

O/0809/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. UK00004103901
& UK00004126219 BY FILIZ CATALTEPE TO REGISTER:**

Infty

AS A TRADE MARK IN CLASS 30

AND

IN-FITY

IN FITY

(SERIES OF TWO)

AS A TRADE MARK IN CLASSES 5, 29, 30, 31, 32 & 35

AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 451143 & 452362 BY
INFINITY FOODS CO-OPERATIVE LIMITED**

BACKGROUND AND PLEADINGS

1. On 24 September 2024, Filiz Cataltepe (“the applicant”) applied to register the first trade mark (being that under no. 4103901) shown on the cover page of this decision in the UK (“the first application”). The first application was published on 4 October 2024 and registration is sought for the following goods:¹

Class 30: Chai tea; iced tea; coffee; coffee substitutes; tea; tea substitutes; artificial coffee.

2. On 18 November 2024, the applicant applied to register the series of two trade marks (being that under no. 4126219) shown on the cover page of this decision in the UK (“the second application”). The second application was published for opposition purposes on 29 November 2024 and registration is sought for the following goods and services:

Class 5: Nutritional supplements; dietary supplements; food supplements; nutraceuticals for use as a food, dietary or nutritional supplement; protein supplements; vitamin and vitamin supplements; mineral supplements; herbal supplements for general health and well-being; herbal teas for medicinal purposes; Chinese traditional medicinal herbs; medicinal herbal preparations; medicinal herbal extracts, other than essential oils, for medical purposes.

Class 29: Edible seeds; processed chia seeds; processed seeds; processed fruits, fungi, vegetables, nuts and pulses; preserved, frozen, dried and cooked fruits and vegetables; prepared nuts; mixtures of fruit and nuts; dairy products and dairy substitutes.

¹ Registration was initially sought for a wider range of goods but the specification was amended after the applicant filed a TM21B on 10 February 2025. After the amendment was implemented, the opponent was asked whether it wished to maintain the opposition against the first application by letter on 14 February 2025. No response was received and as communicated to the parties on 4 March 2025, the opposition was treated as being maintained.

Class 30: Chai tea; iced tea; culinary herbs; herbal infusions; honey; flavourings and seasonings; spices; sauces; coffee; coffee substitutes; tea; tea substitutes; natural sweeteners; artificial coffee; bakery goods; food mixtures consisting of cereal flakes and dried fruits; processed seeds used as a flavouring for foods and beverages; spices; confectionery.

Class 31: Unprocessed seeds; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers.

Class 32: Soft drinks, mineral and aerated waters; soft drinks flavoured with tea; non-alcoholic drinks; non-alcoholic fruit drinks and fruit juices; non-alcoholic syrups for making beverages.

Class 35: Advertising; marketing; sales promotion; online ordering services; retail services and wholesale services connected with the sale of food and drink, unprocessed seeds, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers; information, advisory and consultancy services in relation to all the aforesaid services.

3. The first and second applications were opposed on 4 December 2024 and 6 February 2025, respectively, by Infinity Foods Co-operative Limited (“the opponent”). Both oppositions are based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) ground of both oppositions is reliant upon the following two registrations:

INFINITY

infinity

Infinity

(series of three)

UK registration no. 2500511

Filing date 20 October 2008; registration date 27 February 2009

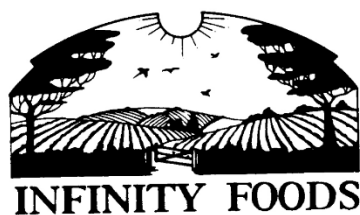
Relying on all goods, namely:

Class 29: Fruits and vegetables, all being preserved, dried or cooked; edible oils, edible fats; preserves; all included in Class 29.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; salt, mustard; salad dressings; spices; all included in Class 30.

Class 31: Grains, fresh fruits, fresh vegetables; seeds; malt; all included in Class 31.

("the opponent's first registration"); and



UK registration no. 1322815

Filing date 30 September 1987; registration date 8 September 1989

Relying on all goods, being those identical to the first mark, save for the term "salad dressings", which is not present in this specification.

("the opponent's second registration").

4. In relying on both of the above registrations, the opponent gave a statement of use confirming that it has used them on all of the goods for which they are registered.
5. The opponent's claim under the section 5(2)(b) ground is that the marks are highly similar and that the goods and services applied for are both identical and similar to its own goods. As such, the opponent claims that there exists a likelihood of confusion amongst the relevant public, which includes the likelihood of association.
6. Under both section 5(4)(a) grounds of opposition, the opponent relies on the unregistered sign 'INFINITY', which it claims to have used throughout the UK since 1987 in respect of the following goods and services:

"Fruits and vegetables, all being preserved, dried or cooked; edible oils, edible fats; preserves; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; salt, mustard; salad dressings; spices; grains, fresh fruits, fresh vegetables; seeds; malt.

Wholesale and retail services in connection with the sale of fruits and vegetables, all being preserved, dried or cooked, edible oils, edible fats; preserves; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, salt, mustard, salad dressings, spices, grains, fresh fruits, fresh vegetables, seeds, malt, soft drinks, chocolate, bread, bread mixes, cakes, beans, snack bars, cereals, herbs, milk, condiments, pasta, water, soup, fruit drinks, cordials, sweets, honey, supplements."

7. In addition to the above, the second opposition includes a reliance upon "wholesale and retail services in connection with the sale of food supplements, vitamin supplements, herbal tea."

8. Under this ground, the opponent claims to have generated a significant goodwill in its business and that the sign relied upon is associated with the same. The opponent claims that the applicant's use of a highly similar mark in relation to identical and highly similar goods and services amounts to a misrepresentation, whereby the relevant public will believe the applicant's marks were that of the opponent or that they were economically connected. It is claimed that this would ultimately lead to damage to the opponent in the form of loss of sales or dilution.
9. The applicant filed counterstatements wherein it denied all of the claims made and, further, requested that the opponent provide proof of use for both of its registrations.
10. Upon the filing of the counterstatement in defence of the second application, these proceedings were consolidated in accordance with the power granted to the Registrar under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties via written correspondence on 4 March 2025.
11. The opponent is represented by TENNANT IP LIMITED and the applicant is represented by RevoMark. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

13. The opponent's evidence came in the form of the witness statement of Martyn Laidlaw dated 6 May 2025. Mr Laidlaw is the Company Secretary of the opponent, a position he has held since 2010. Overall, Mr Laidlaw has been with the opponent since December 2003. His evidence is accompanied by seven exhibits, being ML 1 to ML 7, and was adduced in order to demonstrate genuine use of the marks relied upon and that the opponent's business enjoys the benefit of a protectable goodwill.

14. I do not intend to discuss the opponent's evidence in full at this point but will, where necessary, discuss it below.

DECISION

Proof of use

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. Section 6A is also relevant. It reads:

“(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.”

17. Section 100 of the Act is also relevant. It reads:

“100. 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.”

18. Given their filing dates, the marks in the opponent's registrations qualify as earlier trade marks under the above provisions. Both registrations completed their registration processes more than five years prior to the filing date of the applications. As above, the applicant requested proof of use meaning that the opponent's marks are subject to the use provisions.

19. 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 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 Marken 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].”

20. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applications, being 24 September 2019 for the first application and 18 November 2019 for the second. The relevant periods are, therefore, 25 September 2019 to 24 September 2024 and 19 November 2019 to 18 November 2024. Given the significant overlap between these relevant periods, I will consider them as one throughout my assessment of genuine use, only deviating from this approach where it becomes necessary to distinguish between them.

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”² because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Evidence of use

22. The opponent’s evidence sets out that it is a producer and supplier of organic food and drinks to customers and wholesale businesses. The history of the opponent is provided and, in short, I note that it began in 1971 by selling vegetarian products and baked goods, before expanding in 1976 to include wholesale as well as an additional range of goods such as chocolate, cocoa, oils and preserves.

23. The evidence states that a catalogue is produced every two months listing all of the food and drink it offers to customers. A sample of these catalogues from January 2020 to October 2024 is provided in evidence.³ There are around 60 pages worth of evidence but half of them are simply the cover page of the catalogue and the remainder are simply lists of goods offered. Each cover shows the branding as ‘Infinity Foods’. Having considered the lists of goods, I note that they are repetitive

² *Jumpman* BL O/222/16

³ ML1

in that they show a consistent list of products offered during the relevant period. I do not intend to list every good shown but note that the catalogues include a range of goods such as different varieties of rice, grains such as couscous, barley, quinoa and buckwheat groats, cacao nibs, cocoa powder, chocolate, instant hot drinks, cereals such as muesli, flakes and granola, coffee beans and different varieties of flour.

24. In further support of the type of goods offered under the relevant branding, I note that the opponent has provided a number of labels for the goods sold.⁴ These images are undated but I note that they show use of both the word 'INFINITY' and the figurative mark, being that under its second registration. The images show coffee beans, chocolate covered nuts, chocolate covered dates, cocoa powder, chocolate buttons, rice, avocado oil, rice flour, figs (this image is cut off so I cannot see the relevant branding), nuts, oat flakes, porridge oats, pumpkin seeds, red kidney beans, jars of red peppers, tins of stuffed vine leaves and wheatgerm.

25. Copies of information labels for products are also provided and these show the mark in the opponent's second registration.⁵ These labels include product specifications for olive oil and cocoa powder but are from 2018 so are prior to the relevant periods. In addition, this exhibit also includes images of the labels the opponent used. These are undated but show the branding 'infinityfoods/organics' and are for different mayonnaise products.

26. Images of the opponent's website are provided in evidence showing a range of goods that the opponent offers. The first set of screenshots are undated and show a range of goods in line with the goods covered by the catalogues discussed above. There are some additional goods not in the catalogues but these lack the relevant branding. For example, there are some supplement products but these appear under the branding 'BetterYou' or 'Forest Whole Foods'. Further, it is not clear

⁴ ML2

⁵ ML3

whether the goods shown are available for purchase through the website shown. While this exhibit does show a screenshot from the opponent's website during the relevant periods on 10 June 2021 (as obtained via the internet archive facility, the Wayback Machine), it simply shows a limited number of goods such as whole sesame seeds, black sesame seeds and sunflower seeds. There are also images of drink products but these appear under the branding 'KARMA DRINKS'.

27. On the point of its own website, it is noted that the screenshot from June 2021 includes information about the opponent's fresh produce.⁶ This information includes reference to the organic certification of its fresh fruit and veg and, also, information as to the seasonal availability of its organic produce.

28. In terms of turnover, the opponent has provided figures for sales of INFINITY branded products in the UK for the years 2002 to 2024. While only 2019 to 2024 are relevant here, the remaining figures may become relevant later on in this decision so I will reproduce them all for completeness. The opponent's turnover is as follows:

Year	UK Turnover (£)
2002	1,289,769
2003	2,143,133
2004	2,674,406
2005	3,039,654
2006	2,952,607
2007	2,923,826
2008	2,819,667
2009	2,835,325
2010	2,989,556
2011	3,335,177

⁶ See pages 12 and 13 of ML4

2012	3,837,743
2013	4,744,827
2014	5,899,049
2015	6,212,216
2016	6,276,516
2017	6,435,521
2018	6,297,650
2019	6,757,744
2020	7,679,407
2021	5,845,106
2022	5,140,397
2023	5,251,736
2024	5,668,404
Total	103,049,436

29. As for how the above applies to the present assessment, I remind myself that both relevant periods began at the end of 2019. Therefore, it is likely that the majority of turnover for 2019 will have come prior to both relevant periods. As there is no breakdown showing how the figures can be said to apply to the relevant periods, I will discount the 2019 figures from the present assessment entirely. That being said, applying a similar approach to 2024 (on the basis that the relevant periods concluded towards the end of that year and the lack of breakdown), I will include the 2024 figures in the present assessment. Therefore, I consider that the turnover insofar as it relates to genuine use was £29,585,050.

30. A range of invoices have been provided that the opponent confirms as being invoices to both consumers and wholesalers.⁷ The invoices are dated between 2018 and 2024 and show sales made to addresses across the UK. Each invoice includes the mark that appears in the second registration in the top left-hand

⁷ ML5

corner. The invoices are confirmed as covering the opponent's own 'INFINITY' branded goods as well as a range of third party goods that it retails in. There are over 160 pages of invoices so it is not possible for me to discuss each and every one. However, the narrative evidence helpfully confirms that of the opponent's own branded goods, the invoices cover honey, chocolate, edible oils, tea, coffee, cocoa powder, grains, fruit, vegetables, flour and nuts. I also note that, from my own brief review of the invoices, there are mixed spices sold under the 'Infinity Foods' branding.⁸ There are also a range of third-party products that are relied on for retail and wholesale services. Lastly, I note that the invoices have a column for 'brand' and where the opponent's brand is covered, it states either 'Infinity Foods' or 'Infinity Bulk'.

31. In terms of advertising, the opponent has provided figures as to its advertising spend in respect of 'INFINITY' branded products for the years 2009 to 2022. These are as follows:

Year	Advertising spend (£)
2009	46,056
2010	37,264
2011	19,589
2012	22,473
2013	27,859
2014	27,444
2015	57,945
2016	69,902
2017	76,811
2018	79,294
2019	87,494
2020	69,754

⁸ See, for example, pages 107, 112 and 141 of ML5

2021	74,081
2022	98,608
Total	794,574

32. In respect of the spend for 2023 and 2024, the evidence confirms that the spend for 'INFINITY' branded products is not yet available. However, the evidence does confirm that for 2023, the full marketing spend was £105,872 but that this included spend associated with marketing non-'INFINITY' branded products under its retail/wholesale business.

33. Taking a similar approach to the advertising spend as I did with the turnover, I will discount the 2019 figures. As there are no figures for 2024, I have no way to determine the spend for that year. As such, the relevant advertising spend insofar as it relates to genuine use was £348,315, though I bear in mind that a portion of that will relate to advertising of the retail/wholesale arm of the opponent's business.

34. The evidence moves on to discuss the opponent's attendance at various trade fairs in the UK over the years. These include attendance at the 'Natural and Organic Products Europe Show – London' and the 'Brighton Food Festival' both for 20 plus years. In addition, it confirms its attendance at shows such as 'Lunch! Show – London', 'Organic Food Festival Bristol' and 'Go! Organise Festival – London', amongst others. In support of this, images of the fair stands at the Brighton Food Festival in 2004 are provided.⁹ While outside the relevant period, such evidence may be of assistance later on in this decision.

35. Lastly, the evidence shows a number of undated printouts from the opponent's social media pages for its general food business and its wholesale businesses.¹⁰ While noted, the printouts are undated and any posts that are from within the relevant period have a very limited level of engagement. I note that the Facebook

⁹ ML6

¹⁰ ML7

accounts were created in 2011, whilst the Instagram accounts were created in 2015 and 2017.

Form of the mark

36. It is noted that the opponent has used its branding in various ways throughout the evidence. These include use of 'Infinity Foods', 'Infinity Bulk', 'infinityfoods/organics' and in the figurative manner of the mark in its second registration. Clearly, use of the mark in the second registration is use of that mark as registered. As for the other uses, I will deal with these below.

37. In respect of the marks in the first registration, these are the word 'INFINITY' in different cases. In considering the form of the mark, I remind myself that use of a mark encompasses its use as part of another mark taken as a whole or in conjunction with another mark, so long as it continues to be perceived as an indicator of origin for the goods at issue.¹¹ In my view, the use of the word 'Infinity' in the ways shown above is use of the marks, as registered, in the first registration because regardless of the additional elements, it maintains its position as the indicator of origin for the goods in the evidence.

38. As for the mark in the second registration, this is figurative and includes the words 'INFINITY FOODS' underneath a drawing of a picturesque landscape of fields (which I will refer to as the 'landscape device'). The use of the words 'Infinity Foods', 'Infinity Bulk' or 'infinityfoods/organic' cannot be said to be use of this mark as registered. I must, therefore, consider whether they are acceptable variants of the same. In doing so, I am reminded of the guidance set out by Professor Phillip Johnson, sitting as the Appointed Person, in the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. In the present case, I consider that the word 'INFINITY' is the most distinctive element of the mark in the second registration.

¹¹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

This is because 'FOODS' is wholly descriptive and as per the aforementioned guidance (at paragraph 15 of *Lactalis*), where a mark contains words and a figurative element the word element will usually be more distinctive. That being said, I consider that the landscape device does carry a degree of distinctiveness because it is a large part of the mark and is a fairly detailed depiction of a landscape. Therefore, I do not consider its removal can be said to be the subtraction of a non-distinctive element. The use of the marks 'Infinity Foods', 'Infinity Bulk' and 'infinityfoods/organic' are not, therefore, use of acceptable variants of the mark in the second registration. That being said, there is extensive use of the figurative mark throughout the evidence (in each invoice, for example) so I do not consider that this is particularly detrimental to the opponent.¹²

Assessment of the evidence

39. Based on the evidence I have discussed above, the opponent clearly operated a sizeable food business in the UK during the relevant period. The turnover during the relevant periods stood at around £29 million and its advertising spend around £300,000. In my view, such use is clearly sufficient to demonstrate that the opponent has made a genuine attempt to create or preserve a market share for its marks. While this may be the case, I must now consider whether such use can be reasonably applied to the goods relied upon.

40. The figures for the opponent's turnover and spend are not broken down to demonstrate how they apply to the goods relied upon. Further, the invoices provided are simply a collection of 160 pages of evidence and it is not proportionate (or fair to the applicant) for me to go through them in minute detail to draw out each and every instance of use in favour of the opponent.¹³ Such an issue may sometimes be a stumbling block for parties seeking to rely on a wide range of

¹² On this point, I do appreciate that some of the images provided showing how the branding is displayed (as per paragraph 25) are either from prior to the relevant periods or undated. However, the use of acceptable branding is consistent throughout the evidence such as on the opponent's invoices or in its catalogues, for example.

¹³ For the avoidance of doubt, I have still given brief consideration to the items in the invoices.

goods under genuine use (as broad turnover figures, without breakdowns, may simply be deemed a bare assertion).¹⁴ However, in the present case, I appreciate that the opponent has made an express attempt to demonstrate use of its marks on goods such as the following:

A variety of rice, grains (such as couscous, barley, quinoa, buckwheat groats, wheatgerm), cacao nibs, cocoa powder, instant hot drinks, cereals such as muesli, flakes (including oat flakes and porridge oats) and granola, coffee beans, varieties of flour (including rice flour), chocolate covered fruits and nuts, chocolate buttons, edible oils (including avocado oil), nuts, seeds (such as pumpkin seeds and sesame seeds), red kidney beans, jars of red peppers, tins of stuffed vine leaves, honey, tea, fruit and vegetables

41. In respect of the latter two goods (being fruit and vegetables), it is noted that the opponent's invoices were confirmed as covering such (and I note that the invoices do include numerous entries for 'mixed vine fruit' under the relevant branding).¹⁵ Further, the screenshots of the opponent's website from within the relevant period made specific reference to the availability of its fresh produce.

42. I do not consider it necessary to labour the issue of a fair specification in any great detail as I am satisfied that despite the lack of any breakdown, the evidence as a whole suitably demonstrates a genuine attempt to use the opponent's marks on the goods listed above. Further, I note that the applicant has failed to make any comment as to the evidence put forward by the opponent.

43. As to how this applies to the specifications relied upon, I am of the view that the use may be attributed to the terms listed below. Therefore, the opponent may rely on the following terms:

¹⁴ See the comments of Professor Phillip Johnson, as the Appointed Person, in the case of *Eros Bodyglide* (O/0984/25)

¹⁵ For example, see pages 29, 112, 121, 140 and 144 of ML5

Class 29: Fruits and vegetables, all being preserved, dried or cooked; edible oils; all included in Class 29.

Class 30: Coffee, tea, cocoa, rice, artificial coffee; flour and preparations made from cereals, confectionery, namely chocolate, chocolate coated nuts and fruit; spices; all included in Class 30.

Class 31: Fresh fruits, fresh vegetables; all included in Class 31.

44. As for those goods for which no use has been found, I only intend to discuss a few terms.¹⁶ Firstly, while the opponent has shown use for ‘honey’, I do not consider that this is a “preserve” in class 29. This is on the basis that preserves are goods such as jams or jellies made from fruit and honey does not fall into this category. Secondly, I note that while different types of seeds and grains appear throughout the evidence, these appear to be foodstuffs in their processed forms, ready for human consumption. For example, the images of pumpkin seeds and sesame seeds shown in the evidence appear to be goods that are ready to eat.¹⁷ On this point, I note that the only reference to raw seeds in the invoices comes under the brand ‘Alara’ and not the opponent’s brand.¹⁸ By virtue of the specification including ‘seeds’ and ‘grains’ in class 31, I do not consider that use of seeds in the way shown by the opponent is use of goods under this class. Without any evidence of actual seeds or grains in their unprocessed form, I am not willing to accept that the opponent has used its marks on such goods.

45. Given that there has been no genuine use for ‘salad dressings’ in the first registration, the specifications of the opponent’s marks are now identical. This is

¹⁶ This is on the basis that, for the most part, where I have removed the terms, I have done so because there has simply been no suitable attempt to provide evidence of use for the same.

¹⁷ See page 16 of ML2 and page 10 of ML4

¹⁸ See, for example, page 26 of ML5

on the basis that this term was the only one that differed between the two specifications relied upon.

Section 5(2)(b): legislation and case law

46. Section 5(2)(b) states that:

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

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

47. Section 5A of the Act states as follows:

“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.”

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

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

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

Comparison of goods and services

49. The competing goods and services are as follows:

The opponent's goods	The applicant's goods
<u>Class 29</u> Fruits and vegetables, all being preserved, dried or cooked; edible oils; all included in Class 29.	<i>The first application</i> <u>Class 30</u> Chai tea; iced tea; coffee; coffee substitutes; tea; tea substitutes; artificial coffee.

<u>Class 30</u> Coffee, tea, cocoa, rice, artificial coffee; flour and preparations made from cereals, confectionery, namely chocolate, chocolate coated nuts and fruit; spices; all included in Class 30. <u>Class 31</u> Fresh fruits, fresh vegetables; all included in Class 31.	<i>The second application</i> <u>Class 5</u> Nutritional supplements; dietary supplements; food supplements; nutraceuticals for use as a food, dietary or nutritional supplement; protein supplements; vitamin and vitamin supplements; mineral supplements; herbal supplements for general health and well-being; herbal teas for medicinal purposes; Chinese traditional medicinal herbs; medicinal herbal preparations; medicinal herbal extracts, other than essential oils, for medical purposes. <u>Class 29</u> Edible seeds; processed chia seeds; processed seeds; processed fruits, fungi, vegetables, nuts and pulses; preserved, frozen, dried and cooked fruits and vegetables; prepared nuts; mixtures of fruit and nuts; dairy products and dairy substitutes. <u>Class 30</u> Chai tea; iced tea; culinary herbs; herbal infusions; honey; flavourings and seasonings; spices; sauces;
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	coffee; coffee substitutes; tea; tea substitutes; natural sweeteners; artificial coffee; bakery goods; food mixtures consisting of cereal flakes and dried fruits; processed seeds used as a flavouring for foods and beverages; spices; confectionery. <u>Class 31</u> Unprocessed seeds; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers. <u>Class 32</u> Soft drinks, mineral and aerated waters; soft drinks flavoured with tea; non-alcoholic drinks; non-alcoholic fruit drinks and fruit juices; non-alcoholic syrups for making beverages. <u>Class 35</u> Advertising; marketing; sales promotion; online ordering services; retail services and wholesale services connected with the sale of food and drink, unprocessed seeds, raw and unprocessed agricultural, aquacultural,
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	horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers; information, advisory and consultancy services in relation to all the aforesaid services.
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50. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

52. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

53. Outside of a vague denial of similarity of goods and services, I have no comment in respect of the goods and services comparison from the applicant. As for the opponent, it is noted that it has made detailed submissions as to the goods and services comparison in its submissions in lieu of a hearing. I can confirm that I have taken these into account and will discuss them further below if necessary.

54. In considering the present comparison, I will begin with the goods of the first application.

The first application

Class 30

Coffee; tea; artificial coffee.

55. The above terms appear in the opponent's specifications and, as such, these terms are self-evidently identical.

Chai tea; iced tea.

56. The above terms are both types of tea. The opponent's specifications include the broad term "tea". Therefore, the applicant's goods fall within the opponent's broader term, meaning that they are identical under the principle outlined in *Meric*.

Coffee substitutes; tea substitutes.

57. It is my understanding that the above terms will seek to replicate the taste of coffee or tea but by using alternate ingredients to alleviate sensitivity to ingredients or the effects of caffeine, for example. I consider that such goods are similar to the opponent's terms of "coffee" and "tea". While their natures do not directly overlap in that they will likely consist of different ingredients, they are all drinkable products. Further, the goods will be consumed in the same way meaning that these goods overlap in method of use also. As for purpose, I appreciate that while coffee and tea may be consumed for the effects of caffeine, they can also be consumed for their taste. While substitutes, the fact that the above goods will seek to replicate the taste of tea and coffee means that there is an overlap in purpose despite the potential lack of caffeine. As for trade channels, I am of the view that the producer of coffee and tea will also produce and sell substitutes to appeal to the market that do not consume such drinks. Further, the goods will likely be found in the same sections of stores. As for user, someone who likes to drink coffee or tea may, at

some point, also seek to drink alternatives so as not to consume too much caffeine on a daily basis. On this point, I consider that the goods are also competitive in that someone who does not wish to consume caffeine will choose the applicant's goods over the opponent's. Overall, I consider that these goods are similar to a high degree.

The second application

Class 5

Nutritional supplements; dietary supplements; food supplements; nutraceuticals for use as a food, dietary or nutritional supplement; protein supplements; vitamin and vitamin supplements; mineral supplements.

58. The opponent's submissions in respect of the applicant's supplement goods are as follows:

“56) [...] The Opponent submits that the supplements can be consumed by consumers instead of the foodstuffs registered by the Opponent. For example, the registered foodstuffs such as fruits and vegetables are enriched with vitamins and minerals, and the supplements applied can be consumed in place [sic] of such foodstuffs, meaning there is a degree of competitiveness between the respective goods.

57) Furthermore, supplements can be found at all food supermarket stores and due to the goods being competitive, a low degree of similarity can be found.”

59. I accept that a consumer may seek to introduce vitamins or nutrients into their diets via supplements or fresh fruit and vegetables. As such, there is technically a degree of competition between them but I consider that, in practice, a user is unlikely to actually choose vitamin supplements over eating fruit, or vice versa. The

goods have different natures and methods of use. As for purpose, while the opponent's "fresh fruits, fresh vegetables" will introduce certain vitamins into a user's diet, their primary purpose is as a foodstuff for sustenance. As such, I do not consider that there is an overlap in core purpose. As for trade channels, I have nothing before me to suggest that the producers of these goods coincide. I accept that both goods can be found in supermarkets as put forward by the opponent. However, the goods will be found in different locations or sections of stores. As such, being sold in supermarkets is not sufficient by itself to warrant a finding of a material overlap in trade channels. If it were, then goods such as frozen fish and greeting cards would overlap in trade channels as both can be purchased from a supermarket. As for user, there is some overlap due to the fact that both goods will be sought by members of the general public at large.

60. Taking all of the above into account, I do not consider that a relatively broad overlap in user, together with a degree of competitiveness, is sufficient to result in any meaningful degree of overlap between these goods. They are, therefore, dissimilar.

Herbal teas for medicinal purposes.

61. The above teas are for medicinal purposes so are not, therefore, identical to the opponent's term of "tea" in class 30. That being said, there is a degree of overlap in nature between the goods as they are both tea products that will consist of primarily the same ingredients. The method of use will be the same. The purposes will, however, differ, with one being consumed for taste or to quench thirst and the other being to help alleviate an ailment. As for trade channels, I find that despite the overlapping natures (both goods being teas), I do not consider that the producer of an ordinary tea would produce tea for medicinal purposes. Further, such goods will be found in separate sections of retail environments. The user of the goods will overlap as someone who drinks ordinary herbal tea may seek the same for medicinal purposes if they are unwell. The goods are not complementary and neither are they in competition because the context of their use is not such

that consumers would elect to choose one over the other. Overall, owing to their shared nature, method of use and user, I find that these goods are similar to a medium degree.

Chinese traditional medicinal herbs; medicinal herbal preparations; medicinal herbal extracts, other than essential oils, for medical purposes; herbal supplements for general health and well-being.

62. The above goods can all cover different types of herbs that can be used in teas. As such, I find that the assessment I make in the preceding paragraph applies here meaning that the above goods are similar to a medium degree with the opponent's "tea".

Class 29

Edible seeds; processed chia seeds; processed seeds.

63. I consider that the best comparators for the above goods are terms in both class 29 and 30 of the opponent's specifications. This includes "fruits and vegetables, all being preserved, dried or cooked", "preparations made from cereals" and "confectionery, namely chocolate, chocolate coated nuts and fruit". While different in nature, these goods can all either be consumed as snacks or used as ingredients in cooking. As such, I find that they overlap in method of use and purpose. As for trade channels, I do not consider it likely that the goods will be produced by the same undertakings and I have nothing to suggest that they would. That being said, in the context of ingredients, they may all be found in the same sections of retail environments. The user overlaps in that all of these goods will be sought by members of the general public at large. The goods are not complementary but there is a degree of competition between them, especially when someone is looking for quick snack foods as they may wish to eat some seeds or preparations

made from cereals, such as a snack bar, for example. Overall, I find that these goods are similar to at least a medium degree.

Processed fruits [and] vegetables; preserved, frozen, dried and cooked fruits and vegetables.

64. All of the above terms fall within the opponent's term of "fruits and vegetables, all being preserved, dried or cooked". These goods are, therefore, identical under the principle outlined in *Meric*.

Processed [...] nuts and pulses; prepared nuts.

65. The above goods can cover snack foods that include a variety of nuts and pulses. Whilst no such term exists in the opponent's specifications, I do consider the above terms are similar to the opponent's "fruits and vegetables, all being preserved, dried or cooked" as well as "confectionery, namely chocolate, chocolate coated nuts and fruit". This is on the basis that while they differ in nature (even where the opponent's goods include nuts, they are chocolate covered), they can both be consumed as snack foods meaning that there is an overlap in method of use and purpose. In terms of trade channels, I do not consider it likely that the producer of processed nuts will also produce the goods of the opponent.¹⁹ However, such goods are likely to be placed in close proximity with one another in retail environments. Therefore, there is some overlap in trade channels. As for the consumer, I consider it likely that the user will overlap but even where it does not overlap directly, the goods are competitive in that a user looking for a snack may choose the opponent's goods over those of the applicant, and vice versa. As a result, I find that these goods are similar to a medium degree.

¹⁹ As I will come to discuss below, the producers may coincide when it comes to mixtures of fruit and nuts. However, this is not the term at issue here and I see no reason why an overlap would exist between dried fruits and processed nuts in the same way. Further, even where the opponent's goods are chocolate covered nuts, I have nothing before me to suggest an overlap here.

Mixtures of fruit and nuts.

66. In considering these goods, I can adopt the reasoning in the preceding paragraph with regard to any overlaps with “fruits and vegetables, all being preserved, dried or cooked”. That being said, I consider that any overlap in trade channels is stronger between the goods at issue here because a provider of dried fruits may also produce the above goods of the applicant. In my view, this additional factor takes the present goods to a level of similarity being between a medium and high degree.

Processed [...] fungi.

67. Whilst not a vegetable, I consider that the best comparator of the above term comes from the opponent’s term of “fruits and vegetables, all being preserved, dried or cooked”. While their natures differ, I consider that these goods share overlaps in method of use, purpose, trade channels and user for similar reasons to those expressed in paragraphs 65 and 66 above. As such, I find that these goods are similar to between a medium and high degree.

Dairy products and dairy substitutes.

68. The above term can cover a range of goods including milk, cheese, yoghurts, oat milk or almond milk to name just a few. In considering the opponent’s submissions in respect of these goods, I note that they have argued that they are similar to the opponent’s “tea” and “coffee” goods on the basis that dairy products are essential to most consumers’ preferences when consuming such goods. While I appreciate that a majority of consumers may drink tea and coffee with milk or milk substitutes, they are not complementary. On this point, I appreciate that milk or its substitute may be important to tea or coffee. However, the relationship between such goods is not likely to lead consumers to believe that they are the responsibility of the same

undertaking.²⁰ Further, the goods clearly differ in nature, method of use and purpose. I accept that there is an overlap in user but this is at a very general level. Taking all of this into account, I find that these goods are dissimilar.

69. Whilst the above reflects the position put forward by the opponent, I consider it necessary to consider a comparison with the opponent's "fruits and vegetables, all being preserved, dried or cooked". I do so because the applicant's term can cover goods such as cheeses or non-dairy substitutes, which can include small individually packaged cheeses (or alternatives) for snacks or lunch boxes. In the context of such goods, I appreciate that both can be consumed as snacks to sustain the user. However, I do not consider that this alone is sufficient to warrant a finding of similarity between the goods. I say this because their natures differ entirely and, as far as I am aware, an undertaking that produces and sells cheeses will not produce and sell dried or preserved fruit and I have nothing before me to suggest otherwise. On this point, the goods will be found in different sections of supermarkets, with the applicant's goods being refrigerated whereas the opponent's preserved fruits will either be found in home baking aisles or tinned foods sections. Lastly, I do not consider that the goods are competitive because when a user is looking for a snack, they are not likely to seek to choose a savoury snack like cheese over a sweet snack like dried fruit, or vice versa.

70. In considering the present context of this comparison, I am reminded of the case of *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) wherein Mr Iain Purvis K.C., sitting as a deputy High Court judge, set out at paragraph 24 of his judgment that:

"[A]ny finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question. It strikes me that here the hearing officer was engaging essentially in a box-

²⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied. Had the hearing officer stood back and considered the overall question of similarity, I believe she would have considered and certainly ought to have considered that the idea that figurines and works of art were similar to electric lamps, chandeliers or mirrors was nonsensical and it hardly needed a careful consideration of the *Canon* or *TREAT* factors to come to that conclusion. I therefore agree with the appellant that this category of goods should have been found dissimilar, and certainly it could not have reasonably been found similar to more than 'a very low degree'."

71. While the above case involved a comparison of entirely different goods than those that are at issue here, I am of the view that the same principle applies. I accept that there may be overlaps in method of use, purpose and user. However, I do not consider that those overlaps are sufficiently pronounced but I appreciate that they exist. If I were to simply apply a *tick-box* exercise, it could be argued that the overlaps give rise to a finding of similarity between these goods. However, I am of the view that upon taking a step back and considering the actual terms before me, a finding of similarity between them is nonsensical. On this point, I am of the view that to find similarity here would offer far too broad a level of protection to the goods at issue. I say this because such an outcome would mean that any consumable goods that can include snack foods are similar to one another. I appreciate that I have found similarity between various snack foods above. However, those comparisons involved goods which were more closely associated than those at issue here. Given how many different types of snack foods there are (crab sticks, crisps, popcorn and dried meats such as jerky to name just a few), I consider that such a finding is not supportable and neither is it reasonable. As a result, I find that the above goods are dissimilar to the opponent's goods.

Class 30

Chai tea; iced tea; coffee; coffee substitutes; tea; tea substitutes; artificial coffee.

72. I have considered these terms when considering the first application above. Those same findings apply here, namely that the above goods are either identical or highly similar to the goods of the opponent.

Herbal infusions.

73. The above term, as far as I understand it, is another way of describing what are commonly referred to as fruit teas. In the alternative, it is a term that covers a type of tea using different infused herbs that can include fruit teas. Either way, I find that the above term falls within the opponent's term of "tea", meaning that it is identical under the principle outlined in *Meric*.

*Spices.*²¹

74. The above term appears identically in the opponent's specifications. Such goods are clearly identical.

Flavourings and seasonings; sauces; culinary herbs.

75. The above goods are flavourings for foods and whilst different in nature to the opponent's term of "spices", I do find that they overlap in method of use and purpose because they will all be added to foods to improve flavour. Further, their trade channels overlap as a producer of spices is also likely to produce herbs, for example. Such goods are also likely to be found in close proximity in stores (with jarred herbs and spices often found directly next to one another). As for user, the

²¹ This term appears twice in the second application's specification.

goods overlap and may also share a competitive relationship. Overall, I find that they are similar to a high degree.

Natural sweeteners.

76. While the above goods can be used to sweeten tea and coffee, I consider that the best comparator for the above goods is the term “spices” in the opponent’s specifications. While the natures of these goods differ, there is some degree of overlap in method of use and purpose. That being said, these overlaps are limited because while both goods will be used to enhance the flavour of something, the applicant’s goods are used to sweeten food whereas the opponent’s will be primarily used on savoury dishes to add spice. In addition, the goods overlap in user. In terms of trade channels, I have nothing to suggest that the goods will be produced by the same undertakings or that they will be found in close proximity of one another in stores. Lastly, the goods are not complementary or competitive. Overall, I find that these goods are similar to a low degree.

Honey.

77. Honey can be used as a natural sweetener and, in that context, I find that the findings made in the preceding paragraph are applicable here. Therefore, I find the above term is similar to a low degree with the opponent’s “spices”.

Bakery goods.

78. Bakery goods can, as far as I am aware, include preparations made from cereals. Therefore, I find that the opponent’s term of “preparations made from cereals” falls within the above term of the applicant, meaning that these goods are identical under the principle outlined in *Meric*.

Food mixtures consisting of cereal flakes and dried fruits.

79. The opponent's specifications include the term "preparations made from cereals".

I consider that this can include food mixtures made from cereal flakes and, as such, it falls within the applicant's term meaning that these goods are identical under the principle outlined in *Meric*.

Processed seeds used as a flavouring for foods and beverages.

80. As far as I am aware, the above term can cover goods such as cumin seeds and mustard seeds. These are spices so I find that these goods are identical under the principle outlined in *Meric* with "spices" in the opponent's specifications.

Confectionery.

81. The opponent's specifications include the term "confectionery, namely chocolate, chocolate coated nuts and fruit". This falls within the above term and I, therefore, find that these goods are identical under the principle outlined in *Meric*.

Class 31

Unprocessed seeds; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds.

82. The above goods are raw and unprocessed and, as such, are not foods ready for human consumption. As such, considering all the relevant factors, I see no reason why they would overlap to any meaningful degree with the opponent's goods. As such, I find that these goods are dissimilar.

Fresh fruits and vegetables.

83. The opponent's specifications include the term "fresh fruits, fresh vegetables". Such goods are clearly identical.

Fresh herbs.

84. I consider that "spices" in the opponent's specification is the closest comparator to the above term. At paragraph 75 above, I found the opponent's "spices" to be similar to a high degree with the applicant's "culinary herbs". Save for lack of overlap in trade channels (on the basis that fresh herbs are found in different sections of stores and are unlikely to be produced by the same undertakings as spices), I find that the same findings can apply here. Taking into account the overlaps in method of use, purpose and user, I find that these goods are similar to a medium degree.

Natural plants and flowers.

85. The plain meaning of the above term can cover plants and flowers that are used as herbs. As far as I understand it, it is common for herbs to also be sold as live plants that users can trim accordingly so as to use their herbal benefits (such as mint or basil plants, for example). In this context, I find that the same finding reached in the preceding paragraph can apply here in that these goods are similar to a medium degree with the opponent's "spices".

Class 32

Non-alcoholic fruit drinks and fruit juices.

86. The opponent's specifications include the term "fresh fruits". It is my understanding that a producer of fresh fruits may also produce and sell the juice from said fruit.

As such, I find that there is an overlap in trade channels between these goods. The natures and methods of use differ. The above goods are used to quench the user's thirst whereas the opponent's goods are for sustenance. As such, the purposes do not overlap. The goods will be sought by the same users and may even be competitive in nature as a user who wishes to introduce more fruit into their diet may wish to do so by eating fruit over drinking fresh juice, or vice versa. In respect of complementarity, I accept that fresh fruit is important to fresh fruit juice and, in some instances, consumers will believe that the provider of the juice is the provider of the fruit used to create the juice. As such, there is some degree of complementarity between them. Overall, I consider that these goods are similar to between a low and medium degree.

Soft drinks, non-alcoholic drinks.

87. Given that soft drinks and non-alcoholic drinks are broad enough to cover fruit drinks, I find that the reasoning provided in the preceding paragraph is applicable here. As such, I find that these goods are similar to between a low and medium degree with the opponent's "fresh fruit".

Soft drinks flavoured with tea.

88. The above term covers a ready-made tea drink such as a bottled iced tea for example. While the nature and method of use of this term does not directly overlap with the opponent's "tea" (on the basis that the above term covers a ready-made drink whereas the opponent's does not), I find that there is an overlap in purpose, trade channels and user. Further, the goods are competitive as a user may wish to buy a ready-made soft drink with tea flavour over buying dried tea to avoid having to make the beverage themselves or they may wish to make the tea drink themselves at home. As a result, I find that these goods are similar to a medium degree.

Non-alcoholic syrups for making beverages.

89. The above term can cover a fruit syrup to allow for the creation of a fruit juice at home. As such, I am of the view that, save for complementarity, the same findings at paragraph 86 above in respect of trade channels and user apply here. Therefore, I find that these goods are similar to a low degree with the opponent's "fresh fruits" due to overlaps in trade channels and user and a potential degree of competition between them.

Mineral and aerated waters.

90. Outside of a shared user base, I see no obvious reason as to why the above terms share any degree of meaningful overlap with the goods of the opponent. In short, I do not consider an overlap in user alone is sufficient to warrant a finding of similarity between the goods. They are, therefore, dissimilar.

Class 35

Advertising; marketing; sales promotion; information, advisory and consultancy services in relation to all the aforesaid services.

91. The opponent's submissions in respect of the above services were roped in with its submissions in respect of the applicant's retail services (which I will discuss below). I see no reason why said submissions apply to the above services. In any event, considering all the relevant factors, I see no obvious reason why there exists any meaningful degree of overlap between the above services and the goods of the opponent. These services are, therefore, dissimilar.

Retail services and wholesale services connected with the sale of food and drink, fresh fruits and vegetables, fresh herbs, natural plants and flowers; information, advisory and consultancy services in relation to all the aforesaid services.

92. In considering the above services, I remind myself of paragraphs 46 to 57 of *Oakley, Inc v OHIM*, Case T-116/06, wherein the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Further, I remind myself of the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14 wherein Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, confirmed that the GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

93. Where the goods covered by the above services of the applicant are identical to those of the opponent (namely 'food', which covers a range of the opponent's goods and 'fresh fruits and vegetables'), I find that there exists an overlap in user and trade channels. Further, there is a degree of complementarity between them in the way described in *Oakley*. As a result, I find that these goods and services are similar to a medium degree. However, where the goods are not directly covered (insofar as the services cover drink, fresh herbs and natural plants and flowers), I find that they only overlap in trade channels and user, with no degree of complementarity. As such, I find that these goods and services are similar to a low degree.

94. Insofar as the applicant's services cover the *information, advisory and consultancy* in relation to the retail services discussed above, I find that there exists an overlap in trade channels and user with the relevant goods of the opponent. As such, I find that these services are similar to a low degree with the opponent's goods.

Retail services and wholesale services connected with the sale of unprocessed seeds, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds; information, advisory and consultancy services in relation to all the aforesaid services.

95. The goods covered by the above retail services are not similar to the goods of the opponent. As such, I see no reason why the findings I have made above in respect of the other retail services are applicable. Therefore, I find that these services are dissimilar to the goods of the opponent.

Online ordering services; information, advisory and consultancy services in relation to all the aforesaid services.

96. The above term can, in my view, cover the online retail of the various goods of the opponent's specifications. As such, applying the same reasons given in relation to the services discussed at paragraph 93 above, I find that these services are similar to a medium degree with the goods of the opponent, with the *information, advisory and consultancy services* being similar to a low degree for the reasons discussed at paragraph 94 above.

Conclusion of the goods comparison

97. In order for there to be a likelihood of confusion under section 5(2)(b) of the Act, there must be at least some degree of similarity between the goods and services at issue.²² As a result, and in light of my findings above, the opposition fails against the following goods and services of the second application:

²² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

- Class 5: Nutritional supplements; dietary supplements; food supplements; nutraceuticals for use as a food, dietary or nutritional supplement; protein supplements; vitamin and vitamin supplements; mineral supplements.
- Class 29: Dairy products and dairy substitutes.
- Class 31: Unprocessed seeds; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds.
- Class 32: Mineral and aerated waters.
- Class 35: Advertising; marketing; sales promotion; retail services and wholesale services connected with the unprocessed seeds, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds; information, advisory and consultancy services in relation to all the aforesaid services.

The average consumer and the nature of the purchasing act

98. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.
99. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

100. The opponent submits that the goods and services all relate to food and beverages and, as such, are aimed at the general public. It is claimed that the goods at issue will all be found within food stores and the food and beverage

services (which I take to mean, restaurants, cafes and so on). Further, the opponent submits that the level of attention paid will be low to average.

101. Even though some goods are for medicinal purposes, I do not consider that they are those that will be selected by doctors and other medical professionals. This is because, as far as I understand it, medicinal teas are not commonly prescribed by medical professionals but are merely selected from the same sections as ordinary cold medicines, for example. As such, I agree with the opponent in that the average consumer will consist of members of the general public at large. I also agree with the submission regarding the purchasing process in that the goods will be available via food stores. In addition, I appreciate that the goods will also be selected online via the retailers' websites. The purchasing process for such goods is primarily visual as consumers will either select them after having seen them on a shelf or an image on a website. That being said, the aural component will not be discounted entirely due to word of mouth recommendations, for example. As for the services, these will be selected after having viewed signage on the high street, after having viewed pamphlets or advertising online or on television. Again, the selection process will be primarily visual, though not discounting the aural element entirely.

102. In terms of the level of attention paid, all of the goods are those that will be consumed by the user so attention will be given to factors such as taste, nutrition and other dietary factors. Where the goods are medicinal in nature, the consumer will consider additional factors relating to the ailment they are intended to treat. I accept that some goods will be casual selections, such as confectionery, which will attract a lower degree of attention (but not outright low). However, for the most part, I find that the consumer will pay a medium degree of attention when selecting the goods. As for the services, these are retail services and consumers will, therefore, consider factors such as price, stock, location of the store (for physical retail) and delivery options (for online retail). These are relatively ordinary factors and I consider that they will attract a medium degree of attention.

Comparison of the marks

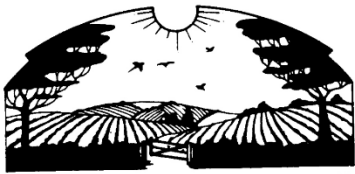
103. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

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

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

105. 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.

106. The respective trade marks are shown below:

The opponent's marks	The application
INFINITY infinity Infinity (series of three) ("the opponent's first registration")  INFINITY FOODS ("the opponent's second registration")	Infity ("the first application") IN-FITY IN FITY ("the second application")

107. I have submissions from the opponent as to the similarity of the marks at issue. If necessary, I will discuss these below. As for the applicant, outside of a denial of any similarity of the marks in its counterstatements, it has made no comment.

Overall impression

108. The marks in the opponent's first registration are word only marks for the word 'INFINITY' in different cases. Regardless of the case used, the overall impression of these marks lies in this word. There are no other elements in the marks that contribute to their overall impressions. The mark in the opponent's second registration is a figurative mark that consists of the words 'INFINITY FOODS' in a standard black typeface, which sits below the landscape device, which features a gate, two trees, a hillside, some birds and the sun. While the eye of the consumer will be drawn to the words 'INFINITY FOODS', 'FOODS' is clearly descriptive of the goods at issue and, therefore, plays a lesser role than 'INFINITY'. As for the

landscape device, this plays a role due to its size and detail but this is lesser than the word 'INFINITY'.

109. The mark in the first application is a word only mark, consisting solely of the word 'Infity'. There are no other elements that contribute to its overall impression, which lies in the word itself. The marks in the second application are also word only marks that are 'IN-FITY' and 'IN FITY'. Despite the presence of the hyphen in the first mark (which plays a negligible role, serving only to create a space between the words), the overall impression of these marks will be dominated by their two words. There are no other elements present that contribute to either mark.

Visual comparison

The opponent's first registration and the first application.

110. Visually, these marks share the letters 'I-N-F-I-T-Y'. This forms the entirety of the applicant's mark and the first, second, third, sixth, seventh and eighth letters of the opponent's mark. The marks differ in the presence of the letters 'I-N' as the fourth and fifth letters of the mark in the opponent's mark. Given that the beginnings and ends of the marks are identical, with the two different letters being subsumed into the body of the opponent's mark, I find that these marks are visually similar to a high degree.

The opponent's first registration and the second application.

111. Visually, these marks share the same similarities and differences as discussed in the preceding paragraph. However, the applicant's marks contain either a hyphen or a space between the letters 'N' and 'F'. Despite the negligible role the hyphen plays, both marks will be seen as two words and, as such, the space between them (be that a hyphen or an actual space) acts as a further point of

difference between them. Overall, given the shared use of the letters, I consider that these marks are visually similar to between a medium and high degree.

The opponent's second registration and the applications.

112. The opponent's submissions set out that these marks are similar to between a low and medium degree owing to the stylisation of its own mark. However, it still maintains that the dominant elements of its mark and the applicant's marks are highly similar. I agree with the assessment that the marks are similar to between a low and medium degree overall due to the presence of the device element of the opponent's mark, which is absent from the applicant's mark. As for the submission regarding the highly similar word elements, this may be relevant when it comes to a consideration of confusion. However, a finding in respect of this point at this stage of my decision would be as a result of an artificial dissection of the mark.

Aural comparison

The opponent's first registration and the applications.

113. Despite the presence of the space/hyphen in the marks of the second application, all of the applicant's marks will be pronounced the same, being the three syllables 'IN-FIT-EE'. The opponent's mark consists of four syllables, being 'IN-FIN-IT-EE'. The first and last syllables of the marks are identical. As for the syllables between these, they are not the same but I do accept that they are similar in that (despite being of differing lengths), they start and end the same in how the 'F' and 'IT' sounds are pronounced. That being said, the 'N' sound in the middle of the opponent's mark is still a point of aural difference. Overall, I consider that these marks are aurally similar between a medium and high degree.

The opponent's second registration and the applications.

114. In respect of the 'INFINITY' and 'INFITY/IN FITY' elements of the marks, the same finding can be reached here to that which was reached above. However, the opponent's mark at issue here includes the additional word, 'FOODS'. Despite this being descriptive, it is still likely to be pronounced.²³ As a result, I consider that its presence means that the aural similarity between these marks is medium.

Conceptual comparison

115. The opponent submits that the word 'INFINITY' conveys an obvious and clear meaning to the relevant public, namely something that is infinite or endless. I agree and find that this meaning will be immediately grasped by the average consumer. The opponent goes on to submit that whilst 'INFITY' does not have a dictionary definition, consumers are not likely to notice the differences between the words or, if they do, will consider it a misspelling of 'INFINITY'. As such, the opponent's position is that the marks will either convey the same meaning or will associate the marks conceptually due to 'INFITY' simply being a misspelling. The opponent makes no comment as to the marks in the second application, being 'IN-FITY' and 'IN FITY' but I presume that its position remains the same as it does for the 'Infity' mark.

The opponent's first registration and the first application.

116. The conceptual comparison of the marks is to be conducted on the marks as they appear before me. Therefore, I do not consider it appropriate for me to conduct a comparison on the basis that consumers will misread 'INFITY' as 'INFINITY', thereby leading to conceptual identity. That being said, I do accept that consumers, when perceiving a verbal sign, will break it down into elements which resemble

²³ See *Enrich International Ltd v Onyinye Udokporo*, BL O/1141/25, paragraphs 13-18.

words known to them.²⁴ I appreciate that the word 'INFITY' will not be 'broken down' in the way described in the case referred to here but due to the close resemblance of 'INFITY' to 'INFINITY', I do agree that a significant proportion of consumers will immediately grasp 'INFITY' as a misspelling of 'INFINITY'. For those consumers, my primary view is that the marks are conceptually identical because no difference will be attributed to the misspelling. However, if this is wrong and some difference in concept is created by the misspelling, I consider that there exists a medium degree of conceptual similarity between the marks.

The opponent's second registration and the first application.

117. The findings made in the preceding paragraph in respect of 'INFINITY' and 'INFITY' are applicable here. That being said, there are additional elements to consider in the opponent's mark that affect its conceptual meaning and therefore constitute points of conceptual difference. These additional elements are the landscape device and the word 'FOODS'. The landscape evokes the concept of nature or farmland (potentially indicating that the goods originate from farms, for example) and the word 'FOODS' clearly evokes the idea that the goods at issue are foodstuffs. While they are not prominent concepts in light of the goods at issue, they are still additional points of difference and, in my view, result in a finding that the marks are conceptually similar to a medium degree in the event that my primary finding in the preceding paragraph is correct or conceptually similar to a low degree if it is not.

The opponent's registrations and the second application.

118. Whilst I have accepted that a significant proportion of consumers would view 'INFITY' as a misspelling of 'INFINITY', I do not consider that this applies to 'IN-FITY' or 'IN FITY'. Regardless of whether the mark has a hyphen or a space, the

²⁴ *Mundipharma v OHIM — Altana Pharma (RESPICUR)*, T-256/04, paragraph 57

separation between 'IN' and 'FITY' is such that consumers will not make the same connection. As such, 'IN FITY' will be viewed as a combination of the known word 'IN' and the unknown word 'FITY'. As a whole, the mark has no concept and is, therefore, not capable of being compared to either of the opponent's registrations.

Distinctive character of the opponent's registrations

119. 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 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).”

120. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use. Given that the opponent has filed evidence of use, I will consider whether said use is sufficient to enhance the distinctiveness of its registrations. Before doing so, however, I will consider the inherent position.

121. The marks in the first registration are simply the words 'INFINITY' in different cases. The use of different cases has no impact on any of the marks, so it is the word 'INFINITY' that carries their distinctiveness. As above, the meaning of 'INFINITY' will imply something being infinite or endless. This is not descriptive of the goods relied upon but, given their nature as foodstuffs, I do consider that there is some connection in that it implies the idea of the food being sustainable, in that it is from an endless resource, for example. This connection is not necessarily that direct so while it does lessen the distinctiveness of the mark, it is not to a significant degree. Overall, I find that the marks in the opponent's first registration have a slightly lower than medium degree of inherent distinctiveness.

122. As for the second registration, the inherent distinctiveness of the word 'INFINITY' will be the same as above. As 'FOODS' is directly descriptive of the goods relied upon, I find that it does not affect the distinctiveness of the mark. As for the landscape device, I appreciate that this may have some connection to the goods in that it implies that the goods originate from farms. However, it is sizeable and relatively detailed with multiple elements within it. As such, I consider that it elevates the distinctiveness of the mark, though not to a significant degree. Overall, I consider that the second registration enjoys a medium degree of inherent distinctiveness.

123. I turn now to consider whether the opponent's use is such that it has enhanced the distinctiveness of the marks. I have summarised the evidence in full at paragraphs 22 to 35 above. I do not intend to repeat that evidence but note that the use shown covers 20 plus years of turnover for a total of over £100 million with 14 years of advertising spend, totaling almost £800,000. In addition, I remind myself that the opponent has made an effort to demonstrate some of its advertising efforts by way of its evidence confirming attendance at various UK trade shows for over 20 years. Taking all of the evidence into account, I am mindful that the relevant market in the UK for the relevant goods is likely to be an enormous one meaning that the opponent's annual turnover (which was in the region of £6 to £7 million per annum in the lead up to the relevant date) is not likely to reflect a sizeable share of the market. That being said, use of over 20 years for a total revenue of over £100 million is, in my view, sufficient to demonstrate that the opponent has operated a successful business operation over a longstanding period of time which suitably gives rise to some level of knowledge of the marks across the relevant consumer base. This is supported further by its advertising efforts, covering not just its total spend but efforts to promote the brand at numerous trade shows, again over a longstanding period of time. Overall, I am satisfied that the opponent's use has enhanced the distinctiveness of the marks in its registrations. Given the unremarkable inherent nature of the marks (especially in the sole/dominant word 'INFINITY'), I do not consider that the use is at a significant enough level to enhance the distinctiveness to a high degree. However, I do consider that it enhances the distinctiveness of the marks in both registrations to an above medium degree.

Likelihood of confusion

124. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services 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 borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, 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 they have retained in their mind.

125. In respect of indirect confusion, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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)".

126. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances whereby indirect confusion occurs.

127. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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.

128. I found the goods in the first application to be identical or similar to a high degree with the goods in the opponent's specification. As for the second application, I have found the goods and services at issue to be either identical or similar to various degrees, including low. The average consumer base for the goods and services at issue will be members of the general public who will select them via primarily visual means (though I do not discount an aural component) whilst paying mostly a medium degree of attention. On this point, I remind myself that some goods will attract a lower (but not outright low) degree of attention. In respect of the marks at issue, I have found the following:

a. The mark in the first application is:

- (i) Visually similar to a high degree, aurally similar to between a medium and high degree and conceptually identical or similar to a medium degree (depending on whether a concept is attributed to the misspelling or not) with the marks in the opponent's first registration; and
- (ii) Visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to either a medium or low degree (again depending on whether a concept is attributed to the misspelling between 'INFINITY' and 'INFITY', or not) with the mark in the opponent's second registration.

b. The marks in the second application are:

- (i) Visually and aurally similar to between a medium and high degree with the marks in the opponent's first registration. These marks are not capable of being conceptually compared; and

- (ii) Visually similar to between a low and medium degree and aurally similar to a medium degree with the mark in the opponent's second registration. These marks are not capable of being conceptually compared.

129. Lastly, I have found the marks in the opponent's first registration to be inherently distinctive to a slightly lower than medium degree. As for the mark in the opponent's second registration, this is inherently distinctive to a medium degree. I have found that the marks across both of the opponent's registrations have been enhanced to an above medium (but not high) degree of distinctiveness, thanks to the use made of them.

130. In considering the issue of confusion, I will address the applications separately below, beginning with the first.

The first application

131. Taking all of the above into account, I consider that consumers will misremember or inaccurately recall the mark in the first application for the marks in the opponent's first registration. This is particularly the case given that the first four letters of the marks are identical, as are the last three, with the two letters of difference being subsumed into the body of the marks in the opponent's first registration. As such, I consider that the difference is likely to be overlooked when consumers are confronted with the marks, especially considering the principle of imperfect recollection. On this point, I appreciate that my conceptual comparison above did not take into account 'INFITY' being misread as 'INFINITY' (it was focused on 'INFITY' as a misspelling). However, I consider this likely for a significant proportion of consumers when it comes to the issue of confusion. This is because the issue of confusion is a multifactorial assessment based on many different factors, so while the marks are highly similar, I also bear in mind a number of other factors in favour of this conclusion. These include the prominence of the

visual aspect of the selection process,²⁵ the fact that the selection process for the goods at issue is not high (in some instances, it is even on the lower end of the scale) and the enhanced degree of distinctiveness of the opponent's marks. Combined, I find that all of the relevant factors point towards consumers reading 'INFITY' as 'INFINITY'. Such a misreading also creates a shared conceptual hook which acts as a further point in favour of this conclusion. On this point I will say that even if the conceptual hook was absent, the degrees of visual and aural similarity between the marks are such to overcome any lack of conceptual hook.²⁶ Consequently, I consider that there exists a likelihood of direct confusion between the first application and the marks in the opponent's first registration.

132. In respect of the mark in the opponent's second registration, I do not consider that this will be directly confused with the mark in the first application due to the additional elements, especially the prominence of the landscape device. On this point, however, I am of the view that bearing in mind what I have said about the word 'INFITY' in the preceding paragraph, there is a likelihood of indirect confusion. I say this because when considering the issue of indirect confusion, it is not always the case that it is to be assessed on the basis that *all* differences are noticed. Therefore, for the same reasons discussed when considering direct confusion above, the similarity of 'INFITY' and 'INFINITY' (being the dominant element of the mark in the opponent's second registration) is such that the differences are likely to be overlooked. Therefore, I find that the additional points of difference in the mark in the opponent's second registration will be viewed as either non-distinctive additions (being the word 'FOODS') that allude to a sub-brand or brand extension, or are simply alternative stylings (the landscape device) used in marks of the same or economically connected undertakings. Consequently, I find that there exists a

²⁵ I raise this because the marks are visually similar to a high degree.

²⁶ On this point, I remind myself of the case of *Nokia Oyj v OHIM*, Case T-460/07, wherein the GC set out that conceptual differences do not always overcome visual or aural similarities. Whilst I appreciate that the marks at issue here are not technically different as, if 'INFITY' is not seen as a misspelling of 'INFINITY', it will have no concept meaning that it is incapable of conceptual comparison. However, I consider the principle of *Nokia* still applies.

likelihood of indirect confusion between the mark in the first application and the mark in the opponent's second registration.

The second application

133. The opponent's submissions in respect of confusion do not address the fact that the marks in the second application include a space or hyphen between the elements 'IN' and 'FITY'. In my view, this point means that the conclusions I have reached in respect of the first application cannot simply be mirrored here. On the contrary, I am of the view that the space/hyphen between these elements is such that consumers will be able to accurately recall the marks in the second application so as not to confuse them with the marks across the opponent's registrations. While the applicant's marks are still similar to higher degrees with the marks in the opponent's first registration, I do not see any reasonable scenario where consumers would overlook the gap (be that a space or a hyphen) between the elements 'IN' and 'FITY' to the point that they would believe the mark to be one word which would then be viewed as a misspelling of 'INFINITY' in the same way as described above. Further, I have found that the applicant's marks will be understood as the ordinary word 'IN' followed by the made-up word 'FITY' and while this point of difference does not create a different concept (on the basis that, as a whole, it carries no meaning), it does remove the risk of there being any shared conceptual hook between the marks at issue. Consequently, even bearing in mind the principle of imperfect recollection, I do not consider that there exists a likelihood of direct confusion between any of the opponent's marks and the marks in the second application, even when viewed on identical goods or in circumstances where the consumer pays a lower degree of attention.

134. In respect of indirect confusion, I do not consider that consumers will view the marks as being from the same or economically linked undertakings. In short, the source of origin for the applicant's marks will be viewed as 'IN FITY' or 'IN-FITY' whereas the source of origin for the marks across both of the opponent's

registrations will be 'INFINITY'. Consumers will notice that these are different and will see no reason why the undertaking responsible for the marks bearing the element 'INFINITY' (either as its sole or dominant element) would alter its mark in such a way to create the two words 'IN FITY', or vice versa. Consequently, and bearing in mind what I have said above about there needing to be a proper basis for a finding of indirect confusion when there is no direct confusion (see paragraph 127), I find that there exists no indirect confusion. Again, I find that this applies regardless of the fact the marks may be viewed on identical goods and in circumstances where the consumer pays a lower degree of attention.

Section 5(4)(a)

135. 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.

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”.

136. 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.”

137. I can deal with the present ground swiftly. Even if I were satisfied that a strong goodwill existed in the opponent's business in respect of all of the goods and services relied upon (being those set out at paragraph 6 above), this ground takes the opponent no further than the section 5(2)(b) ground. I say this because 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.²⁷ I find that to be the case here. The claims under this ground, therefore, stand or fall with the section 5(2)(b) ground.

CONCLUSION

138. The opposition against the first application succeeds in full but the opposition against the second application fails. Therefore, subject to any successful appeal against my decision, the first application is refused registration but the second application may proceed to registration for all goods and services applied for.

COSTS

139. Given the success of the opposition against the first application but the failure of the opposition against the second application, I find that the parties have achieved an equal measure of success. As such, I make no order as to costs.

Dated this 7th day of September 2026

A COOPER

For the Registrar

²⁷ *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501