O/0514/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003774128

BY TERENCE KING AND ROBERT GIBSON

TO REGISTER THE TRADE MARK:



IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 435915 BY

CPG (SOCIÉTÉ PAS ACTIONS SIMPLIFIÉE)

BACKGROUND AND PLEADINGS

1. On 5 April 2022, Terence King and Robert Gibson ("the applicants") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 27 May 2022 and registration is sought for the following goods:

Class 30 Ice-cream; Cream (Ice -); Ice creams; Ice cream; Ice-cream cakes; Fruit ice cream; Ice cream drinks; Yoghurt based ice cream [ice cream predominating]; Vegan ice cream; Ice cream mixes; Ice cream bars; Fruit ice creams; Ice cream confections; Dairy ice cream; Ice cream desserts; Ice cream confectionery; Ice creams containing chocolate; Ice cream stick bars; Ice cream with fruit; Instant ice cream mixes; Non-dairy ice cream; Mixtures for making ice creams; Ice, ice creams, frozen yogurts and sorbets; Mixtures for making ice cream; Confectionery ices; Flavored ices; Iced lollies; Ice confectionery; Edible ice; Edible ices; Sorbets [ices]; Ice pops; Ice confections; Ice lollies.

2. On 30 August 2022, the application was opposed by CPG (Société pas actions simplifiée) ("the opponent") based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(b) of the Act, the opponent relies upon UK trade mark no. 903274801 for the mark AMORINO, which was filed on 8 July 2003 and registered on 10 August 2007.[1] The opponent relies upon some goods for which the mark is registered, namely:

Class 29 Milk and dairy products.

Class 30 Coffee, tea, cocoa, sugar; pastry and confectionery; ices; ice.

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing European Union trade mark ("EUTM"). As a result of the opponent having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Class 43 Providing of food and drink.

3. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent relies upon the same mark set out above. The opponent claims a reputation for the goods and services underlined in paragraph 2 above and claims that use of the applicants' mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier mark.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign AMORINO, which it claims to have used throughout England since November 2009 in relation to "ice cream; ice cream confectionery; ice cream desserts". The opponent claims that use of the applicants' mark would be contrary to the law of passing off.

6. The applicants filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the earlier mark.

7. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

REPRESENTATION

8. The applicants are represented by Wilson Gunn.

9. The opponent is represented by Keltie LLP.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in the form of the witness statement of Paolo Benassi dated 2 March 2023, which is accompanied by 19 exhibits (PB1 to PB19). Mr Benassi is the President of the opponent, a position he has held since 2002.

11. The applicants filed evidence in the form of the witness statement of Terence King, one of the applicants, dated 16 May 2023, which is accompanied by 16 exhibits (Exhibits 1 to 16).

12. The applicants filed written submissions in lieu dated 9 October 2023.

13. The opponent filed written submission in lieu dated 11 October 2023.

14. I have taken the evidence and submissions into account and will refer to them below where necessary.

RELEVANCE OF EU LAW

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

DECISION

Proof of Use

16. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years prior to the filing date of the application in issue, it is subject to the use provisions of section 6A of the Act. As the question of use is relevant to both the section 5(2)(b) and 5(3) grounds of opposition, I will begin by assessing genuine use.

17. The relevant statutory provisions are as follows:

> "6(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

18. Section 100 of the Act is also relevant, which reads:

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

19. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application i.e. 6 April 2017 to 5 April 2022. As the earlier mark is a comparable mark, use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).[2] Only use in the UK will be relevant after that date.

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

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and*

[2] See paragraph 7 of Part 1, Schedule 2A of the Act.

Designs) [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

21. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

22. Mr Benassi states that he and his co-founder opened their first ice cream shop in Paris, under the name AMORINO, in 2002. A franchise network was launched in 2006, with more than 90 ice cream shops opening throughout France. The business expanded into Barcelona in 2008 and London in 2009. As of the date of Mr Benassi's statement, the opponent had 20 ice cream shops in the UK.[3] During the relevant period, at least 16 of these were operational. I note that 4 shops were opened in 2022, but without further information it is not possible to tell whether they were opened before or after the relevant period. I note that all of the stores opened prior to or during the relevant period were located in London, with the exception of one, which was located in Leeds. Between 2016 and 2022, the number of shops operated by the opponent increased from 150 to 200; however, these are worldwide outlets, and so it is not clear how many were operational in the EU prior to IP Completion Day.

23. Mr Benassi states that the opponent started selling gelato-filled macaroons in 2013 and now more than 3.5million are made each year. The opponent also offers a café service, with a hot and cold drink offering including ice cream and sorbet-based drinks. Mr Benassi has provided the following revenue figures for all food and beverage products sold in AMORINO outlets in the UK:

2017 (from April)	£2,930,622
2018	£5,219,639
2019	£5,660,271
2020	£3,429,356

[3] Exhibit PB1

2021	£5,328,457

24. Specifically, in relation to ice cream sales made under the mark AMORINO in the UK, the opponent's revenue is as follows:

2017 (from April)	£2,446,084
2018	£4,085,461
2019	£4,588,196
2020	£2,600.850
2021	£4,125,868

25. Mr Benassi has also provided revenue figures for other goods sold through the opponent's ice cream shops between April 2017 and the end of 2021.[4] It is not always clear what goods some of the revenue figures relate to. For example, it is not clear to me what is meant by "extras" or "retail" and no explanation is provided by Mr Benassi. However, of those that I am able to identify, they are as follows:

Burgers	£6,612
Coffee	£1,145,786
Cold drinks	£128,315
Crepes	£402,189
Macarons	£1,997,216
Waffles	£709,717
Cakes	£7,302

26. Examples of the opponent's packaging have been provided, such as:[5]

[4] Exhibit PB9
[5] Exhibit PB11







27. In my view, the use shown is sufficient to demonstrate genuine use in relation to ice cream, burgers, coffee, cold drinks, crepes, macarons, waffles and cakes, as well as the provision of ice cream parlour and café services. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

29. I have considered whether the term "ices" is broad enough to cover the opponent's ice cream goods. In my view, it is certainly not clear cut. I note that in *Collins English Dictionary* an example of use of the term "ice" is as an ice cream (such as choc ices).[6]

[6] https://www.collinsdictionary.com/dictionary/english/ice

I also note that the applicant has not taken issue with the opponent's reliance upon use in relation to ice cream in the context of their specification. Consequently, I will proceed on the basis that the term "ices" is wide enough to cover the opponent's ice cream goods (for reasons that will become clear below, nothing will turn on this).

30. The opponent has clearly made several million pounds worth of sales in relation to ice cream in the UK each year during the relevant period. However, the term "ices" is broad enough to also cover goods such as ice lollies, granita and ice cubes. No use has been shown for these goods. Consequently, I find that the opponent should not be entitled to rely upon the broader term. The applicant has suggested that a distinction should be drawn between the evidence of use shown by the opponent (which it states relates to non-alcoholic ice cream) and alcoholic ice cream. However, I do not consider that the average consumer would identify the use shown by the opponent as "non-alcoholic ice cream"; rather, it would simply be referred to as use in relation to ice cream. There is no evidence of use in relation to class 29 milk and dairy products; whilst ice cream is itself a dairy product, such goods are in class 30 (not class 29). There is no evidence of use in relation to tea, cocoa or sugar. I note that the opponent has provided evidence of sales in relation to coffee. This amounts to over £1million during the relevant period and I am satisfied that the opponent should be able to rely upon this term.

31. I am not convinced that the opponent's use in relation to waffles and crepes would fall within any of the terms in classes 29 or 30. The opponent's best case appears to be "pastry and confectionery". However, I consider the term "pastry" to cover goods made from dough which are baked, and confectionery to cover sweets and chocolate. I do not consider that waffles and crepes (which are neither made from dough, nor baked, nor are they properly described as sweets or chocolate) fall within either of these terms. In any event, again, for reasons that will become clear below, nothing will turn on this. By contrast, I consider the opponent's use in relation to "macarons" to be use in relation to a type of confectionery. However, as use has only been shown in relation to one type of confectionery, I do not consider that the opponent should be able to retain the broader term.

32. All of the opponent's use in relation to class 43 appears to relate to the provision of ice cream parlours and café services. Clearly, this would fall within the term for which the opponent has protection. However, as the opponent has only shown use for a subset of those services, I do not consider that it should be entitled to rely upon the broader term.

33. In light of my findings above, I consider a fair specification to be:

Class 30 Coffee; macarons; ice cream.

Class 43 Ice cream parlours; café services.

Section 5(2)(b) – case law

34. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

35. The applicants have based their submissions in relation to the similarity of the goods and services upon the products they actually sell i.e. alcoholic ice cream products. However, I must compare the parties' respective specifications, not the products that they actually sell in practice (save to the extent that it affects my proof of use findings above for the opponent's mark). There is nothing in the applicants' specification that limits its goods to alcoholic products only. In any event, the opponent's specification covers ice cream at large, which would include both alcoholic and non-alcoholic flavours. Consequently, I do not consider that this line of argument assists the applicant.

36. The applicants' goods include "ice-cream" and the opponent's specification covers both "ice cream" and "ice cream parlours". In respect of "ice cream" these goods are self-evidently identical. In the case of the opponent's "ice cream parlours", there is plainly an overlap in trade channels and user. The average consumer will also consider the goods and services to be important or indispensable in such a way that they would expect the same undertaking to be responsible for both.[7] They are, therefore, complementary. Consequently, I consider them to be similar to a medium degree. I will proceed on the basis of these goods and services, as they represent the opponent's best case.

The average consumer and the nature of the purchasing act

37. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties' 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:

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

> "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."

38. The average consumer for the parties' goods and services is likely to be a member of the general public. The cost of the goods and services is likely to vary, but they are not likely to be particularly expensive. Whilst not necessarily everyday purchases, they are likely to be purchased reasonably frequently. The average consumer will consider various factors during the purchasing process such as flavour and ingredients for the goods, and customer service, product selection and location for the services. Consequently, I consider that a medium (or average) degree of attention is likely to be paid during the purchasing process.

39. The goods and services are likely to be selected following perusal of signage on physical premises or online equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that orders may be placed verbally and word-of-mouth recommendations may play a part.

Comparison of trade marks

40. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("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."

41. 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.

42. The respective trade marks are shown below:

Opponent's trade mark	Applicants' trade mark
AMORINO	

43. The opponent's mark consists of the word AMORINO. There are no other elements to contribute to the overall impression which resides in the word itself. The applicants' trade mark consists of the word AMORI in large, stylised font, presented above the words GELATO COCKTAILS which are in a much smaller font. These elements appear alongside a device, which appears to be a combination of a cocktail glass, the words 'up to 6% ABV' and a love heart. In my view, the word AMORI plays the greater role in the overall impression due to its size and the fact that the eye is naturally drawn to the element of the mark that can be read. The device plays a slightly lesser role,

and the words GELATO COCKTAILS play a much lesser role due to their size and their descriptive nature.

44. Visually, the marks overlap in that the word AMORI in the applicants' mark represents the first five letters of the opponent's mark. They differ in the addition of the letters NO to the end of the opponent's mark and the presence of the device in the applicants' mark, which has no counterpart in the opponent's mark. The words GELATO COCKTAILS in the applicants' mark are also a point of visual difference, although I recognise that they may be overlooked due to their size and descriptive nature. In my view, the marks are visually similar to between a low and medium degree.

45. Aurally, the word AMORINO is likely to be pronounced AMM-ORR-EEE-NOO. The word AMORI in the applicants' mark is likely to be pronounced AMM-ORR-EEE. The device will not be articulated, in my view, nor will the words GELATO COCKTAILS. Whilst I accept that descriptiveness does not automatically render an element of a mark aurally invisible, the descriptive nature combined with the very small size of the words leads me to conclude that they would not be articulated by the average consumer. [8] I consider the marks to be aurally similar to between a medium and high degree.

46. Conceptually, The parties appear to be in agreement that the word AMORI is derived from the word AMORE, which means love in Latin-based languages (such as Spanish/Italian).[9] They also both appear to agree that AMORINO is a reference to the Italian for Cupid (i.e. the god of love).[10] If these meanings are understood by the average consumer then they are both likely to be perceived as having laudatory connotations (i.e. referring to ice cream that will be loved by the customer). There will be a medium degree of conceptual similarity between them (with both having a reference to love, but one being the word for love itself and the other being the name of a God). However, I bear in mind that neither party is explicit that they consider that these meanings will be understood by the average consumer. If they are not, then the

[8] BL O/115/22

[9] See paragraph 31 of the opponent's written submissions in lieu and Exhibit 5 to Mr King's statement.

[10] See exhibit 7 to Mr King's statement and paragraph 31 of the opponent's written submissions in lieu.

marks will simply be perceived as invented/foreign language words with no particular meaning. Consequently, they will be conceptually neutral.

Distinctive character of the earlier trade mark

47. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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)."

48. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

49. I will begin by assessing the inherent distinctive character of the earlier mark. Mr King has filed evidence to show that marks with the word AMORE as their root are common in the marketplace for the relevant goods.[11] The only pages that I am able to date prior to the relevant date are as follows:

a) A Facebook page for a business selling ice cream called Amore di Gelato is provided which shows posts dating back to 2019.

b) Social media pages for a business called AMORE GELATO have been provided. The visible post is dated August 2021.

50. I do not consider this evidence to be sufficient to demonstrate that such names were common in the marketplace at the relevant date. If the earlier mark is perceived as an invented/foreign language word with no meaning, it will be inherently distinctive to a high degree. If it is understood as referring to the God of love, it will be inherently distinctive to no more than a medium (or average) degree.

51. I must now consider whether the distinctiveness of the earlier mark has been enhanced through use. I have summarised the opponent's evidence of use during the relevant period above. I bear in mind that the relevant market for assessing enhanced distinctiveness is the UK market. Consequently, the evidence of use in relation to the wider EU will not be relevant for the purposes of this assessment. In addition to the evidence summarised above, I note the following:

a) The opponent teamed up with a Chelsea-based florist to put together an edible flower display to mark the RHS Chelsea Flower Show in 2016. This was covered on a website called *SW Londoner*, as well as some national publications.[12] The opponent spent over £14,000 on PR fees in relation to this event.[13]

[11] Exhibits 9 to 14
[12] Exhibits PB7 and PB8
[13] Exhibit PB7

b) The opponent's AMORINO brand has been referenced on websites of news and magazine publications such as *The Evening Standard* (2014, 2016, 2018), *Bazaar* (2018), *Time Out* (2019, 2021), *Tatler* (2019) and *Metro* (2021).[14] The opponent is referred to as being amongst the best ice cream parlours in London.

c) Information has been provided about the opponent's social media followers, but this is as of February 2023 (which is after the relevant date) and is not broken down to identify what proportion of these followers are customers based in the UK (if any).[15]

52. I have no evidence before me as to the market share held by the mark. Whilst I recognise that the opponent's revenue in the UK is not insignificant, I consider it likely that it represents a small share of the market for ice cream and ice cream parlours in the UK, which must undoubtedly be significant. The opponent began trading in the UK in 2009, which means that use has been reasonably long-standing (with around 13 years use prior to the relevant date). I have no overall advertising and marketing expenditure figures, although I recognise that there have clearly been promotional activities undertaken by the opponent. The opponent's business is mostly confined to the London area, although I recognise that it did also have an outlet in Leeds prior to the relevant date. Consequently, geographical spread of the use has been relatively limited. Taking all of this into account, I am not satisfied that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

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

[14] Exhibit PB13
[15] Exhibit PB12

borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods and services may be offset by a greater degree of similarity between the respective marks, and vice versa. As I mentioned above, it is necessary for me to 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. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. I have found as follows:

a) The goods and services are either identical or similar to a medium degree.

b) The average consumer will be a member of the general public who will pay a medium (or average) degree of attention during the purchasing process.

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d) The marks are visually similar to between a low and medium degree and aurally similar to between a medium and high degree. There will be either a medium degree of conceptual similarity between the marks, or the conceptual position will be neutral, depending on the perception of the average consumer.

e) The earlier mark is inherently distinctive to either no more than a medium or a high degree, depending on whether it is perceived as having any meaning by the average consumer.

55. Bearing in mind the visual differences between the marks, and the predominantly visual purchasing process, I do not consider it likely that the marks will be mistakenly recalled or misremembered as each other, even when used on identical goods. Even leaving aside the additional device/text elements in the applicant's mark, I consider that the words AMORI and AMORINO are sufficiently different that they will not be mistakenly recalled as each other, even when the earlier mark is attributed a high

degree of distinctiveness and/or there is conceptual similarity. Consequently, I do not consider there to be a likelihood of direct confusion.

56. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case 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)".

57. I have already found that the average consumer will recognise the difference between the words AMORI and AMORINO. The addition of the letters NO to the end of the earlier mark makes it noticeably longer than the word AMORI. Having recognised these differences, I can see no reason why the average consumer would expect the marks to originate from the same or economically connected undertakings. They are not consistent with a sub-brand or brand extension. Consequently, I do not consider there to be a likelihood of indirect confusion.

58. For the avoidance of doubt, my finding would have been the same even if I had found the earlier mark to benefit from a modest degree of enhanced distinctiveness (which is the opponent's best case on the evidence before me). This is because the visual differences between the marks, in a predominantly visual purchasing process, would be sufficient to offset any enhancement.

59. The opposition based upon section 5(2)(b) of the Act is dismissed.

Section 5(3)

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

"5(3) A trade mark which -

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

61. Section 5(3A) of the Act states:

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

62. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

"10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(a) the United Kingdom include the European Union".

63. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

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

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

66. In determining whether the opponent has demonstrated a reputation for the goods and services relied upon, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with those goods and services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it".

67. I have summarised the opponent's evidence of use in relation to the UK market above. I note that the opponent has also traded in France, having opened its first ice cream shop in Paris in 2002, with more than 90 ice cream shops opened throughout France. In 2008, the opponent opened its first shop in Barcelona and subsequently expanded to Milan. In 2016, the opponent was awarded a Quality Charter for its ice creams in France. However, I have no evidence of market share, advertising expenditure or revenue in relation to sales in France or the wider EU.

68. Whilst the tests for enhanced distinctiveness and reputation are different, the same factors are applicable to both. For the same reasons already given, I consider that the evidence falls short of establishing that the opponent had the requisite reputation in the UK at the relevant date. I have very little evidence regarding the wider EU market.

However, given that the opponent has had more than 90 stores in France alone, I recognise that this must represent a significant share of the market. Consequently, whilst the evidence is extremely thin, I will consider whether this ground could succeed on the basis of a qualifying reputation in France in relation to ice cream and ice cream parlours.

69. Whilst the opponent can rely upon a reputation in the EU, I must still be satisfied that a link would be made in the mind of the relevant public, which in this case, is the UK relevant public. In my view, there is no reason for them to make a link absent a reputation here. Consequently, as no link would arise, meaning there could be no damage, the opposition under this ground must fail.

70. For the avoidance of doubt, even if I had found that the opponent had a modest reputation in the UK for ice cream and ice cream parlours (which is the opponent's best case based on the evidence before me) this ground would still not have been successful. This is because the differences between the marks and the modest reputation of the earlier mark would be sufficient to avoid a link arising, even when used on identical goods and even when the mark is benefitting from a high degree of distinctive character. Consequently, I do not consider that a link would be made in the mind of the relevant public. If a link is made, then it would be too fleeting to give rise to damage.

71. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

72. Section 5(4)(a) of the Act states as follows:

> "5(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".

73. Subsection (4A) of section 5 of the Act 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."

74. I can deal with this ground relatively swiftly. I am satisfied that the evidence is sufficient to establish a protectable goodwill in relation to ice cream and ice cream parlours. However, whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it has been acknowledged that they are unlikely to produce different outcomes in practice.[16] Certainly, I believe that to be the case here. For the same reasons set out above, I do not consider that misrepresentation or damage would arise.

75. The opposition based upon section 5(4)(a) of the Act is dismissed in its entirety.

CONCLUSION

76. The opposition is unsuccessful, and the application may proceed to registration.

[16] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

COSTS

77. The applicants have been successful and are entitled to a contribution towards their costs, based upon the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicants jointly the sum of **£1,500**, which is calculated as follows:

Preparing a counterstatement and considering the Notice of opposition	£350
Preparing evidence and considering the opponent's evidence	£750
Written submissions in lieu	£400
Total	**£1,500**

78. I therefore order CPG (Société pas actions simplifiée) to pay Terence King and Robert Gibson the sum of **£1,500**. 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 4th day of June 2024

S WILSON
For the Registrar