O/0175/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003893743
BY HERMANOS COLOMBIAN COFFEE ROASTERS LTD
TO REGISTER THE TRADE MARK:

HERMANOS COLOMBIAN COFFEE ROASTERS

IN CLASSES 18, 25, 29, 30, 32, 35, 40 AND 43
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600003036 (FAST TRACK)
BY VINCENZO RAPISARDA

AND

IN THE MATTER OF REGISTRATION NO. UK00003668384
IN THE NAME OF VINCENZO RAPISARDA
FOR THE TRADE MARK:

hermanos

IN CLASS 43
AND
IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506728
BY HERMANOS COLOMBIAN COFFEE ROASTERS LTD

BACKGROUND AND PLEADINGS

1. This decision involves cross-consolidated proceedings wherein Vincenzo Rapisarda ("VR") and Hermanos Colombian Coffee Roasters Ltd ("HC") brought actions against one another. I summarise the relevant proceedings below, beginning with VR's opposition on the basis that it was brought first.

VR'S OPPOSITION AGAINST HC'S APPLICATION NO. UK00003893743

2. On 27 March 2023, HC applied to register the following trade mark:

HERMANOS COLOMBIAN COFFEE ROASTERS

3. The mark contains the following disclaimer:

> *"Registration of this mark shall give no right to the exclusive use of the words 'COLOMBIAN COFFEE'."*

4. The application was published for opposition purposes on 16 June 2023 in respect of the following goods and services:

> **Class 18:** *Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals; bags, wallets and other carriers; tote bags; grocery tote bags; canvas bags; canvas shopping bags; cloth bags; casual bags; reusable shopping bags; textile shopping bags; parts and fittings for all the aforesaid goods.*
>
> **Class 25:** *Clothing, footwear, headgear; shirts; t-shirts; casual shirts; long-sleeved shirts; printed t-shirts; sweatshirts; hooded sweatshirts; socks; gloves; trousers; casual trousers; leggings [trousers]; jogging bottoms; jogging tops; jogging pants; hats; beanie hats; sports caps and hats; parts and fittings for all the aforesaid goods.*

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other milk products; oils and fats for food; birds' eggs and egg products; dairy products and dairy substitutes; dairy spreads; chilled dairy desserts; dairy-based beverages; cream [dairy products]; dairy-based whipped topping; dairy-based beverages containing oats; milk based drinks; milk beverages; milk drinks; milk based drinks [milk predominating]; milk-based beverages; milk-based snacks; milk beverages with high milk content; milk-based beverages containing coffee from Colombia; milk-based beverages flavored with chocolate; coffee creamers; flavoured milk drinks; flavoured milk beverages; milk beverages with cocoa; milk beverages containing fruits; beverages made from milk; milk-based beverages containing fruit juice; edible oils and fats; meat products; seafood and molluscs, not live; processed fruits, fungi, vegetables, nuts and pulses; sausage skins and imitations thereof; soups and stocks.*

Class 30: *Coffee, cocoa and substitutes therefor; iced coffee; coffee extracts; chocolate coffee; coffee concentrates; flavoured coffee; ground coffee; coffee bags; decaffeinated coffee; instant coffee; coffee beverages; coffee drinks; coffee beans; mixtures of coffee; coffee based beverages; prepared coffee and coffee based beverages; ground coffee beans; drip bag coffee; roasted coffee beans; coffee in brewed form; coffee beverages with milk; powdered coffee in drip bags; ice beverages with a coffee base; preparations for making beverages [coffee based]; coffee [roasted, powdered, granulated, or in drinks]; coffee based fillings; all of the aforementioned goods being from Colombia; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice [frozen water]; instant tea; tea beverages; tea bags; iced teas; tea-based beverages; tea beverages with milk; preparations for making beverages [tea based]; cooling ice; processed grains, starches, and goods made thereof, baking preparations; frozen yogurts; flavourings ; baked goods, chocolate and desserts; tea cakes; cakes, tarts and biscuits (cookies); milk chocolate*

teacakes; fruit cake snacks; sweet and savoury snacks; flour based savoury snacks; chocolate cakes; cream cakes; sponge cakes; iced cakes; chocolate pastries; savoury pastries; fruit pastries; almond pastries; pastries containing creams; prepared desserts [pastries]; pastries containing creams and fruit; pies [sweet or savoury]; tarts [sweet or savoury]; biscuits [sweet or savoury]; chocolate biscuits; salty biscuits; bread biscuits; savoury biscuits; filled biscuits; cheese-flavoured biscuits; biscuits flavoured with fruit; biscuits having a chocolate coating; biscuits containing chocolate flavoured ingredients; sweet biscuits for human consumption; savoury snacks; pastries consisting of vegetables and fish; pastries consisting of vegetables and meat; pastries consisting of vegetables and poultry; natural sweeteners, sweet coatings and fillings; sweet glazes and fillings.

Class 32: *Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages; non-alcoholic beer; non-alcoholic drinks; non-alcoholic carbonated beverages; smoothies [non-alcoholic fruit beverages]; non-alcoholic beverages flavoured with coffee from Colombia; non-alcoholic beverages flavoured with tea; flavoured carbonated beverages; carbonated non-alcoholic drinks; soda pops; soda water; tonic water; glacial water; coconut water; spring water; table water; aerated water [soda water]; sparkling water; still water; waters [beverages]; juices; juice drinks; aerated juices; fruit juice drinks; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing vegetable juices; non-alcoholic cordials; syrups and other non-alcoholic preparations for making beverages; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making beverages. .*

Class 35: *Wholesale, retail and online retail services connected with the sale of subscription boxes containing coffee and coffee preparations; retail and online retail services in relation to coffee; wholesale services in relation to coffee; all of the aforementioned services being in relation to Colombian coffee; Advertising; business management, organization and administration; office functions; advertising, marketing and promotional services; business assistance, management and administrative services; commercial trading and*

consumer information services; wholesale and retail services in relation food, drinks, clothing, headgear and bags; online retail services in relation to food, drinks, clothing and tote bags; retail and online retail services in relation to non-alcoholic beverages; wholesale, retail and online retail services connected with the sale of subscription boxes containing food; wholesale services in relation to non-alcoholic beverages; retail and online retail services in relation to preparations for making beverages; wholesale services in relation to preparations for making beverages; retail services via global computer networks related to non-alcoholic beverages; mail order retail services related to non-alcoholic beverages; retail and online retail services connected with the sale of clothing and clothing accessories; retail and online retail services in relation to teas; wholesale services in relation to teas; wholesale, retail and online retail services in relation to baked goods; information, advisory and consultancy services relating to the aforesaid.

Class 40: *Recycling of waste and trash; air purification and treatment of water; printing services; food and drink preservation; treatment of food and beverages; coffee roasting and processing; grinding of coffee; food processing; pasteurising of food and beverages; information, advisory and consultancy services relating to the aforesaid.*

Class 43: *Coffee shops; coffee shop services; café, cafeteria, snack bar, coffee bar, coffee house, restaurant, bar and takeaway services; operation of a café or coffee shop; all of the aforementioned services being in relation to Colombian coffee; Services for providing food and drink; temporary accommodation; information, advice and reservation services for the provision of food and drink; provision of food and drink; serving food and drinks; takeaway food and drink services; food and drink preparation services; catering of food and drinks; preparation of food and drink; preparation and provision of food and drink for immediate consumption; provision of information relating to the preparation of food and drink; cafés; rental of furniture, linens, table settings, and equipment for the provision of food and drink; information, advisory and consultancy services relating to the aforesaid.*

5. On 18 September 2023, the application was partially opposed by VR under the fast-track procedure. The opposition, which is directed against the applied-for goods and services in classes 29, 30, 32, 35, 40 and 43, is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), with VR relying on the following trade mark:

UK00003668384 hermanos Filing date: 14 July 2021 Date of entry in register: 12 November 2021 **Class 43:** *Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Carvery restaurant services; Hotel restaurant services; Mobile restaurant services; Restaurant reservation services; Providing restaurant services; Restaurant information services; Japanese restaurant services; Spanish restaurant services; Ramen restaurant services; Tempura restaurant services; Washoku restaurant services; Sushi restaurant services; Carry-out restaurants; Self-service restaurants; Restaurants (Self-service -); Reservation of restaurants; Fast food restaurants; Take-out restaurant services; Self-service restaurant services; Salad bars [restaurant services]; Booking of restaurant seats; Fast-food restaurant services; Restaurant and bar services; Bar and restaurant services; Providing reviews of restaurants; Providing information about restaurant services; Restaurant services provided by hotels; Udon and soba restaurant services; Restaurant services incorporating licensed bar facilities; Provision of information relating to restaurants; Providing reviews of restaurants and bars; Agency services for reservation of restaurants; Travel agency services for booking restaurants; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink in restaurants and bars; Serving food and drink in restaurants and bars; Serving food and drink for guests in restaurants; Providing food and drink for guests in restaurants.*

6. VR claims that the marks are similar and that the goods and services are identical or similar, leading to a likelihood of confusion.

7. By virtue of its earlier filing date, the trade mark relied upon by VR is an “earlier mark” in accordance with Section 6 of the Act. As VR’s earlier mark had not been registered for more than five years when HC’s mark was filed, it is not subject to the use conditions under Section 6A of the Act. Consequently, VR may rely upon all of the services it has identified without demonstrating that it has used the mark. However, this is subject to the invalidity filed by HC being rejected and to VR’s earlier trade mark remaining registered for the services relied upon (see below).

8. HC filed a defence and counterstatement denying the claims made.

HC’S INVALIDITY AGAINST VR’S REGISTRATION NO. UK00003668384

9. On 23 November 2023, HC applied to invalidate VR’s earlier mark UK00003668384 in its entirety based upon Section 5(4)(a) of the Act. Under this ground, HC relies upon the unregistered signs ‘HERMANOS’ and ‘HERMANOS COLOMBIAN COFFEE ROASTERS’ which are claimed to have been used throughout the UK since July 2018 in relation to the following goods and services: *provision of food and drink; coffee shops; coffee shop services; retail of coffee, products for making coffee and coffee pots; retail of coffee makers and their accessories; coffee.* HC claims that at the application date of VR’s registration, HC had goodwill in the UK in the signs in respect of the goods and services concerned and that use of the mark covered by VR’s registration would amount to a misrepresentation, causing damage. On this basis, HC submits that VR’s registration should be declared invalid in its entirety under Section 47(2) and 5(4(a) of the Act.

10. VR filed a defence and counterstatement denying the claims made. Beyond the denial of the claims, the counterstatement does not contain any further submissions.

11. HC is represented by Stobbs. VR is represented by Trama Legal s. r. o.

12. In view of the relationship between each of the above cases, on 23 March 2024 the Registrar directed under Rule 62(1)(g) of the Trade Marks Rules 2008 that they be consolidated. Further, the Registrar invoked Rule 62(1)(j) of the Trade Marks Rules 2008 to convert the fast-track opposition into a standard opposition.

HEARING AND REPRESENTATION

13. A hearing took place before me, by video conference, on 9 October 2025. HC was represented by Julius Stobbs of Stobbs IP. VR did not attend the hearing and elected not to file submissions in lieu.

RELEVANCE OF EU LAW

14. 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

15. Only HC filed evidence in these proceedings. This consists of a witness statement from Santiago Gamboa, dated 28 May 2024. Mr Gamboa is a director of HC and his witness statement is accompanied by 14 exhibits, being those labelled SG1 – SG14. Since HC's case is based on a claim of passing off, Mr Gamboa's evidence goes to the use by HC of the signs relied upon in order to establish goodwill. In addition, Mr Gamboa provides evidence concerning the cross-over between coffee shops/cafes and restaurant businesses.

16. I do not intend to summarise HC's evidence (or the submissions of the parties, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

17. As it will be recalled, the ability of VR to rely on its earlier trade mark in the opposition against HC's trade mark application depends on the outcome of HC's

application to invalidate VR's earlier mark. Hence, I shall start with HC's invalidity, which is based on Section 5(4)(a).

DECISION

HC'S INVALIDITY AGAINST VR'S REGISTRATION NO. UK00003668384

18. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

19. Subsection (4A) of Section 5 states:

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

20. The relevant parts of section 47 state:

> "47. (1) […]

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

(a) […]
(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.

[…]

(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."

21. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

22. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The relevant date for Section 5(4)(a)

23. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

24. There is no evidence of VR having used its mark before it applied to register it. Hence, the relevant date in the present case is the filing date of VR's registration, i.e. 14 July 2021.

Goodwill

25. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

26. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the

prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

27. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

28. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not

acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

29. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

30. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

> "The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.
>
> 37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.
>
> 38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the

size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

31. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales

held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, *"very limited",* the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.[1]

32. I now turn to the evidence.

33. Mr Gamboa says that HC was founded by himself and his brother Victor Gamboa (hence the name 'hermanos', which means brothers in Spanish) and by their friend AM. He also says that they are Colombian, and that HC offers Colombian coffee and coffee beans at its coffee shops and online channels.

34. HC's first pop-up location opened in 2018 in Walthamstow, and it soon expanded to other London locations over the next few years. Mr Gamboa says that before the end of July 2021, HC opened nine coffee shops in the following locations:

Location	**Date opened**	**Date closed**
Blackhorse lane (London)	July 2018	N/A
Columbia Road (London)	October 2020	N/A
Victoria Station (London)	July 2019	N/A
The Loom – Whitechapel (London)	November 2019	N/A
Barnes (London)	10 July 2021	N/A
Angel Lane/Walworth (London)	April 2021	N/A
Old Street Station (London)	September 2018	May 2020
Broadway Market (London)	July 2020	July 2021

[1] *See also: Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

Bethnal Green Road (London)	October 2018	July 2020

35. As can be seen from the above table, at the relevant date of 14 July 2021, HC had six coffee shops opened in London, with another one that closed down in the same month of July 2021, although it is not clear whether that was before or after the relevant date. Copies of pictures showing the shop fronts and interiors at the locations listed in the above table are provided; they all show the sign 'HERMANOS' in larger letters, above the word 'COLOMBIAN COFFE ROASTERS', both on the signage outside the shops, inside the shops, and on bags of coffee offered for sale.[2]

36. Sales figures for the period July 2018 to July 2021 are provided. They are as follows:

Period	**Total amount**	**Number of sales**
21 July 2018 - 31 December 2018	£99,760.24	30,232
2019	£249,410.83	62,265
2020	£661,177.04	147,372
1 January 2021 – 16 July 2021	£799,646	165,885

37. That amounts to a total of just over £1.8 million worth of sales in the three years prior to the relevant date from nine shops, all located in London. The total number of transactions from which this turnover was generated is nearly 406,000.

38. Although the sales are not broken down by product, Mr Gamboa says that their cafes provide coffee, other drinks and pastries and sell other products, such as coffee beans and French press coffee makers. Mr Gamboa says that the products are also sold through HC's online shop. Archive copies of webpages from HC's website at www.hermanoscoffeeroasters.com are exhibited,[3] showing how the online shop

[2] SG1
[3] SG2

looked on 27 November 2020. The example shows that the website offered coffee beans, coffee maker set, dripper, dripper set, filters, coffee pot, glass server, and French press coffee maker. However, whilst the coffee beans are sold in packaging displaying the 'HERMANOS' sign, the other product appear to be sold under other brands or display no brand. Further, although Mr Gamboa does not provide the total sales generated through the website, he says that between 1 September 2020 and 31 July 2021 the number of online sales was 1,869 – this, I understand, is the number of transactions, but no corresponding value is provided.

39. Seven examples of reviews received by HC from TripAdvisor are exhibited.[4] They are dated on various dates in 2019 and 2020 and mention products such as pastries, cakes, coffee and ground coffee/coffee beans. Reviews from google.com are also exhibited[5] and appear to be very positive from many customers. In addition, copies of two articles are exhibited. One is from a UK website that reviews coffee (www.batchcoffee.co.uk); it is dated 26 November 2019 and mentions that 'HERMANOS' has three locations in London. Another is from the UK website www.richmondandtwickenhamtimes.co.uk; it is dated 25 July 2021 and mentions that HC is established in four locations in London.

40. Page views, site sessions and unique visitors of HC's website between September 2018 and July 2021 are also provided and are as follows (approximately): nearly 250,000 views, nearly 65,000 site sessions and nearly 55,000 unique visitors; aside from the fact that the number of unique visitors does not appear to be very substantial, the only information available is the one I recorded at paragraph 38 above, namely that there were 1,869 online sales.

41. Lastly, in terms of marketing and promotion, Mr Gamboa says that HC has engaged in advertising via Facebook and Instagram with 39 campaigns being run between 2018 and 2021, which reached 1.3 million people.

[4] SG3
[5] SG4

Conclusions on goodwill

42. The evidence shows that the signs 'HERMANOS' and 'HERMANOS COLOMBIAN COFFEE ROASTERS' were used by HC on the cafe store fronts, as well as on coffee cups, coffee bean packaging, posters used inside the cafes, social media and on the company's website. Prior to the relevant date, HC opened 9 coffee shops in London, although only 6 or 7 were still open at the relevant date. Admittedly, a turnover of £1.8million in a three-year period is not huge, nevertheless, it is undoubtedly more than trivial. It also demonstrates that by the relevant date, HC had built up a successful business. Further, the success of HC's business is corroborated by the large number of positive reviews received by its coffee shops. However, the fact that all HC's coffee shops were geographically limited to the city of London raises the issue of the goodwill being localised. On the point, in *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another* - [1987] RPC 189 (CA), Dillon L.J. stated that:

> ".....However, we have before us the case of plaintiffs with a strong reputation and goodwill in certain parts of the country, particularly Coventry and Oxford Street, which is faced with threats by the defendants to use the name "Chelsea Man" in all or any parts of the country in connection with the sale of men's clothing, in such a manner as is likely to mislead potential customers of the defendants and thereby to injure the plaintiffs' goodwill. Since the intended use by the defendants of the name "Chelsea Man" is nationwide, *prima facie*, it seems to me, the plaintiffs must be entitled to ask for a nationwide injunction. In my judgment, on the facts of the present case, the court would be justified in circumscribing the ambit of the injunction to narrower limits than England and Wales (which are the limits accepted by the plaintiffs) only if it were satisfied that the use by the defendants of the name "Chelsea Man" outside those limits in connection with their business *would not be likely substantially to injure the plaintiffs' goodwill.* I am far from satisfied that this is the case, for a number of reasons.
>
> If it be assumed, for the sake of argument, that the injunction were confined to the three proposed restricted areas, it also has to be assumed that there is a live possibility, perhaps amounting to a probability, that the defendants with

their large resources and wide chain of existing shops, would soon be using the name “Chelsea Man” in trading in towns close to the borders of some or all of those areas.

I do not propose to embark on a further examination of the evidence of which counsel on both sides have given us a careful and helpful analysis. In my judgment, it clearly shows that the use by the defendants of this name or mark even outside such areas would be likely to cause substantial confusion between the plaintiffs' and defendants' respective businesses, and thus to cause damage to the plaintiffs' business within those areas.....”

43. At the hearing Mr Stobbs also referred me to the decision in *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874 where the opponent’s earlier right in the Worcester area was held to be sufficient to prevent the applicant from acquiring a national trade mark that was valid throughout the UK.

44. In *Saxon Trade Mark* [2003] FSR 39 (HC), Laddie J. identified different considerations that apply where the senior and junior users have only local goodwills, and one proposes to trade in the area in which the other has established goodwill (or, by analogy, makes an application to register a national mark which implies such an intention). In dealing with an appeal from a decision of a hearing officer on behalf of the registrar, the judge stated that:

“32. Mr Foley appears to have construed the section as if it is only concerned with cases where the use of the mark by the proprietor starts after use of the same or a similar mark by someone else. I do not think that this is what the section says. For the prohibition to bite, all that needs to be shown is that, at the time of the application to register, the normal use of the mark by the proprietor would be liable to be prevented by passing off proceedings brought by someone else. It may well be that in most cases this will only arise when the other party had commenced using his mark before the proprietor, but it is not inevitably so and the section does not require it to be so. The fact that the convenient title “proprietor of an earlier mark” is used to designate the other party does not limit the scope of the section. Consider, for example, a case in

> which one proprietor uses a mark on a retail clothing business in Manchester and the other uses it on a similar business in Plymouth. They commence trade at the same time. Their trades do not compete because of the geographical separation. Assume the Manchester trader registers the mark. Normal use of it would include use in Plymouth. That would be liable to give rise to a cause of action in passing off (see *Levey (A.A.) v Henderson-Kenton (Holdings) [1974] R.P.C. 617* and *Evans v Eradicure [1972] R.P.C. 808*). For that reason the registration by the Manchester trader would fall foul of s.5(4)(a) even though the Plymouth trader commenced use of the mark at the same time. For the same reason the Plymouth trader could not register the mark."

45. Accordingly, whilst HC is relying on a right which subsists in a particular locality and which pre-dates the filing date of VR's trade mark, the latter applies anywhere in the UK, including in London, which is the locality in which HC had established goodwill in the earlier signs. On this basis, HC's goodwill would satisfy the conditions in Section 5(4)(a). This is because, as the case-law makes clear, in order to rely on Section 5(4)(a), HC needs to establish that it had built up a protectable goodwill prior to the filing date of VR's trade mark, even if such goodwill applied only in a particular locality.

46. In the present case, I find that the evidence of turnover (£1.8 million over a three-year period) combined with the number of coffee shops run under the earlier signs (9), the length and continuity of use (three years prior to the relevant date) and the extent of use of the earlier signs (on HC's shops frontages, on coffee cups, coffee bean packaging, posters used inside the cafes, social media and on the company's website) is adequate to establish a protectable goodwill at the relevant date. I also find that HC's owned goodwill in the earlier signs in relation to *coffee shops* and *coffee shop services*. I also note at this stage the comments of Dr Brian Whitehead, sitting as the Appointed Person in *Bunnyjuice, Inc.* v *Mercis B.V.*, Case BL O/0064/24 as follows:

> "In trade mark law, the analysis of proof of use, reputation and enhanced distinctive character needs to be performed on a granular basis, looking at each of the individual goods and services in turn. […] In passing off law, however, goodwill attaches to a business, rather than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, "What is

the nature of the business?", but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc."

47. Accordingly, I find that HC had goodwill in the claimed services relating to its main business, namely *coffee shops; coffee shop services*. This, in my view extends to the claimed *provision of food and drink* because these services reflect the nature of the business to which HC's goodwill is attached.

48. HC also claims to have used the earlier signs in relation to the *retail of coffee, products for making coffee and coffee pots; retail of coffee makers and their accessories; coffee.* However, although there is evidence of HC offering these retail services, the number of transactions is very small (less than 2,000 of the nearly 406,000 transactions that took place in relation to the provision of coffee shop services), there is no indication of how much turnover was generated by these sales, and the sales are not broken down by products; I therefore find that the evidence fails to establish the existence of a more than trivial goodwill in respect of the claimed *retail of coffee products for making coffee and coffee pots; retail of coffee makers and their accessories;*. Nevertheless, since the sale of coffee appear to be closely related to that of HC's coffee shop business and has also been made under HC's signs, I find that HC's goodwill extends to *coffee*.

49. Having found that had HC goodwill (to the extent set out above) sufficient to sustain a passing off action, I will now turn to the issue of misrepresentation.

Misrepresentation

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

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

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

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

And later in the same judgment:

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

51. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> “64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

52. Accordingly, once it has been established that the party relying on the existence of an earlier right under Section 5(4)(a) had sufficient goodwill at the relevant date to sustain a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

53. As regards the question of proof of misrepresentation, in *Neutrogena*, Morritt L.J. stated that:

> "The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:
>
> > 'where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a "jury question". By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.
> >
> > The question does not cease to be a "jury question" when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in

doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.'"

54. In this instance, one of the signs relied upon by HC is identical to VR's mark (both consisting of the word 'hermanos'); the other sign is very highly similar, since the additional words 'COLOMBIAN COFFEE ROASTERS' in the second sign are wholly descriptive. Further, although the identical element 'hermanos' is a Spanish word meaning 'brothers', it is likely to be perceived by the UK relevant public as an invented word with a high level of distinctive character, as there is no evidence that the Spanish language or the Spanish word 'hermanos' is known by a significant portion of the UK relevant public. I have found HC to hold goodwill in its business under the sign in relation to *coffee shops; coffee shop services* and *provision of food and drink.* These are identical to (and as such are in the exact same field as) most of VR's registered services which are various types of restaurant services, namely: *Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Carvery restaurant services; Hotel restaurant services; Mobile restaurant services; Providing restaurant services; Japanese restaurant services; Spanish restaurant services; Ramen restaurant services; Tempura restaurant services; Washoku restaurant services; Sushi restaurant services; Carry-out restaurants; Self-service restaurants; Restaurants (Self-service -); Fast food restaurants; Take-out restaurant services; Self-service restaurant services; Salad bars [restaurant services]; Fast-food restaurant services; Restaurant and bar services; Bar and restaurant services; Restaurant services provided by hotels; Udon and soba restaurant services; Restaurant services incorporating licensed bar facilities; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Providing food and drink in restaurants and bars; Serving food and drink in restaurants and bars; Serving food and drink for guests in restaurants; Providing food and drink for guests in restaurants.* On this basis it is, in my view, inevitable that there will be a misrepresentation between HC's earlier sign and VR's identical registered mark in relation to these identical services.

55. Alternatively, if I am wrong and the goodwill in relation to *coffee shops* and *coffee shop services* does not warrant HC relying on *provision of food and drink*, coffee shops and restaurants are in the same field of activity, namely that of hospitality which

encompasses a wide range of businesses including hotels, restaurants, cafes, pubs and catering services. In this connection, I reject Mr Stobbs' submission that restaurants and cafes are the same thing. Further, whilst I bear in mind that Mr Gamboa has provided a few examples of coffee roasters and cafes expanding to serve meals, and having a food and drink menu, I do not think this evidence adds much to HC's case; this is because it does not show that traders who provide coffee shops services operate linked outlets identified as offering resturant services. Having said that, while:

a) there is a difference between coffee-serving establishments and restaurants, insofar as cafes offer a more casual experience and quick refreshments, as opposed to restaurants, which are designed for more formal dining experiences, and

b) there is no evidence of an industry trend whereby cafes have expanded into the restaurant business,

given the closeness of the type of businesses (both of which consist in the provision of food and drink), as well the identity and high distinctive character of the shared name 'hermanos' (at least in the UK), I think that the average consumer would be more likely to think that it is a chain of outlets under the same brand, rather than a coincidence. In my view, the identity of the name and its highly distinctive character are sufficiently powerful, that the absence of evidence of convergence on the market of café and resturant business is not fatal.

56. For the sake of completeness, I will mention that in reaching the above conclusion I have considered whether the comments made by Mr James Mellor QC, sitting as the Appointed Person, in *The Cheeky Indian* (decision BL-O/219/16) might provide a steer here as to the issue of misrepresentation in relation to some of the contested restaurant services that relate to different types of cuisine. In particular, I refer to the following comments Mr Mellor made when allowing an appeal against the Hearing Officer's decision that there would be confusion between two figurative marks incorporating the words 'Cheeky Indian' and 'Cheeky Italian' respectively, in relation to identical services for the provision of food and drink. He stated:

> “19. So far as category (c) is concerned, a finding of indirect confusion may follow where the earlier mark comprises a number of elements and a change of one element appears entirely logical and consistent with a brand extension. Again, the Hearing Officer’s application of this notion could only have taken place on the basis that ‘the element’ in question was ‘Italian’ or ‘Indian’. The first problem is that, even allowing for imperfect recollection, in my view the average consumer would not reduce each mark down to the words ‘CHEEKY ITALIAN’ or ‘CHEEKY INDIAN’. Since it is accepted that these marks are primarily visual, the differences which the average consumer would retain as part of his or her recollection of each mark (which are sufficient to dispel a likelihood of direct confusion) are not logical or consistent with a brand extension at all.
>
> 20. The second problem is that, for the average consumer to perceive a brand extension, the extension has to be something which is familiar and natural, so that it is immediately perceived by the average consumer. In this case there is no evidence that traders who provide food and drink or catering services operate linked outlets identified as offering different national cuisines. In my view, the experience of the average consumer is to the exact opposite: usually, those traders who do identify a national cuisine in their branding only refer or allude to one. There may be chains of outlets under the same branding, but the average consumer is not accustomed to seeing a house mark used in conjunction with individual words indicating different national cuisines.
>
> 21. The Hearing Officer’s reasoning as to indirect confusion might have been supportable if the Opponent had filed evidence of extensive use of ‘CHEEKY’, especially if that use had been in relation to a range of different national cuisines. But this case does not involve any family of CHEEKY marks, nor any enhanced distinctive character generated through use.”

57. Admittedly, the fact that the words ‘Italian’ and ‘Indian’ in the marks at issue in that case suggested use of the same marks in relation to different types of national cuisines, prompted Mr Mellor’s comments about the average consumer’s experience that traders who do identify a national cuisine in their branding only refer or allude to

one. However, such point was not the only consideration in that case. In this case, HC's sign and VR's trade mark are identical both consisting of the word 'HERMANOS' (as opposed to the competing marks in *The Cheeky Indian* creating different overall impressions). In addition, even proceeding on the basis that HC's goodwill only attaches to coffee shops, as it will be recalled, the average consumer will perceive 'HERMANOS' as an invented word, with a high degree of distinctiveness (as opposed to the shared element 'Cheeky' in *The Cheeky Indian* being an ordinary word). Lastly, even if some consumers would understand the word 'HERMANOS' as a Spanish word, that would only reinforce the misrepresentation, as there would be no reason for an unrelated trader to use a Spanish word in relation to, for example, a Japanese restaurant, or a restaurant offering sushi. Accordingly, I do not think that the reference to different types of cuisine is a sufficiently strong argument to overcome the identity of the name and its striking distinctiveness in the present case.

58. This leaves *Restaurant reservation services; Restaurant information services; Reservation of restaurants; Booking of restaurant seats; Providing reviews of restaurants; Providing information about restaurant services; Provision of information relating to restaurants; Providing reviews of restaurants and bars; Agency services for reservation of restaurants; Travel agency services for booking restaurants; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals.*

59. As Mr Stobbs stated at the hearing, these services can be broken down in three categories, namely: (a) restaurant reservation services; (b) restaurant information services; (c) providing reviews of restaurants. As regards these services Mr Stobbs referred me to the decision no. BL-O-584/15 at paragraph 29 where the Hearing Officer found that there was a low to medium degree of similarity between the cafe services and restaurant booking services. She stated:

> ""Category 2" services provide customers with the ability to book a table at a restaurant or otherwise provide information about a restaurant, such as menus, opening times, location, reviews etc. These are services that an overwhelming majority of restaurants and other food providing establishments would operate in some way or another. As already described, cafe services can be broad

enough to be akin to restaurant services and it is considered that there is no reason why this would not also extend to providing relevant information and the ability to reserve a table in the manner already described. They are considered to be similar to a low to medium degree."

60. I agree with the Hearing Officer for the reasons she gave. Although her analysis was carried out in the context of assessing the similarity of the services in the context of a Section 5(2)(b) objection, the same principle applies equally to the question of whether there is misrepresentation for the purpose of a Section 5(4)(a) objection. This is because both the concept of misrepresentation and that of likelihood of confusion come to the same thing, namely, whether the consumer is likely to be deceived as to the origin of the goods and services, the similarity and closeness of the goods and services being one of the relevant factors. In my view, although restaurant reservation services and restaurant information services have a different nature compared to the services to which HC's goodwill attach, they still fall within the same field of activity as demonstrated by the fact that they can be offered by the same establishments that provide food and drinks. There is misrepresentation in relation to these services, namely: *Restaurant reservation services; Restaurant information services; Reservation of restaurants; Booking of restaurant seats; Providing information about restaurant services; Provision of information relating to restaurants; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals.* The same conclusion extends in my view to *Providing reviews of restaurants; Providing reviews of restaurants and bars.*

61. These leaves: *Agency services for reservation of restaurants; Travel agency services for booking restaurants.*

62. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millett L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any

natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J*. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> ‘…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be

a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

> '…in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

63. These are agency and travel services which would not be provided by the same establishments providing the food and drink. On that basis, I am not convinced that in

relation to these services there is a risk of misrepresentation as they are one step removed from HC's services. The gap between the services (which belong to different fields of activity) is too large and the goodwill is not sufficiently strong to bridge that gap. As I have concluded that the requirement of misrepresentation is not met in relation to these services, the passing off ground of invalidity fails in relation to them.

Damage

64. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

> "In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

65. In this case, it is my view that there exists a real likelihood of damage by way of substitution, as well as an obvious risk of damage should HC's customers be dissatisfied with services purchased from VR, under the mistaken belief that they derive from HC.

66. The application for invalidation of the registration under Section 47(2)(b) and 5(4)(a) of the Act therefore succeeds in relation to the following services:

Class 43: *Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Carvery restaurant services; Hotel restaurant services; Mobile restaurant services; Restaurant reservation services; Providing restaurant services; Restaurant information services; Japanese restaurant services; Spanish restaurant services; Ramen restaurant services; Tempura restaurant services; Washoku restaurant services; Sushi restaurant services; Carry-out restaurants; Self-service restaurants; Restaurants (Self-service -); Reservation of restaurants; Fast food restaurants; Take-out restaurant services; Self-service restaurant services; Salad bars [restaurant services]; Booking of restaurant seats; Fast-food restaurant services; Restaurant and bar services; Bar and restaurant services; Providing information about restaurant services; Restaurant services provided by hotels; Udon and soba restaurant services; Restaurant services incorporating licensed bar facilities; Provision of information relating to restaurants; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink in restaurants and bars; Serving food and drink in restaurants and bars; Serving food and drink for guests in restaurants; Providing food and drink for guests in restaurants; Providing reviews of restaurants; Providing reviews of restaurants and bars.*

67. But fails in relation to the following services:

Class 43: *Agency services for reservation of restaurants; Travel agency services for booking restaurants.*

68. I now turn to the opposition.

VR'S OPPOSITION AGAINST HC'S APPLICATION NO. UK00003893743

Section 5(2)(b)

69. 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."

70. Section 5A of the Act is 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."

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

72. 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."

73. Guidance on this issue has also 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.

74. 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:

> "[…] 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."

75. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC (as he then was) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

76. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

77. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the 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."

78. VR's opposition to HC's application is partial, directed to the goods and services in classes 29, 30, 32, 35, 40 and 43. This means that the applied-for goods in classes 18 and 25 will proceed to registration regardless.

79. The only services in VR's registration which have survived the invalidity are *Agency services for reservation of restaurants; Travel agency services for booking restaurants.* The only comment VR made in its pleadings with regards to the similarity of the goods and services is as follows:

> *"It is submitted that following the established practice of the Opponent and its commercial use of the mark in Class 43, any reference to the goods and services connected with providing food and drink as well as wholesale and retail services in relation to food and drinks will cause confusion among the relevant consumers."*

80. As it can be seen that is a very general statement, namely that any goods and services connected with providing food and drink will cause confusion - this statement identifies an overlap only with HC's goods in classes 29, 30 and 32 and services in classes 35 and 43, but does not address the similarity with HC's services in class 40. However, in light of the outcome of the invalidity attack, the surviving services in VR's registration relate to agency and travel agency services for booking/reserving restaurants, not to the provision of food and drink. These services have nothing in common with HC's foodstuff in classes 29 and 30 and drinks in class 32. Likewise, I cannot see any meaningful overlap with HC's retail, wholesale and business services in class 35. The same goes for HC's services in class 40 which include *Recycling of waste and trash; air purification and treatment of water; printing services; food and drink preservation; treatment of food and beverages; coffee roasting and processing;*

grinding of coffee; food processing; pasteurising of food and beverages; information, advisory and consultancy services relating to the aforesaid. The users, uses, nature and purpose of these goods and services are different, the goods and services have different methods of use, they are neither complementary nor in competition and do not share distribution channels. These goods and services are dissimilar.

81. Finally, HC's services in class 43. For ease of reference, I reproduce them below:

> **Class 43:** *Coffee shops; coffee shop services; café, cafeteria, snack bar, coffee bar, coffee house, restaurant, bar and takeaway services; operation of a café or coffee shop; all of the aforementioned services being in relation to Colombian coffee; Services for providing food and drink; temporary accommodation; information, advice and reservation services for the provision of food and drink; provision of food and drink; serving food and drinks; takeaway food and drink services; food and drink preparation services; catering of food and drinks; preparation of food and drink; preparation and provision of food and drink for immediate consumption; provision of information relating to the preparation of food and drink; cafés; rental of furniture, linens, table settings, and equipment for the provision of food and drink; information, advisory and consultancy services relating to the aforesaid.*

82. Under the Section 5(4)(a) ground I found that VR's survived services *Agency services for reservation of restaurants; Travel agency services for booking restaurants* are one step removed from the services to which HC's goodwill attaches, namely provision of food and drink, coffee and coffee shop services. For the same reasons I find that VR's services are dissimilar to the following services in HC's specification:

> **Class 43:** *Coffee shops; coffee shop services; café, cafeteria, snack bar, coffee bar, coffee house, restaurant, bar and takeaway services; operation of a café or coffee shop; all of the aforementioned services being in relation to Colombian coffee; Services for providing food and drink; temporary accommodation; provision of food and drink; serving food and drinks; takeaway food and drink services; food and drink preparation services; catering of food and drinks; preparation of food and drink; preparation and provision of food and drink for*

immediate consumption; provision of information relating to the preparation of food and drink; cafés; rental of furniture, linens, table settings, and equipment for the provision of food and drink; information, advisory and consultancy services relating to the aforesaid.

83. However, I find that HC's *information, advice and reservation services for the provision of food and drink* are sufficiently broad to encompass VR's services and are identical (Meric).

Conclusion of the goods and services comparison.

84. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

85. Under the Section 5(2)(b) ground, a likelihood of confusion can only exist where there is at least some similarity between the goods and services. This means that as a result of my findings above, the present grounds fail in relation to all but one term in HC's applied-for specification, namely *information, advice and reservation services for the provision of food and drink.*

Average consumer

86. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and services 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

87. The average consumer for the services at issue is a member of the general public. The services will be provided from the provider's agency premises or online with the consumer selecting the services having viewed an image displayed on a webpage. Considered overall, the selection process will be a predominantly visual one, although aural considerations will play their part, through, for example, booking on the phone. As regards the level of attention, it will be neither higher, no lower than the norm, as there are no specific considerations which would warrant a low or high degree of attention being applied by the consumer during the selection.

Comparison of marks

88. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

89. It would be wrong, therefore, to artificially dissect the trade marks, 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. The respective marks are shown below:

The applied-for mark	**The earlier mark**
HERMANOS COLOMBIAN COFFEE ROASTERS	hermanos

Overall Impression

90. Both marks are word only marks. The earlier mark consists of the word 'hermanos' with no other element to contribute to the overall impression. HC's mark consists of the words 'HERMANOS COLOMBIAN COFFEE ROASTERS'; as I have concluded that the verbal element 'HERMANOS' will be understood as an invented word with a high degree of distinctiveness. Since the services which I found to be similar namely *information, advice and reservation services for the provision of food and drink* can relate to coffee shops, the words 'COLOMBIAN COFFEE ROASTERS' are weakly distinctive resulting in the word 'HERMANOS' playing the greatest role.

91. Visually and aurally the marks share the distinctive and dominant element 'HERMANOS' but differ in all of the other elements. They are visually and aurally similar to a medium degree. Conceptually, the word 'HERMANOS' conveys no concept, whilst the words 'COLOMBIAN COFFEE ROASTERS' convey a weakly distinctive concept insofar as the relevant services can relate to coffee shops.

Distinctive character of the earlier mark

92. 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)."

93. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, 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 made of it.

94. The earlier mark consists of the words 'hermanos' which I have already found to be highly distinctive.

Likelihood of confusion

95. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

96. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one

else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

97. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in Cheeky Italian Ltd v Sutaria (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

98. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

99. Earlier in this decision I found that:

- The marks are visually and aurally similar to a medium degree and conceptually neutral in respect of the shared distinctive and dominant element.

- The services are identical

- The goods and services will be selected visually with a medium degree of attention. However, aural considerations cannot be discounted completely.

- The earlier mark is highly distinctive.

100. I consider that given the identity of the (limited) services remaining at issue, the high degree of distinctiveness of the shared element 'HERMANOS', the weakly distinctiveness of the differentiating elements of the marks, and the absence of any striking conceptual difference between them, the average consumer is likely to directly confuse the marks or to believe that the later mark is variant mark used by VR.

OUTCOME

101. The invalidity fails in relation to the following services which will remain registered:

> **Class 43:** *Agency services for reservation of restaurants; Travel agency services for booking restaurants.*

102. However, the invalidity is successful in relation to all of the remaining services which will be cancelled *ab initio*, namely:

> **Class 43:** *Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Carvery restaurant services; Hotel restaurant services; Mobile restaurant services; Restaurant reservation services; Providing restaurant services; Restaurant information services; Japanese restaurant services; Spanish restaurant services; Ramen restaurant services; Tempura restaurant services; Washoku restaurant services; Sushi restaurant services; Carry-out restaurants; Self-service restaurants; Restaurants (Self-service -); Reservation of restaurants; Fast food restaurants; Take-out restaurant services; Self-service restaurant services; Salad bars [restaurant services]; Booking of restaurant seats; Fast-food restaurant services;*

Restaurant and bar services; Bar and restaurant services; Providing reviews of restaurants; Providing information about restaurant services; Restaurant services provided by hotels; Udon and soba restaurant services; Restaurant services incorporating licensed bar facilities; Provision of information relating to restaurants; Providing reviews of restaurants and bars; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink in restaurants and bars; Serving food and drink in restaurants and bars; Serving food and drink for guests in restaurants; Providing food and drink for guests in restaurants.

103. The opposition is successful only in relation to the following services which will be refused:

Class 43: *information, advice and reservation services for the provision of food and drink.*

104. However, the opposition fails in relation to all of the remaining goods and services which will proceed to registration (either because they have not been objected or because the opposition has failed):

Class 18: *Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals; bags, wallets and other carriers; tote bags; grocery tote bags; canvas bags; canvas shopping bags; cloth bags; casual bags; reusable shopping bags; textile shopping bags; parts and fittings for all the aforesaid goods.*

Class 25: *Clothing, footwear, headgear; shirts; t-shirts; casual shirts; long-sleeved shirts; printed t-shirts; sweatshirts; hooded sweatshirts; socks; gloves; trousers; casual trousers; leggings [trousers]; jogging bottoms; jogging tops; jogging pants; hats; beanie hats; sports caps and hats; parts and fittings for all the aforesaid goods.*

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other milk products; oils and fats for food; birds' eggs and egg products; dairy products and dairy substitutes; dairy spreads; chilled dairy desserts; dairy-based beverages; cream [dairy products]; dairy-based whipped topping; dairy-based beverages containing oats; milk based drinks; milk beverages; milk drinks; milk based drinks [milk predominating]; milk-based beverages; milk-based snacks; milk beverages with high milk content; milk-based beverages containing coffee from Colombia; milk-based beverages flavored with chocolate; coffee creamers; flavoured milk drinks; flavoured milk beverages; milk beverages with cocoa; milk beverages containing fruits; beverages made from milk; milk-based beverages containing fruit juice; edible oils and fats; meat products; seafood and molluscs, not live; processed fruits, fungi, vegetables, nuts and pulses; sausage skins and imitations thereof; soups and stocks.*

Class 30: *Coffee, cocoa and substitutes therefor; iced coffee; coffee extracts; chocolate coffee; coffee concentrates; flavoured coffee; ground coffee; coffee bags; decaffeinated coffee; instant coffee; coffee beverages; coffee drinks; coffee beans; mixtures of coffee; coffee based beverages; prepared coffee and coffee based beverages; ground coffee beans; drip bag coffee; roasted coffee beans; coffee in brewed form; coffee beverages with milk; powdered coffee in drip bags; ice beverages with a coffee base; preparations for making beverages [coffee based]; coffee [roasted, powdered, granulated, or in drinks]; coffee based fillings; all of the aforementioned goods being from Colombia; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice [frozen water]; instant tea; tea beverages; tea bags; iced teas; tea-based beverages; tea beverages with milk; preparations for making beverages [tea based]; cooling ice; processed grains, starches, and goods made thereof, baking preparations; frozen yogurts; flavourings ; baked goods, chocolate and desserts; tea cakes; cakes, tarts and biscuits (cookies); milk chocolate*

teacakes; fruit cake snacks; sweet and savoury snacks; flour based savoury snacks; chocolate cakes; cream cakes; sponge cakes; iced cakes; chocolate pastries; savoury pastries; fruit pastries; almond pastries; pastries containing creams; prepared desserts [pastries]; pastries containing creams and fruit; pies [sweet or savoury]; tarts [sweet or savoury]; biscuits [sweet or savoury]; chocolate biscuits; salty biscuits; bread biscuits; savoury biscuits; filled biscuits; cheese-flavoured biscuits; biscuits flavoured with fruit; biscuits having a chocolate coating; biscuits containing chocolate flavoured ingredients; sweet biscuits for human consumption; savoury snacks; pastries consisting of vegetables and fish; pastries consisting of vegetables and meat; pastries consisting of vegetables and poultry; natural sweeteners, sweet coatings and fillings; sweet glazes and fillings.

Class 32: *Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations for making non-alcoholic beverages; non-alcoholic beer; non-alcoholic drinks; non-alcoholic carbonated beverages; smoothies [non-alcoholic fruit beverages]; non-alcoholic beverages flavoured with coffee from Colombia; non-alcoholic beverages flavoured with tea; flavoured carbonated beverages; carbonated non-alcoholic drinks; soda pops; soda water; tonic water; glacial water; coconut water; spring water; table water; aerated water [soda water]; sparkling water; still water; waters [beverages]; juices; juice drinks; aerated juices; fruit juice drinks; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing vegetable juices; non-alcoholic cordials; syrups and other non-alcoholic preparations for making beverages; non-alcoholic fruit extracts used in the preparation of beverages; preparations for making beverages. .*

Class 35: *Wholesale, retail and online retail services connected with the sale of subscription boxes containing coffee and coffee preparations; retail and online retail services in relation to coffee; wholesale services in relation to coffee; all of the aforementioned services being in relation to Colombian coffee; Advertising; business management, organization and administration; office functions; advertising, marketing and promotional services; business assistance, management and administrative services; commercial trading and*

consumer information services; wholesale and retail services in relation food, drinks, clothing, headgear and bags; online retail services in relation to food, drinks, clothing and tote bags; retail and online retail services in relation to non-alcoholic beverages; wholesale, retail and online retail services connected with the sale of subscription boxes containing food; wholesale services in relation to non-alcoholic beverages; retail and online retail services in relation to preparations for making beverages; wholesale services in relation to preparations for making beverages; retail services via global computer networks related to non-alcoholic beverages; mail order retail services related to non-alcoholic beverages; retail and online retail services connected with the sale of clothing and clothing accessories; retail and online retail services in relation to teas; wholesale services in relation to teas; wholesale, retail and online retail services in relation to baked goods; information, advisory and consultancy services relating to the aforesaid.

Class 40: *Recycling of waste and trash; air purification and treatment of water; printing services; food and drink preservation; treatment of food and beverages; coffee roasting and processing; grinding of coffee; food processing; pasteurising of food and beverages; information, advisory and consultancy services relating to the aforesaid.*

Class 43: *Coffee shops; coffee shop services; café, cafeteria, snack bar, coffee bar, coffee house, restaurant, bar and takeaway services; operation of a café or coffee shop; all of the aforementioned services being in relation to Colombian coffee; Services for providing food and drink; temporary accommodation; provision of food and drink; serving food and drinks; takeaway food and drink services; food and drink preparation services; catering of food and drinks; preparation of food and drink; preparation and provision of food and drink for immediate consumption; provision of information relating to the preparation of food and drink; cafés; rental of furniture, linens, table settings, and equipment for the provision of food and drink; information, advisory and consultancy services relating to the aforesaid.*

COSTS

105. HC has been more successful than VR and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £2,160 as a contribution towards the costs of proceedings, applying a reduction of 10% to reflect the degree of success achieved by VR. The sum is calculated as follows:

Filing an invalidity and a counterstatement: £600
Filing evidence: £800
Attending a hearing: £800
Official fee: £200
Total: £2,400 -10% = £2,160

106. I, therefore, order Vincenzo Rapisarda to pay Hermanos Colombian Coffee Roasters Ltd the sum of £2,160. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of February 2026

TERESA PINTO
For the Registrar