

BL O/0822/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001824260

**IN THE NAME OF
SANDO & CO HOLDING SA
FOR THE FOLLOWING TRADE MARK:**



IN CLASSES 29, 30 AND 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 453424
BY EPI GESTION, S.L.**

BACKGROUND AND PLEADINGS

1. Sando & Co Holding SA (“the Holder”) is the holder of the international trade mark registration shown on the cover of this decision (“the IR”). On 4 July 2024 the Holder applied to protect the registration in the UK, claiming a priority date of 17 April 2024.¹ The application was accepted and published in the Trade Marks Journal on 7 February 2025, in respect of the following goods and services:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other dairy products; oils and fats for food.

Class 30: Coffee, tea, cocoa and substitutes thereof; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery products; chocolate; ice cream, sherbets and other edible ices; sugar, honey, treacle; yeast, baking powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice for refreshment.

Class 43: Services for providing food and beverages; temporary accommodation.

2. On 7 April 2025, EPI GESTION, S.L. (“the Opponent”) filed a notice of opposition, partially opposing the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Notice of Opposition, the Opponent indicated that the opposition is directed against the following services in the application:

Class 43: Services for providing food and beverages; temporary accommodation.

¹ Priority is claimed from the Holder’s Switzerland mark No. 816223

3. The Opponent relies upon the following trade marks (“the Earlier Marks”):

SANDOS SELECT CLUB

UK registration number: 905502539²

Filing date: 27 November 2006

Registration date: 15 November 2007

(“the First Earlier Mark”)

For the purpose of these proceedings, the Opponent relies upon the following services for which the mark is registered:

Class 43: Restaurant services (food); cafés, brasseries, pubs, bars, catering; catering services; temporary accommodation (hotels); hotel reservations, temporary accommodation reservations; hotel reservations via global computer networks.



² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the Opponent’s marks were converted into comparable UK trade marks. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

UK registration number: 909343451³

Filing date: 31 August 2010

Registration date: 11 February 2011

("the Second Earlier mark")

For the purpose of these proceedings the Opponent relies upon the following services for which the mark is registered, namely:

Class 43: Temporary accommodation services (hotel); rental of hotel and tourist home services; information relating to hotels; restaurants, cafés, brasseries, pubs, bars, food catering and hotels; restaurant services (food); catering; hotel-reservation services; accommodation reservation services; hotel reservations via global computer networks; hotels.

4. Given their filing dates, the Opponent's marks are earlier rights, in accordance with section 6 of the Act. By virtue of their earlier filing dates, the earlier rights constitute earlier marks within the meaning of section 6(1) of the Act. As the earlier rights completed their registration procedure more than five years before the filing date of the opposed contested mark, they are, in principle, subject to the use provisions set out in section 6A of the Act. However, as the Applicant did not request the Opponent provide proof of use, the Opponent can rely upon the services it has identified without having to demonstrate use.

5. In its notice of opposition, the Opponent states:⁴

"The services covered in class 43 relate to the hospitality industry which are similar to the services covered by the opponent's earlier trade mark. Further, the services have the same users and are complimentary to each other. The trade marks are highly similar sharing the distinctive element SANDO. It is conceivable that the applicant's trade mark could be mistaken as a new sub-brand of the opponent, or considered to identify services originating from the

³ As footnote (2).

⁴ Form TM7, filed 7 April 2025, Q9.

same undertaking. Overall, there is a likelihood of confusion and association on the part of the relevant”.

6. The Holder filed a defence and counterstatement denying the grounds of the opposition.⁵

7. The Holder is represented by Mr Hendrik Puschmann and the Opponent is represented by Jensen & Son. The Opponent filed evidence, which is detailed below. Neither party requested a hearing nor filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers.

EVIDENCE

8. The Opponent’s evidence comes from Alberto Rubio Garcia, administrator of EPI GESTION, S.L.U, a position held for two years. The witness statement is dated 7 November 2025 and is accompanied by three exhibits, ARG EV1 – ARG EV 3.

9. I can confirm that I have reviewed the evidence and will refer to it later in my decision, to the extent I consider it necessary.

RELEVANCE OF EU LAW

10. 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.

⁵ Form TM8, filed 13 June 2025, Paragraph 8.

PRELIMINARY ISSUES

11. The Holder has raised points in their counterstatement that I intend to address as preliminary issues. Before going further into the substantive merits of these proceedings, it is necessary to explain, why, as a matter of law, these points will have no bearing on the outcome of this opposition.

Different industries and target markets

12. The Holder argues within its counterstatement that:⁶

“The opponent operates under the “SANDOS” brand in the hospitality sector, specifically for hotels and resorts [...]. In contrast, Sando & Co Holding SA’s “SANDO” trademark is used for the operation of burger restaurants [...]. These are distinct industries with different target audiences, distribution channels, and commercial strategies, making any risk of confusion or association purely hypothetical and unfounded.”

13. It is important to note that differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from each party’s specification. Furthermore, since the Opponent’s earlier marks are not subject to proof of use, it is entitled to protection in relation to all the services for which it is registered. As such, it is the services as described in each of the parties’ specifications that I will be comparing later in this decision. The assessment I must make between the services is a notional and objective assessment, rather than a subjective one.

14. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time. As such, it is not appropriate to take such factors into account in my assessment. I will make an assessment, later in this decision, as to who the average consumer could be for the services at issue. However, again, this is a notional assessment based on how the terms are worded.

⁶ Counterstatement filed 13 June 2025, paragraph 8.

MY APPROACH

15. I consider the Opponent's best case lies with its reliance upon the first earlier mark. This is because it is a word only mark whereas the second earlier mark is a figurative mark that consists of additional elements that point further away from a likelihood of confusion. If I find a likelihood of confusion with the first earlier mark, the issue in respect to the second earlier mark is not relevant but, conversely, if there is no likelihood of confusion, it follows that there is unlikely to be a likelihood of confusion for the second earlier mark. Consequently, I will focus on the first earlier mark, returning to consider the second earlier mark, only if it becomes necessary to do so.

DECISION

Section 5(2)(b)

16. Section 5(2)(b) and 5A of the Act is as follows:

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

(a)...

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

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

17. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

19. Pursuant to section 60A of the Act, goods and/or services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgement of the Court of justice of the European Union (“CJEU”) in *Canon, Case C-39/97*, the court state at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

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

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

22. In *Gérard Meric v OHIM, 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 10 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. For the purposes of considering the issue of similarity, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.⁷

24. The competing services are as follows:

Opponent's services	Holder's services
Class 43: Restaurant services (food); cafés, brasseries, pubs, bars, catering; catering services; temporary accommodation (hotels); hotel reservations, temporary accommodation reservations; hotel reservations via global computer networks.	Class 43: Services for providing food and beverages; temporary accommodation.

Class 43

Services for providing food and beverages.

28. The Holder's above services involve the preparation, supply and serving of food and/or drink for consumption by customers. The Opponent's '*restaurant services (food); cafés, brasseries, pubs, bars, catering and catering services*' in its earlier mark, are all examples of establishments or services through which food and/or beverages are provided. Accordingly, the Opponent's services are encompassed within the Holder's broader services and are therefore identical, based on the principles outlined in *Meric*.

Temporary accommodation.

⁷ See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

29. The Holder's above service generally refers to the short-term lodging for people away from their usual place of residence. The Holder's service is a wider category which encompasses the Opponent's '*Temporary accommodation (hotels)*'. These services are therefore identical based on the principles outlined in *Meric*.

The average consumer and the nature of the purchasing act

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

31. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, 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.

32. The average consumer of the temporary accommodation services is primarily the general public but will include business professionals. The services will be provided by travel agencies and websites or directly by accommodation providers, either from physical premises or online. The frequency with which these services are selected is likely to vary, from an annual holiday to more frequent business and leisure trips. The services are likely to be selected after consumers view signage on the high street or promotional materials, or via online searches. Visual considerations will therefore play an important role in the selection process, although I do not discount that there may also be an aural component to the selection process, particularly where consumers discuss options with travel agents or receive recommendations from previous customers. It is my view that consumers are likely to consider factors such as price, location, quality rating, facilities and cancellation protection. Taking all of these factors into account, I find that the average consumer, when selecting these services, is likely to pay a medium degree of attention.

33. For the services for providing food and beverages, in my view, the average consumer is primarily a member of the general public, but will include business professionals, who will purchase the services on a fairly frequent basis. The selection process is likely to be dominated by visual considerations, as the average consumer is likely to select the services after viewing signage at or outside the premises, websites, menus and advertisements. However, I do not discount an aural

component, particularly where recommendations are made verbally or orders are placed in person or by telephone. Prices will vary for the services, ranging from low to very high, with consumers taking into account factors such as the type and quality of food and drink provided, the nature, location and availability of the establishment, menu choice, dietary requirements, reviews and hygiene rating. Taking the above factors into account, I find the average consumer is likely to pay a medium degree of attention.

Comparison of marks

34. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

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

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

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

Opponent's mark	Holder's IR
SANDOS SELECT CLUB	

Overall Impression

37. In its counterstatement, the Holder submits:

“... the opponent cannot legitimately claim exclusivity over the term “SANDO” included in “SANDOS” as “SANDO” is a widely recognized term in the culinary world, referring to a type of Japanese sandwich. As such, any attempt to monopolize this term is groundless and cannot be used to restrict my client’s rights.”

38. The Holder’s mark is a figurative mark comprised of two elements. The mark consists of the word ‘SANDO’, presented in black and bold upper-case letters, without any stylisation. The word ‘SANDO’ is displayed in an arc above a figurative device which depicts a stylised figure. I acknowledge the Holder’s comments describing the figurative element as a *“Japanese man holding a burger”*. However, this is not a typical representation of a burger and as such, I do not consider that the average consumer would recognise the stylised figure as holding a ‘burger’. Although I bear in mind that the eye is naturally drawn to the elements of a mark that can be read,⁸ given the relative size and central positioning, it is my view that the stylised figure device and the word ‘SANDO’ dominate the overall impression in roughly equal measure.

⁸ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

39. The Opponent's earlier mark is a word mark, comprising of the words "SANDOS SELECT CLUB", presented in black standard uppercase letters without any stylisation. There are no other elements that contribute to the overall impression of the mark, which resides in the words themselves. I find that 'SANDOS' is the dominant element of the mark and therefore plays the greater role in the overall impression of the mark, while the words 'SELECT CLUB' may be considered as a laudatory term in relation to the services, and is therefore less distinctive.

Visual Comparison

40. Visually, the marks coincide insofar as they share the first five letters 'SANDO'. These letters comprise the entirety of the word element in the Holder's mark. This similarity appears at the beginning of the respective marks, a position to which consumers tend to pay more attention, particularly as consumers in the UK read from left to right.⁹ The additional letter 'S' at the end of the Opponent's mark, 'SANDOS', acts as a point of visual difference. I remind myself that the ends of marks tend to have less visual impact than the beginnings.¹⁰

41. A further point of difference is the inclusion of the words 'SELECT CLUB' in the Opponent's mark. The Holder's mark also contains a stylised figure device, this element co-dominates the overall impression of the IR but has no counterpart in the Opponent's earlier mark. Accordingly, weighing up the similarities with the differences, I find the marks to be visually similar to no more than a medium degree.

Aural Comparison

42. The average consumer will make no attempt to articulate the stylised figure device in the Holder's mark and the words 'SELECT CLUB' in the Opponent's mark will be given their ordinary dictionary pronunciation. SANDOS in the Opponent's mark and SANDO in the Holder's mark appear to be invented words. As such, the average consumer may attempt a variety of pronunciations. In my view, the most likely of these

⁹ See El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

¹⁰ El Corte Inglés

for the Holder's mark is 'SAN-DOH' and for the Opponent, 'SAN-DOS'. The Opponent's mark consists of five syllables, whereas the Holder's mark consists of two. While the first syllable is identical, and the beginnings of marks tend to have more aural impact,¹¹ the second syllables differ due to the 'S' sound in 'SANDOS'. Further, the words 'SELECT CLUB' have no counterpart in the Holder's mark and are therefore a point of aural difference. Overall, I consider the marks to be aurally similar to no more than a medium degree.

Conceptual Comparison

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

44. In its counterstatement,¹² the Holder submits that, "*SANDO' is a widely recognised term in the culinary world, referring to a type of Japanese sandwich...*" As I do not have any evidence before me to establish that the word 'SANDO' is widely recognised as referring to a Japanese sandwich, I do not consider that the average UK consumer will understand the meaning of the word 'SANDO' as such. Instead, I consider that the average consumer will perceive 'SANDO' to be an invented word with no obvious meaning. It is settled case law that I must consider if the services have a potential effect on conceptual meaning as a result of any allusion/suggestion between the mark and the services.¹³ As mentioned earlier in the decision, I do not consider that the average consumer would recognise that the stylised figure is holding a burger/sandwich. However, for those consumers that do consider this element to be a burger or sandwich, the figurative element is likely to evoke the concept of someone eating.

45. I find that the word 'SANDOS' in the Opponent's mark, would be perceived by the average consumer to be an invented word with no obvious meaning. The words

¹¹ El Corte Inglés

¹² Counterstatement dated 13 June 2026, paragraph 8

¹³ BL O/1174/25, paragraph 32.

‘SELECT CLUB’ when considered together, are likely to be understood as promoting an exclusive or premium service.

46. As mentioned above, I find that the average consumer will interpret the words ‘SANDO/SANDOS’ as invented words with no obvious meaning. Those elements are therefore conceptually neutral. That being said, I cannot discount the additional elements, namely the stylised figure in the Holder’s mark and the laudatory term ‘SELECT CLUB’ in the Opponent’s mark. I find that these elements convey concepts which are not present in the other mark and therefore I find the marks as a whole to be conceptually dissimilar.

Distinctive character of the earlier mark

47. The distinctive character of a trade mark can be measured only, first, by reference to the goods and/or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

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

49. As noted above, the earlier mark includes the word ‘SANDOS’, followed by the ordinary dictionary words, ‘SELECT CLUB’. The word ‘SANDOS’ is likely to be perceived as an invented word, whereas ‘SELECT CLUB’ is likely to be perceived as a laudatory promotional indication that the Opponent’s hotel and hospitality services provide offerings such as exclusive clubs, membership schemes or premium facilities. The distinctive character of the earlier mark lies overwhelmingly in the word ‘SANDOS’, which is not descriptive of the services at issue. The other elements do not materially increase the distinctiveness of the mark. I find the earlier mark has an overall high level of distinctive character.

50. Although enhanced distinctive character has not been pleaded, I will turn to the evidence filed by the Opponent to determine whether the distinctiveness of the Opponent’s mark has been enhanced through use. The Opponent was founded in 1997, the principal activity of which is described as operating hospitality businesses. For the years 2022 to 2024, inclusive, the Opponent’s UK revenue totalled over 120 million euros. However, these figures are not broken down by reference to each of the services relied upon, such as hotel accommodation services or services that provide food and drink. It is noted that no sales figures are provided for 2020 and 2021 due to the pandemic restrictions.

51. The Opponent has won or been nominated for several awards between 2021 and 2025,¹⁴ including The Traveller Review Award in 2012, The WeddingWire Couple's Choice Awards in 2025 and the Travelers' Choice Awards in 2024. With regard to advertising and promotion, for the years 2020 to 2024, inclusive, the Opponent's expenditure for advertising in the UK, totalled over 1.2 million euros, although this figure is also not broken down by reference to each of the services relied upon, such as hotel accommodation services or services that provide food and drink. **Exhibit 4** shows examples of promotional and advertising material. **Exhibit 3** shows brochures for the services provided by SANDOS. Its evidence does not offer any insight as to the size of the relevant market, the Opponent's share of the market or the number of UK customers utilising the Opponent's services.

52. Whilst the evidence demonstrates use of the mark, it does not enable me to assess market share, consumer recognition or the extent to which the mark has come to identify the services of a single undertaking. I therefore find that the earlier mark possesses no more than its inherent degree of distinctive character.

Likelihood of confusion

53. In determining whether there is likelihood of confusion, I must take all of the above factors into account and consider if there is a likelihood of confusion for the average consumer.

54. 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 goods and services may be offset by a greater degree of similarity between the marks and vice versa. I must bear in mind the distinctive character of the earlier mark, the average consumer

¹⁴ Opponent's evidence, Exhibit ARG1

for the goods and the nature of the purchasing act. To do so, I must recognise that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

55. Earlier in this decision, I have found:

- the services to be *Meric* identical;
- the average consumer for the services at issue will primarily be the general public but will include business professionals.
- the services will be selected predominantly by visual means although I do not discount aural considerations. The average consumer for the services will pay a medium degree of attention when selecting the services at issue;
- the marks are visually and aurally similar to no more than a medium degree;
- the ‘SANDOS’ element in the earlier mark and the ‘SANDO’ element in the Holder’s mark are invented words and are therefore conceptually neutral, whilst the laudatory term, ‘SELECT CLUB’ in the earlier mark and the figurative element in the Holder’s mark, make the mark as a whole conceptually dissimilar;
- the Opponent’s earlier mark is inherently distinctive to a high degree;
- the overall impression of the Opponent’s mark lies in the word ‘SANDOS’;
- the device and the word ‘SANDO’ dominate the overall impression in the Holders mark in roughly equal measure.

56. Taking all the above factors into account, even bearing in mind the principle of imperfect recollection, I consider that there are sufficient visual, aural and conceptual

differences between the marks to avoid them being mistakenly recalled as one another. I acknowledge that the respective marks contain the same five letters 'SANDO' and that these five letters appear at the beginning of the respective marks, a position where the attention of consumers is usually directed¹⁵ and that 'SANDO' and 'SANDOS' will be perceived as invented words. I have also found the Opponent's earlier mark to possess a high level of distinctive character overall. However, the additional letter 'S' and the laudatory term 'SELECT CLUB' in the Opponent's mark and the stylised figure in the Holder's mark, create noticeable points of difference. Taking these factors into account, I do not consider that the average consumer paying a medium degree of attention would mistake one mark for the other and, therefore, find no likelihood of direct confusion.

57. I will now go on to consider indirect confusion. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:¹⁶ this is mere association not indirect confusion.

58. In *LA. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C. (as he then was), 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.

¹⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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 subbrand 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)".

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

60. For a finding of indirect confusion, I would need to conclude that consumers would notice the shared common element of the marks, namely the letters 'SANDO', while at the same time recognising the differences between them, namely the additional letter 'S' at the end of 'SANDOS' and the laudatory term 'SELECT CLUB' in the Opponent's mark and the stylised figure in the Holder's mark. The invented word 'SANDO' is entirely encompassed within the Opponent's earlier mark and plays a significant role in the overall impression of the Holder's mark. As 'SANDOS' is an invented and highly distinctive word, consumers are unlikely to regard the highly

similar word 'SANDO' to be a coincidence and are more likely to attribute the differences between the marks to brand variation, rebranding or an alternative mark used by the same or an economically linked undertaking. While the laudatory term 'SELECT CLUB' contributes to the overall impression of the Opponent's mark and will be recognised as a point of difference, it is exactly the sort of wording envisaged in *LA Sugar* category (b), namely a sub brand of the main house mark which offers a premium service. I do not consider that the difference is sufficient to exclude the impression that the highly similar words 'SANDO' and 'SANDOS' identify services originating from the same or economically linked undertakings. Furthermore, whilst the stylised figure co-dominates the overall impression of the Holder's mark, its impact arises mainly from its relative size and central positioning. In my view, consumers are likely to consider that element as simply an addition to the highly similar word element, and not an indication of a different commercial origin. Given the above, I am satisfied that the average consumer, even paying a medium level of attention, is likely to assume a commercial association between the parties due to the presence of the highly similar words 'SANDOS' and 'SANDO'. Accordingly, I find that there is a likelihood of indirect confusion.

Conclusion

61. The opposition based on s5(2)(b) of the Act has been successful. Subject to any successful appeal, the application will be refused.

Final Remarks

62. As I have found a likelihood of confusion between the Holder's mark and the Opponent's first earlier mark, there is no need for me to go on to consider the Opponent's second earlier mark.

COSTS

63. The Opponent has been successful and it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.¹⁷ I award

¹⁷ As the proceedings were commenced after 01 February 2023

the Opponent the sum of £850 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition & considering the other side's statement: £250

Official fee: £100

Preparing evidence £500

Total: £850

64. I therefore order Sando & Co Holding SA to pay Epi Gestion, S.L. the sum of £850. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of September 2026

Mrs Joanne Roberts

For the Registrar