O/0091/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003935771

IN THE NAME OF ELISE & GASTON LIMITED

FOR THE FOLLOWING TRADE MARK:

Elise & Gaston

IN CLASS 30

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. CA000507292

BY

GENUPORT TRADE GMBH

Background and pleadings

1. Elise & Gaston Limited ("the proprietor") is the owner of the trade mark shown on the cover page of this decision ("the contested mark"). The contested mark was filed on 19 July 2023 and registered on 8 December 2023. It stands registered for the following goods:

Class 30 Chocolates; Chocolate sweets; Chocolates in the form of pralines; Chocolate truffles; Chocolate biscuits; Chocolate; Chocolate confectionery; Caramels [sweets]; Truffles [confectionery]; Candies [sweets]; Confectionery chocolate products; Chocolate coated biscuits; Sweets; Milk chocolate; Bonbons; Pralines; Chocolate chips; Shortbread with a chocolate coating; Chocolate fudge; Chocolate bars; Biscuits having a chocolate coating; Chocolate shells; Chocolate spread; Shortbread part coated with chocolate; Candy; Candy canes; Lollipops; Confectionery; Chocolate spreads containing nuts; Chocolate-based spreads; Gummy candies; Confectionery chips for baking; Macarons; Tarts [sweet or savoury]; Biscuits; Waffles; Pancakes; Crepes; Chocolate coffee; Cappuccino; Non-dairy ice cream; Dairy ice cream; Ice cream desserts; Vegan ice cream; Coffee.

2. On 26 April 2024, Genuport Trade GmbH ("the applicant") applied to revoke the contested mark in respect of all goods for which it is registered based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The applicant relies upon the following trade mark:

Gaston ("the earlier mark")

UK Trade Mark no ("UKTM"): UK801436259[1]

Filing date: 29 August 2018

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 56 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the applicant having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original EUTM filing date of 29 August 2018

Registration date: 29 April 2019

Relying upon all goods for which the mark is registered, namely:

Class 29 Fruits, preserved; preserved vegetables; dried fruits; dried vegetables; jellies for food; fruit spreads; jams; compotes; glazed fruits; extruded potato products for food [as far as included in this class]; fruit chips, vegetable chips and potato chips; potato sticks; potatoes-based snacks; raisins; processed nuts and seeds, particularly hazelnuts, peanuts, cashews, pistachios and almonds, dried, roasted, salted and/ or spiced; cassava chips.

Class 30 Sweetmeats [candy]; bakery goods; confectionery; coffee; tea; cacao; coffee substitutes; rice; sago; flours; cereal preparations; ice cream; sugar; honey; yeast; baking powder; salt; mustard; vinegar; sauces [condiments]; spices; products made from tapioca, rice, maize, wheat or cereal for snack purposes; puffed corm; chocolate coated and sugar-coated fruits.

3. The applicant argues that the respective goods are identical or similar and that the marks are similar, therefore resulting in a likelihood of confusion.

4. The proprietor filed a counterstatement denying the claims made.

5. The mark relied upon is deemed an earlier mark in accordance with section 6 of the Act. Given that it has been registered for more than five years from the date of the application, ordinarily it would be subject to the proof of use requirements under section 6A of the Act. However, the proprietor did not put the applicant to proof of use of its mark and consequently it may rely upon all of its goods as identified.

6. The applicant is represented by Wilson Gunn, and the proprietor is represented by Moore Barlow LLP. Only the proprietor filed evidence. No hearing was requested and only the applicant filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

Relevance of EU LAW

7. 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.

Evidence & Submissions

8. The proprietor's evidence consists of the witness statement of Mr Fouad Hachemi, dated 3 February 2025, which is accompanied by two exhibits (FH1 – FH2). Mr Hachemi is the Director of Elise & Gaston Limited, and he provides evidence of use of the contested marks as relied upon. I have read Mr Hachemi's evidence in its entirety and will summarise the most pertinent points below.

9. The applicant has filed written submissions in lieu dated 8 April 2025.

10. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate to the extent that it is necessary in my decision.

Preliminary Issues

11. I have reviewed the content of Mr Hachemi's witness statement and note that he has provided evidence of the proprietor's mark in use, along with a selection of pages from the applicant's website, which he states:

> "show that the Applicant is focused on importing and marketing of foodstuffs in Germany rather than the UK and that its target market is other businesses and not consumers."

12. In respect of the submissions regarding the mark in use, the claim under section 5(2)(b) and the assessment as to a likelihood of confusion is one to be taken on a notional basis in relation to the marks and the goods as registered and not in fact how

they are being used in the marketplace. The commercial use of the contested mark or the earlier mark is therefore of little relevance in these proceedings. I do not consider that the proprietor's evidence assists me in this assessment, and therefore, I will not comment any further upon this evidence.

Decision

13. Section 5(2)(b) has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
>> (a) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
>>
>> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
>> (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
>>
>> (b) the registration procedure for the earlier trade mark was not completed before that date, or
>>
>> (c) the use conditions are met.
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

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

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

Relevant law

14. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 C120/04, *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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

15. The competing goods are as follows:

The contested mark	**The earlier mark**
	Class 29: Fruits, preserved; preserved vegetables; dried fruits; dried

	vegetables; jellies for food; fruit spreads; jams; compotes; glazed fruits; extruded potato products for food [as far as included in this class]; fruit chips, vegetable chips and potato chips; potato sticks; potatoes-based snacks; raisins; processed nuts and seeds, particularly hazelnuts, peanuts, cashews, pistachios and almonds, dried, roasted, salted and/ or spiced; cassava chips
Class 30: Chocolates; Chocolate sweets; Chocolates in the form of pralines; Chocolate truffles; Chocolate biscuits; Chocolate; Chocolate confectionery; Caramels [sweets]; Truffles [confectionery]; Candies [sweets]; Confectionery chocolate products; Chocolate coated biscuits; Sweets; Milk chocolate; Bonbons; Pralines; Chocolate chips; Shortbread with a chocolate coating; Chocolate fudge; Chocolate bars; Biscuits having a chocolate coating; Chocolate shells; Chocolate spread; Shortbread part coated with chocolate; Candy; Candy canes; Lollipops; Confectionery; Chocolate spreads containing nuts; Chocolate-based spreads; Gummy candies; Confectionery chips for baking; Macarons; Tarts [sweet or savoury]; Biscuits; Waffles; Pancakes; Crepes; Chocolate coffee; Cappuccino; Non-dairy ice cream; Dairy ice cream; Ice	Class 30: Sweetmeats [candy]; bakery goods; confectionery; coffee; tea; cacao; coffee substitutes; rice; sago; flours; cereal preparations; ice cream; sugar; honey; yeast; baking powder; salt; mustard; vinegar; sauces [condiments]; spices; products made from tapioca, rice, maize, wheat or cereal for snack purposes; puffed corm; chocolate coated and sugar-coated fruits.

cream desserts; Vegan ice cream; Coffee.	

16. The proprietor submits:

"2. It is not accepted that the goods in the Later Registration are identical or similar to those of the Earlier Registration: the Applicant's mark covers fruits, nuts and vegetables under class 29 and so has a focus on raw food products which are not similar to class 30 goods. By contrast, the Later Registration in class 30 only covers finished food products, including sweets, chocolates, confectionery and biscuits. The Earlier Registration makes no mention at all of biscuits, macarons or related items and concentrates on raw food materials and products.

3. Given that the Later Mark is not registered in relation to goods which are similar or identical or those covered by the Earlier Mark, there exists no significant risk of confusion".

17. The applicant submits:

"17. The class 30 goods of the Later Registration are identical with and highly similar to the class 30 goods for which the Earlier Registration is protected, being for confectionery, sweets and desserts.

18. The class 30 goods of the Later Registration are similar to the class 29 goods of the Earlier Registration being in relation to foodstuffs. Raisins, nuts, seeds, jams and jellies, for which the Earlier Registration has protection in class 29 are often used on and with the products for which the Later Registration has been registered in class 30.

19. The Proprietor, in Paragraphs 2 & 3 of the Counterstatement denies that the goods of the Later Registration are identical with or similar to the goods of the Earlier Registration, citing that the Earlier Registration has a focus on "raw foods" whereas the Later Registration covers "finished food products". The Proprietor has not given sufficient weight to the inclusion of identical terms

present in both class 30 specifications, nor that the Earlier Registration has protection for confectionery, ice cream, chocolate coated fruits, to name a few, which are all identical to the class 30 goods of the Later Registration and are all "finished food products".

20. Overall, the goods of the Later Registration are identical with and highly similar to the goods of the Earlier Registration".

18. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "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."

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

20. 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 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."

21. I bear in mind that it is permissible to group goods/services together for the purposes of the assessment[2].

Confectionery;

22. The applicant's specification also includes the term *confectionery* in class 30. These terms are self-evidently identical.

Chocolates; Chocolate sweets; Chocolates in the form of pralines; Chocolate truffles; Chocolate; Chocolate confectionery; Caramels [sweets]; Truffles [confectionery]; Candies [sweets]; Confectionery chocolate products; Sweets; Milk chocolate; Bonbons; Pralines; Chocolate chips; Chocolate fudge; Chocolate bars; Chocolate shells; Candy; Candy canes; Lollipops; Gummy candies; Confectionery chips for baking; Macarons;

23. The applicant's specification includes the term *confectionery*. I consider confectionery to be defined as sweet foods that are rich in sugar and carbohydrates and can include items such as sweets, chocolate, sweet pastries and cake. The

[2] *Separode Trade Mark* O/399/10

applicant's term is wide and therefore encompasses the proprietor's above terms on the principles outlined in *Meric*.

Chocolate coated biscuits; Shortbread with a chocolate coating; Biscuits having a chocolate coating; Shortbread part coated with chocolate; Biscuits; Chocolate biscuits;

24. I consider the proprietor's terms to be encompassed by the applicant's earlier *bakery goods* and as such they are identical on the principles outlined in *Meric*. If I am wrong about that, I consider that biscuits such as those outlined above may be chosen as an alternative sweet snack to bakery goods or confectionery and therefore share a purpose. They will all be eaten informally without utensils, and there may be some overlap in nature where the earlier confectionery is chocolate based and the proprietor's biscuits are chocolate coated. There is a degree of competition between the goods. Users will be shared; however, it is my view that the respective goods are unlikely to be sold on the same shelves. I do not find complementarity. Overall, I find that these goods are similar to between a medium and high degree.

Chocolate spread; Chocolate spreads containing nuts; Chocolate-based spreads;

25. The applicant's specification includes the term *confectionery*. There may be an overlap in nature as confectionery (as defined above) includes goods which are chocolate-based. I consider that the purpose of the goods will differ, as will the method of use (confectionery normally being chosen as a standalone sweet treat, such as a chocolate bar, whereas spreads would be used as a topping or filling which is added to other goods), however, there may be an overlap in user. It is foreseeable that an entity would produce both chocolates and chocolate spread, and there may be an element of overlap in trade channels, however, I do not consider that the goods would be found on the same shelves in supermarkets, as chocolates would not be found in the same aisles as spreads, which are likely to be found near preserves. I do not find competition, nor do I find complementarity. Overall, I find the goods to be similar to a medium degree.

Tarts [sweet or savoury];

26. In the absence of specific submissions, I consider a tart to consist of a pastry base with an open top, which can be filled with either sweet or savoury ingredients. I consider a tart to be a type of baked goods, and this term would therefore be encompassed by the applicant's *bakery goods* on the principles outlined in *Meric*.

Waffles; Pancakes; Crepes;

27. The above goods are generally considered to be baked goods. The applicant's specification includes the term *bakery goods*. I consider this to be a wide term which encompasses the proprietor's above terms on the principles outlined in *Meric*. If I am wrong about that, I consider that there will be an overlap in purpose and method of use and there may also be an overlap in user. There may be an overlap in trade channels. I do not find competition, nor do I find complementarity. Overall, I find the goods to be similar to a high degree.

Non-dairy ice cream; Dairy ice cream; Ice cream desserts; Vegan ice cream;

28. The applicant's specification includes the term *ice cream* in class 30. I consider this to be a wide term which encompasses the proprietor's above terms on the principles outlined in *Meric*.

Chocolate coffee; Cappuccino; Coffee.

29. The proprietor's above terms are all types of coffee. The applicant's specification includes the term *coffee* at large and therefore encompasses the above on the principles outlined in *Meric*.

Average consumer and the purchasing act

30. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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. (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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

31. The average consumer will be members of the general public. The goods at issue are day-to-day consumable products, being foodstuffs and beverages. The goods will be purchased fairly frequently and be relatively inexpensive. Consideration may be given to the content of the food and its nutritional value. I would expect the general public to pay a fairly low degree of attention during their selection. The goods are likely to be self-selected from a supermarket or their online equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, given that word of mouth recommendations may be made, or requests made to serving staff, I do not completely discount an aural component to the purchase.

Comparison of marks

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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."

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

34. The respective trade marks are shown below:

The applicant's mark	The proprietor's mark
Gaston	Elise & Gaston

35. The proprietor submits:

> "It is admitted that the Later Mark contains the word GASTON but it is not admitted that GASTON is a dominant element of the Later Mark both visually, conceptually and phonetically, ELISE & GASTON is significantly different to GASTON in trade mark terms; where one or more words are used in a mark, it is likely that the first word ELISE will be seen as having dominance, especially by the relevant market sector here (consumers). In addition, the use of the "&" further distinguishes the marks conceptually as the Later Mark is made up of 2 Christian names not one and removes the likelihood of confusion in practice."

36. The applicant submits:

> "23. The term GASTON in the Later Mark is a co-dominant and distinctive element of the mark. The Earlier Mark is for the identical term GASTON
>
> 24. In paragraph 1 of the Counterstatement it is argued that GASTON is not the dominant element of the Later Mark and that "&" distinguishes the mark conceptually with the Later Mark being "made up of two Christian names".
>
> 25. GASTON is distinctive in relation to the goods in question and has no inherent meaning or describing elements in relation to foodstuffs. The average

consumer would consider it to be a name and so would consider it to be indicative of the origin of the product.

26. The “&” adds little distinctive value as the average consumer would understand it to mean “and”. Therefore, the Later Mark would be considered as being, phonetically and conceptually, ELISE AND GASTON. Therefore, it would be perceived by the average consumer as being a collaboration between two parties, one called ELISE and another called GASTON.

27. At paragraph 3 of the Proprietor’s witness statement, it is stated that the Later Mark is always used in conjunction with a carriage design. However, the Later Registration is for a word mark and so the protection sought is for the word elements, which contain the identical word GASTON for which the Earlier Registration has protection.

28. Overall, the Later Mark is highly similar to the Earlier Mark”

Overall impression

37. The earlier mark is a word only mark which consists of the word ‘Gaston’. The mark is presented in a plain typeface. There are no other elements in the mark which contribute to its overall impression, which lies in the word itself.

38. The contested mark is a word only mark which consists of the words ‘Elise & Gaston’. The ‘&’ will be understood to mean ‘AND’ by the average consumer. The mark is presented in a plain typeface. There are no other elements in the mark which contribute to its overall impression. As the word ‘AND’ is a conjunction which is used to join two words, I find that ‘Elise’ and ‘Gaston’ are equally dominant elements of the contested mark.

Visual comparison

39. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise which means that either mark is capable of being presented in any typeface. In this instance, both marks are word only marks. Visually, the competing marks are similar to the extent that they share the word ‘Gaston’. However,

I note that the word has different positions in both marks, appearing as the second word in the contested mark and the only word in the earlier mark, which will act as a point of difference. The contested mark also contains 'Elise &' which will not go unnoticed. Overall, I am of the view that the shared use of 'Gaston', albeit at different positions within the respective marks, is such that the marks are visually similar to a medium degree.

Aural comparison

40. As outlined above, the marks share the same word, 'Gaston', which I consider will be pronounced identically in both marks as GAS-TON. The contested mark also contains the additional word/symbol 'Elise &' which will be pronounced EH-LEES AND (the '&' being articulated as set out above), and this will be a point of aural difference between the marks. Taking all of this into account and noting that the beginning of the marks tends to have more aural impact than the ending,[3] I consider the marks to be aurally similar to a low to medium degree.

Conceptual comparison

41. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU[4]. Both parties have identified that the words used in both marks are names.

42. In this instance, as a point of similarity, both marks include the word 'Gaston'. In my view, the average consumer is likely to identify this word as a name.

43. The contested mark also contains the additional word/symbol, 'Elise &'. I consider that the average consumer will also understand 'Elise' to be a name, and therefore, the contested mark will be understood to be made up of two forenames. These will not be considered as a first name and a surname due to the use of '&' in the middle of the mark which joins the two (as set out above).

[3] *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02
[4] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

44. Taking all of this into account, and on the basis that I have found ‘Elise’ and ‘Gaston’ are equally dominant elements of the contested mark, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the applicant’s trade mark

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

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

46. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The applicant has not pleaded that its mark

has obtained an enhanced level of distinctiveness and no evidence has been filed to that effect. Therefore, I only have the inherent position to consider.

47. The applicant's mark consists of the word 'Gaston' which is a forename. As there are no other elements to the mark which contribute to its overall impression, the distinctiveness lies in the word itself.

48. In *Harman International Industries, Inc v OHIM,* Case C-51/09P, the CJEU found that:

> "Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common".

49. Whilst I therefore recognise that, as a general rule, forenames are considered to be less distinctive, I also recognise that 'Gaston' is not a particularly common name within the UK. The mark is not descriptive or directly allusive of the goods, and therefore overall, I consider the earlier mark to be inherently distinctive to a medium degree.

Conclusions on Likelihood of Confusion

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related.

51. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. 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 necessary for me to keep in mind the distinctive character of the applicant's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

52. I have found as follows:

- The goods at issue range from being identical either self-evidently or on the principles in *Meric* to having a medium degree of similarity.
- I have identified that the average consumer will be members of the general public. They will select the goods primarily by visual means, although I do not discount an aural component;
- I have concluded that members of the general public will pay a fairly low degree of attention;
- The contested mark is visually similar to the earlier mark to a medium degree;
- The contested mark is aurally similar to the earlier mark to a low to medium degree;
- I have found the contested mark and the earlier mark to be conceptually similar to a medium degree;
- I have found the earlier mark overall to be inherently distinctive to a medium degree;

53. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I do not consider that consumers would misremember or inaccurately recall which mark was which. Even though both marks share the identical word 'Gaston' (which is not descriptive or allusive of the goods at issue), the additional elements in the contested mark will not be overlooked. As a result, I do not find that consumers will be directly confused by the marks as a result of the common presence of 'Gaston' and I do not find that the consumer is likely to mistake one mark for another.

Consequently, I do not consider that there exists a likelihood of direct confusion between the marks, even on identical goods.

54. Moving on to consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[5]

> "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 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-

[5] BL O/375/10

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).”

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

56. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[6]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[7]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.

57. For indirect confusion to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods provided under one are regarded as a brand extension or sub brand of the other, for example.

58. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo,* Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson.* The judge said:

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[6] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[7] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

59. As stated above, I have found that ‘Elise’ and ‘Gaston’ are equally dominant elements of the contested mark. Despite the fact that both marks share the same word, ‘Gaston’, I do not consider this to be so distinctive that the average consumer would assume that no one but the brand owner would use this. In addition, I can see no logical reason which would lead consumers to think that the proprietor’s mark is a sub-brand or brand extension of ‘Gaston’, particularly as ‘Elise &’ is not indicative of the goods for which a sub-brand would be assumed to relate. Further, the placement of ‘Gaston’ within the proprietor’s mark, being the second name, reiterates this, as if the proprietor’s mark was a brand extension or a sub-brand, you would expect ‘Gaston’ to appear as the first name in the mark. Further, I do not consider that the proprietor’s mark would be seen as a collaboration between two different brands, one belonging to ‘Gaston’ and one to ‘Elise’, as whilst they are equally dominant elements of the proprietor’s mark, neither is so distinctive that one would assume that no other brands would use the names. I also have no evidence before me to suggest that collaborations are particularly common in the confectionary business.

60. As stated above, whilst ‘Gaston’ is not a particularly common name, I do not consider that the average consumer would find this to be so significant that only the proprietor would use it. In respect of the contested mark, I have found ‘Elise’ and ‘Gaston’ are equally dominant elements of the mark, and as such they are more likely to be seen as one, not two marks, and it is not sufficient that a mark merely calls another mark to mind[8]. If I am wrong about that, it does not automatically follow that there is a likelihood of indirect confusion, and as stated in *Whyte and Mackay,* a specific assessment of the likelihood of confusion is still required.

61. Taking all of the above into account, I find that there exists no likelihood of indirect confusion, even when the consumers are confronted by the marks on identical goods.

Conclusion

62. The application to invalidate UK trade mark registration number 3935771 under section 5(2)(b) of the Act is unsuccessful in its entirety, subject to any successful appeal.

[8] *Duebros Limited v Heirler Cenovis GmbH* O/547/17

COSTS

63. The proprietor has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note ("TPN") 1/2023. In the circumstances I award the proprietor the sum of £600 as a contribution towards the cost of the proceedings. I note that the proprietor has filed a witness statement and two exhibits in respect of these proceedings, however, as stated above, I did not consider that the proprietor's evidence assisted me in this assessment and have therefore made my assessment of costs accordingly. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£250.00
Preparing evidence and considering the other side's submissions	£350.00
Total:	**£600.00**

64. I therefore order Genuport Trade GmbH to pay Elise & Gaston Limited the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of February 2026

LA Bailey

For the Registrar