

O/0011/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTERS OF

UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1605912

UK TRADE MARK REGISTRATION NO. 3341823

UK TRADE MARK REGISTRATION NO. 917962980

IN THE NAME

OF

RIPPLE FOODS, PBC

AND

UK TRADE MARK REGISTRATION NO. 1029283

UK TRADE MARK REGISTRATION NO. 900001644

UK TRADE MARK REGISTRATION NO. 912348934

UK TRADE MARK REGISTRATION NO. 1336468

IN THE NAME

OF

MARS WRIGLEY CONFECTIONERY UK LIMITED

AND

CONSOLIDATED OPPOSITION/CANCELLATION NOS.

505180, 505181, 505183, 505571, 505572, 505576 AND 436081

Background and Pleadings

1. There are seven actions involved in these consolidated proceedings, namely four revocation actions based on non-use, two invalidation actions and an opposition.

Revocation Actions under nos. 505180, 505181, 505183 and 505576

2. On 22 July 2022 and 22 November 2022, Ripple Foods PBC (“RFP”), filed four applications to revoke UK trade marks in the name of Mars Wrigley Confectionery UK Ltd (“Wrigley”), as set out below, on the grounds of non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”).¹

(i) UKTM no. 1029283

(“the ‘283 mark”)

RIPPLE

Filed and registered on 10 May 1974, for goods in class 30.

(ii) UKTM no. 900001644

(“the 644 mark”)

RIPPLE

Filed on 1 April 1996 and registered on 20 January 1999, for goods in classes 29, 30 and 32.

(iii) UKTM no. 912348934

(“the 934 mark”)



Filed on 27 November 2013 and registered on 11 April 2014, for goods in classes 29 and 30.

(iv) UKTM no. 1336468


(“the 468 mark”)

¹ The specifications for each mark are set out in full in Annex 1 attached to this decision.

RIPPLE

Filed on 24 February 1988 and registered on 6 September 1991, for goods in class 30.

3. Under section 46(1)(a) RFP claims non-use in each of the five year periods following the date on which each mark was registered and under section 46(1)(b) further periods of non-use, all the dates of which are set out in the following table:

Mark		Periods 46(1)(a) and (b)
'283 mark	RIPPLE	<p><u>46(1)(a)</u> 11 May 1974 to 10 May 1979; Effective revocation date: 11 May 1979.</p> <p><u>46(1)(b)</u> 22 July 1983 to 21 July 1988; 22 July 2012 to 21 July 2017; 22 July 2017 to 21 July 2022; Effective dates of revocation 22 July 1988, 22 July 2017 and 22 July 2022.</p>
'644 mark	RIPPLE	<p><u>46(1)(a)</u> 21 January 1999 to 20 January 2004; Effective revocation date: 21 January 2004.</p> <p><u>46(1)(b)</u> 22 July 2004 to 21 July 2009; 22 July 2012 to 21 July 2017; 22 July 2017 to 21 July 2022; Effective dates of revocation 22 July 2009, 22 July 2017 and 22 July 2022.</p>
'934 mark		<p><u>46(1)(a)</u> 12 April 2014 to 11 April 2019; Effective revocation date: 12 April 2019.</p> <p><u>46(1)(b)</u> 22 July 2015 to 21 July 2020; 22 July 2016 to 21 July 2021; 22 July 2017 to 21 July 2022;</p>

		Effective dates of revocation 22 July 2020, 22 July 2021 and 22 July 2022.
'468 mark	RIPPLE	<u>46(1)(a)</u> 7 September 1991 to 6 September 1996; Effective revocation date: 7 September 1996. <u>46(1)(b)</u> 22 November 1996 to 21 November 2001; 22 November 2012 to 21 November 2017; 22 November 2017 to 21 November 2022; Effective dates of revocation 22 November 2001, 22 November 2017 and 22 November 2022.

4. Wrigley filed a defence and counterstatement in each proceeding, defending use of each of its trade marks in the periods claimed.

Opposition proceedings no. 436081

5. On 3 January 2022, RFP sought designation of the International Registration no. 1605912 in the UK for its trade mark RIPPLE (“the ‘912 mark”) in classes 29, 30 and 32.² On 5 September 2022, Wrigley opposed the designation under sections 5(1), 5(2) and 5(3) of the Act, relying on its aforementioned ‘283 mark, ‘644 mark, ‘934 mark and ‘468 mark registrations.

6. RFP filed a defence and counterstatement putting Wrigley to strict proof of each of its claims and seeking proof of use of each of its trade mark registrations for all the goods relied upon.

Invalidation actions under numbers 505571 and 505572

7. On 28 November 2022, Wrigley issued invalidation proceedings against RFP’s trade marks as set out below³:

- (i) UKTM 3341823
- (“the ‘823 mark”)

² As set out in full in Annex 2 attached hereto.

³ The specifications are set out in full in Annex 2 attached to this decision.



Filed on 28 September 2018 and registered on 21 June 2018 in relation to goods in classes 29 and 32.

(ii) UKTM no. 917962980

("the '980 mark")



Filed on 28 September 2018 and registered on 12 June 2019 for goods in classes 29 and 30.

8. Wrigley's invalidation action is brought under sections 5(2)(b) and 5(3) of the Act relying on each of its trade mark registrations numbered '283, '644, '934 and '468 as aforesaid.

9. RFP filed a defence and counterstatement putting Wrigley to strict proof of each of its claims and seeking proof of use for each of the trade mark registrations for the goods relied upon.

10. RFP further claims as its primary position that Wrigley is precluded from bringing any cancellation actions against it, relying on a purported settlement agreement entered into by the parties in or around May 2019. It claims that Wrigley consented to RFP's registrations and the settlement agreement included a clause which prevented Wrigley from issuing cancellation proceedings provided certain conditions were met. RFP claims that those conditions have not been breached and therefore there is no basis for Wrigley bringing any invalidation action against it.

Representation

11. Wrigley is represented by Stobbs LLP and RFP is represented by Abion UK Ltd⁴. Both parties filed evidence. A hearing was requested which took place before me on 5 June 2024 by video conference. At the hearing Mr Julius Stobbs appeared for

⁴ previously Lane IP.

Wrigley and Mr Sam Carter (counsel) instructed by Abion UK Ltd appeared for RFP. Both parties filed skeleton arguments in advance of the hearing.

Relevance of EU law

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence and submissions

13. Wrigley's evidence consists of:

(i) the witness statement of Kerry Cavanaugh dated 23 November 2022 together with 45 exhibits marked KC1-45. Mr Cavanaugh is the "CBU Director UK" of Wrigley a position he has held for over 4 years, although he has worked for the company since 2014. His evidence is taken from his own personal knowledge and from records, data and documents held by Wrigley. He confirms that Wrigley and Mars Food Ireland Ltd are subsidiaries of Mars Incorporated. His statement serves to demonstrate the use of the RIPPLE brands across the various periods and to show the reputation held by Wrigley; and

(ii) the witness statement of Catherine Byfield dated 8 March 2023, together with 5 exhibits marked CB1-CB5. Ms Byfield is a trade mark attorney in the employ of Stobbs IP Limited, Wrigley's representative. Her evidence consists of (a) the results of searches she conducted to identify chocolate brands who offer chocolate as well as other food and beverage goods, (b) examples of confectionery brands collaborating with other food and beverage brands, (c) examples of Wrigley's expansion into other product ranges and (d) details of brands (including Wrigley) who produce vegan alternatives to their dairy products.

14. RFP's evidence consists of the witness statements of Robert Snell dated 9 March 2023 and 17 July 2023 respectively, accompanied by four exhibits marked RS1, and RS1(no.2)-RS3(no.2). Mr Snell is a chartered trade mark attorney and senior associate previously under the employ of Lane IP (now Abion UK Ltd), RFP's representative. His evidence serves to exhibit a copy of the purported settlement

agreement between the parties, dated 16 May 2020 and various correspondence resulting from the same.

15. Neither party filed submissions during the evidence rounds.

16. Given the considerable overlap in the issues to be determined in these consolidated proceedings, I shall summarise the various witness statements to the extent they are necessary when dealing with the relevant parts of the proceedings to which the evidence relates. Suffice to say I have taken into account all the material filed by both parties in coming to my decision but shall only refer to the salient points as appropriate.

17. I shall deal with the revocation action first as this will impact and/or limit the extent of the earlier rights that Wrigley may rely upon in the opposition and invalidation proceedings. Thereafter, I consider that it is appropriate to deal with the opposition next and lastly with the invalidation action. In so far as the invalidation action is concerned, the other revocation and opposition proceedings are not dependent on the outcome of this decision and therefore if RFP succeeds in relation to its primary position in defending the action based on breach of contract/estoppel, then Wrigley's invalidation action will fall away without any need for further consideration.

Decision

Revocation proceedings

18. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

19. As some of Wrigley's marks are comparable marks, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the ‘five-year period’) has expired before IP completion day-

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

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

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.”

20. Section 100 is also relevant, which reads:

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

General Principles

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

22. Proven use of a mark which fails to establish that the commercial exploitation of the trade mark is real because the use would not be viewed as warranted in the economic sector concerned to create or maintain a market for the goods and services at issue is, therefore, not genuine use.⁵ In making the required assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

Relevant Periods and My Approach

23. I remind myself that there are multiple relevant periods for each mark in these proceedings as set out at paragraph 3. Whilst the relevant periods differ, section 46(3) of the Act (which is reproduced above) states that the registration of a trade mark shall not be revoked if genuine use is resumed or commenced prior to a period of three months before the date of the application for revocation. Therefore, it can be said that so long as use is provided for the lattermost relevant period (but not the earlier relevant periods), each mark will survive revocation in respect of all relevant periods based on the later use. Both parties conceded that given the wording of section 46(3) and the possibility of resumption of use, I should focus my attention initially on the later of the relevant periods claimed (“the fourth relevant period”) for each mark namely:

- (i) 22 July 2017 to 21 July 2022 for the ‘283, ‘644 and ‘934 marks; and

⁵ *Nike Innovate CV v Intermar Simanto (Jumpman)* O/222/16 Daniel Alexander sitting as the Appointed Person on appeal.

(ii) 22 November 2017 to 21 November 2022 for the '468 mark.

24. At the outset Mr Carter on RFP's behalf conceded that Wrigley had demonstrated genuine use of all the aforementioned marks for *chocolate/s* and *cake/s* during the fourth relevant period. In light of this concession, I need not consider whether Wrigley has demonstrated genuine use in relation to these goods in any of the other periods claimed. Mr Carter, however, submitted that in terms of the evidence filed, these goods represent a fair specification of the use shown by Wrigley overall.

25. Wrigley claims that it has demonstrated use for a broader set of goods than those conceded by RFP (as outlined below) and so it will be necessary for me to consider the evidence of use in relation to these goods not only in the lattermost period but also if necessary in the preceding periods as this may impact the goods upon which Wrigley may rely for the purposes of its opposition and invalidation claims. I shall, therefore, also consider use in the following periods for these goods ("the third relevant periods"):

(i) 22 July 2012 to 21 July 2017 for the '283 and '644 marks;

(ii) 22 July 2016 to 21 July 2021 for the '934 mark;

(ii) 22 November 2012 to 21 November 2017 for the '468 mark.

26. The broader set of goods as outlined by Mr Stobbs include:

'283 Mark

Class 30: Non-medicated confectionery but not including ice cream, frozen confections containing cream, water ices, ice cream confections or water ice confections and not including preparations for making or coating any of these excluded goods.

'644 Mark

Class 29: dairy products; chilled desserts.

Class 30: cereal preparations; cocoa; drinking chocolate; non-medicated confectionery; cakes; frozen confections; chilled desserts; chocolate based drinks; chocolates, chocolate.

'934 Mark

Class 29: milk and milk products; dairy products; products prepared for consumption and consisting primarily of the aforesaid goods.

Class 30: cocoa; preparations made from cereals; confectionery; drinking chocolate; cakes; chocolate; ice cream; frozen confectionery; products prepared for consumption and consisting primarily of the aforesaid goods.

'468 Mark

Class 30: cereal preparations, all for food for human consumption; cocoa, non-medicated chocolate confectionery, none being frozen.

27. Mr Stobbs on Wrigley's behalf also accepted that no use had been shown across any of the periods for a range of goods as set out below.⁶ These goods shall, therefore, be revoked from the earliest date from which revocation can take effect, which in each case is the day following the fifth anniversary of completion of the registration procedure of each mark.

28. The goods for which it was conceded that no use had been shown are:

'644 Mark

Class 29: Meat, fish, poultry and game, sea foods; fruit and vegetables, all being preserved, dried, cooked or processed; eggs; preparations made from all the aforesaid goods; soups; mousses; edible oils and fats; jams and jellies; salads; drinks made from dairy products; sweet spreads, savoury spreads; fillings, snack foods; prepared meals, semi-prepared meals, constituents for meals, proteinaceous substances, dips; all included in Class 29.

Class 30: Rice, pasta; cereals; tea, coffee; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; pastries; biscuits; frozen yoghurt; mousses, sorbets; bread; pastry; coffee based drinks, fillings; sweet spreads, savoury spreads, snack foods, prepared meals, semi-prepared meals, constituents for meals;

⁶ As per Annex A attached to his skeleton arguments and as outlined in the hearing.

dressings; sauces; pizzas, pizza bases, sauces and toppings for pizzas; sauces for pasta and rice, salad dressings; mayonnaise; dips; all included in Class 30.

Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; aerated water; beer; essences for making beverages; extracts of hops for making beer; fruit juice/ fruit juices; ginger beer / ginger ale; grape must [unfermented]; lemonades; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; must; non-alcoholic beverages; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; orgeat; pastilles for effervescing beverages; powders for effervescing beverages; preparations for making aerated water; preparations for making beverages; preparations for making liqueurs; preparations for making mineral water; sarsaparilla [soft drink]; seltzer water; soda water; sorbets beverages/ sherbets [beverages]; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages; none of the afore-mentioned goods including beer wort.

'934 Mark

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk drinks; products prepared for consumption and consisting primarily of the aforesaid goods.

Class 30: Coffee, tea and artificial coffee; rice; tapioca and sago; flour; bread; pastry; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; coffee substitutes; cereal bars; pasta; noodles; biscuits; pesto; products prepared for consumption and consisting primarily of the aforesaid goods.

'468 Mark

Class 30: Rice, pasta; cereals, all for food for human consumption; tea, coffee, coffee essence, coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; bread biscuits; all included in Class 30.

Assessment of Wrigley's evidence

29. In terms of Wrigley's evidence, I note that Mr Cavanaugh's witness statement consists of:

- (i) The history of the Ripple brand, having been launched in the UK in 1969;⁷
- (ii) The range of products offered under the Ripple brand during the fourth relevant period to include chocolate, confectionery and chocolate cakes;⁸
- (iii) Use of Ripple between 2014 and 2017 in respect of 'hot chocolate powder' with UK retail sales value figures during this period amounting to £500,000;⁹
- (iv) Use of Ripple for 'dessert pots' (consisting of a chocolate sauce and chocolate mousse) between 2013 and 2014 with net sales in the UK (to include Ireland) over this period of £218,000;
- (v) Use of the marks between 2015 and 2017 (ending on 7 February 2017) in respect of the Galaxy Ripple Mcflurry ice cream dessert in collaboration with McDonald's, with UK net sales value in excess of £1.4million;¹⁰
- (vi) Use of the marks between 2017 and 2021 in respect of various confectionery products including single pack chocolate bars, multipack chocolate bars, chocolate Easter eggs, Christmas selection boxes, advent calendars containing chocolate bars, celebration cakes and cupcakes;¹¹
- (vii) Sales value figures for chocolate bars manufactured in the UK in 2017 amounting to over £182 million increasing to £210 million in 2019. Wrigley's UK value/market sales for Ripple products are as per the following table:¹²

Year	Value Sales	Market share chocolate	Market share chocolate bars
2017	in excess of £27,900 million	0.7%	3.6%
2018	in excess of £25,800 million	0.7%	3.4%
2019	in excess of £25,200 million	0.6%	3.2%

⁷ Exhibits 1 and 2.

⁸ Exhibits 5, 7, 8, 10, 11, 12, 23 and paras 18-40.

⁹ Exhibits 31, 36, 37 and para 23.

¹⁰ Exhibits 22, 24, 25 and paras 37-40.

¹¹ Exhibits 5, 7, 8, 10, 11, 12, 23, 31, 38, 39 and 40 and paras 18-40.

¹² Paragraphs 41-55.

2020	in excess of £15,200 million	0.4%	1.9%
2021	in excess of £20,000 million	0.5%	2.5%

(viii) A table setting out that the sales of Ripple chocolate bars ranked in the top 15 of chocolate bars sold in the UK between 2017 and 2021;

(ix) Unit sale figures and net sales value in the UK across the range of products showing that inter alia millions of chocolate bars in a variety of configurations were sold between 2017 and 2022;

(x) Net sales figures for UK and Ireland for cakes sold under the brand Ripple between 2019 and 2022 amounting to £6.5 million;

(xi) A selection of sample invoices addressed to third party retailers in the UK and Ireland who are said to have stocked goods bearing the marks between 2017 and 2022 which support the sales figures as claimed. These retailers include Tesco, Asda, Sainsbury's, Morrisons, Co-op, Waitrose, Iceland, Supervalue and Dunnes. Photographs are produced of the products on the shelves of these retailers and reviews of the products from customers dated between 2019 and 2022.¹³

(xii) Details regarding the social media presence of the Ripple brands as at September 2022 showing that its Facebook account had 1.82 million views/likes and 1.78 followers; its YouTube account had 243,000 views/likes and 3160 subscribers; its Instagram account had 43,000 followers and its Twitter account had 12,100 followers.¹⁴ I note that the names of these accounts are by reference to 'Galaxy chocolate' but that the posts within each platform refer to a range of goods displaying the Ripple trade marks on the packaging and in the accompanying text.

(xiii) Details of Wrigley's advertising and promotional activity are produced to include its 'Ripple Taste' marketing campaign, 'Ripple Cake' launch and 'Ripple bar 99' campaign promoted to replace the Cadbury flake during a shortage.¹⁵

¹³ Exhibit 8.

¹⁴ Exhibit 30 and 31 and para 56-58.

¹⁵ Exhibits 33-40 and para 59.

Its marketing spend is shown to run in the millions of pounds across the various campaigns during the relevant periods.

(xiv) Details of Wrigley's sponsorship activities relating to the Ripple brand include its association with the Football Association, FIFA World Cup, the Sex and the City film and tv programmes and the Vogue magazine collaboration;¹⁶

(xv) Details of independent surveys conducted to show the popularity of the Ripple chocolate bar;¹⁷

(xvi) Examples of third party media coverage of the Ripple brand in various printed publications to include The Metro (April 2017), The Mirror (December 2019 and May 2020) and The Express (July 2021).¹⁸

30. I note the following from Catherine Byfield's witness statement:

- Examples of confectionery brands offering chocolate products and other food/beverages items to include milk drinks, hot chocolate, ice cream, dessert pots and spreads.¹⁹
- Examples of food brands, including confectionery brands collaborating with other food and beverage brands. Examples are produced of collaborations between beverages and biscuit brands, crisps and spreads brands, beverage and confectionary brands, spreads and chocolate brands, chocolate and ice cream brands.²⁰
- Examples of brands offering their core goods and a dairy-free alternative including Wrigley's chocolate brands offering a range of both dairy and vegan goods.²¹
- Examples of Ripple offering plant based milk including a chocolate flavoured range in the US.²²

¹⁶ Exhibits 42 and paras 60-62.

¹⁷ Exhibits 43-44 and paras 63-63. I note that no permission was sought to introduce this evidence into proceedings.

¹⁸ Exhibit 45 and para 65.

¹⁹ Exhibit CB1

²⁰ Exhibit CB2

²¹ Exhibit CB3

²² Exhibit CB4

Form of the mark

31. I shall start by considering the form of the mark shown in evidence. I am satisfied that Wrigley's evidence demonstrates the use of the word RIPPLE/Ripple in both its text only and figurative form throughout its evidence on the products themselves, on packaging in its promotional activities and via social media. I note Mr Carter's comments regarding the use shown and that it is only in combination with the word Galaxy which therefore is said to affect the distinctiveness of the mark RIPPLE/Ripple solus. However, it is settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product.²³ This is the position here. Consequently, where the mark is used in either form either solus or in combination with the word Galaxy I am satisfied that this is use upon which Wrigley may rely.

Sufficiency of the Use

32. I am satisfied that the evidence shows details of considerable sales running into millions of pounds, marketing spend, promotional activity, social media content and distribution to major supermarkets, which demonstrates the scale and extent of use of goods under the Ripple marks in the UK and EU.

33. Given RFP's concessions and in light of the evidence filed I am satisfied that genuine use had been shown during the fourth relevant period for cake/s, cupcakes, chocolate, single or multi pack chocolate bars, Easter eggs, selection boxes and advent calendars.

34. With regards to *dessert pots*, I am satisfied that genuine use has been shown for these goods in the period 2013 to 2014, but not beyond June 2014.

35. In so far as *hot chocolate* (which is a term commonly used to refer to drinking chocolate) Mr Cavanaugh provides details of the sales figures amounting to £500,000 but has only specified the period of use in general terms in her evidence namely "between 2014 and 2017". It is unclear when during 2017 the use extends to. The documentary evidence to support such a statement does not assist, as there is no indication as to when the use continued until or when it ceased. At the hearing Mr

²³ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

Stobbs drew my attention to Exhibits 31, 36 and 37 of Mr Cavanaugh's statement, submitting that use was shown in the screenshots included. However, I note that the references to promotional activity within these exhibits taken from the various sources are undated and there are no social media posts dated beyond 2014. Mr Cavanaugh's evidence was, however, unchallenged during the evidence rounds and therefore I am prepared to accept on the balance of probabilities, that at least a proportion of that use would have extended into 2017 to satisfy use in the fourth relevant period for *drinking chocolate* where appropriate, but I cannot be certain that the use extended beyond 2017.

36. With regards *ice cream* the product collaboration with McDonalds for the Galaxy Ripple Mcflurry ice cream was shown to run from 2015 to 2017. The volume of sales amounted to £800,000 in 2016 and the evidence shows that the collaboration ended on 7 February 2017. Whilst it was argued by RFP that the evidence only showed use for toppings and sauce and not for the ice cream itself, I do not agree. Consumers were not sold the ice cream separately from the toppings/sauce rather the product was sold as a complete unit and therefore I do not consider that consumers would see the individual elements as separate and distinct from each other. Furthermore, I believe that consumers would understand that Wrigley was working in collaboration with McDonald's by way of a commercial agreement to market the goods together. Consequently, I am satisfied that the evidence filed is sufficient to demonstrate genuine use for *ice cream* up until February 2017.

37. In so far as *sweet spreads* and *sauces* (given that these were referred to by Mr Stobbs at the hearing) I can see no evidence of use for goods under the marks that would come within these descriptions and even if there was, any use was so small that it would not be sufficient to be regarded as genuine use in accordance with the caselaw.

Arriving at a fair specification

38. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

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

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

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

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

39. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.C., sitting as the Appointed Person, summed up the law as follows:

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

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40. The goods for which I found or where RFP had conceded that genuine use has been shown are as follows:

cake/s, cupcakes, single or multi pack chocolate bars, Easter eggs, selection boxes, advent calendars, (all the aforementioned goods during the last relevant period 2017-2022), ice cream (from 2015 up until 7 February 2017), dessert pots (up until June 2014) and drinking chocolate (2014 to 2017).

41. I find that the average consumer of these goods are members of the general public with no particular speciality or expertise, other than those perhaps with particular individual dietary requirements or intolerances. The selection process on the whole will therefore only involve a low to medium level of care.

42. Mr Carter submitted that Wrigley’s specification includes broader terms than that which has been demonstrated in evidence and that its specification should be restricted solely to *chocolate* and *cakes* as this would be a fair and reasonable description of the goods as given by the average consumer. In particular, in relation to the term ‘confectionery’ he submitted that this was a very broad term encompassing all sorts of sweets/candies and pastries/patisseries and therefore Wrigley’s specification should be limited to the narrower terms to reflect what had been shown in evidence. Understandably Mr Stobbs advanced the contrary argument submitting that Wrigley should retain broader terms as set out above.

43. When coming to a fair specification it should be noted that the exercise to be undertaken is not to reduce the specification to the narrowest interpretation of the terms defining the particular examples of the goods for which genuine use has been shown, but rather to allow a particular category of goods which realistically exemplifies the term within which they fall. I bear in mind that this must be taken from the viewpoint of the average consumer and how they would fairly describe the category of goods in question. Describing the use shown in the narrowest possible way should therefore only be exercised if this is what the average consumer would do.

44. Dealing with the term *confectionery*, I bear in mind that the dictionary definition defines confectionery as sweets and chocolates collectively.²⁴ Confectionery is the broad category to describe sweet treats like candies and chocolates, whilst chocolate is a specific type of confectionery made from cocoa beans. All chocolates are a form of confectionery, although I acknowledge that not all confections are chocolate. Whilst I accept that consumers would describe a good proportion of the goods shown in evidence as *chocolate*, I also consider that they would also describe them collectively as *confectionery* which would include all the different products shown in evidence namely bars of chocolate, advent calendars, Easter eggs and selection boxes. I do not consider that it would be appropriate, therefore, to limit Wrigley's specification to the narrower subcategory, and the specification as drafted accords with the perception of the average consumer as to the goods concerned. To limit the scope of Wrigley's specification to just chocolate would strip Wrigley of its protection for which use has been shown and for which the average consumer would not consider different in substance. In my view both *confectionery*, *chocolate* and *chocolate products* are fair and reasonable terms to describe the range of products for which Wrigley has shown use.

45. Further, I note that Wrigley has the terms "*dairy products; milk and milk products; products prepared for consumption and consisting primarily of the aforesaid goods*" which consumers in my view would understand to include such items as milk, yogurt, butter, cream and cheese and products made of these ingredients. Given that chocolate goods contain dairy ingredients (amongst other ingredients) and are predominantly made of cream and/or milk, Wrigley may also retain *dairy products; milk and milk products; products prepared for consumption and consisting primarily of the aforesaid goods*.

46. In so far as the term *cocoa* is concerned, this in my view describes the raw ingredient which is usually mixed with other ingredients to make chocolate in various forms. Whilst I accept that the goods shown in evidence would undoubtedly be made from cocoa there is no evidence that Wrigley supplies cocoa under any of its marks. Acknowledging that cocoa sometimes is used to describe drinking chocolate powder with an intense flavour, I nevertheless consider that in those circumstances *drinking*

²⁴ www.dictionary.cambridge.org/dictionary/english/confectionery.

chocolate is a term which would adequately cover these goods as a fair description of the use shown. I consider that the term *cocoa* is too broad a term to represent a fair description of the *chocolate* goods sold by Wrigley from the perspective of the average consumer.

47. The evidence shows that use has been made of the mark for *ice cream* and which would fairly describe the goods shown in evidence. Wrigley may also retain the term *frozen confectionery* which also covers the ice cream products shown in evidence but only up until February 2017.

48. Wrigley has the terms *milk drinks* which in my view would refer to milk and favoured milk drinks. There is no evidence that it sells milk or milk drinks or that it sold these goods within the relevant periods under the marks. I note that Wrigley has used the marks for drinking chocolate in powdered form where milk or water is to be added to make a drinking chocolate beverage, however, in my view this cannot be reasonably described as a milk drink. Consequently, Wrigley may not retain this term.

49. Further up until 2014 the evidence shows use for *dessert pots*, described as a chocolate dessert. Wrigley has the terms *chilled desserts* which in my view adequately describes what has been shown in evidence (up until June 2014).

50. In so far as the term *preparations made from cereals* in my view this is too broad a term and 'cake' would be an appropriate sub category of the goods shown in evidence and how those goods would be described by the average consumer. To my mind the term *cakes* adequately covers the goods for which use has been shown in evidence.

51. Wrigley has the term *preparations for making beverages* in class 32 which taking its ordinary meaning from the viewpoint of the average consumer is a broad term which encompasses a broad range of preparations intended to be mixed with milk or water to make a drink such as tea, coffee, drinking chocolate, fruit squash and the like. However, in the explanatory notes accompanying the Nice classification the goods proper to this class do not include 'milk beverages with milk predominating', 'milk substitutes' or 'beverages with coffee, cocoa, chocolate or tea base'. The only use shown in evidence is for *drinking chocolate* but not beyond 2017. The term *drinking chocolate* in class 30 as set out in Wrigley's specifications fairly describes the nature of the goods shown in evidence. Given that the term *drinking chocolate* would cover

both the preparation and a premixed ready to drink good, Wrigley may also retain the term *chocolate based drinks*.

52. In light of my findings above I consider that the following represents a fair specification for Wrigley's marks which shall not be revoked:

Class 29: Milk and milk products; dairy products; products prepared for consumption and consisting primarily of the aforesaid goods;

Class 30: Confectionery; chocolate; chocolate products; cakes; drinking chocolate; chocolate based drinks.

53. In light of section 46(6)(b) of the Act I also find that genuine use of the marks has been shown for the following goods but not beyond the date at which the grounds for revocation existed. The outcome of which is that in addition to the terms as outlined above I am satisfied that Wrigley may retain the terms set out below but only up until the relevant effective date of revocation for each mark. These goods shall be revoked from the effective date of revocation following the third relevant period namely:

For the '644 mark from 22 July 2017

Class 29: chilled desserts.

Class 30: chilled desserts; frozen confections.

For the '934 mark from 22 July 2021

Class 30: ice cream; frozen confectionery.

Opposition Proceedings

54. I now turn to firstly consider the opposition under section 5(2)(b). This is because Wrigley's claim under section 5(1) requires that both the marks and the goods are identical for a claim under this ground to succeed whereas under section 5(2)(b) the goods need only be similar. I shall return to this position if necessary later in my decision.

Section 5(2)(b)

55. Section 5(2)(b) of the Act states as follows:

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

(a)

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

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

56. Section 5A of the Act reads as follows:

“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.”

Proof of use

57. Section 6A sets out the relevant provision of the Act in relation to proof of use. The relevant period for assessing proof of use is the five year period ending with the date of the UK designation of the ‘912 mark namely 4 January 2017 to 3 January 2022. This is a different relevant period to the relevant periods for the purposes of the revocation actions but there is considerable overlap between the two. I note however, that earlier in my decision, in relation *ice cream* and *frozen confectionery/frozen confections* I found that the use shown did not go beyond February 2017 and that for *chilled desserts* not beyond 2014. Consequently, I partially revoked Wrigley’s marks for these goods as at the effective date of revocation following the end of the third relevant period being 22 July 2017 and 22 July 2021 respectively. Given the wording of section 5(2)(b) of the Act, Wrigley is only able to rely upon those goods for which the earlier marks are protected as at the relevant date, in this case 3 January 2022. Consequently, given that these revocation dates predate the UK designation date of the ‘912 mark, Wrigley may not rely on *ice cream*, *frozen confectionery/frozen confections* for the purposes of its opposition.²⁵

²⁵ See Riveria Trade Mark decision [2003] RPC 50 (O/104/03 and O/214/03); *T-Mobile(UK) Limited v O2 Holdings Ltd*, O/088/07 and later on appeal O/364/07; *Tax Assist Direct Limited v Mr Nasratul*

58. In relation to *chilled desserts* the use shown falls outside the relevant proof of use period given that the evidence does not show use for these goods beyond June 2014. For the purposes of the opposition Wrigley may not rely upon *chilled desserts*.

59. For *drinking chocolate* and *chocolate based drinks* the use shown in evidence for these products as already outlined just falls on the right side of the relevant period to count.

60. Consequently, for the reasons already provided, I am satisfied that genuine use has been shown for both the figurative and word only marks within the proof of use relevant period for *chocolate, confectionery; chocolate products; cakes; milk and milk products; dairy products; products prepared for consumption and consisting primarily of milk and milk products and dairy products; drinking chocolate and chocolate based drinks*. I adopt my earlier findings, and Wrigley may rely on these goods for the purposes of its opposition.

The principles

61. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead

Ameen on appeal, O/220/12 (Tax Assist Trade Mark) and *PT MRI Indonesia v Dr Curtis N Rhodes, Jr* O/0689/25 (TM Moores Rowland).

rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of the goods

62. In light of my findings above the competing goods are as follows:

Ripple's goods	Wrigley's goods
<p>Class 29</p> <p>Plant-based non-dairy cheese substitutes; milk, yogurt and protein-based beverages used as a milk and yogurt substitute, namely, non-alcoholic plant-based beverages in the nature of milk composed primarily of plant proteins, fats and carbohydrates.</p>	<p>Class 29</p> <p>Milk and milk products; dairy products; products prepared for consumption and consisting primarily of milk and milk products and dairy products.</p>
<p>Class 30</p> <p>Frozen non-dairy desserts.</p>	<p>Class 30</p> <p>Chocolate, confectionery, chocolate products, cakes, drinking chocolate and chocolate based drinks</p>
<p>Class 32:</p> <p>Protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; beverages and aromatized beverages based on protein and other fluid nutrients, namely, protein drinks for use as food fillers and not for use as meal fillers; protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of grain.</p>	

63. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, where the court stated at paragraph 23 that:

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

64. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat* [1996] R.P.C. 281, namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

65. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

66. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

67. I remind myself that in accordance with section 60A of the Act the fact that goods may be recorded in different classes is not a basis for a finding of dissimilarity on this fact alone. Likewise, the fact that goods appear in the same class does not automatically make them similar either.

68. The goods to be compared are as set out earlier in my decision. I shall go through each of RFP’s terms in turn grouping terms together where appropriate.²⁶ Before doing so, however, I note that the explanatory notes of the Nice Classification sets out that goods in Class 29 includes “mainly foodstuffs of animal origin, as well as vegetables and other horticultural comestible products” and include milk substitutes. Whereas the goods described as particular to class 30 includes “mainly foodstuffs of plant origin, except fruits and vegetables”. I shall bear these class headings in mind when undertaking the comparison.

Class 29

milk, yogurt and protein-based beverages used as a milk and yogurt substitute, namely, non-alcoholic plant-based beverages in the nature of milk composed primarily of plant proteins, fats and carbohydrates.

²⁶ *Separode* Trade Mark BL O-399-10 (AP)

69. Given the limiting nature of the use of the term 'namely' within RFP's specification its goods are effectively limited to 'non-alcoholic plant-based beverages in the nature of milk composed primarily of plant proteins, fats and carbohydrates' which are plant based dairy/milk substitutes. In light of my previous findings Wrigley has retained and may rely on *chocolate, chocolate products, drinking chocolate, chocolate based drinks, dairy products, milk and milk products, products prepared for consumption and consisting primarily of milk and milk products and dairy products* in classes 29 and 30 which would (taking the ordinary meaning of the words) be regarded as including ingredients of both animal and plant origin. Milk/dairy substitutes are made from a variety of plants, nuts, soy and seeds for direct consumption or for the preparation with other goods and beverages. It is also common in the market and been shown in evidence by Ms Byfield that dairy/milk substitutes are increasingly offered as dairy free alternatives to products that consist of milk and dairy ingredients satisfying the same needs. In my view the respective goods coincide in distribution channels and are generally displayed in the same aisle/section of retail outlets although I accept not necessarily on the same shelves. I do not consider that dairy/milk substitute goods are exclusively directed at a particular narrow subset of consumer, as has been argued by Mr Carter but rather to the general members of the public and therefore the end user/relevant consumer coincides. The respective goods are in competition, but not complementary. I do not consider that the nature of the goods would overlap, however Wrigley's products and the plant based dairy substitutes have the same method of use and purpose. The goods, therefore, are similar to a medium degree.

Plant-based non-dairy cheese substitutes;

70. Taking the ordinary meaning of RFP's term, it is a plant-based alternative to cheese. Wrigley has retained the term *dairy products, milk and milk products and products prepared for consumption and consisting primarily of milk and milk products and dairy products* which amongst other matters include cheese, milk, and butter typically produced from cows. For the same reasons as outlined in the preceding paragraph I consider that the respective goods overlap in relevant public, distribution channels, method of use and purpose. Further they would be in competition, with consumers choosing a plant based alternative over a dairy/milk product. Consequently, I find that the respective goods are similar to a medium degree.

Class 30

Frozen non-dairy desserts.

71. Wrigley has *confectionery and dairy products, milk and milk products and products prepared for consumption and consisting primarily of milk and milk products and dairy products*, in its specification. I find RFP's *frozen non-dairy desserts* goods are similar to Wrigley's *confectionery* overlapping in user, method of use, purpose and channels of trade. Wrigley has filed evidence to show that it is customary for confectionery producers to produce frozen confectionery in the form of desserts and therefore I consider that this would also extend to non-dairy ranges. I consider that the goods therefore would be in competition but not complementary. A consumer may choose to buy a non-dairy version over a traditional confectionery which would include those that are frozen. Overall, I consider that that there is a medium degree of similarity between RFP's *frozen non-dairy desserts* and Wrigley's *confectionery*.

Class 32

Protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; beverages and aromatized beverages based on protein and other fluid nutrients, namely, protein drinks for use as food fillers and not for use as meal fillers; protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of grain.

72. I consider that the applied for goods are all plant and protein based beverages and share a degree of similarity with Wrigley's *drinking chocolate/chocolate based drinks* in class 30, overlapping in purpose all being drinkable consumables, relevant public and distribution channels. The nature of the respective goods is different, but I consider that there is a degree of competition between them in that consumers may choose a plant based version over a traditional beverage or a preparation as opposed to a drink that is pre mixed. Overall, I consider that they are similar to a low degree.

Average consumer and the purchasing process

73. When considering the opposing marks, the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of

assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.²⁷

74. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

75. The average consumer in my view is a member of the general public. I do not consider that RFP's goods in general terms being dairy/milk substitute goods are exclusively directed at a particular narrow subset of consumer, as has been argued by Mr Carter. The goods are likely to be purchased frequently and are of relatively low cost. The average consumer is likely to factor in such things as the ingredients, dietary requirements/preferences and flavours when selecting the goods. Consequently, I consider that an average (medium) level of attention will be undertaken in the purchasing process, no higher or lower than the norm for such goods.

76. The goods are likely to be self-selected from shelves of retail outlets or their online equivalents. Consequently, the purchasing process is likely to be predominantly visual. However, I do not discount an oral component to the purchasing process, as a result of advice being sought from retail assistants for example.

Comparison of the trade marks

77. 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


²⁷ *Lloyd Schuhfabrik Meyer*, case c-342/97.

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.”

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

79. The respective trade marks are shown below:

RFP's mark	Wrigley's earlier marks
RIPPLE	The '934 mark  The '283, '644 and '468 marks RIPPLE

80. Both the applied for mark and the earlier '283, '644 and '468 marks are for the word RIPPLE in which clearly the overall impression lies. In relation to the figurative '934 mark the word is presented in title case in a stylised font in brown lettering. Whilst the stylisation plays a part in the overall impression of the '934 mark it is to a lesser degree, and so it is the word itself that dominates the mark.

81. In so far as the word only marks, the applied for mark and the '283, '644 and '468 marks are clearly self-evidently identical, visually, aurally and conceptually. The meaning of the word ripple i.e. a small undulating wave on the surface of water, will be perceived by the relevant consumers in the same way in each mark.

82. Given that the stylisation and use of colour is the only difference between the applied for mark and the '934 mark and I have already found that it is the word itself that dominates the '934 mark the stylisation playing a much lesser role, the respective marks are clearly highly similar visually. In so far as any aural and conceptual comparison, they are identical.

Distinctive character

83. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, sets out the legal position to determine the distinctive character of a mark. In this case the CJEU stated that:

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

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

84. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. 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.

85. The earlier marks are for the word 'Ripple' which is a dictionary word meaning undulating wave on the surface of water. This may allude to the ripple effect of the presentation of the chocolate goods but otherwise has no descriptive or allusive meaning relative to the nature of the goods themselves. The stylisation and colour of the figurative mark does not impact particularly on the distinctive character of the mark when regarded as a whole. Consequently, I find that inherently the earlier marks overall have a medium degree of distinctive character.

86. Wrigley has claimed an enhanced degree of distinctive character and based on my assessment of the evidence filed in relation to its sales, market share, promotional activity I find that it has enhanced its inherent distinctiveness position for all its marks from a medium degree to between a medium and high degree for *chocolate*, *cake* and *confectionery*. I do not find that the evidence supports a claim in relation to any of the other goods relied upon.

Likelihood of confusion

87. When considering whether there is a likelihood of confusion between the marks, I must consider whether there is direct confusion, where one mark is mistaken for the other, or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods down to the same or related sources.

88. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods of one undertaking from another. In doing so, I must consider 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 he has retained in his mind.

89. The differences between the two types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,²⁸ by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, who noted 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 recognised 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, 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.).

²⁸ 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).”

90. I bear in mind that the examples as set out by Mr Purvis in *L.A. Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.²⁹ Furthermore, in *Liverpool Gin*, Arnold L.J. pointed out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. A finding of indirect confusion should not be made merely because two marks share a common element; it is not enough that one mark merely calls to mind another, this is mere association, not indirect confusion.³⁰

91. I remind myself that I found the following:

- The goods are similar in various degrees ranging from low to medium.
- The average consumer is a member of the general public selecting the goods via visual means but not discounting an oral component. An average (medium) level of attention will be used in the selection process.
- Each mark is aurally and conceptually identical to the applied for mark. Visually the word only marks are identical whereas the earlier figurative mark is highly similar to the applied for mark.
- The earlier marks are inherently distinctive to a medium degree but their distinctiveness has been enhanced to between a medium and high degree by the use that has been made of them for chocolate, confectionery and cakes.

92. Given the identity/high similarity between the marks visually, aurally and conceptually for goods that are similar (even to a low degree), I consider that consumers would directly confuse the word only marks RIPPLE one for the other. Given that the word RIPPLE is identical, the goods are sufficiently similar for consumers to believe that they are offered by Wrigley under the same mark leading to direct confusion between the two. In so far as the ‘934 mark is concerned for the stylised word Ripple, Wrigley conceded in its skeletons filed before the hearing that

²⁹ *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

³⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

the stylisation would not go unnoticed but that this is a plain case of indirect confusion.³¹ I agree, if consumers recognise the difference between the word only mark and the figurative earlier mark they will nevertheless believe that the same or related entity is responsible for the goods particularly given the enhanced degree of distinctive character enjoyed. Consumers would believe that the origin of the goods comes from the same or related source and that entity is merely producing a different range of goods under the RIPPLE brand used without the stylisation. Consequently, I find that there is a likelihood of direct and indirect confusion and the claim under section 5(2)(b) succeeds.

93. In so far as Wrigley's section 5(1) claim is concerned given that I have not found any identity between the respective goods, this ground fails.

Section 5(3)

94. Moving on to consider Wrigley's section 5(3) claim its position is not improved beyond that which I found under section 5(2)(b). However, for completeness I shall consider this ground albeit briefly.

95. Section 5(3) of the Act states:

“A trade mark which-

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

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

96. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer*

³¹ Paragraph 42.

v Interflora. The conditions of section 5(3) are cumulative. Firstly, Wrigley must show that the earlier marks are similar to RFP's mark. Secondly, Wrigley must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later marks. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. For the purposes of section 5(3) the relevant date for the assessment is 3 January 2022.

Similarity between the marks

97. I have already assessed the similarity/identity between the marks for the purposes of the opposition. I adopt those findings as they apply equally here.

Reputation

98. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

99. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”³² I remind myself that in its pleadings Wrigley claimed a reputation in relation to all of its goods as registered. However, in its skeleton argument filed before the hearing it amended its position and only advanced a claim to a reputation for “at least chocolate, cakes, confectionary and desserts by the relevant date”.³³ I take from this that it conceded that this was its best case and shall proceed on the same basis.

100. I note that the assessment of whether Wrigley has a reputation for the goods claimed is a different test to the one undertaken for an enhanced level of distinctive character but generally it is still based on the same evidence.³⁴ I have summarised the evidence earlier in relation to genuine use and Wrigley’s claim to enhanced distinctiveness, which in light of my findings will apply equally to the assessment of whether it holds a reputation. I have no hesitation in finding that the evidence supports Wrigley’s claim to a strong (between medium and high) reputation for chocolate, confectionery and cakes.

101. Dealing with Wrigley’s claim to a reputation for desserts and for completeness the other goods for which I found genuine use, the evidence in my view does not show that as at the relevant date its reputation extends to cover these goods. The evidence relating to dessert pots is very limited, at its height amounting to £218,000 of net sales between 2013 and 2014,³⁵ one screenshot of an article taken from the Grocery Trader dated December 2009 and two social media posts dated June 2014.³⁶ I was not directed to nor could I find any evidence of use of the marks for desserts beyond 2014 (some eleven years before the relevant date). Further in relation to Wrigley’s collaboration with McDonalds for the Mcflurry ice cream this relationship ended in 2017 (some five years before the relevant date). Even though Wrigley has shown use for

³² *General Motors* para 27

³³ Paragraph 53.

³⁴ *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J.

³⁵ Mr Cavanaugh’s witness statement paragraph 36.

³⁶ Exhibits 21 and 30.

drinking chocolate and chocolate based drinks, the modest sales figures are dated between 2014 and 2017 and the evidence shows that there are no social media posts referring to these goods beyond 2014. I do not find therefore that Wrigley has demonstrated that it has maintained a reputation for these goods as at January 2022.

Link and Damage

102. Having found a reputation for some of the goods, I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.³⁷ Taking each of the factors in turn:

The degree of similarity between the conflicting marks

Earlier in my decision when considering the section 5(2)(b) ground I found the contested marks to be visually, aurally and conceptually either identical or highly similar.

The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

In so far as RFP's goods as applied for in classes 29 and 30 where I have found similarity in various degrees to Wrigley's goods in which it holds a reputation namely chocolate and confectionery, that finding applies equally here.

However, in relation to RFP's *plant-based non-dairy cheese substitutes* the finding of similarity was based on Wrigley's general terms milk and dairy product goods in class 29 in which I have found Wrigley does not hold a reputation. I see no obvious similarity between RFP's *plant-based non-dairy cheese substitutes* and any of Wrigley's goods in which it holds a reputation, namely chocolate, cakes and confectionery. Taking the ordinary meaning of RFP's term, it is a plant-based alternative to cheese. There is no similarity between the respective terms other than at a very high level of generality in so

³⁷ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

far as users and channels of trade. In my view, however, these are insufficient factors for a finding of similarity on this basis alone, given that all kinds of goods are sold and bought in supermarkets nowadays without consumers believing they have the same origin.³⁸

In so far as RFP's goods in class 32 I find no obvious similarity between these goods and Wrigley's *confectionery, chocolate or cake*. RFP's goods are plant based/protein based beverages which have no obvious similarity in accordance with the *Treat* factors to chocolate, confectionery and cakes. I find that the nature of the goods differ and although the respective goods may overlap in purpose all being consumables, channels of trade and users, this is solely on the basis that they may be sold in supermarkets which sell a vast range of different goods. The fact that RFP's goods may be chocolate favoured when sold is insufficient a basis for similarity to be found. I do not consider that these factors alone are sufficient for a finding of similarity when taking the core meaning of the goods in accordance with settled caselaw.

The relevant public is a member of the general public.

The strength of the earlier marks' reputation

I have found that based upon the evidence filed, Wrigley has a strong reputation (between medium and high) for chocolate, confectionery and cakes.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the earlier marks are inherently distinctive to a medium degree and by virtue of the use made of them, their distinctive character has been enhanced further to between a medium and high degree for the same goods for which it claims a reputation.

³⁸ *Znine Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) Case T-363/08

Whether there is a likelihood of confusion

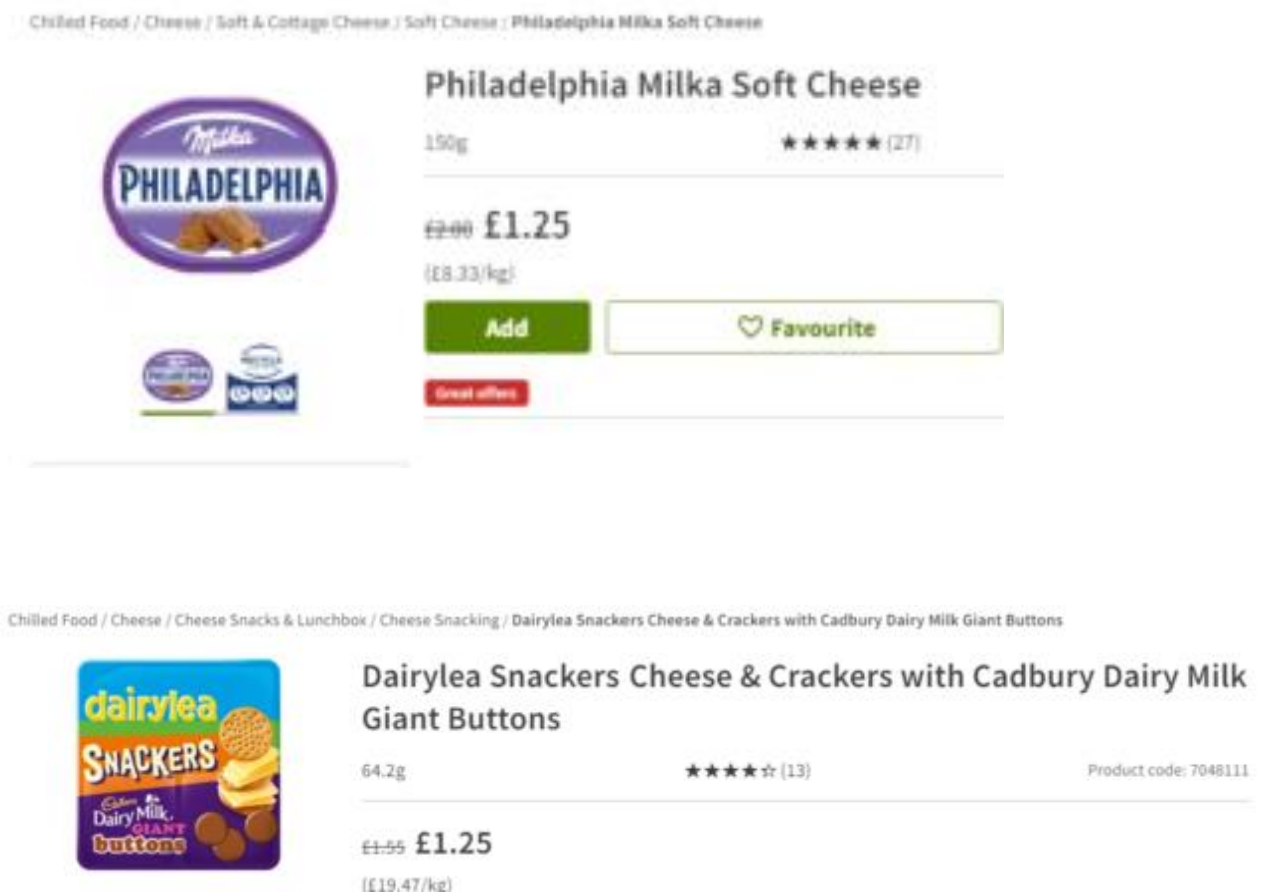
For the reasons I have already outlined I found a likelihood of confusion.

103. A link means that the earlier marks will be brought to mind by the applied for mark. One of the considerations in deciding whether a link will be made between the marks is whether there is a likelihood of confusion. If there is a likelihood of confusion, there must be a link, because confusion means that there must be more than a bringing to mind. Given my earlier findings, for those goods I found to be similar to Wrigley's goods in which it holds a reputation then I also find that due to the identity/high similarity between the marks, the relevant public will believe that the marks are used by the same undertaking or will believe that there is an economic connection between the undertakings leading to a link being made. In so far as these goods I also find that this link would lead to damage in that RFP would gain an unfair advantage with an increased chance of consumers buying RFP's products because of their perceived link to Wrigley. In my view this would take unfair advantage of the earlier marks' reputation and gain a foothold in the industry quickly, without having to make an equivalent investment or marketing effort themselves. The economic behaviour of customers would change leading to a commercial advantage being gained by RFP.

104. With regards to the *plant based non-dairy cheese substitutes* goods that I found to be dissimilar to Wrigley's *chocolate, cakes and confectionery* whilst I accept that there is no necessity under this ground for the respective goods to be similar, I see no conceivable way in which the general member of the public would find a link between an entity producing confectionery, cakes and chocolate to an entity producing cheese alternatives. This is notwithstanding Wrigley's evidence which shows two examples of producers of soft cheese having entered into a collaboration with chocolate brands to produce a chocolate flavoured variety within its range or where chocolate goods i.e. buttons are included within the product (images of which are reproduced below).³⁹ I do not consider that there would be an equivalent cross over by a confectionery producer into the cheese market in the same way for a link to be made in the minds of the relevant consumer. Further, the evidence filed by Wrigley is not of great assistance

³⁹ Exhibit CB2 of Ms Byfield's statement.

since it is dated in 2023 and therefore these examples are not indicative of the market as at the relevant date for me to draw any positive conclusions from it in favour of Wrigley.⁴⁰ In the instances shown, the collaboration in my view would be clear in the mind of the relevant public as the respective figurative marks of the chocolate brands were clearly displayed on the packaging of the goods themselves alongside the cheese brand which would have made it obvious to the consumer of the commercial connection between the two entities.



105. I do not envisage consumers when seeing the word Ripple on cheese substitute goods to make a link with Wrigley’s marks which purely have a reputation for cakes, chocolate and confectionery. To my mind there is insufficient closeness between the respective fields of activity for any link to be found. If Wrigley’s mark is brought to mind, it would be fleeting at best and insufficient to lead to any of the heads of damage to arise.

⁴⁰ The screenshot of the Dairylea/Cadbury buttons product is dated January 2023 whereas the screenshot of the Philadelphia/Milka product is undated but which would be reasonable for me to take as dated March 2023 when the statement was completed.

106. In so far as RFP's *Protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; beverages and aromatized beverages based on protein and other fluid nutrients, namely, protein drinks for use as food fillers and not for use as meal fillers; protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of grain* in class 32 I again found under section 5(3) that these goods did not share similarity with those goods in which Wrigley held a reputation, however I have already found in Wrigley's favour under section 5(2)(b) based on its reliance on drinking chocolate/chocolate based drinks. I therefore do not propose to consider the section 5(3) ground further in relation to these goods as it will not place Wrigley in any stronger position.

107. Wrigley's claim under section 5(3) succeeds in part.

Invalidation Proceedings

108. Before moving on to consider the invalidation actions against RFP's registered marks, RFP as its primary defence argues that Wrigley has consented to the registrations in accordance with section 47(2) of the Act and is precluded (in contract and/or estoppel) from bringing a cancellation action as a result of a settlement agreement entered into by the parties in May 2019 ("the Agreement"). RFP argues that the terms of that agreement which were dependent on RFP complying with certain conditions have not been breached and therefore the Agreement still stands, in that Wrigley cannot challenge the registrability/validity of its marks. It argues that the Agreement constitutes a binding contract and Wrigley is bound by the consent it gave to the registrations. Further in the alternative RFP argues that Wrigley is estopped from bringing its cancellation action as RFP relied on the representations made by Wrigley in the Agreement to its detriment by giving undertakings and acting in accordance with them.

109. In reply Wrigley argues that RFP breached the terms of the Agreement by using the mark for chocolate/vanilla milk and protein shakes in the US negating the terms of the Agreement and furthermore that there is no basis to argue that Wrigley has consented to the registrations in accordance with the interpretation of section 47(2) of the Act as the consent was conditional. In any event, it gave notice to RFP by way of

letter dated 4 October 2022 of its intention to treat the settlement as ended and that it would be no longer bound by its terms.

110. In support of its claim RFP relies on the terms of the Agreement which were set out in a letter dated 6 May 2019 as between the parties' then representatives. The relevant terms are as follows:

"We confirm that Mars, Incorporated is willing to withdraw its opposition against [RFP PBC's] EUTM application no.17962980 and UK application no.3341823 ("the Applications") and not file any cancellation action against the Applications post registration provided your client undertakes:

1. to limit the specification of the Application by deleting class 30 entirely....
2. not to use any sign in the UK or elsewhere in the EU containing or comprising "RIPPLE" in a 'trade dress' the same or similar to that shown below:



3. not to use the Applications or any other sign containing or comprising "RIPPLE" in connection with desserts containing cocoa or chocolate."

111. I note that there were no submissions put before me regarding the entities that entered into the Agreement. Wrigley's case is not that it was not bound by the terms of the Agreement because it was entered into by its parent company, Mars Incorporated. It advanced no argument in this regard. Wrigley appears to have accepted before me, that any actions made by Mars Incorporated applied to Wrigley and therefore it is unnecessary for me to consider this point further.

112. Dealing first with the claims by Wrigley that RFP had breached the terms of the Agreement such that it was no longer bound by it. It appears to me that there is no suggestion that RFP has used any sign containing or comprising the word RIPPLE "in a trade dress" the same or similar to Wrigley's marks (as shown above). Further it

appears that RFP did in fact limit its specification in accordance with clause 1. The only clause therefore that could amount to a breach as identified by Wrigley is in relation to clause 3. The question is whether RFP's use of its '980 and '823 marks in the US for 'chocolate milk and protein shakes' could be construed as "desserts containing cocoa or chocolate" meaning that RFP was in breach of the conditions, and as such allowing Wrigley to claim that it was no longer bound by the Agreement.

113. I bear in mind that the extent of my jurisdiction is not to determine as to whether a breach of contract has occurred, the parties have other recourse available to them to pursue such a claim. My assessment of RFP's defence is to determine whether there is any legitimate claim for an abuse of process claim or whether there is anything that prevents Wrigley from being able to bring the cancellation application. I bear in mind when assessing the Agreement that it was one entered into as part of a settlement agreement in relation to an opposition regarding conflicting rights.

114. At the outset, I note that it has been determined that it is in principle possible for an abuse of process claim to be brought in breach of a settlement agreement or a coexistence agreement.⁴¹ Whilst it is not open to me to determine whether there has been a breach of contract, that being said, on the face of the terms of the Agreement and taking the ordinary meaning of the words I can see nothing in relation to RFP's actions that could be construed as it being in breach of its undertaking. Firstly, I do not find that a chocolate milk beverage or protein shake could be construed as a chocolate dessert, notwithstanding that a milk shake can be offered as a sweet drink course following a meal in certain establishments. Secondly, given the wording of clauses 1 and 2 which refer to EU and UK marks it is arguable whether the territorial scope of the Agreement is limited only to these jurisdictions. Consequently, I am not convinced that using the marks in relation to these aforementioned goods in the US would appear at first blush to constitute a breach of the Agreement to give Wrigley the opportunity to deem that it was no longer bound by its terms. However, whether the Agreement has been breached is not a matter that is for consideration before me and therefore it is unnecessary for me to consider this point further. I shall therefore consider the

⁴¹ *Punter of England v Chancellor, Masters and Scholars of the University of Cambridge* and a first instance decision numbered BL O/286/20.

arguments in relation to consent and whether Wrigley consented to the registrations in accordance with section 47(2).

115. Mr Stobbs argues that as the consent referred to by RFP is conditional it does not constitute consent within the meaning of the Act. In support of this contention, my attention was drawn to *Kerly's Law of Trade Marks and Trade Names 17th Ed* paragraph 7-039 which states (absent footnotes):

“An interesting issue may arise if the consent is only provided on condition that the new mark is used in a particular way. The issue might turn on the way the transaction is construed. If the consent itself is conditional, then this would not appear to satisfy the requirements of the 1994 Act. On the other hand, if the consent is unconditional but is provided as part of an agreement which includes a term specifying the manner of use then, it is suggested, the provision would be satisfied and, in the event of breach, the earlier proprietor would have to sue for breach of contract.”

116. In my view I do not find that the consent given by Wrigley to the registrations of RFP's marks as set out in the Agreement was conditional but rather it is in keeping with the second scenario envisaged by *Kerly's* namely that the consent itself was unconditional but that it was provided as part of an agreement which included terms specifying the manner of use by RFP of its marks. Consequently, this would satisfy the requirements of the Act and therefore in the event of breach (according to *Kerly's*) Wrigley's only recourse was to sue for breach of contract.

117. On the ordinary reading of the Agreement it appears clear to me that Wrigley consented to the registrations and that it is not now open to it to challenge the prima facie registrability of RFP's marks by way of an invalidation cancellation based on earlier rights. This however would be in direct contrast to a revocation cancellation action based on non-use. To my mind there is a clear distinction between the two in terms of the intention of the parties at the time the Agreement was entered into. I consider that an invalidation cancellation is a claim which challenges the validity of a registration based on amongst other things earlier rights or absolute grounds. It appears reasonable therefore for a party to rely on an agreement with an expectation that no cancellation action post registration will be filed against them. However, it

appears incongruous to me for a party to enter into an agreement that would curtail its ability to challenge a registration that is liable to be cancelled because it has not been used. I see no conceivable way that in this scenario RFP could succeed with such a defence arguing that Wrigley was prevented from bringing any action to challenge the marks based on non use. To my mind a party cannot merely sit on a trade mark in such circumstances without the expectation that its validity will be challenged. However, this latter scenario is not before me and therefore I need not give further consideration to it.

118. I find that Wrigley agreed not to challenge the prima facie validity of RFP's marks post registration based on earlier rights and that RFP was entitled to rely on this consent with an expectation that the registrability of its marks per se could not be challenged. Consequently, I find that on its face Wrigley has no ability to bring an invalidation action against RFP relying on its earlier rights as it had consented to the registrations. If Wrigley believed that RFP had breached the terms of the Agreement then it was open to it to challenge that position and sue for breach of contract through the courts. The consequence of this is that the invalidation action is struck out and fails at the first hurdle.

Final outcome

The revocations

119. RFP's revocation action succeeds in part, however, it has failed in respect of the following marks and goods which shall remain registered:

UKTM no. 1029283

Class 30: Non-medicated confectionery but not including ice cream, frozen confections containing cream, water ices, ice cream confections or water ice confections and not including preparations for making or coating any of these excluded goods.

UKTM no. 900001644

Class 29: Dairy products.

Class 30: drinking chocolate; chocolate based drinks; non-medicated confectionery; cakes; chocolates, chocolate; all included in Class 30.

UKTM no. 912348934

Class 29: milk and milk products; dairy products; products prepared for consumption and consisting primarily of the aforesaid goods.

Class 30: confectionery; drinking chocolate; cakes; chocolate; products prepared for consumption and consisting primarily of the aforesaid goods.

UKTM no. 1336468

Class 30: cakes; non-medicated chocolate confectionery, none being frozen; all included in Class 30.

120. The following marks shall be revoked from the following dates for the following goods:

UKTM no. 900001644 from 22 July 2017 for:

Class 29: chilled desserts.

Class 30: frozen confections; chilled desserts.

UKTM no. 912348934 from 22 July 2021 for:

Class 30: ice cream; frozen confectionery.

121. The following marks shall be revoked from the day following the fifth anniversary of the registrations for the following goods:

UKTM no. 900001644 from 21 January 2004 for:

Class 29: Meat, fish, poultry and game, sea foods; fruit and vegetables, all being preserved, dried, cooked or processed; eggs; preparations made from all the aforesaid goods; soups; mousses; edible oils and fats; jams and jellies; salads; drinks made from dairy products; sweet spreads, savoury spreads; fillings, snack foods; prepared meals, semi-prepared meals, constituents for meals, proteinaceous substances, dips; all included in Class 29.

Class 30: Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; pastries, biscuits; frozen yoghurt; mousses; sorbets; bread; pastry; coffee based drinks, fillings; sweet spreads, savoury spreads, snack foods, prepared meals, semi-prepared meals, constituents for meals; dressings; sauces; pizzas, pizza bases, sauces and toppings for pizzas; sauces for pasta and rice, salad dressings; mayonnaise; dips; all included in Class 30.

Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; aerated water; beer; essences for making beverages; extracts of hops for making beer; fruit juice/ fruit juices; ginger beer / ginger ale; grape must [unfermented]; lemonades; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; must; non-alcoholic beverages; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; orgeat; pastilles for effervescing beverages; powders for effervescing beverages; preparations for making aerated water; preparations for making beverages; preparations for making liqueurs; preparations for making mineral water; sarsaparilla [soft drink]; seltzer water; soda water; sorbets beverages]/ sherbets [beverages]; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages; none of the afore-mentioned goods including beer wort.

UKTM no. 912348934 from 12 April 2019 for:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk drinks; products prepared for consumption and consisting primarily of the aforesaid goods.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; coffee substitutes; cereal bars; pasta; noodles; biscuits; pesto; products prepared for consumption and consisting primarily of the aforesaid goods.

UKTM no. 1336468 from 7 September 1996 for:

Class 30: Rice, pasta; cereals and cereal preparations, all for food for human consumption; tea, coffee, cocoa, coffee essence, coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; bread biscuits; all included in Class 30.

The Opposition

122. The opposition succeeds overall under section 5(2)(b) and in part under section 5(3). The UK designation of International Registration no. WO1605912 shall be refused registration for the following goods:

Class 29: milk, yogurt and protein-based beverages used as a milk and yogurt substitute, namely, non-alcoholic plant-based beverages in the nature of milk composed primarily of plant proteins, fats and carbohydrates; plant-based non-dairy cheese substitutes.

Class 30: Frozen non-dairy desserts.

Class 32: Protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; beverages and aromatized beverages based on protein and other fluid nutrients, namely, protein drinks for use as food fillers and not for use as meal fillers; protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of grain.

The Invalidation

123. The invalidation action shall be refused in its entirety. The trade marks numbered 3341823 and 917962980 shall remain registered for the following goods:

Class 29: Plant-based non-dairy cheese substitutes;

Class 32: Non-alcoholic plant-based beverages; non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; protein enriched non-alcoholic beverages, not being dairy; non-alcoholic plant-based beverages composed primarily of plant proteins, fats and carbohydrates.

Costs

124. I consider that broadly speaking Wrigley has enjoyed the greater degree of success overall and consequently it is entitled to an award of costs in its favour. However, I take on board that Wrigley failed in its invalidation claim and it conceded non-use for a good proportion of its specification meaning that its marks were revoked for these goods. At the hearing neither party advanced a claim for off scale costs and therefore I consider that an award of costs according to the scale as set out in TPN 2/2016 is appropriate taking into account the degree of success and failure by each party. Consequently, for these reasons I award costs to Wrigley as follows:

Preparing and considering the various statements of grounds and counterstatements:	£1,000
Drafting evidence and considering the other side's evidence:	£1,500
Preparing for and attending a hearing:	£1000
Official fee for the opposition:	£200
Total	£3,700

125. I order Ripple Foods, PBC to pay Mars Wrigley Confectionery UK Limited the sum of £3,700 as a contribution towards its costs. 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 this case, if any appeal against this decision is unsuccessful.

Dated this 8th day of January 2026

Leisa Davies

For the Registrar

Annex 1

Wrigley's Goods
<p>'283 Mark</p> <p>Class 30: Non-medicated confectionery but not including ice cream, frozen confections containing cream, water ices, ice cream confections or water ice confections and not including preparations for making or coating any of these excluded goods.</p>
<p>'644 Mark</p> <p>Class 29: Meat, fish, poultry and game, sea foods; fruit and vegetables, all being preserved, dried, cooked or processed; eggs; preparations made from all the aforesaid goods; soups; dairy products; mousses, chilled desserts; edible oils and fats; jams and jellies; salads; drinks made from dairy products; sweet spreads, savoury spreads; fillings, snack foods; prepared meals, semi-prepared meals, constituents for meals, proteinaceous substances, dips; all included in Class 29.</p> <p>Class 30: Rice, pasta; cereals and cereal preparations; tea, coffee, cocoa; drinking chocolate; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; non-medicated confectionery; pastries, cakes, biscuits; frozen yoghurt, frozen confections; chilled desserts, mousses, sorbets; bread; pastry; coffee and chocolate based drinks, fillings; sweet spreads, savoury spreads, snack foods, prepared meals, semi-prepared meals, constituents for meals; chocolates, chocolate; dressings; sauces; pizzas, pizza bases, sauces and toppings for pizzas; sauces for pasta and rice, salad dressings; mayonnaise; dips; all included in Class 30.</p> <p>Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; aerated water; beer; essences for making beverages; extracts of hops for making beer; fruit juice/ fruit juices; ginger beer / ginger ale; grape must [unfermented]; lemonades; lithia water; malt beer; malt wort; milk of almonds [beverage]; mineral water [beverages]; must; non-alcoholic beverages; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages; orgeat; pastilles for effervescing beverages; powders</p>

for effervescing beverages; preparations for making aerated water; preparations for making beverages; preparations for making liqueurs; preparations for making mineral water; sarsaparilla [soft drink]; seltzer water; soda water; sorbets beverages]/ sherbets [beverages]; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; whey beverages; none of the afore-mentioned goods including beer wort.

'934 Mark

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; dairy products; milk drinks; products prepared for consumption and consisting primarily of the aforesaid goods.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; coffee substitutes; drinking chocolate; cereal bars; pasta; noodles; biscuits; cakes; chocolate; ice cream; frozen confectionery; pesto; products prepared for consumption and consisting primarily of the aforesaid goods.

'468 Mark

Class 30: Rice, pasta; cereals and cereal preparations, all for food for human consumption; tea, coffee, cocoa, coffee essence, coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; nonmedicated Chocolate confectionery, none being frozen; bread biscuits; all included in Class 30.

Annex 2

Ripple's Goods
<p>'912 mark</p> <p>Class 29: Plant-based non-dairy cheese substitutes; milk, yogurt and protein-based beverages used as a milk and yogurt substitute, namely, non-alcoholic plant-based beverages in the nature of milk composed primarily of plant proteins, fats and carbohydrates.</p> <p>Class 30: Frozen non-dairy desserts.</p> <p>Class 32: Protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; beverages and aromatized beverages based on protein and other fluid nutrients, namely, protein drinks for use as food fillers and not for use as meal fillers; protein-based beverages, other than milk-substitutes, namely, non-alcoholic plant-based beverages in the nature of grain.</p>
<p>'823 and '980</p> <p>Class 29: Plant-based non-dairy cheese substitutes;</p> <p>Class 32: Non-alcoholic plant-based beverages; non-alcoholic plant-based beverages in the nature of vegetable, legume, seed plant-based beverages not being milk substitutes; protein enriched non-alcoholic beverages, not being dairy; non-alcoholic plant-based beverages composed primarily of plant proteins, fats and carbohydrates.</p>