O-0068-26

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1822901
BY THE PINKFONG COMPANY, INC. FOR THE TRADE MARK:

Bebefinn

IN CLASSES 3, 5, 18, 21, 24, 29, 30 AND 32

AND

IN THE MATTER OF A FAST TRACK OPPOSITION THERETO UNDER NO. 600003622

BY ŽITO PREHRAMBENA INDUSTRIJA D.O.O.

Background & Pleadings

1. International trade mark 1822901 (“the IR”) consists of the sign shown on the cover page of this decision. The IR is registered with effect from 1 July 2024 and the holder is The Pinkfong Company, Inc.. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. I note that the mark also claims a priority date of 14 March 2024 from several Korean trade marks. The holder seeks protection for the following goods:

> *Essential oils; fabric softeners for laundry use; beauty soap; body wash; non-medicated soaps for babies; shampoos; hand cleansers; shampoos for babies; hair conditioners for babies; soaps for personal use; hair rinses; hair conditioners; toiletry preparations; cleaning, polishing, scouring and abrasive preparations; functional cosmetics being skin care preparations; lip balm; make-up; shaving preparations; moisturising lotions [cosmetic]; bath flakes; body and beauty care cosmetics; body lotion; deodorants for body care; bath foam; bath fizzies; baby lotions; baby milk lotion; baby oil; non-medicated baby creams; bath and shower preparations; cosmetics for children; baby bubble bath; face and body glitter; perfume; hair creams; beauty masks; mask pack for cosmetic purposes; bath crystals for cosmetic use; cosmetics; room fragrances; aromatics [essential oils] for use in automobiles; fragrances and perfumery; body art stickers; nail art stickers; removable tattoos for cosmetic purposes; pre-moistened cosmetic tissues; baby wipes for cosmetic use; cleaning preparations for household purposes; cleaning preparations; laundry soap; baby detergents; cleaning preparations for babies' bottles; non-medicated mouthwashes and gargles; non-medicated dental rinse; dentifrices for babies; dentifrice; non-medicated pet shampoos; pet shampoos and conditioners [non-medicated, non-veterinary grooming preparations]; pre-moistened cleansing tissues; pre-moistened tissues of paper for babies.* (Class 3)

> *Baby food made from agricultural products; baby food made from aquatic products; food for babies (except lacteal flour for babies); beverages for infants;*

baby food made from livestock products; food for babies; milk powders [foodstuff for babies]; mosquito killing preparations for application to mosquito nets; mosquito-repellent incenses; vitamin and mineral preparations; nutritional supplements; disinfectants for hygiene purposes; mosquito repellents for application to the skin; food supplements; dietary supplements; air deodorising preparations; deodorants, other than for human beings or for animals; deodorants for clothing and textiles; first aid boxes sold filled; mosquito-repellent bands; sticking plasters; tissues impregnated with pharmaceutical lotions; disposable sanitizing wipes; adhesive bandages; adhesive bandages for skin wounds; tissues impregnated with antibacterial preparations; diaper bands being baby diapers; swim diapers for babies; babies' diapers; disposable baby diapers; inserts made of cloth specially adapted for reusable babies' diapers; mothproof paper; dietary and nutritional supplements in powder form containing lactic acid bacteria; food supplements mainly based on seaweed; food supplements based on dried fish and shellfish; dietary supplemental drinks with dietary fiber. (Class 5)

Pouches for holding make-up, keys and other personal items; cosmetic bags sold empty; portable cosmetic bags (sold empty); animal carriers [bags]; bags for carrying animals; bags for carrying pets; breast harnesses for pets; hair bows for pets; snoods for pets [clothing for animals]; collars for pets; boots for pets; scarf for pets; raincoats for pets; clothing for pets; leather and imitations of leather; bags; luggage tags of leather; duffel bags; messenger bags; haversacks; reusable shopping bags; luggage bags; carriers for suits, shirts and dresses; bags for sports; baby carriers worn on the body; children's bags; back frames for carrying children; luggage tags; key wallets; sling bags for carrying babies; sling bags for carrying infants; slings for carrying infants; baby wrap carriers; purses; trunks and traveling bags; school satchels; parasols for golf; golf umbrellas; parasols [sun umbrellas]; umbrellas; mountaineering sticks; canes; reins for guiding children (Class 18)

Cosmetic utensils; brushes; combs and sponges; toothbrushes for babies; floss for dental purposes; toothbrushes; toothbrush holders; cleaning tools and washing utensils (other than electric); trash cans; kettles; plastic containers for household use; lunch boxes; drinking steins; mats, not of paper or textile, for beer glasses;

mugs; coasters, not of paper or textile; tableware for children, other than knives, forks and spoons; cups for baby food; disposable table plates; dishes; paper cups; cups; tableware, other than knives, forks and spoons; drinking vessels; food and drink preparation utensils for household purposes [other than electric]; spoon holders; household containers for foods; basters for kitchen use; cookie sheets; cookie [biscuit] cutters; cookie presses; cookie jars; heat-insulated containers; containers for ice, for household purposes; buckets; insulated flasks; thermal insulated bottles; portable buckets; non-electric portable coolers; insect habitats; flower pots; aquarium ornaments; indoor aquaria; portable potties for children; tissue box covers; coin banks; ironing boards; plastic bathtubs for children; shower caddies; baby baths; boxes for sweets; decanters; place mats, not of paper or textile; place mats of plastic; ceramics for household purposes; glass ornaments; porcelain ornaments; spectacle cleaning cloths; cleaning cloths for spectacles; replacement brush heads for electric toothbrushes; electric toothbrushes; gloves for household purposes; potholders; bath brushes; bath sponges; works of art of porcelain, earthenware or glass; soap holders; services [dishes] of precious metal; services [dishes], not of precious metal. (Class 21)

Labels of textile; cloth banners; fitted toilet seat covers of textile; shower curtains; furniture coverings of textile; place mats of textile material; table decorations of textile; fabric valances; coasters of textile; curtains of textile; table linen; curtains of plastic; bed and table covers; linen for household purposes; blanket throws; pillow covers; children's blankets; diaper changing cloths for babies; sleeping bags for babies; crib bumpers [bed linen]; crib sheets; quilts; bedsheets; bed linen; bed covers; cushion covers; sleeping bags; bath linen; bath mitts; towels, not of paper; beach towels; children's towels; handkerchiefs of textile; towels of textile; tissue of textile; furnishing and upholstery fabrics; fabric; sheets [textile]; ribbonlike fabrics; non-woven fabrics and felts. (Class 24)

Frozen peas; pollen prepared as foodstuff; preserved, frozen, dried and cooked fruits and vegetables; processed nuts; processed vegetables and fruits; dried fruits; dried fruit-based snacks; nut-based snack foods; food products made primarily from fruits; fruit jellies; bottled vegetables; jams; processed vegetable products; vegetable-based snack foods; soups; instant or pre-cooked soup;

vegetable juices for cooking; jellies for food; tofu-based snacks; processed beans, namely, foodstuffs made from beans (excluding bean curds and foodstuffs made from bean curds); frozen fruits; croquettes; meat, frozen; packaged meats; meat, fish, poultry and game; processed eggs; prepared meat; chicken nuggets; pork cutlets; sausages; processed meat products; chicken nugget; processed cheese; dried milk powder; powdered milk; milk; milk substitutes; beverages consisting principally of milk; processed dairy products; lactic acid bacteria drinks; milk products; cheese; oils and fats for food; food products made from oil and fat; frozen fish; fish and shellfish (not live) (including those frozen or preserved with salt); sheets of dried laver (hoshi-nori); processed seaweed products; dried anchovy; fish and shellfish (preserved); fish cakes; food products made from fish and shellfish; canned tuna; tuna fish, not live. (Class 29)

Polished cereals; flour and preparations made from cereals; almond paste; cereal-based processed products; cereal-based snack food; frozen dumplings; frozen noodles; deep-frozen pizzas; dough; instant noodles; mandu [Korean-style dumplings]; wheat-based snack foods; stir-fried rice; breakfast cereals; cooked rice; instant rice; batter mixes; hot dogs (sausages in a bread roll); baking-powder; leaven; malt extracts for use as flavoring; dry confectionery; fruit ices; fruit ice cream bars; fruit ice creams; confectionery; chewing gum; frozen yogurt [confectionery ices]; frozen cookie dough; doughnuts; marshmallow; muffins; biscuits; chewing gum, not for medical purposes; water ice; bread; bread-based stuffing mixes; sugar confectionery; sorbets; cotton candy; candy for food; ice creams; ice confectioneries; confectionery in jelly form; candy bars; cakes; cookies; crackers; pies; popcorn; pastry dough; pastries; puddings; Chinese pancake stuffed with sugar (Hotteok); chocolate products; sugar; natural sweeteners; rice cakes; soy sauce [soya sauce]; gochujang; seasonings; chemical seasoning; sauces; ketchup; spices; iced tea; tea; chocolate-based beverages; coffee; beverages made of coffee; cocoa; beverages with a tea base; beverages made of tea; ice; sandwiches; spaghetti; jeon [Korean-style pancakes]; pasta; pizzas. (Class 30)

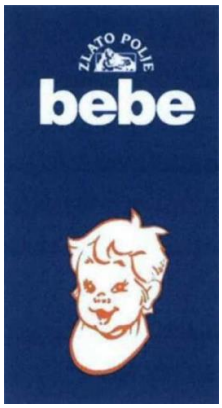
Concentrates for making fruit drinks; powders used in the preparation of fruit-based beverages; syrups for making fruit-flavored drinks; syrups for lemonade;

preparations for making effervescent beverages; syrups and other preparations for making beverages; fruit purees for making beverages; syrups for beverages; vegetable extracts for beverages; concentrated fruit juice; fruit drinks and juices; fruit-flavored beverages; aerated fruit juice; frozen fruit-based drinks; frozen carbonated beverages; plum drinks; sparkling juice based beverages; barley-based beverages; raspberry drinks; non-alcoholic beverages; vitamin enriched water [beverages]; soda pop; soda water; soda drinks; smoothies; sports drinks; rice-based beverages, other than milk substitutes; isotonic drinks; energy drinks; whey beverages; sherbet beverages; non-alcoholic beverages flavoured with tea; vegetable-based beverages and fruit-based beverages; vegetable smoothies; vegetable juices [beverages]; soft drinks; coconut-based beverages; cola; soya-based beverages; cream soda; aerated water [soda water]; herb drinks; brown rice-based beverages, other than milk substitutes; red ginseng drinks; waters [beverages]; flavored waters; beers. (Class 32)

The application was published for opposition purposes on 6 December 2024.

2. On 27 February 2025, Žito prehrambena industrija d.o.o. ("the opponent") opposed the application, in its entirety, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") using the fast track opposition procedure. For the purpose of the opposition, the opponent relies upon the following mark and the goods set out below:

International Registration 1799964:



Date of registration and designation: 3 November 2023

Priority date: 17 May 2023[1]

Food for babies and toddlers; dietetic foods adapted for infants; food preparations for babies and toddlers; beverages for babies and toddlers; lacteal flour for babies and toddlers; diabetic bread, diabetic cookies and biscuits, diabetic crackers. (Class 5)

Tea; flour and cereal products, bread, pastries and confectionery, ice cream; honey, molasses syrup; breakfast cereals, cereal and semolina porridge; food based on semolina, cereals, flakes; wheat, corn, oat or rice flakes; wheat, corn, oat or rice semolina; wheat, corn, oat or rice flour; biscuits; cookies; snacks based on wheat, corn, oats or rice; cereal based snacks; crackers, bread, breadcrumbs, couscous, flour, muesli, rusk, crackers. (Class 30)

3. Under the provisions laid out in section 6 of the Act, the opponent's trade mark clearly qualifies as an earlier mark. Given the respective dates in play, in accordance with section 6A of the Act, the opponent's mark is not subject to the proof of use requirements. Consequently, it can rely upon its mark and all goods it has identified without providing evidence of use.

4. In its Notice of Opposition, the opponent contends that the parties' marks are highly similar, and the respective goods similar or identical, such that there exists a likelihood of confusion.

5. In its counterstatement, the holder denies the opponent's claims, including that the parties' goods are identical or similar to a "high to moderate" degree, concluding instead that the threshold for a likelihood of confusion has not been met.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence

[1] From Slovenian mark Z-202370433

upon such terms as the registrar thinks fit".

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than proof of use evidence which is filed with the notice of opposition) in Fast Track oppositions. No such leave was sought by either party in the present proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, though both parties elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

9. The holder is represented by Withers & Rogers LLP and the opponent by Harrison IP Limited.

Relevance of EU Law

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

Section 5(2)(b)

11. Section 5(2)(b) of the Act reads 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."

12. 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."

Section 5(2)(b) - Case law

13. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

14. The goods to be compared are laid out at paragraphs 1 and 2 to this decision.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*[2], the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

16. In its submissions in lieu, the holder admits that the applied-for goods in class 5 "relating to "baby food"" are similar to the goods relied upon by the opponent which are proper to the same class. To my mind, there are a number of terms in the parties' specifications which are quite clearly identical, either literally or by virtue of the *Meric* principle outlined above. I provide examples of these below:

- In class 5 of their respective specifications, both parties have *food for babies* and a number of the holder's terms are encompassed by the same (*baby food made from aquatic products* or *baby food made from livestock products*, for example).

- In class 30, the parties share a number of terms including *tea*, *breakfast cereals* and *pastries*. There are also several instances in which one parties' goods are encompassed by the other's goods (the holder's *fruit ice creams* are caught by the opponent's *ice cream* and its *cereal-based processed products* is encompassed by the opponent's *flour and cereal products*, for example).

17. In light of these findings, and for reasons which will later become apparent, I will first assess the likelihood of confusion where the respective marks are used in relation to identical goods.

The average consumer and the nature of the purchasing act

[2] Case T- 133/05

18. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question[3]. 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*,[4] Birss J. (as he then was) 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

19. The average consumer of the goods at issue is likely to be a member of the general public (particularly a parent or caregiver in the case of goods such as *food for babies*, for example). To my understanding, the goods are likely to be self-selected from the shelves of a traditional retail outlet such as a supermarket, or an online equivalent. This suggests that the marks' visual impression will play the greatest role in the selection process. However, given that guidance may be sought from retail representatives or peers, for example, I do not discount the relevance of the marks' aural position. The consumer is likely to be alive to considerations such as quality and nutritional value when approaching its selection, though the goods are not typically of a high cost and purchases are made, for the most part, fairly frequently. Weighing all considerations, I find the average consumer will generally pay a medium degree of attention.

Comparison of trade marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse

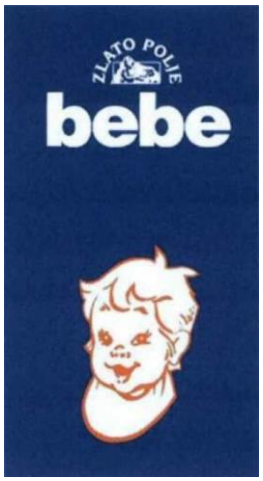
[3] *Lloyd Schuhfabrik Meyer*, Case C-342/97
[4] [2014] EWHC 439 (Ch)

its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM,*[5] that:

> "34. ...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."

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

22. The trade marks to be compared are displayed in the table below:

Opponent's mark	Holder's mark
	**Bebefinn**

[5] Case C-591/12P

23. The opponent's mark is figurative, with various elements positioned on top of a rectangular navy background, presented in a vertical orientation. In the bottom half of the rectangle is an image of an infant's face with a somewhat playful expression. The infant is wearing what appears to be a bib or neckerchief around its neck and is presented in white, though the image's contrasting lines are presented in orange. Above the infant is the word "bebe", expressed in an unremarkable, bold white font. Above "bebe", in a central position, is an arched emblem comprising a number of elements. The words "ZLATO POLJE" are written in the arch's border, with an image appearing below. It is difficult to make out precisely what the image represents though it appears to incorporate a depiction of a person. The arch above 'bebe', and the text within it, are notably smaller than the mark's other elements. Particularly in light of the elements' respective sizes, I consider the mark's overall impression to reside predominantly in the word *bebe*. Its infant image and the words written in the mark's arched element are also significant, though the image within the arch is difficult to identify and therefore plays little part in terms of an overall impression.

24. The holder's mark comprises a single word of eight letters; Bebefinn. In the absence of any additional components, the mark's overall impression resides solely in the word itself.

25. Visually, the marks coincide in four letter sequence b-e-b-e/B-e-b-e. In the holder's mark, these are the first four letters of eight, whilst in the opponent's mark the sequence represents a single word. There are also a number of other elements within the opponent's mark which have no counterpart in the applied-for mark (an image of an infant and an arched emblem with additional wording, for example). Weighing these differences alongside my findings concerning the marks' respective overall impressions, and keeping in mind that the beginnings of marks generally have more of an impact on the consumer,[6] I find the marks' visual similarity is fairly low.

26. Aurally, the opponent's mark is likely to comprise six syllables in its entirety; vaguely ZLAH-TO-POL-JEH-BEE-BEE, though I accept that, particularly as the words within the mark are not ordinary dictionary words with which the average UK consumer will be

[6] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

familiar, the articulation of the respective syllables will naturally vary. Given the respective weight attributed to the mark's different elements, the consumer may be inclined to reduce the mark to two syllables, loosely "BEE-BEE", but I have nothing before me to suggest that this would be the case and will therefore base my comparison on the marks as they appear before me. The holder's mark is likely to be articulated in three syllables, BEE-BEE-FINN. The marks clearly share an identical sequence of two syllables in BEE-BEE, but they are situated in different positions within the parties' marks. There is little meaningful similarity between the marks' remaining aural elements. For completeness, I accept that that there may be variation in the pronunciation of "BEBE" but, regardless of how the consumer chooses to articulate it, it will be consistent in both marks. Keeping in mind what I have said regarding the marks' overall impressions and the effect of the beginnings of marks in particular, I find the aural similarity is of a low degree.

27. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer in the UK.[7] I turn first to the opponent's mark. The image of an infant will naturally evoke a concept of a young child. As for the words ZLATO POLJE, to my mind the average consumer will not derive any meaning from these elements but instead will perceive them simply as foreign or invented words. Given its nature and proportionate size within the mark, the image in the arched element will not provide any conceptual value. The mark's remaining element, 'bebe', is, to my knowledge, not an ordinary dictionary word. Whilst the opponent contends that "the element BEBE has no meaning in English", I note that the holder has alleged that 'bebe' will be "commonly understood and interpreted to mean "baby"". I do not consider this, however, reflective of the average consumer's understanding.[8] Whilst I accept that there may be some UK consumers who identify "bebe" as a foreign word meaning 'baby', I find *the average consumer* will likely perceive it simply as a foreign or invented word and will not assign it any concept. Weighing these findings, the predominant concept likely to be communicated by the opponent's mark is that of a young child. The holder's mark comprises a single word element, BEBEFINN. To my mind, this is likely to be perceived

[7] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29
[8] See, for example, *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, in which Ms Anna Carboni (as the Appointed Person) described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts

as an invented or foreign word which will fail to present any tangible concept. For those consumers to whom 'bebe' is a meaningful term, as above, I accept that this element may be recognised within the mark, and awarded the same meaning. However, for the most part, and particularly as I have found the average consumer will assign no meaning to "bebe", my primary view is that the mark will not present any concept. With this in mind, I find the conceptual position is neutral, with one mark offering the consumer at least some degree of concept and the other absent of any clear concept. If I am considered wrong to find the average consumer unlikely to derive any concept from *bebe*, I accept that this could create a point of conceptual coincidence. However, in the holder's mark, BEBE precedes FINN to create a single word element which, in its entirety, will still be perceived as an invented word without a clear meaning. BEBE is also only one of a number of elements in the opponent's mark. In this scenario, I find the conceptual similarity is of no more than a medium degree.

Distinctive character of the earlier trade mark

28. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[9] 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

[9] Case C-342/97

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)."

29. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

30. As I have no evidence to support a finding of enhanced distinctiveness, I have only the mark's inherent position to consider. As noted above, the earlier mark comprises a number of word and figurative elements. When considered in respect of some of the goods relied upon (foods aimed at babies or children for example), I do not find the image of an infant particularly distinctive. However, I accept that this would not necessarily apply to all of the opponent's goods. The word *bebe*, whilst not particularly elaborate, is not an ordinary dictionary word and I have found it likely to be perceived as a foreign or invented term. Of the mark's remaining components, the words in the mark's emblem will also be perceived as foreign or invented words and will naturally award some distinctiveness to the mark, whilst the image in the arch makes little to no contribution in this regard. Weighing all considerations, and having kept in mind my findings concerning the mark's overall impression, I find the earlier mark is inherently distinctive to between a medium and fairly high degree.

Likelihood of confusion

31. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. 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/services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

32. In *Kurt Geiger v A-List Corporate Limited*[10], Mr Iain Purvis K.C. as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, "in what does the distinctive character of the earlier mark lie?" Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

[10] BL O/075/13

33. Confusion can be direct or indirect. I take note of the comments made by Mr Iain Purvis Q.C. (as he then was), as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*[11], where he explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

[11] BL O/375/10

34. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[12], Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*[13], where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing 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.

35. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

36. I begin by considering a likelihood of direct confusion. As the case law makes clear, this is a simple matter of the average consumer mistaking one trade mark for the other. I have already elected to proceed on the basis that at least some of the parties' terms are identical. Even when I consider the matter in these circumstances, I find there are sufficient differences between the parties' marks, particularly visually, to enable the average consumer to readily identify that the marks are not the same. Not only are the marks' BEBE/BEBEFINN word elements significantly different in their length but the earlier mark incorporates a number of additional word and figurative elements which are absent from the later mark. These are unlikely to be overlooked by the average consumer paying a medium degree of attention, notwithstanding the distinctiveness enjoyed by the earlier mark nor the marks' identical four letter sequence "BEBE". Weighing these considerations, whether the goods' selection is approached by visual or aural means, I find there is no likelihood of direct confusion.

37. As highlighted above, a finding of indirect confusion must have a "proper basis". Even where considered in respect of identical goods, I cannot see a clear line of reasoning as to why the average consumer would, having acknowledged the marks' differences, nonetheless conclude that the marks originate from a shared or related

[12] [2021] EWCA Civ 1207
[13] BL O/219/16

undertaking. The opponent submits that "the average consumer, if they remember the FINN suffix at all, may also infer (incorrectly, but rationally) that the FINN in BEBEFINN denotes a sub-brand or brand extension of a broader BEBE brand." Whilst I do not overlook the distinctiveness of the earlier mark, nor the marks' shared BEBE element, to my mind the differences between the marks, particularly the variation between the words *bebe* and *Bebefinn* are not such that they would be attributed to an evolution of an existing brand or sub-brand, for example. Rather, I find the average consumer is more likely to conclude that two independent entities happened to incorporate the same letter sequence or word "BEBE" in their respective marks. Even where this identical element is identified, I cannot see how the resulting perception would go any further than one mark simply bringing the other to mind, which is not sufficient.[14] I reach this conclusion regardless of whether or not the average consumer applies any meaning to the marks' respective "bebe/Bebe" element. I do not find any of the examples provided above by Mr Purvis applicable here, nor can I find any additional basis on which the average consumer would be minded to conclude that the marks originate from a shared or related undertaking. In short, I can see no *proper basis* for a likelihood of indirect confusion.

38. Having reached that conclusion in respect of identical goods, the opponent would be in no better position were I to assess the likelihood of confusion based on goods of a lesser similarity. For completeness, when approaching its selection of any of the relevant goods, were the average consumer to apply a lower than average degree of attention, I find the marks' differences are sufficient, and of such a nature, to allow the consumer to readily distinguish one from the other.

Conclusion

39. The opposition has failed. Subject to any successful appeal, the application will proceed to registration for all goods applied for.

Costs

[14] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

40. As the holder has succeeded, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 1/2023, with adaptations made for fast track opposition proceedings. In accordance with that TPN, I award the costs to the holder as follows:

Considering a notice of opposition and filing a counterstatement:	£250
Filing written submissions in lieu of a hearing:	£350
Total:	£600

41. I order Žito prehrambena industrija d.o.o. to pay The Pinkfong Company, Inc. the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of January 2026

Laura Stephens
For the Registrar