

BL O/0711/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3698872

BY FOODCO NATIONAL FOODSTUFF PJSC

TO REGISTER THE TRADE MARKS:



IN CLASSES 29 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 432096

BY CASHEW NEWCO LIMITED

BACKGROUND AND PLEADINGS

1. On 22 September 2021, Foodco National Foodstuff PJSC (“the Applicant”) applied to register in the UK the series of two trade marks shown on the cover page of this decision (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 31 December 2021, in respect of goods in Classes 29 and 30 (see annex for the full list of goods).

2. On 23 March 2022, Cashew Newco Limited (“the Opponent”) filed a notice of opposition, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon its United Kingdom trade mark number 1452100, ‘FUDCO’ (“the earlier mark”). The earlier mark was filed on 4 January 1991, and became registered on 10 July 1992, in respect of the following goods:

Class 29 Pulses, dried milk; fruits and vegetables, all being dried, cooked, preserved, processed, frozen or canned; meat, fish, poultry and game; meat extracts; jellies, preserves and jams; milk and milk products; all included in Class 29.

Class 30 Flours and spices; cereals and preparations made from cereals, all for food for human consumption; biscuits (other than biscuits for animals), chocolate, non-medicated confectionery; tea, coffee, cocoa; mixtures of coffee and chicory; coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; snack foods; all included in Class 30.

3. On 14 September 2022, the Applicant filed a Form TM21B limiting the goods originally claimed. Following the limitation, the opposition was maintained by the Opponent. As a result of the limitation the goods claimed are now:

Class 29 Tuna.

Class 30 Rice.

4. Under section 5(2)(b), the Opponent claims that the marks are highly similar, and that the goods are sufficiently similar, and as such a likelihood of confusion exists. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the Opponent made a statement of use in relation to all the goods relied upon.

5. The Applicant filed a counterstatement denying the claims made and putting the Opponent to proof of use of the earlier mark.

6. The Opponent is represented by Serjeants LLP; the Applicant is represented by Beck Greener LLP. A hearing was neither requested nor considered necessary, however, a case management conference (“CMC”) did take place on 3 October 2022, regarding a procedural issue which does not impact the substantive issues, nor bear any outcome, on these proceedings. Therefore, it will not be addressed within this decision. Only the Opponent filed evidence and submissions. Both parties chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

EVIDENCE

7. The Opponent filed evidence consisting of a witness statement of Mr Saagar Patel, dated 6 September 2022, and his corresponding six exhibits (SP1- SP6). Mr Patel, who is the Head of Strategic Projects of Vibrant Brands Limited, has held this position since 19 October 2020. In his witness statement, Mr Patel states that as Vibrant Foods Limited own 100% of the shares of Cashew Newco Limited he is authorised to speak on behalf of both Cashew Newco Limited and Vibrant Foods Limited. Although no explanation is given as to the relationship between “Vibrant Brands Limited” and “Vibrant Foods Limited”, I will proceed on the basis that the use shown was use with the consent of the opponent, as it will have no bearing on the outcome of this decision, for the reasons set out below. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used in the UK for the relevant period.

8. Whilst I do not intend to summarise the evidence here, I have read all of the evidence and will return to it to the extent I consider necessary in the course of this decision.

RELEVANCE OF EU LAW

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Proof of use

10. I will begin by assessing whether, and to what extent, the evidence supports the Opponent's statement that it has made genuine use of its mark in relation to the goods for which it is registered. The relevant period for this purpose is the five-year period ending with the date of the application in issue, namely 23 September 2016 to 22 September 2021.

11. Section 6A of the Act states:

“(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), (b) 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.”

12. The onus is on the Opponent, as the proprietor of the earlier mark, to show genuine use because Section 100 of the Act states:

“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.”

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer*, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky - Order v Bunderversvereinigung 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 Marken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

14. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the

proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the Opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

15. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*,¹ where he stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

¹ Case BL O/424/14

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

17. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the mark.

Form of the mark

18. Before I consider whether the Opponent has demonstrated sufficient use in relation to its mark, I will first consider the marks shown within the evidence, and if I consider these to be use of the mark as registered, or to be acceptable variants of the same.

19. The Opponent's registration is for the word only mark 'FUDCO'. Where it has used its registration as registered, that will clearly be use on which the Opponent can rely. In addition, it is noted from the evidence that the Opponent's registration has also been used in the following ways:



20. Section 6A(4)(a) of the Act enables an Opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that “use of a mark, in its literal sense, generally encompasses both its independent use and

its use as part of another mark taken as a whole or in conjunction with that other mark”, but that “a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

21. In *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, BL O/281/14, Iain Purvis QC (as he then was), sitting as the Appointed Person, stated:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalisation which appears in the Register of Trade Marks. See for example *Present-Service Ullrich GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-66/11 at [57]. A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register while remaining ‘identical’ to the registered mark.”

22. As shown, the signs presented as trade marks in the Opponent’s evidence includes figurative versions of the mark, incorporating colour, stylised fonts and figurative elements. However, I bear in mind that as the registered trade mark is a word mark, fair and notional use of the mark allows it to take on a different presentation, such as a different colour, font or letter case, etc. This is use of the mark as registered and is use upon which the Opponent can rely.

23. Where there is use in the Opponent’s evidence of the word FUDCO accompanied by the additional non-distinctive words ‘PREMIUM QUALITY’, ‘TRUSTED BRAND’, ‘ESTD 1979’, and lowly distinctive figurative elements, I am of the view that the word FUDCO will still be perceived as indicative of the origin of the goods. Accordingly, I consider that the marks shown above, are all use of the mark as registered and use upon which the Opponent can rely.

Genuine use

24. With regards to the Opponent's evidence of use the Applicant submits:²

"The Opponent has not demonstrated through its evidence that it was creating or building a share in the market for the relevant goods in the UK in accordance with the genuine use test in Walton; the Applicant accordingly requests that the Tribunal refuses the Opposition in its entirety.

The mark in the Opponent's registration, namely FUDCO ("the Opponent's mark") has not been used in the UK by the Opponent, or with its consent, for any of the Opponent's goods within the 5 year period immediately preceding the date of the Application ("the Relevant period"), namely 22 September 2016 to 21 September 2021) [sic], or at any other material time, and there are no proper reasons for non-use. The Opponent's evidence in chief, namely Mr Patel's statement and accompanying exhibits, comprises of material which he says is for the purpose of showing use of the mark FUDCO, but Mr Patel does not say that his evidence is for showing "genuine use" of the Opponent's registration. In any case, the material provided does not demonstrate that the conditions necessary for establishing genuine use of the registration have been met *inter alia* for the reasons summarised below:

- The majority of the material provided by the Opponent is either undated or outside the Relevant period.
- The Opponent does not specify for what products it has allegedly used the mark FUDCO in the UK or otherwise.
- Much of the material provided by the Opponent does not show use in the UK.
- No sales figures are provided for products sold under the mark FUDCO.
- No evidence of sales to UK end consumers is provided for goods under the mark FUDCO.

² Submissions in lieu of a hearing

- Alleged advertising examples and figures are ambiguous and do not provide relevant details for marketing of goods under the mark FUDCO.
- No social media figures or examples of use are provided, including no third party media attention.

In view of the aforesaid and for the reasons explained in the paragraphs below, the Opponent has not demonstrated that it was creating or building a share in the market for the relevant goods in the UK in accordance with the test in *Walton*.”

25. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period.

26. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

27. The Opponent claims to have used its registered trade mark ‘FUDCO’ in relation to the following goods:

Class 29 Pulses, dried milk; fruits and vegetables, all being dried, cooked, preserved, processed, frozen or canned; meat, fish, poultry and game; meat extracts; jellies, preserves and jams; milk and milk products; all included in Class 29.

Class 30 Flours and spices; cereals and preparations made from cereals, all for food for human consumption; biscuits (other than biscuits for animals), chocolate, non-medicated confectionery; tea, coffee, cocoa; mixtures of coffee and chicory; coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; snack foods; all included in Class 30.

28. In his witness statement Mr Saagar Patel states that the Opponent has used the mark ‘FUDCO’ on product packaging, in the UK since 1979.

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

29. Exhibit SP1 contains 13 photographs showing the 'FUDCO' mark in use. In one of the photographs (No.4), the mark is shown on signage placed on the front of a shop premises, and in another photograph (No. 13), the mark can be seen in use on what appears to be a promotional stand positioned outside the front of a retail store, as can be seen from the following:



30. The remaining 11 photographs (4 of which are duplications) feature store shelving display units containing various food products. Whilst some of these photographs clearly show the 'FUDCO' mark in use on goods such as *dry peas, dry lentils, seed, beans, almonds, spices, bay leaves cashew nuts, walnuts, chillies, flour, sago seeds, chilli powder, curry powder and dates*, on some of the photographs the wording is so small that the mark and actual type of goods cannot be determined, as the following example shows (photograph No.2):



31. All 13 photographs contained in the exhibit are undated. However, I note that some of the photographs feature 'keep a safe distance' signage, as per the example shown above, which only came into force after March 2020, as a result of the Covid social distancing rules.

32. Exhibit SP2 contains a number of invoices, purchase orders and delivery notes. A significant number of the documents are purchase orders which provide no details of the purchase amounts and unit prices of the products being supplied. Furthermore, a significant number of the invoices are from third party suppliers to the Opponent and not issued by the opponent. Accordingly, I find that these invoices fail to demonstrate that the goods in question were marketed or sold by the Opponent under the mark 'FUDCO'.

33. However, I note that Exhibit SP2 also contains 9 invoices from the Opponent (Cashew Newco Ltd), featuring the 'Fudco' mark relating to the sale of goods (foodstuffs) to various companies in the UK. These invoices are dated between 1 April 2017 and 4 August 2022, namely:

- 3 invoices dated in 2017, amounting to £24,574.64;
- 3 invoices dated in 2020, amounting to £82,174.41;
- The remaining 3 invoices are dated in 2022, and therefore fall outside the relevant period.

34. The 6 invoices that fall within the relevant period are dated between 1 April 2017 and 25 November 2020. With regard to these invoices, the following is noted:

a) The invoices contain numerous examples of goods being sold which are outside the scope of the Opponent's specification, such as, over 2,300 units of various varieties of nuts. Therefore, whilst the sales figures contained in the 6 relevant invoices is not insignificant (£106,749.05 in total), a significant proportion of the sales (£87,000 approximately) relate to *nuts* (various varieties). Prepared nuts such as those that are salted, roasted and flavoured, etc., and nut-based snacks, such as, nut and raisin mixtures and nut-based food bars, are proper to Class 29, however, I note that the Opponent has not

claimed *nuts*, or *nut-based snacks* in its specification. Furthermore, whilst it is noted that *snack foods*, have been claimed by the Opponent in Class 30, this would not cover 'nut-based' snacks, on the basis that these goods would be proper to Class 29, as previously stated. Whilst I bear in mind that sugar/chocolate covered nuts are proper to Class 30 (confectionery), notably, there is only one reference in the 6 invoices at issue relating to the sale of 1 unit of *sugar-coated almonds*, amounting to £35.00.

b) The invoices contain the sale of over 260 units of goods that are not identifiable due to the description used in the invoices. The opponent has provided no explanation to assist me in this regard. These goods amount to over £3,200. As such, I am unable to ascertain whether or not these goods fall within the scope of the Opponent's specification. The goods at issue are as follows:

Ayumi natural amla powder; bhardo methi; daria mabaleswar black; far far cars coloured; far far potato jali; haldi powder rajapuri; shankhpushpi vegecaps hesh; Jeera kala (Shahi jeera); orma lapsi fine white; lindi pipper powder bot; mukwhas tip top; phool makhana; garmar in brine; sitopaladi churna bottle heash; sopari mongroli unroasted; sopari tukda scented; toor dall unoily; triphala churna bottle hesh; urad whole aust; vall dall; moong dall shilka; chilli & lemon; daria mabaleswar black; daria salted roasted gram tray; daria unsalted roasted gram; daria unsalted roasted gram; cornuts original; cornuts chilli & lemon; fatakdi alum powder; fatakdi alum slab; gantoda powder; adulsa tulsu syrup hesh; jethimade powder bott he; maha sudarshan churan bottle; karela extract vegecaps hesh; mahasudarshan capsules hesh; jethimade (malethi) whole; kala chana (deshi) Indian; kalijiri whole; mehendi powder pure (henna) ayum; mukwhas Gujrati; mukwhas manpasand green; mukwhas pan masala; mukwhas tip top; phool mukhana; sopari scented coin.

c) There are sales of 1 unit of pigeon peas; over 10 units of dal in various forms;

d) There are sales of 2 units of dried milk;

- e) There are sales of 145 units of desiccated coconut, 1 unit of dried cranberries, 5 units of mango pulp, 1 unit of diced mango, over 259 units of raisins (in various forms), 3 units of dried apricots, and 1 unit of crispy onion;
- f) There are sales of 20 units of flour (various varieties);
- g) There are sales of various spices, including 6 units of cinnamon sticks, 1 unit of cumin, 2 units of pepper in various forms, 206 units of cardamom, 1 unit of salt, 1 unit of garam masala, 1 unit of mustard powder, and 3 units of dried chilies (in various forms).
- h) There are sales of 1 unit of pearl barley, 21 units of seeds (various varieties), over 280 units of popping corn, 5 units of semolina (in various forms), and 19 units of rice (various varieties);
- i) There are sales of 4 units of tea (various forms and varieties);
- j) There are sales of 5 units of papadums;
- k) There are sales of 1 unit of sugar-coated almonds.
- l) There are sales of 1 unit of moong beans and 1 unit of moth beans;
- m) There are sales of over 14 units of soya in various forms;


35. With regard to the contents of Exhibit SP3, Mr Patel states that this exhibit demonstrates that the Opponent has carried out a number of different marketing initiatives under the 'FUDCO' mark. However, it is noted that the exhibit merely contains 7 images, showing the mark being used in relation to an assortment of nuts, which as previously mentioned, are goods not covered by the Opponent's earlier mark. Furthermore, it is not clear from the exhibits where these images were retrieved from, for example, a magazine, catalogue or marketing leaflet, etc. Moreover, only image 7 is dated, namely 25 October 2021, which is outside the relevant period.

36. Exhibit SP4 relates to screenshots taken from the Opponent's website (fudcoshop.com). Mr Patel states that 'customers are able to purchase products from

the website and find out further information on the brand'. The website features the Opponent's mark 'FUDCO' being used in relation to, amongst other things, flours, spices, dried fruit, nuts and seeds, pulses and grains, canned and bottled products and soya. However, there are no visible dates on any of the pages and the Opponent has not provided any figures to demonstrate how many people have viewed its website or indeed the geographical location of such viewers.


37. Mr Patel gives evidence that the Opponent's goods are sold in a number of different shops, such as Sainsbury's, Quality Foods and the 'Fudco' branded shop as shown in Exhibit SP5. However, none of the images are dated and Mr Patel does not give evidence as to when these products were first stocked in these stores. Consequently, it is not clear to me that these goods were sold by these retailers during the relevant period.

38. Mr Patel states that 'Fudco' advertises its products on Sunrise Radio and that Exhibit SP6 shows the statistics for the radio station (as shown below). Mr Patel states that the following table demonstrates that the station has a good reach and as a result, the brand has been exposed to a large number of people through one advert. However, as can be seen from the following, the periods referred to in the table, namely 1 August to 31 December 2021, 1 January to 31 July 2022 and 1 August 2021 to 31 July 2022, are largely outside of the relevant period.



Back to Back Songs on Sunrise

Campaign Analysis provided for Fudco



Background

- Sunrise Radio is the UK's leading commercial Asian radio station consistently since inception
- Now in its 33rd of providing music & entertainment the UK's Asian community
- Broadcasting to London on 963/972 am, nationwide on DAB, mobile, tablet and Alexa enabled devices. Content on Sunrise YouTube Channel, Facebook @ ThisIsSunriseRadio; Twitter & Instagram @ ThisIsSunrise + weekly Podcasts
- Sunrise Radio reaches 376,000 Asian adults nationally every week, 82% of these adults are main-shopper, in London Sunrise it's 87% main-shoppers


Back to Back Songs – a popular feature on Sunrise Radio National (inc London) Monday-Sunday

- 2 popular Bollywood songs played back to back
- Bollywood songs are approximately 4-5 minutes long – the feature is generally 8-10 minutes long
- The sponsor receives 3 x 10 second credits per feature – 1 at the top of the feature, 1 in-between the two songs and 1 at the end of the feature

Delivery	1 August-31 December '21	1 January-31 July'22	1 August'21-31 July'22
Reach (000's)	787	780	942
Impacts (000's)*	20,814	24,328	45,140
OTH**	26.4	31.2	47.9

Rajar Q1 2021

* Number of times the message is heard
** The number of times each individual hears the message



39. Furthermore, pages 2-4 of the exhibit relate to an invoice headed 'AIRTIME BOOKING REVISION' amounting to £3,840.00, for a period of five weeks between 4 December 2021 and 31 December 2021. Whilst this exhibit demonstrates promotion of the 'FUDCO' mark via the Sunrise Radio Station, the dates are outside the relevant period.

40. Page 5 of the exhibit relates to a Sunrise advertising Schedule titled 'Fudco Competitions 11-15 Jul 2022'. However, again the dates are outside the relevant period.

41. I have carefully considered whether the evidence of use provided by the Opponent in respect of the goods relied upon, during the relevant period, meets the requirements for genuine use as per *Walton*, set out earlier in this decision. It is important to recall that the onus is on the Opponent to provide 'sufficiently solid' evidence in order to prove use.

42. As highlighted by the Applicant, there are clearly some issues with the Opponent's evidence. Where proof of use is required, as in this case, it is typical to see evidence such as turnover figures relating to products sold, etc., and whilst it is noted that the Opponent has provided 9 invoices featuring the 'Fudco' mark relating to the sale of goods to various UK companies, only 6 of the invoices are dated within the relevant period.

43. Furthermore, whilst the sales contained in the 6 invoices amount to approximately £107,000, approximately £90,000 worth of these sales relate to goods that are either not covered by the Opponent's specification, or are not identifiable, as previously discussed. Therefore, sales of goods, relating to those claimed in the Opponent's specification, amount to no more than £17,000 (approx.).

44. The lack of turnover figures is not necessarily fatal to the assertion of genuine use, if other material filed by the Opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, I am of the view that there is very little evidence of other activity in this case.

45. Whilst it is clear that the Opponent has been using its mark in the UK, over a number of years, taking the evidence as a whole, my view is that the Opponent's evidence is insufficiently solid to adequately demonstrate that there has been genuine use of the mark in relation to the goods upon which the Opponent relies, during the relevant period.

46. Accordingly, from the evidence before me, I find that I am unable to establish with any certainty, if the Opponent has attempted to create and maintain a market for the goods at issue in the UK, under the mark at issue. If the mark had been put to genuine use on the goods relied on in the UK, within the relevant period, then it should not have been a difficult matter for the Opponent to show it. However, it did not. Consequently, I find that the evidence fails to show real commercial exploitation of the mark in order to create and maintain a share of the UK market for the given goods.

47. As the opponent has failed to demonstrate genuine use of the mark relied upon, the opposition fails. However, in the event that I am wrong in this finding, I will now proceed to consider the merits of the opposition. I will proceed on the basis that the goods are identical, as that represents the opponent's best case.

Section 5(2)(b)

48. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because-

[...]

(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.

[...]

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.”

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

50. As noted above, I will proceed on the basis that the goods are identical.

The average consumer and the nature of the purchasing act

51. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

52. 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. 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.”

53. The average consumer for the parties' goods at issue will be a member of the general public. The goods are an everyday foodstuff which is likely to be purchased frequently, at low cost. The main focus of attention will be use and flavour, although some attention may be paid to allergy information and calories, etc. I find that the average consumer will pay a medium degree of attention during the purchasing process. The goods will be purchased primarily visually, selected from the shelves of a retail outlet or from an online equivalent. That said, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant.

Comparison of the marks


54. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

56. The trade marks to be compared are as follows:

Opponent's mark	Applicant's marks (series of 2)
FUDCO	 The image shows two versions of the 'Foodco' logo. The top version is in black, featuring a stylized wheat stalk icon to the left of the word 'فودكو' in Arabic script and 'Foodco' in English. The bottom version is in green, featuring the same stylized wheat stalk icon to the left of the word 'فودكو' in Arabic script and 'Foodco' in English.

57. With regard to the similarity of the marks, the Opponent submits:⁴

“Although the Applicant's mark contains stylisation, it has no overall impact or impressions on the average consumer. The main element of their mark is the word element. We do not believe that the stylisation in the mark increases the

⁴ Written submissions in lieu of a hearing.

distinctiveness between the marks. Both marks contain the same suffix and prefix and therefore it is very likely that the average consumer would simply assume that the Applicant's mark was a sub-brand of the Opponent's FUDCO brand.

Both marks contain almost identical words that have no specific meaning. It is therefore argued that conceptually the marks are identical, if not highly similar.

Phonetically the only difference are the middle letters, however OO and U make extremely similar sounds and in some cases, like the word ZOO, an identical sound. As such the marks are considered phonetically highly similar.”

58. With regard to the similarity of the marks, the Applicant submits:⁵

“The Opponent's mark consists only of the term "Fudco" [sic] which has no meaning in English. The Applicant's mark consist [sic] of the term "Foodco" in a stylised font as well as the same term directly above transliterated in Arabic script, which is also in the same slightly stylised font; there is also a distinctive device to the left of both word elements and with a rectangular border surrounding all elements.

[...] the English word element "Foodco" in the Applicant's mark contains the letters "oo" following the letter "F" in the prefix/start of the mark, whereas the Opponent's mark contains the different letter "U" in the prefix/start of the mark. The Court held the following in *Trubion v OHIM* (T-412/08) at [40]: "consumers generally pay greater attention to the beginning of a word sign than to the end." Therefore, differences between the beginning of what are short English word elements in the parties' marks would have a significant influence on the perception of the relevant public. The relevant public would not consider that the Applicant's mark as a whole looks similar to the Opponent's mark.

There are also significant phonetic differences between the marks. The Arabic and English word elements of the Applicant's mark would be pronounced

⁵ Written submissions in lieu of a hearing.

exactly as they read, namely "food-co" and the Arabic equivalent, whereas the word element in the Opponent's mark would be pronounced "fudd-co" as it does not contain the sound created by the presence of the letters "oo" in the word "food". The terms "Fudco" and "Foodco" have only one syllable in common, namely "co" which is at the end of both marks and is not a dominant or distinctive component in either and is a generic abbreviation for the word "company" which is used by countless businesses. The relevant public would not consider that the Applicant's mark as a whole sounds similar to the Opponent's mark. However, contrary to the Opponent's submission, the relevant public would not perceive the words "food" and "fud" as the same as only one of these words would be recognised and have a concrete meaning to the average consumer, namely "food". The marks are therefore conceptually different.

For the relevant public, the "food" element of the Applicant's mark conveys a clear and distinct concept. It is a well-known English word which is used extensively in everyday language. Conversely, the Opponent's mark has no clear meaning whatsoever. There is no such thing as a "fud" which is not a term in English.

[...]

However, contrary to the Opponent's submission, the relevant public would not perceive the words "food" and "fud" as the same as only one of these words would be recognised and have a concrete meaning to the average consumer, namely "food". The marks are therefore conceptually different."

Overall impression

59. The Opponent's word-only mark 'FUDCO' is presented in standard capital letters. There are no other elements that contribute to the overall impression of the mark which resides in this single element.

60. The Applicant's marks (series of two) are composite marks consisting of a combination of three elements, namely a figurative device element at the start of the mark, followed by figurative writing, resembling Arabic script, placed above the verbal element 'Foodco', presented in standard sentence case, with a capital first letter, and lower-case letters following. The word and figurative elements in the marks are all contained within a rectangular border, the first mark is presented in black, whereas the second mark is presented in gold and green. I find that the word 'Foodco' is the more dominant and distinctive element and is likely to be noticed first, keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”

61. Slightly less dominant are the figurative and device elements present in the marks. However, these elements still contribute to the overall impression of the marks. I find that the rectangular border will have little impact on the consumer.

Visual comparison

62. Visually, the words in the marks coincide insofar as they identically share the same first letter 'F' and the last three letters 'DCO / dco'. The word elements also have a similar length, being five and six letters respectively. The marks are visually different in that the Applicant's marks have the letters 'oo' between the 'F' and 'd' in the marks (Foodco), whereas the Opponent's mark has a letter 'U' between the 'F' and 'D' of the mark (FUDCO). Furthermore, the Applicant's marks contain a figurative device element and figurative writing, resembling Arabic script, neither of which are replicated in the Opponent's mark. I consider the marks to be visually similar to between a low and medium degree.

Aural comparison

63. Aurally the Opponent's mark is likely to be pronounced as 'FUD-CO', (the 'U' in 'FUD' being pronounced as in 'mud' and 'bud', etc.), whereas the Applicant's marks will likely be pronounced as 'Food-co' ('food' being pronounced as in the ordinary dictionary word 'food'). The figurative elements contained in the Applicant's marks will not play a part in the aural comparison. Overall, I find the competing marks aurally similar to a medium degree. However, I bear in mind that a proportion of consumers may pronounce the 'U' in the Opponent's mark as in 'flu', and therefore, for this group of consumers the competing marks will be articulated identically.

Conceptual comparison

64. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

65. The Opponent's mark 'FUDCO' has no conceptual component and will be perceived by the average consumer as an invented word. With regards to the Applicant's marks, I consider that the average consumer will notice that the word 'Foodco' consists of the standalone words 'food' and 'co' and as such, 'food' will be given its ordinary dictionary meaning, i.e. *any nourishing substance that is eaten, drunk, or otherwise taken into the body to sustain life, provide energy, promote growth, etc;*⁶ and the word 'co' perceived as a company identifier, i.e. 'food company'. Accordingly, I find that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

66. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

⁶ www.collinsdictionary.com/dictionary/english/food

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not 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).”

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

68. I note that the Opponent has not pleaded that its mark has acquired enhanced distinctive character through use. However, as the Opponent has filed evidence of use, as summarised above, I will make a finding in relation to enhanced distinctiveness for the sake of completeness. Whilst the overall turnover figures have not been provided, the invoices submitted in relation to the relevant goods demonstrate a modest turnover during the relevant period. I am of the opinion that the sales represented by the invoices provided, do not represent a particularly significant share of what is undoubtedly an extensive market. I recognise that the

use shown has taken place over a number of years and that use has been reasonably geographically widespread across the UK. However, I have seen very little evidence relating to advertising expenditure or marketing activities undertaken by the Opponent. Taking all of this into account, I find that the Opponent has not demonstrated that its mark has acquired enhanced distinctiveness through use.

69. I have, therefore, only the inherent position to consider. The earlier mark comprises the word 'FUDCO'. As previously mentioned, I consider that this word will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods for which the mark is registered. Therefore, I consider the Opponent's mark to be inherently distinctive to a high degree.

Likelihood of confusion

70. 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. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

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

72. Earlier in the decision I concluded that the respective marks are visually similar to between a low and medium degree, either aurally identical or aurally similar to a

medium degree, and conceptually dissimilar. I have found the Opponent's mark to be inherently distinctive to a high degree, but that the evidence does not show the distinctiveness has been enhanced through use. I will proceed on the basis that the goods are identical. Furthermore, I have identified the average consumer to be a member of the general public, who will pay a medium degree of attention during the selection of the goods at issue. I am of the view that the purchasing process for the goods at issue would be predominantly visual in nature, though I have not discounted aural considerations.

73. Taking into account all of the above factors, particularly the fact that the purchasing process is predominantly visual, I am not convinced that the marks 'FUDCO' and 'Foodco' (with some stylisation), would be mistakenly recalled or misremembered for one another, even bearing in mind the principle of imperfect recollection. Consequently, I do not consider there to be any likelihood of direct confusion.

74. I will also assess if there is a likelihood of indirect confusion.

75. 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).”

76. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

77. 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.

78. For a finding of indirect confusion, I would need to conclude that consumers will notice the common elements ‘F_DCO / F__dco’, while at the same time recalling the differences between the marks and assume that the marks are from the same or related undertakings. However, to my mind, the stated differences between the letters in the marks, namely ‘FUDCO / Foodco’ (and figurative elements), are not a logical brand extension or sub-brand and, as such, I do not see a logical step which

would induce consumers to be indirectly confused. Rather, I am of the view that the average consumer would put the presence of the common elements 'F_DCO/ F_ _dco' in the marks down to coincidence rather than economic connection. Therefore, the high point of coincidence between these marks is that there are some shared letters, which share a similar pattern, however, visually the marks as a whole look quite different, which is an important factor, bearing in mind that I am of the view that the purchasing process for the goods at issue would be predominantly visual in nature. Accordingly, even bearing in mind the relatively low cost of the goods at issue, I find that there is no likelihood of indirect confusion.

Conclusion

79. The opposition under section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration.

Costs

80. As the Applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. The Applicant, in its written submissions,⁷ dated 15 March 2023, has requested the Tribunal awards costs off the scale, the associated submissions read as follows:

"In its letter of 7 June 2022, the Tribunal set the Opponent a deadline of 8 August 2022 by which to file any evidence and submissions in the proceedings. The Opponent requested an extension of time on 8 August 2022 but failed to do so in the correct format as per the Tribunal's letter of 16 August 2022. The Opponent filed a Form TM9R request for a retrospective extension of time on 18 August 2022 which was refused by the Tribunal in its letter of 30 August 2022. A CMC was requested by the Opponent but not copied to the Applicant, resulting in delay to the 13 September 2022 date originally scheduled for the CMC. The CMC was eventually held on 3 October 2022 at which point it had been almost 17 weeks since the Tribunal's letter of

⁷ Written submissions in lieu.

7 June 2022 inviting the Opponent to file evidence - nothing had been filed. The Opponent was permitted to file its submissions and evidence by the close of 3 October 2022; this consisted of submissions dated 3 October 2022, the witness statement of Saagar Patel and Exhibits SP1 to SP6. In its letter of 6 October 2022 following the CMC, the Hearing Officer stated the following which should be borne in mind by the Tribunal when determining costs:

"I did not make an award of costs at the CMC but advised that any costs in relation to the CMC would be reflected in the final decision dependent on any submissions made by the parties."

The Tribunal's letter of 24 November 2022 stated that the Opponent's evidence was not presented properly. The Opponent then filed a further TM9R and corrections on 14 December 2022. In total, over a half a year elapsed from the Tribunal's initial letter of 7 June 2022 to the corrected filing of the Opponent's evidence. The Applicant chose not to file any evidence or submissions in reply, informing the tribunal of the same on 14 February 2023. The evidence rounds were completed following the Registry's letter of 15 February 2023.

[...]

In view of the foregoing, the Applicant requests that it be awarded costs off the scale including because of the significant delays and additional costs caused by the Opponent's actions during the proceedings as detailed."

81. TPN 2/2000 recognises that it is vital that the Registry has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. TPN 4/2007 provides further guidance and states:

"5. [...] Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which would lead to an off scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding

factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour.

[...]

7. Any claim for cost approaching full compensation or for “extra costs” will need to be supported by a bill itemising the actual costs incurred.”

82. It is noted that the Opponent’s evidence and submissions were not filed by the original deadline and that their subsequent request for a retrospective extension to the time limit in order to submit the evidence was initially refused by Tribunal. However, following a Case Management Conference (“CMC”) the Opponent was permitted to file its submissions and evidence. Nonetheless, as the Opponent’s evidence was not presented properly, it then filed a further retrospective extension to the time limit, in order for them to correctly file the evidence. I note from the Applicant’s comments above, that the Opponent’s actions caused significant delays and additional costs during the proceedings.

83. Whilst it is acknowledged that the Opponent filed its evidence late, failed to request a retrospective extension to the time limit in the correct format and following a CMC, failed to present its evidence properly, I am not satisfied that the Opponent’s behaviour constitutes a breach of the rules, delaying tactics or is sufficiently unreasonable to justify awarding costs off the standard scale. Whilst it is acknowledged from the Applicant’s letter of 3 October 2022, that the legal costs incurred by the Applicant due to the CMC and delays in proceedings amount to £1,072.50, the Applicant’s request for costs off the scale has not been supported by a bill itemising the actual costs incurred. Accordingly, as indicated by the Hearing Officer in her letter of 6 October 2022, when determining costs, I will bear in mind the Applicant’s attendance at the CMC, in addition to making an award for considering the Opponent’s evidence, in order to reflect the additional costs incurred as a result of the Opponent’s conduct. Consequently, I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement	£300
Considering the Opponent's evidence	£400
Preparing for and attendance at the CMC	£300
Preparing submissions in lieu of a hearing and considering the Opponent's submissions in lieu of a hearing	£300
Total	£1,300

84. I therefore order Cashew Newco Limited to pay Foodco National Foodstuff PJSC the sum of £1,300. The above sum should 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 25th day of July 2023

Sam Congreve
For the Registrar

Annex

Applicant's goods prior to the limitation

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.

Class 30 Coffee, tea, cocoa and artificial coffee; 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].