser role. The word 'ORGANIC' describes or strongly alludes to the goods at issue and appears in a smaller font than the word 'biona'. Any contribution that it makes to the mark is minimal. The typeface is unremarkable and the colour purely decorative; these elements also play a minimal role in the overall impression.

43. The proprietor's marks are each a series of four composite marks. In *Thomas Pink Limited v Victoria's Secret UK Limited* [2014] EWHC 2631 (Ch), Birss J (as he then was) provided the following guidance:

"104. [...] When faced with a series mark it is necessary to bear in mind that there is only a single registered trade mark. All the instances in the series are manifestations of the same mark. So in order, for example, to carry out a comparison with a sign so as to assess infringement, it is necessary to work out what the single registered mark is so as to provide a single point of comparison with the sign alleged to infringe."

44. Each manifestation of the proprietor's first mark contains the following identical elements: the word 'GEO' above the smaller word 'ORGANICS', both surrounded by devices. The manifestations differ from one another in the particular colours used for the devices. In manifestations one, three and four, the top two thirds of the devices are presented in a gold/beige colour, whereas the bottom thirds are presented in black, green and red, respectively. In the second manifestation, the top half of the devices are grey and the bottom half are black. In my view, the single registered mark consists of the word 'GEO' above the smaller word 'ORGANICS', both surrounded by devices, the top two thirds/half thereof being a different colour than the bottom third/half.

45. Turning to the overall impression, at the centre of the mark appears the word 'GEO'. Underneath is the word 'ORGANICS'. Surrounding the words are a number of devices. Mr Marshall submitted that these will be seen as leaves. I do not agree. They do not obviously present as such and arriving at such a conclusion would, to my mind, involve a level of analysis which is not typically undertaken by the average consumer when encountering trade marks. In my view, the devices will simply be seen as shapes, which combine to form a two-colour geometric pattern. The overall impression of the mark is dominated by the word 'GEO'; it is the most distinctive word and appears

at the centre of the mark in the largest font. The word 'ORGANICS' describes or strongly alludes to the goods at issue and is presented in a smaller font. It, therefore, plays a much lesser role. The geometric pattern operates as a decorative surround to the words and, whilst still contributing, plays a lesser role in the overall impression. The typeface is unremarkable and the two colours used in the surround are purely decorative; these elements play a minimal role in the overall impression.

46. As for the proprietor's second mark, each manifestation contains the following identical elements: the word 'GEO' surrounded by devices. The manifestations, again, differ from one another in the particular colours in which the devices are presented. In the first manifestation, the top half of the devices are grey and the bottom half are black. In the second, third and fourth manifestations, the top half of the devices are gold/beige and the bottom half are black, green and red, respectively. I consider that the single registered mark consists of the word 'GEO' surrounded by devices, the top half thereof being a different colour to the bottom half.

47. At the centre of the mark appears the word 'GEO'. Surrounding the words are a number of devices. My comments above about the way in which the devices will be perceived are equally applicable here; they will be seen as shapes which combine to form a two-colour geometric pattern. Due to it being the most distinctive element and appearing at the centre of the mark, the word 'GEO' dominates the overall impression of the mark. The geometric pattern also provides a contribution but acts as a decorative surround for the word and, as such, plays a lesser role. As the typeface is unremarkable and the two colours used in the surround are purely decorative, these elements play a minimal role in the overall impression.

Visual comparisons

The applicant's first mark and the proprietor's first mark

48. The competing marks have some visual similarity on the basis that they are both roughly round and contain word elements at their centres surrounded by device elements. The competing marks are also visually similar insofar as they contain the highly similar words 'ORGANIC' and 'ORGANICS'. However, I bear in mind that these

words play much lesser roles in the respective overall impressions, being descriptive/strongly allusive of the goods at issue. The typefaces in the competing marks are similar, if not the same. However, as they are basic typefaces which play a minimal role in the respective overall impressions, this does not represent a significant point of visual similarity between the competing marks. The position in respect of colour is, effectively, neutral; the protection afforded to the proprietor's mark does not extend to any of the specific colour combinations shown. This means that some of the devices in the proprietor's mark could be presented in the same (or a similar) colour as those in the applicant's mark, but they could also be presented in entirely different colours. The competing marks visually diverge in that their dominant elements are different words, overlapping only in the use of the letter 'o'. The devices used in the surrounds are also different. Bearing in mind my assessment of the overall impressions, I find that there is a low degree of visual similarity between the competing marks.

The applicant's first mark and the proprietor's second mark

49. These competing marks share many of the same visual similarities and differences as the applicant's first mark and the proprietor's first mark. However, the proprietor's second mark does not contain the word 'ORGANICS', which contributed towards the degree of similarity in the comparison already conducted. Although that element plays a much lesser role in the proprietor's first mark, the absence of it here reduces the degree of similarity between the marks under consideration. To my mind, there is only a very low degree of visual similarity between the competing marks.

Aural comparisons

The applicant's first mark and the proprietor's first mark

50. Since the words 'ORGANIC' and 'ORGANICS' in the competing marks are descriptive/strongly allusive, I am not entirely convinced that they would be

pronounced by the average consumer.²⁶ However, since it represents the applicant's best case, I will proceed on the basis that they would. In this connection, the applicant's mark is likely to be articulated as "BYE-OH-NA-OR-GAN-IC" and the proprietor's mark as "GEE-OH-OR-GAN-ICS". The competing marks are similar in length, comprising six and five syllables, respectively. The words 'ORGANIC' and 'ORGANICS' are nearly identical, though I bear in mind that they play much lesser roles in the respective overall impressions. The competing marks also aurally coincide in their identical second syllables. The remaining syllables are different. Overall, I find that there is between a low and medium degree of aural similarity between them.

The applicant's first mark and the proprietor's second mark

51. As the proprietor's second mark does not include the word 'ORGANICS', these competing marks only aurally coincide in their identical second syllables. The applicant's mark is also significantly longer than the proprietor's mark, consisting of six and two syllables, respectively. On this basis, I find that there is a low degree of similarity between the competing marks.

Conceptual comparisons

The applicant's first mark and the proprietor's first mark

52. As explained above, the word 'biona' in the applicant's first mark is likely to be perceived as an invented word which is loosely evocative of life and living things. The word 'ORGANIC' will be readily understood as an indication that the goods sold under the mark have been produced without the use of artificial chemicals. The devices convey the concept of food and food production, depicting items of natural produce and gardening equipment. As for the proprietor's first mark, the word 'GEO' is likely to convey the same meaning to the average consumer as the prefix 'geo-', which means of or relating to the earth.²⁷ In my view, it will be seen in this way, even though it is not being used as a prefix. The word 'ORGANICS' will be understood as referring to things

²⁶ See the comments of Phillip Johnson, sitting as the Appointed Person, in *Enrich International Ltd v Onyinye Udokporo*, BL O/1141/25, paragraphs 13-18.

²⁷ <https://dictionary.cambridge.org/dictionary/english/geo>

which are organic, i.e. produced without the use of artificial chemicals. The devices do not convey any particular concept; they combine to form a geometric pattern. The competing marks are conceptually similar insofar as they both refer to things which are organic. However, I remind myself that the words 'ORGANIC' and 'ORGANICS' play much lesser roles in the respective overall impressions. Whilst it could be argued that the competing marks both evoke nature or the natural world through the meanings of 'bio-' and 'GEO', that association exists only at a very high level of generality. In my view, the link between those meanings is too tenuous to materially contribute to the conceptual similarity between the marks. Taking all the above into account, I find that there is a low degree of conceptual similarity between the competing marks.

The applicant's first mark and the proprietor's second mark

53. My comments regarding the applicant's first mark, as well as the word 'GEO' and the devices in the proprietor's first mark, are equally applicable here. The proprietor's second mark does not include the word 'ORGANICS', which was the sole basis of my finding that the applicant's first mark and the proprietor's first mark were conceptually similar. There is no conceptual similarity between the applicant's first mark and the proprietor's second mark.

Likelihood of confusion

54. 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 vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's first mark, the average consumer for the goods 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.

55. 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 down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By Back Beat Inc*, 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 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).”

56. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.²⁸ However, indirect confusion has its limits; 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.²⁹ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.³⁰

57. Having proceeded on the basis that all the goods at issue are identical, I further concluded that:

- The average consumer is a member of the general public, who will demonstrate between a low and medium level of attention during the purchasing process;
- The purchasing process will be predominantly visual in nature, though aural considerations have not been excluded;
- The applicant’s first mark possesses between a medium and high level of inherent distinctive character;
- I have proceeded on the basis that the distinctiveness of the applicant’s first mark has been enhanced to a high level through use;
- The overall impression of the applicant’s first mark is dominated by the word ‘biona’;

²⁸ 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.

²⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

³⁰ *Liverpool Gin Distillery*, paragraph 13

- The overall impressions of the proprietor's marks are dominated by the word 'GEO';
- The applicant's first mark and the proprietor's first mark are visually similar to a low degree, aurally similar to between a low and medium degree, and conceptually similar to a low degree;
- The applicant's first mark and the proprietor's second mark are visually similar to a very low degree, aurally similar to a low degree, and conceptually dissimilar.

58. Before proceeding with the global assessment, I note that Ms Berger has introduced evidence of what she refers to as similarity and confusion between the competing marks. She describes how employees of the applicant attended a trade show in Birmingham between 29 April 2024 and 1 May 2024, at which several of its customers attended its stand to comment on the similarities between the parties' branding. A representative of the proprietor allegedly had a similar experience.³¹ On 19 June 2024, Ms Berger says that she received an email from the applicant's biggest retail customer. A heavily redacted copy of the email has been provided.³² The customer describes the proprietor's branding as "*very identical*" to the applicant's and says that they "*first thought it was Biona*". According to Ms Berger, other customers have since made similar comments.

59. At the hearing, Mr Marshall confirmed that the above was not being relied upon as evidence of actual confusion but, rather, examples of trade consumers considering the similarities between the marks sufficiently significant to raise the matter with the applicant. Firstly, much of Ms Berger's evidence on the issue is hearsay, and it would have been reasonable and practicable for the individuals involved (the applicant's own employees, at the very least) to have produced their own witness evidence. Even setting this issue aside, and taking the views of those individuals as expressed in Ms

³¹ In his statement, however, Mr Yadlapalli denies speaking to anyone at the applicant's stand, states that none of the proprietor's team mentioned having any discussions with the applicant's representatives about branding, and states that no one mentioned any similarities between the parties' marks to him at the trade show.

³² Exhibit DB1, page 39

Berger's statement at face value, I place no weight on this evidence in the assessment which follows. The question of whether there is a likelihood of confusion must be assessed objectively from the perspective of the notional average consumer. The comments relied upon, including in the email, represent the opinions of a small number of individuals and provide no reliable basis upon which to assess how the average consumer would perceive the competing marks. Nor is there any basis upon which it would be reasonable to conclude that those individuals are representative of the relevant public. How similar the competing marks are and whether there is a likelihood of confusion are, ultimately, matters for the Tribunal. On the basis of the comments that were made, it does not seem as though any of the individuals were confused in any event. Rather, they were simply noticing the similarities, which did not appear to be sufficient for them to either mistake the marks for one another or believe that there was an economic connection between the parties.

60. Moreover, I reject Mr Marshall's argument that I should essentially infer that the proprietor has "*sought to emulate*" the applicant's marks and that this should be taken into account in some way. This was argued on the basis that Mr Yadlapalli makes no attempt to explain how the proprietor's marks were designed or expressly state that they were created without reference to the applicant's mark. However, as Mr Edwards submitted, this was not a point raised in the applicant's pleadings. In any event, the proprietor's motives do not form part of the legal test under section 5(2)(b). The proprietor was not obliged to explain how it came up with the marks. Even if it was established that the proprietor had adopted aspects of the applicant's mark when designing its marks, the question before me is whether, assessed objectively from the perspective of the average consumer, there is a likelihood of confusion between the competing marks. That assessment must be based upon the relevant factors identified in the authorities and outlined above.

61. In addition, Mr Marshall submitted that the average consumer will encounter the competing marks in online supermarket listings, where the products are presented in thumbnail-sized images. I accept that smaller images of products on websites is a real way in which the average consumer may come across the competing marks and that some of the finer detail in the marks may be less visible as a result. However, I do not consider it appropriate to place significant weight on this factor in the assessment

which follows, or to use it as a basis for concluding that the average consumer is unlikely to perceive any differences between the competing marks. The assessment must be made between the marks themselves through the eyes of the average consumer. Although the average consumer may encounter smaller reproductions of the marks in certain contexts, the assessment should not, in my view, be conducted on the basis of circumstances where the marks are displayed at such a reduced size that their elements cannot be properly appreciated. To do so would, in my view, risk excluding elements of the marks which the average consumer is capable of perceiving when encountering them in the ordinary course of trade.³³

62. Turning to the global assessment, I will first consider the applicant's first mark and the proprietor's first mark. I acknowledge that the competing marks are both roughly round with word elements in the middle, contain the highly similar words 'ORGANIC' and 'ORGANICS', and that a proportion of the devices in the proprietor's first mark could be presented in the same, or a similar, colour as those in the applicant's first mark. I also accept that the parties' goods are assumed to be identical and that the distinctiveness of the applicant's first mark is assumed to have been enhanced to a high level. Nevertheless, 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, even paying a lower level of attention, to distinguish between the competing marks and avoid mistaking one for the other. The overall levels of similarity between the marks are low. The elements which produce the similarity play lesser roles in the respective overall impressions: 'ORGANIC' and 'ORGANICS' describe/strongly allude to the goods at issue, the devices serve as decorative surrounds for the words (and have descriptive/allusive qualities in the applicant's first mark), the colours are purely decorative, and the typefaces are unremarkable. The distinctive and dominant elements of the marks, namely the words 'biona' and 'GEO', are, aside from one letter, entirely different. I consider it highly unlikely that these elements will be overlooked, misremembered or imperfectly recalled as one another. To the contrary, it is my view that these are the elements which will be retained in the mind of the average consumer and used to recall the marks. Even in circumstances where the competing marks are

³³ See also, by analogy, the comments of Professor Johnson, again sitting as the Appointed Person, in *Puma SE v Huma Irfan Limited*, BL O/1146/23.

shown in smaller images on websites, to my mind, the difference created by the diverging dominant word elements will be readily appreciated. Consequently, even taking into account the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

63. Furthermore, having regard to all the above factors, I do not believe that the average consumer will assume that the parties are economically linked undertakings on the basis of the competing marks. Whilst the applicant's first mark is assumed to be highly distinctive, factually, the distinctive character of the mark overwhelmingly lies in the word 'biona'. This element has no counterpart in the proprietor's first mark. As such, even if the average consumer assumed that no other undertaking would be using the word 'biona' in a trade mark, that does not assist the applicant; there is no sharing of a common element which is strikingly distinctive. The competing marks do share the highly similar words 'ORGANIC' and 'ORGANICS', but they describe/strongly allude to the goods. In addition, the competing marks both use device elements to form roughly circular surrounds to the words, some of which may be presented in the same colour. However, these elements play lesser, decorative roles, and the devices in the applicant's first mark have descriptive/allusive qualities. In my view, the average consumer is unlikely to perceive these points of similarity as indicating an economic connection. Rather, the average consumer is likely to perceive them as coincidental, i.e. separate undertakings informing consumers that their goods are organic and using device and colour elements as decorative embellishments. Additionally, the differences between the competing marks are not simple additions/removals of non-distinctive elements. To the contrary, the dominant and distinctive element of each mark has been changed. Moreover, the differences between the competing marks do not appear to be consistent with any logical brand extension or rebrand. Although altering decorative embellishments and using the plural/singular forms of the word 'ORGANIC' interchangeably could be perceived by the average consumer in this way, I can see no reason why an undertaking would remove the dominant and distinctive element of its mark and replace it with an entirely different word. In light of all this, I conclude that there is no likelihood of indirect confusion, even in respect of identical goods and even where the average consumer pays a lower level of attention. I also confirm that this finding applies in respect of circumstances where the marks are presented in smaller images on websites.

64. I should add that I have not been persuaded by Mr Marshall's submission that the applicant "*already has a trade mark denoting a brand extension*", that being its second mark. Whilst the applicant's second mark may be an extension of its first, the basis for the marks at issue being perceived as brand extensions of one another still needs to be logical. I do not have any difficulty in appreciating how the applicant's second mark could be seen as an extension of its first: it reproduces the applicant's mark in full, crucially retaining the dominant and distinctive word 'biona', and adds the words 'LITTLE FOODIES', which allude to the goods being for children. However, the proprietor's first mark does not include the word 'biona' (or a sufficiently similar word). The dominant and distinctive element of the mark has been replaced with another, i.e. the word 'GEO'.

65. The proprietor's second mark is even less similar to the applicant's mark than its first. As I have already outlined, it does not include the word 'ORGANICS', which produced the conceptual overlap between the marks already considered and contributed to their visual and aural similarities. All other factors are equal. For the same reasons, and the additional reason that there is no common 'ORGANIC'/'ORGANICS' element, I find that there is no likelihood of direct or indirect confusion between the applicant's first mark and the proprietor's second mark.

Conclusion

66. The applicant's claims under section 5(2)(b) are dismissed.

Section 5(4)(a)

Legislation and case law

67. Section 5(4)(a) of the Act states as follows:

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

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

(aa) [...]

(b) [...]

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

68. Subsection (4A) of section 5 states:

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

69. 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).”

70. As no evidence of use of the proprietor's marks has been filed, the relevant dates for the purposes of the applicant's claims are the filing dates of the proprietor's marks, namely 17 March 2023 and 18 July 2023.³⁴

Goodwill

71. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (at 223-224):

“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.”

72. I proceeded under section 5(2)(b) on the basis that genuine use and enhanced distinctive character had been demonstrated for all the goods in the specification of the applicant's first mark. Whilst I have my concerns regarding the sufficiency of the evidence, for reasons that will become apparent, I will also proceed on the basis that the applicant's business distinguished by a sign identical to its first mark had accrued a strong goodwill by the relevant dates for all the goods relied upon.

Misrepresentation

73. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

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

³⁴ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, paragraph 43

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

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

74. Later in the same judgment, it was stated that:

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

75. In my view, the present ground takes the applicant no further than its section 5(2)(b) ground. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.³⁵ This is because they are both

³⁵ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

76. I have already found that there is no likelihood of confusion between the proprietor's marks and a registered mark identical to the sign relied upon under this ground. For the same reasons as given in my global assessment under section 5(2)(b), I do not consider that a substantial number of the relevant public will be deceived into purchasing the proprietor's goods in the mistaken belief that they are the goods of the applicant. In short, the proprietor's marks are not sufficiently similar to the applicant's sign for misrepresentation to occur, notwithstanding the level of assumed goodwill, the distinctiveness of the applicant's sign, the assumed identity of the goods, and the relevant public paying a lower level of attention when purchasing those goods.

Conclusion

77. The applicant's claims under section 5(4)(a) are dismissed.

OVERALL OUTCOME

78. The applications for invalidation under sections 5(2)(b) and 5(4)(a) of the Act have failed. Subject to any appeal against this decision, the proprietor's marks will remain registered in the UK.

COSTS

79. The proprietor has been successful and is entitled to a contribution towards its costs. It is common ground that any costs award should be based upon the usual scale. For these proceedings, the relevant scale is that published in Tribunal Practice Notice ("TPN") 1/2023.

80. At the hearing, Mr Edwards submitted that costs ought to be awarded at the upper end of the scale. The reasons for this were included in his skeleton argument, namely (i) that the applicant's evidence was over the ordinary 300-page limit, (ii) that Exhibit

DB1 was inadequately presented, and (iii) the applicant repeatedly failed to copy in the proprietor's representatives when corresponding with the Tribunal.

81. I note that the applicant's (admissible) evidence consisted of a 15-page witness statement and a 296-page exhibit. In combination, it is true that this goes over the 300-page limit for evidence in chief. However, it only does so by 11 pages and would not, in my view, have caused the proprietor a great deal of additional work than if the page limit was strictly adhered to. The evidence was not especially voluminous. That said, I appreciate Mr Edwards' comments about the way in which the applicant elected to present its evidence. As outlined previously, the evidence was rather unfocused and difficult to follow. All the documentary evidence was presented in a single exhibit and did not appear to follow any logical order. Many of the references in Ms Berger's statement to parts of it did not seem to be correct. All this means that it would have taken the proprietor longer than was necessary to review the evidence (as it did the Tribunal). I will bear this in mind in making an award for that activity.

82. There is also some force in Mr Edwards' complaint regarding the applicant's failure to copy the proprietor into its correspondence with the Tribunal. I note that this occurred during the evidence rounds. It was raised, on more than one occasion, by the proprietor, and additional correspondence was required to resolve the situation. It also created additional work for the Tribunal, including the issuing of two separate reminders to the applicant. The importance of copying correspondence to the other party in proceedings is clearly explained in, *inter alia*, the Tribunal section of the Manual of Trade Marks Practice. The requirement applies to all parties, including the applicant, who I also note has been professionally represented throughout these proceedings. No explanation has been provided at any time for failing to copy its correspondence to the proprietor. I will bear this in mind when making an award for the preparation and consideration of evidence.

83. Taking the above and the guidance in the TPN into account, I award the proprietor costs on the following basis:

Considering the applicant's statements and preparing counterstatements ³⁶	£600
Preparing evidence and considering the applicant's evidence	£1,400
Preparing for and attending a hearing ³⁷	£600
Total	£2,600

84. I order Windmill Organics Limited to pay Venture Foods (UK) Limited the sum of **£2,600**. 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 6th day of August 2026

James Hopkins
For the Registrar

³⁶ This award includes a contribution towards the cost of reviewing a statement and preparing a counterstatement in each of the two invalidation actions. I have accounted for a degree of duplication across them.

³⁷ The hearing lasted only 1.5 hours. However, I bear in mind that Mr Marshall and Mr Edwards both filed detailed skeleton arguments in advance of the hearing.