

O/0159/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003893940
IN THE NAME OF ERM GLASGOW LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

Chulo's

IN CLASS 30

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000441969
BY ANGELS SHARE (MCR) LIMITED**

Background and pleadings

1. On 27 March 2023, ERM GLASGOW LTD (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 14 April 2023 in respect of the following goods¹:

Class 30: Cookies; Filled cookies; Cookie dough; Cookie mixes; Bakery goods; Dough for cakes.

2. On 14 July 2023, Angels Share (MCR) limited (“the Opponent”) opposed the application under Section 5(2)(b)² of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods in the application. The Opponent relies upon the following two marks:

Chu Lo

UK Registration no. UK00003371478 (“The first earlier mark”)

Filing date: 30 January 2019

Date of registration: 07 June 2019

Relying upon the following goods:

Class 32: Soft drinks; Soft drinks flavored with tea; Carbonated soft drinks; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Fruit-flavored soft drinks; Low calorie soft drinks; Low-calorie soft drinks.



¹ The specification applied for was amended via a form TM21B filed on 05 June 2024.

² At the point of filing, the Opponent also opposed the application based on Section 5(3) and Section 5(4)(a) of the Act. However, as the Opponent did not evidence, the opposition was deemed withdrawn in respect of those grounds. This was confirmed in the official letter of 10 June 2025.

UK Registration no. UK00003451958 (“The second earlier mark”)

Filing date: 16 December 2019

Date of registration: 20 March 2020

Relying upon the following goods:

Class 32: Carbohydrate drinks; Carbonated non-alcoholic drinks; Carbonated soft drinks; Colas [soft drinks]; Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit juice drinks; Fruit-flavored soft drinks; Non-alcoholic drinks; Non-alcoholic fruit drinks; Non-alcoholic sparkling fruit juice drinks.

3. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of section 6 of the Act. As the earlier marks had not completed their registration process more than five years before the filing date of the application in issue, they are not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.
4. The Opponent submits that the marks and the goods at issue are similar.
5. The Applicant filed a counterstatement within which it denies the grounds of opposition. They submit that the goods covered by the Opponent’s registered trade marks and those for which the Applicant is seeking protection are dissimilar.
6. Neither party filed evidence during proceedings. Neither party requested a hearing, however, the Applicant filed submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.
7. The Applicant is represented by Hindles Limited; the Opponent is represented by Abion UK Limited.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the

Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying 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.

DECISION

Section 5(2)

9. The opposition is based upon Sections 5(2)(b) of the Act, which read 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”.

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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

11. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="204 250 547 288">("The first earlier mark")</p> <p data-bbox="204 309 344 342"><u>Class 32:</u></p> <p data-bbox="204 362 786 674">Soft drinks; Soft drinks flavored with tea; Carbonated soft drinks; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Fruit-flavored soft drinks; Low calorie soft drinks; Low-calorie soft drinks.</p>	<p data-bbox="809 309 949 342"><u>Class 30:</u></p> <p data-bbox="809 362 1388 506">Cookies; Filled cookies; Cookie dough; Cookie mixes; Bakery goods; Dough for cakes.</p>
<p data-bbox="204 696 600 734">("The second earlier mark")</p> <p data-bbox="204 752 344 786"><u>Class 32:</u></p> <p data-bbox="204 806 786 1229">Carbohydrate drinks; Carbonated non-alcoholic drinks; Carbonated soft drinks; Colas [soft drinks]; Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit juice drinks; Fruit-flavored soft drinks; Non-alcoholic drinks; Non-alcoholic fruit drinks; Non-alcoholic sparkling fruit juice drinks.</p>	

12. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, 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.

13. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

14. 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 OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82. ...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”.

15. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

Cookies; Filled cookies; Cookie dough; Cookie mixes; Bakery goods; Dough for cakes.

16. The Opponent's earlier rights both cover a range of non-alcoholic beverages; for the purposes of comparing the goods at issue I will consider the goods covered by these registrations as a whole. The Opponent submits that the goods at issue are similar as beverages are often sold in food courts or venues where food products are also offered.³ However, the fact that the average consumer may be able to buy bakery goods or a drink from the same establishment (such as a café) is not a strong basis for finding similarity.

17. I accept that there would be an overlap in trade channels with the Opponent's goods at a very general level, to the extent that they are all likely to be sold through supermarkets or other food vendors. However, even where the goods are stocked in the same shop, they will not usually be sold on the same aisles or within close proximity to one another.

18. While the goods at issue are all to be consumed, the Applicant's baked goods and dough products differ in their nature, purpose and method of use to the Opponent's range of beverages. The Applicant's goods are all snack or dessert foods (or their ingredients) to be eaten, while the Opponent's goods are all liquids to be drunk for refreshment or hydration. The goods are not in competition as a consumer would not choose to purchase a food product in place of a drink. Neither do I consider the goods to be complementary, as they are not important nor indispensable to one another.⁴ Overall, I consider the goods to be dissimilar.

³ Opponent's TM7 page 6 (question 9).

⁴ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

19. It is a prerequisite of section 5(2)(b) that the goods be similar. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.⁵ As I have found all of the goods to be dissimilar, the opposition fails in its entirety.

CONCLUSION

20. The opposition based upon 5(2)(b) has failed. Subject to any successful appeal against my decision, the application will proceed to registration.

COSTS

21. The Applicant has been successful and is entitled to a contribution towards its costs, typically based upon the scale published in Tribunal Practice Notice 1/2023. However, I note that the Applicant has requested an award of costs off the published scale.⁶ In view of this, ERM GLASGOW LTD has 14 days from the date shown below to make written submissions regarding their claim for off-scale costs. I will permit Angels Share (MCR) limited 14 days from the date of receipt of ERM GLASGOW LTD's submissions to respond to those submissions.

22. The period for appeal against my decision for the application to proceed to registration and whatever decision I make on costs, will run from the date of my final decision.

Dated this 26th day of February 2026

Emma Rees
For the Registrar

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden

⁶ Applicant's submissions in lieu paragraph 4.3