

O/0903/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 4020649 AND 4020671

BY

LINHOPE INTERNATIONAL (UK) LIMITED

TO REGISTER THE FOLLOWING SERIES OF FOUR TRADE MARKS

SEXY BOARS

sexy boars

sexyboars

Sexy Boars

AND

SEXY BOAR

sexy boar

sexyboar

Sexy Boar

IN CLASSES 29, 30, 31, 32, 33, 35, 39 AND 43

AND OPPOSITION THERETO UNDER NOS. 448017 AND 448025

BY

CAPRICE HOLDINGS LIMITED

Background and Pleadings

1. On 29 February 2024, Linhope International (UK) Limited (“the Applicant”) applied to register in the UK the series of trade marks as depicted on the cover page of this decision (“the contested marks”) in respect of a range of goods and services in classes 29, 30, 31, 32, 33, 35, 39 and 43 as set out in full in the Annex to this decision.¹ On 15 March 2024, the respective trade mark applications were published in the Trade Marks Journal for opposition purposes.

2. On 14 June 2024, Caprice Holdings Limited (“the Opponent”) opposed the applications under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and against all the aforementioned goods and services for which registration is sought.

3. Under section 5(2)(b) the Opponent relies upon the following trade marks:

UKTM no. 912602868

SEXY FISH

Filed on 14 February 2014 and registered on 5 July 2014. Whilst it stands registered for a broad range of services in classes 41 and 43, for the purposes of this opposition it relies only on the following terms:

Class 43: Services for providing food and drink; restaurant services.

(“the first earlier mark”)

UKTM no. 3438926

SEXY PIZZA

Filed on 24 October 2019 and registered on 17 January 2020. Whilst it stands registered for a broad range of services in classes 41 and 43, for the purposes of this opposition, it relies only on the following terms:

¹ The specifications for each application are in all material respects identical apart from the addition/ omission of the word ‘prepared’ in the class 39 specification and the spelling variation between “tenderisers” and “tenderizers” in class 30. I shall proceed with the assessment as if the terms were identical.

Class 43: Services for providing food and drink; restaurant services; restaurant, bar and catering services; provision of food and drink for consumption both on and off premises; catering services including mobile catering services and catering services provided online from a computer database or from the Internet; self-service restaurant services; bar, public house, snack bar, wine bar, wine club services, sandwich bar, cafeteria, canteen and café services; take away services; fast-food restaurant services.

("the second earlier mark")

4. Under section 5(2)(b) of the Act, the Opponent claims that the marks are highly similar and that the goods and services are either identical or similar, such that there exists a likelihood of confusion which includes a likelihood of association between the respective marks. Further it claims an enhanced distinctive character in relation to the services of the first earlier mark.

5. Under section 5(3) the Opponent relies upon the first earlier mark as aforesaid claiming that it holds a reputation in this mark for the aforementioned services and that use by the Applicant of a mark highly similar to it, would lead to a link being made in the minds of the public leading to damage being caused to the Opponent's reputation. It claims that use of the contested marks would, without due cause, take unfair advantage of, and/or be detrimental to the repute and distinctive character of its first earlier mark.

6. The Applicant filed a defence and counterstatement denying the claims made and putting the Opponent to strict proof of each claim, particularly requesting that the Opponent show genuine use of its first earlier mark. In relation to the section 5(2)(b) claim, the Applicant contends that the respective marks are aurally, visually and conceptually different as are the respective goods/services. Under section 5(3) the Applicant denies that the Opponent has a reputation as claimed or that any of the heads of damage would be caused by the Applicant's use of its marks.

Representation

7. The Opponent is represented by Boulton Wade Tennant LLP, whilst the Applicant is represented by Richard Southall of Bishop & Sewell LLP.² Only the Opponent filed

² Previously with GSC Solicitors LLP.

evidence and submissions during the evidence rounds. A hearing was requested, which took place before me via video link on 11 June 2026. Mr David Ivison (counsel) was instructed to attend the hearing on the Applicant's behalf. Ms Becky Knott (counsel), instructed by Boulton Wade Tennant LLP, appeared for the Opponent. Both parties filed skeleton arguments and authorities in advance of the hearing.

Relevance of EU Law

8. 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 and submissions

9. The Opponent's evidence consists of the witness statement of Christopher Robinson dated 8 November 2024, together with 12 exhibits marked CR1-CR12.

10. Mr Robinson is the current Director of the Opponent and has been with the company since 2019, initially holding the position of Group Chief Finance Officer. His role involves having direct responsibility for the strategy management of the physical restaurants operated by the Opponent and the Intellectual Property of the various brands related to the same. His evidence goes to demonstrate the genuine use the Opponent has made of its first earlier mark, and the enhanced distinctive character and reputation it holds for the services relied upon.

11. The Opponent also filed submissions dated 11 November 2024.

12. Other than the initial pleadings the Applicant did not file any evidence or submissions during the evidence rounds.

13. Whilst I have considered the evidence, submissions and all authorities cited in reaching my decision, I do not propose to summarise them in full, but rather shall refer to the salient points to the extent that they are relevant at the appropriate stages of my decision.

Decision

Proof of Use

14. Due to their earlier filing dates, the marks upon which the Opponent relies qualify as earlier marks within the meaning of section 6 of the Act. The first earlier mark's registration process was completed more than five years before the filing date of the contested marks and therefore it is subject to the proof of use provisions under section 6A of the Act. The Opponent provided a statement of use and Applicant put the Opponent to proof of use of the same. In so far as the second earlier mark, it is not subject to the proof of use provisions, and the Opponent may rely upon all the services as identified.

15. The relevant statutory provisions are as follows:

“6(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5) - (5A) [Repealed]

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

16. As the first earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant which reads as follows:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

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

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

18. The relevant period for assessing genuine use is the five-year period ending with the filing date of the applications in issue i.e. 1 March 2019 to 29 February 2024.

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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of

the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

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

Evidence

21. I note the following from Mr Robinson’s evidence:

22. The Opponent operates a restaurant group, with restaurants in various locations in the UK and elsewhere. One of its brands is “Sexy Fish”. Mr Robinson produces details about the Opponent consisting of current extracts from its website.³

23. The first “Sexy Fish” restaurant opened in London in October 2015, with the other UK based restaurant having opened in Manchester on 12 October 2023. The

³ See Exhibit CR1

restaurant offers Japanese-inspired food and is positioned as a high-end dining experience with notable artistic features and design elements. Details of these features are shown in the undated website extract taken from www.sexyfish.com (accessed on 21 October 2024).⁴

24. The Sexy Fish London restaurant is located in Mayfair, said to be an exclusive area in London. It is said to provide a premium offering and a consistently high standard of food and services, which is reflected in its menu prices. In support of this Mr Robinson provides a selection of its various menus dated in Winter 2020 and January 2023.⁵ He states that the example menus show typical meal prices of around £100 (as at January 2023) such prices being consistent throughout the relevant period.

25. The Opponent has chosen not to disclose its turnover figures for the two restaurants in London or Manchester, explaining that this information is commercially sensitive. However, in order to demonstrate that “genuine use” has been made of the SEXY FISH trade mark, Mr Robinson provides a table (reproduced below) of the number of covers completed over the period January 2019 to January 2024.⁶ He explains that a cover means one individual person eating at their Sexy Fish restaurant in London.

Year	Number of Covers
2019	155,889
2020	75,984
2021	112,653
2022	179,686
2023	144,576
2024	7,217
Total	676,005

26. The restaurant is said to hold 150 guests seated at any one time and therefore these figures are said to demonstrate significant and continuous use of the mark and shows that the restaurant is constantly at capacity.⁷ Mr Robinson states that on

⁴ See Exhibit CR03

⁵ See Exhibits CR04 and CR05

⁶ Paragraph 12.

⁷ See Exhibit CR07

average “710 individual people [sat] and [ate] at Sexy Fish London per day (every day) for the 5 year period 2019 - 2023”.⁸

27. The restaurant is said to have received extensive press coverage in national publications to include The Independent, The Telegraph and London Evening Standard (all of which are said to have large circulation numbers) over a number of years (2019, 2020 and 2024) including features and listings as a leading or high-quality restaurant.⁹ Mr Robinson states that the restaurant has also received extensive media exposure and promotion from celebrities dining at the London venue. Excerpts and photographs published in the MailOnline newspaper are produced showing various celebrities dining at the Mayfair Sexy Fish restaurant between 17 December 2019 and 3 October 2021.¹⁰

28. The “Sexy Fish” brand is promoted through its bespoke website www.sexyfish.com that has been available in the United Kingdom since at least September 2015. Screenshots from 2018 onwards taken of its current website and taken using the Wayback machine archive tool are produced.¹¹ These websites show that restaurant bookings can be made via the telephone or online, with these arrangements being said to have been in place since September 2015.

29. Website analytics data from Google Analytics is produced (broken down by geographical area) said to show the number of unique UK visitors to its restaurant website, from January 2018 to July 2023, totalling over 3.2 million visitors.¹² The number of overseas visitors is said to have been excluded from the data.

30. Mr Robinson concludes that the “SEXY FISH” trade mark has been used extensively in the United Kingdom since at least 2015 in relation to restaurant services, and that the mark enjoys a nationwide reputation among consumers in that sector.

Assessment of the evidence

31. There are obvious deficiencies in the evidence in terms of the Opponent’s financial position, with the Opponent withholding evidence as to its turnover and related trading

⁸ Paragraph 13

⁹ Exhibit CR09

¹⁰ Exhibit CR10

¹¹ Exhibit CR11

¹² Exhibit CR12

activities. I can see no legitimate basis upon which it chose to take this approach, given that such evidence is routinely filed in proceedings before the UKIPO, particularly ones such as these, where genuine use is required to be shown and where a party claims a reputation and enhanced distinctiveness of its mark. The disclosure of any confidential or sensitive information could have been overcome by making a request for confidentiality. However, no such order was sought. I must therefore assess the matter on what is before me. I also note that the evidence was unchallenged by the Applicant until the final hearing where Mr Ivison was at odds to address me not on the veracity or truthfulness of the evidence but as to its sufficiency.¹³

32. The criticisms raised by the Applicant have some merit. For example, whilst the covers to which Mr Robinson refers, which is the height of the Opponent's evidence, show that the restaurant was regularly operating throughout the relevant period, this evidence merely tells me how many diners were served, but not the extent of the use. There also appears to be an inconsistency between the narrative evidence and the table produced in evidence by Mr Robinson. Mr Robinson stated that on average 710 individuals dined at the restaurant per day, every day. However, as I pointed out to Ms Knott at the hearing, this calculation did not appear to tally with the figures within the table which appeared to indicate much lower numbers. There is also no evidence to support how the figures were collated and from what documents. This, therefore, casts some doubt as to the accuracy of the figures claimed.

33. I note, however, that Mr Robinson provides details taken from the Opponent's website and menus showing the mark in use over the relevant period for the provision of restaurant services. He also identified a number of celebrities who attended the establishment and produced the publicity that was generated by those visits in national newspapers. I also note that over 3.2 million visits were made to the Opponent's website by UK visitors over the relevant period.

34. Although the evidence could have been more focused and detailed, notwithstanding the issues I have identified in terms of the number of covers, when taken together, I am satisfied that it nonetheless is sufficient to establish that the

¹³ *Tui v Griffiths* [2023] UKSC 48. The case is ostensibly about expert witness evidence, but it is clear from paragraph 42 of the judgment that it is not limited to expert witnesses.

Opponent has shown genuine use of its first earlier mark SEXY FISH for '*services for providing food and drink; restaurant services*'.

Section 5(2)(b)

35. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

36. Section 5A of the Act reads 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.”

The principles

37. The 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 and are as follows:

(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 the goods and services

38. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, where the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

39. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat* [1996] R.P.C. 281, namely:

- (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.

40. In so far as construing words in specifications, Lord Kitchin set out the proper approach to considering terms in specifications in *SkyKick UK Ltd & Anor v Sky Ltd & Ors*:¹⁴

¹⁴ (Rev1) [2024] UKSC 36

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

41. Further, in *YouView TV Ltd v Total Ltd*,¹⁵ Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

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

¹⁵ [2012] EWHC 3158 (Ch),

“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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

43. In *Kurt Hesse v OHIM*,¹⁶ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM),¹⁷ the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

44. In *Sanco SA v OHIM*,¹⁸ the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different – in that case, chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he was then) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:¹⁹

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

¹⁶ Case C-50/15 P

¹⁷ Case T-325/06

¹⁸ Case T-249/11

¹⁹ BL O/255/13

45. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

46. The Applicant's goods and services to be compared are set out in full in the Annex to this decision, whereas the services relied upon by the Opponent are outlined earlier in my decision.²⁰ Both parties advanced submissions regarding the identity, similarity or otherwise of the respective goods and services which I have taken into account but do not propose to outline. I shall go through each term in turn grouping terms together where appropriate.²¹

Class 29 and Class 30

47. Before I undertake the comparison of the goods and services at issue, I note that there have been a number of decisions, both at first instance and before the Appointed Persons, concerning the relationship between goods in classes 29 and 30 and services which may broadly be described as the provision of food and drink in class 43.²²

48. I acknowledge that the Opponent has not filed evidence directed to the similarity between the goods and services, nor is it permissible for me to rely on findings of fact in previous decisions as a basis for my own assessment.²³ However, those decisions accord with my own experience and understanding as an average consumer namely that restaurants commonly sell their own branded food products through various retail outlets, thereby enabling consumers to replicate the restaurant experience at home. Consequently, I consider that the various decisions demonstrate that this practice is sufficiently commonplace that I may take it into account without specific evidence having been filed on the point. I also note Ms Himsworth's comments in *Top Dog TM*, where she acknowledged that no distinction could necessarily be made between 'ready to eat' food items and those goods that required further processing, particularly

²⁰ At paragraph 2.

²¹ *Separode* Trade Mark BL O/399/10 (AP)

²² See the cases of *Cucina* (O/001/10), *FLAMIN GRILL* (BL O/198/12), *PROVENANCE BRANDS* (BL O/299/14) and *SAINSBURY'S TOP DOG* (O/292/15 and on appeal O/044/16) in relation to class 29. In respect of class 30, see the cases of *AOK* (BL O/409/22) and *COPPOLA* (BL O/106/19).

²³ See *TM Bandit* O/0197/23

where those goods would be regarded as a subset of the goods identified within the wording of the relevant class headings.

49. That said, I also accept, given the broad nature of the goods at issue, that in the absence of evidence, the same conclusion cannot extend to all goods falling within classes 29 and 30. In my view the position would be different in relation to goods which would commonly be regarded as raw or basic ingredients from which the finished dishes are prepared as opposed to products which are of a kind that might be sold by a restaurant for consumption at home. I shall bear these factors in mind as I go through the assessment of the individual goods and services.

Class 29

Foods prepared from a combination of meat, fish and fish products, shellfish and shellfish products, poultry and game, fruit and vegetables, salads including vegetable salads, milk products and other dairy products, edible oils and fats, pickles, pre-prepared uncooked, semi-cooked foods and desserts.

50. The Applicant's goods in class 29 consist of mainly foodstuff of animal origin as well as vegetables and other consumables prepared or otherwise. The Opponent relies upon what can broadly be described as the provision of food and drink services and restaurant services in class 43. I find that the goods in class 29 are typically ones that are provided by an undertaking providing food and drink and restaurant services and as such the goods and the services overlap in channels of trade, users, and purpose. There is a degree of complementarity as the goods are essential for the provision of the services and the average consumer is likely to expect them to come from the same undertaking given that a restaurant cannot function without food. There is also a degree of competition between the goods and the services, because consumers may choose to purchase the goods in order to prepare and cook a meal at home themselves or to dine at a restaurant. Overall, I consider that the goods and the services are similar to between a low and medium degree.

Class 30

[...] Preparations made from cereals; bakery products; pies; pies containing meat, fish, shellfish, poultry or game; vegetable pies; bread, brioche, pastry, pastries, croissants, bread buns, patisserie; muffins; tarts; biscuits; cookies; cakes; oatcakes; biscuits for

cheese; vermicelli, rice, pasta; pizzas; sandwiches; sauces; (condiments); ketchup; relish; brown sauce; chutneys; mayonnaise; marinades; meat tenderizers for household purposes; gravy; fish gravy; condiments; salad dressings; food dressings; food pastes; coffee, coffee substitutes; tea, tea substitutes; tea infusions; iced tea; iced coffee; cocoa, drinking chocolate; rice, ice creams; ice cream products, puddings; desserts.

51. The Applicant's goods in class 30 are general foodstuff and consumables. On the same basis and for the same reasons as my previous assessment, the above goods would also be similar to the Opponent's restaurant and provision of food and drink services as well as its take away and fast-food restaurant services to the same degree. I find that they are similar to between a low and medium degree.

Honey; sugar; treacle; salt; cooking salt; pepper; mustard; vinegar, sweetened vinegar; spices; seasonings; flavourings; seasonings; essences for foodstuffs.

52. The above goods are in my view a range of goods that are used as additives and seasonings intended to improve the flavour of the food and beverages. They are commonly provided in restaurants and takeaways to allow consumers to adjust the taste of their food and drinks. I therefore consider that there will be a degree of overlap between the respective channels of trade and user. I do not consider that there would be an overlap in nature, method of use or purpose. The goods and services are not in competition, but there may be a degree of complementarity where a consumer wishing to buy a coffee, for example, believes that the same undertaking will also supply the sugar used in the coffee. In my view the goods and the services are similar to a low degree.

Flour; wheat flour; yeast, baking-powder;

53. Whilst these goods are intended to be used in preparation of the foodstuff goods that a restaurant may provide, particularly baked goods, they are basic food ingredients, principally intended for use in the preparation or manufacture of a finished food product, or ones that serve a particular function, namely as a thickening or raising agent. In my view, a distinction can be drawn between goods such as condiments, sauces, and those which add flavour which would be supplied for direct consumption alongside prepared food, and the raw or basic ingredients used in the preparation of the finished product.

54. Whilst there may be instances in which providers of food and drink, produce or source such ingredients themselves, there is no evidence before me to suggest that this is widespread. Accordingly, I consider the respective nature, purpose and method of use of the goods and services differ. I do not find that the respective goods are complementary or in competition to the services. Any overlap in use or channels of trade would only be at a high level of generality and insufficient for similarity to bite. I find the goods are dissimilar.

Class 31

Fresh fruit and vegetables.

55. These goods are similar to the Opponent's provision of food and drink and restaurant services overlapping in purpose, namely to provide food items to customers. They share the same trade channels and are directed towards the same end user. This is particularly so where a restaurant grows its own produce and provides its own fruit and vegetables to make its dishes. I consider that the goods are similar to the Opponent's services to a low degree.

Class 32

Non-alcoholic beverages, fruit juices, syrup and other preparations for making beverages, mineral water, smoothies, carbonated beverages, beer, non-alcoholic beer and water.

56. The Opponent has services relating to the provision of drink and restaurant services and bar, catering and café services (for its second earlier mark). An entity providing services in the catering sector will provide both alcoholic and non alcoholic beverages rendering the goods and services as overlapping in purpose, directed at the same end users, through the same channels of trade and again being in competition. I do not find a complementary relationship between the goods and the services, in this instance, since whilst the goods are important to the services they are unlikely to be regarded as being provided by the same undertaking. The nature and method of use of the goods versus the services would also differ. For these reasons overall the respective goods and services are similar to between a low and medium degree.

Class 33

Alcoholic beverages, wine, cider and perry.

57. I find that the alcoholic drinks and the Opponent's services particularly ones that relate to bar, public house and wine bar services would be similar to between a low and medium degree overlapping in user, channels of trade, purpose and being in competition with each other for the same reasons as outlined above.

Class 35

The bringing together for the benefit of others a variety of goods in connection with the sale of prepared foods, prepared meals, snack foods, foodstuffs, meat, fish, shellfish, fruit and vegetables, dairy products, bread and pastry products, edible oils, tea, coffee, milk, beverages, alcoholic beverages enabling customers to purchase those goods from an internet web site, online advertising.

58. In so far as the term *online advertising* is concerned, in absence of any submissions from the parties on the point, I consider that from the way in which the specification has been framed the reference to these services is not to be taken as a free standing term. Rather the use of a comma as opposed to a semi colon indicates that the term *online advertising* forms part of the description to the way in which the goods and services are promoted and made available to consumers i.e. that customers are able to purchase goods via an internet website or via online advertising. It was not argued before me that this term should be construed as separate or distinct or that the Applicant seeks registration for 'online advertising services' as such. Consequently, I have approached the term on the basis that it forms part of the specification description that precedes it.

59. The Applicant's services can be described as the provision of an online retail service to consumers via different means. I consider that these share a degree of similarity with the Opponent's restaurant and the provision of food and drink/ takeaway services because broadly speaking they each are in the business of providing food and drink, they overlap in users and trade channels. Consumers using the Opponent's services, would be purchasing a dining experience or a prepared meal service whereas a retail customer is buying goods from the Applicant. Overall, I consider that the respective services are similar to between a low and medium degree.

Class 39

Delivery of food and drink prepared for consumption, food delivery, food transport services, packing of food.

60. These services can be categorised as those concerned with the transportation and delivery of food and drink and packaging of food i.e. the main purpose of these services is to move goods/foodstuff from one place to another and in terms of packing the food ensuring that they are in appropriate containers for transportation. Whereas the Opponent's services are hospitality, catering and the provision of food and drink services, the main purpose of which is to prepare, provide and serve food and drink for consumption. Therefore, whilst the purposes of these services differ, there will be an overlap in users and trade channels, especially where restaurants offer delivery services and takeaway services as opposed to using third parties to do so on their behalf. I consider that there would be, to a degree, a complementary relationship between the respective services where the delivery of food services is reliant on a restaurant or takeaway for the preparation of the food, thus being indispensable or important and being regarded as provided by the same undertaking. Overall, I consider that the respective services are similar to a medium degree.

Class 43

Bar services, cocktail bar services, cocktail lounge services, provision of alcoholic and non-alcoholic cocktails, restaurants, snack bars, cafeterias, road-houses, takeaway or fast food outlets and restaurant chains.

61. These services are identical to the Opponent's services either self evidently or in accordance with the principles in *Meric*.

62. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against the goods listed below fails and I will say no more about them.²⁴

Class 30: Flour; wheat flour; yeast; baking powder.

²⁴ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

Average Consumer and the purchasing process

63. When considering the opposing marks, the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.²⁵

64. In *Iconix*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)*²⁶ 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

²⁵ *Lloyd Schuhfabrik Meyer*, case c-342/97.

²⁶ [2024] EWCA Civ 262.

(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.

65. Both parties' specifications can broadly be described as services for the provision of food and drink and restaurant/takeaway services and provision of goods sold at the same. As such the average consumer is likely to be the general public and business to business users such as distributors and wholesalers providing the goods to the restaurants and other food establishments. In so far as the frequency of the purchase I consider that it will be fairly frequent with the cost, whilst varying, not being at the higher end of the scale. For the general members of the public, I consider that factors such as dietary requirements, personal preference, quality, value for money as well as cleanliness and reviews will be taken into account in the selection process. For wholesalers and distributors considerations such as cost, quality and reputation are also factors that will be taken into account. I consider that an average (medium) degree of attention will be undertaken for both types of consumer.

66. When deciding which services to select, consumers will see the marks in use on signage at the premises themselves or on promotional/sales material such as fliers or printed advertisements. Consumers may also see the use of the marks on social media or websites. In so far as the goods they are likely to be self selected from retail outlets or their online equivalents following printed advertisements or the same promotional channels. Taking these factors into account, I consider that the selection/purchasing process will be predominantly visual but not discounting aural considerations by way of word of mouth recommendations or following sales enquiries.

Comparison of the marks

67. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

68. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

69. The respective trade marks are shown below:

Contested marks	Earlier marks
SEXY BOAR (Sexy Boar, sexy boar, sexyboar)	‘First earlier mark’ SEXY FISH
SEXY BOARS (Sexy Boars, sexy boars, sexyboars)	‘Second earlier mark’ SEXY PIZZA

My Approach

70. The contested marks are for a series of four marks, each for the words SEXY BOAR/S in various configurations. Nothing turns on the difference in casing, typeface, whether they are presented in the singular or plural, or whether they are presented as two separate words or in combination. Therefore, for the purposes of the marks comparison I will refer to them in the singular, since these differing factors will not make a material impact on my findings.

Overall Impression

71. The contested mark is for the two words SEXY and BOAR. The first word SEXY is laudatory and qualifies the second word, but the word BOAR is not directly descriptive

of the applied for goods and services per se. The word BOAR may be regarded as a male pig or merely refer to the animal as in wild boar. It is not entirely clear whether consumers would regard the reference to BOAR as descriptive of a foodstuff as suggested by the Opponent, in the same way as say chicken or beef, but whilst it is possible to eat wild boar, it is not a common foodstuff in the UK and therefore would only allude to foodstuff rather than being directly descriptive of it. Taking these matters into consideration, I consider that the overall impression resides in the two words in combination but slightly weighted in favour of the word SEXY since this will be the first word that will be read and it qualifies the word that follows.

72. In so far as the earlier marks, the reference to FISH and PIZZA is more clearly descriptive of the foodstuff on offer or the type of restaurant or café. Therefore, the word SEXY whilst laudatory will play a more dominant role in the overall impression of these marks as opposed to the words FISH and PIZZA which will play lesser roles.

Visual and aural comparison

73. Visually and aurally each mark includes the identical word SEXY which is the first word in each mark that will be seen and pronounced. The differences arise from the second words in each mark namely FISH, PIZZA and BOAR. It is settled case law that the beginnings of marks tend to have greater visual and aural impact and I find that this is the case here. As a result of the identical first word SEXY in each mark, I consider that the marks are visually and aurally similar to a medium degree.

Conceptual comparison

74. The shared word SEXY is normally used to describe the physical or alluring qualities of a person, but in the context of the goods and services at issue is likely to be perceived by consumers as describing something that is interesting and exciting or a food or restaurant that is fashionable, appealing or sophisticated.²⁷ The second word in each will be regarded as a foodstuff or an animal. The addition of the word SEXY does not alter the meaning of the second word nor does it create a new meaning in combination over the meaning of the individual words when taken separately.

²⁷ See 'www.dictionary.cambridge.org' and 'www.collinsdictionary.com' (both accessed on 12 August 2026).

Consequently, I consider that the marks are conceptually highly similar if BOAR is regarded as a foodstuff or conceptually similar to a medium degree otherwise.

Distinctive character

75. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the goods/services will possess a low degree of distinctiveness. Conversely invented words with no association to the goods/services are highly distinctive. The more distinctive the earlier marks (either per se or by the use that has been made of them) the greater the likelihood of confusion.²⁸

76. 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).”

²⁸ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

77. As stated above the earlier marks consist of the word SEXY followed by the words FISH and PIZZA respectively. The word SEXY is laudatory but its use in relation to the provision of food and drink services or restaurant services is unusual, as it is not normally used in this context. The words that follow are clearly descriptive of the nature of the food on offer or the type of restaurant establishment. Individually therefore the words being ordinary English dictionary words are not highly distinctive but given the unusual nature of the use of the word SEXY in the context of the services at issue the marks as wholes are inherently distinctive to slightly above a medium degree.

Enhanced distinctive character

78. The Opponent is only claiming an enhanced degree of distinctive character in relation to its SEXY FISH mark. I have already outlined the Opponent's evidence above and its limitations. As at the relevant date the Opponent was operating two restaurants under the name SEXY FISH, one in London and the other in Manchester, that second venue having only opened in October 2023. I note however that no evidence is provided for the Manchester venue, but rather the focus of the evidence has been directed at the London restaurant. Further the Opponent has withheld all information regarding its financial position in terms of its turnover, trading activities and marketing expenditure. Mr Robinson contends that the evidence shows the enhanced distinctiveness it holds as a result of "longstanding and intensive use throughout the UK". However, I disagree.

79. At its height the only evidence produced relating to the intensity of use is a self generated table outlining the number of covers the London restaurant had over the period January 2019 to January 2024. However, as I have already outlined there was no other evidence to support the Opponent's figures, and the accuracy of the average number of individuals eating at the London restaurant per day do not tally with the table. This therefore calls into question the accuracy of the figures produced and whether the table accurately reflects the true position of consumers' engagement with its restaurant.

80. I accept that the evidence shows that a number of celebrities dined at the Opponent's London venue, which generated publicity through the Mailonline newspaper, but no indication has been given as to the number of consumers that read

these articles or booked the restaurant as a result. Further whilst it is said that for example Kim Kardashian has 300 million followers on her Instagram social media platform, no specific evidence is provided of any engagement to posts relating to her attendance at the restaurant. I am provided with a list of Google analytics data of the number of users per geographical region within the UK, which are said to have visited the Opponent's 'sexyfish' website, but again there is no indication as to the number of these that were converted into actual patrons of the restaurant as opposed to foreign visitors or tourists.

81. At its height the Opponent's evidence contends that the London restaurant was running to full capacity each day and on average the price of a three course meal excluding drinks was £100. If I accept that each customer spent this amount per visit this would equate to takings of at least £30,000 per day which would give an approximate annual turnover of millions of pounds. However, since I have no financial information to back this up, this is purely guess work on my part. Even if I were to accept the table at face value, the number of covers only provides details of one factor in the assessment, namely the number of customers that were served; the remaining evidence regarding its promotional spend or market share is limited or non existent.

82. Further the Opponent's evidence is directed to its activities in one localised area of London. Whilst being the capital city and thus accepting that it would attract a greater level of visitors and tourists, I am still unable to accurately assess the true extent of the level of engagement from consumers since the Opponent has chosen not to disclose it. Even if I were to take the covers as an accurate reflection of its business, in comparison to the restaurant market sector as a whole, particularly in London, these figures would not in my view be significant and would not show the use to be geographically widespread.

83. The onus is on the Opponent to file clear and unequivocal evidence and in choosing to limit its evidence in the way it has, it leaves me no option but to be sceptical as to the level of enhancement it is said to enjoy in the distinctiveness of its first earlier mark.

84. Notwithstanding that the Applicant did not challenge the evidence filed, taking the evidence as a whole and given the deficiencies in the evidence as outlined, I find that

it is insufficient to show that the Opponent has achieved an enhanced level of distinctiveness in its SEXY FISH mark beyond its inherent position.

Likelihood of confusion

85. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods/services originate from the same or a related source.

86. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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/services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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. Mr James Mellor, as the Appointed Person, directed that a common sense approach should be undertaken in any assessment where “every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts” applying “the well-established propositions for assessing the visual, aural and conceptual similarities.”²⁹

87. The difference between the two types of confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*³⁰

“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

²⁹ *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20.

³⁰ BL O/375/10.

other hand, only arises where the consumer has actually recognised 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).”

88. I bear in mind that the examples as set out by Mr Purvis in *L.A. Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.³¹ Furthermore, in *Liverpool Gin*, Arnold L.J. pointed 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. A finding of indirect confusion should not be

³¹ *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

made merely because two marks share a common element; it is important to note the aspects of the other elements within the respective marks and the part they play.

89. I also note the decision in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,³² Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

³² [2015] EWHC 1271 (Ch)

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

90. Earlier in my decision I found that the contested mark was visually and aurally similar to the earlier marks to a medium degree. If the word BOAR was seen as a reference to foodstuff, then conceptually the marks were similar to a high degree but otherwise to a medium level. I found the goods and services to be either identical or similar ranging from a low to between a low and medium degree. I found that the earlier marks were overall inherently distinctive to slightly above a medium degree.

91. Dealing with direct confusion first. In my view the differences between the marks as a result of the differing second word in each, despite being descriptive or allusive would not be overlooked, particularly given my findings in relation to the overall impression of each mark. These differences are in my view enough to avoid the marks being mistakenly recalled or misremembered for each other. Consumers are likely to pay specific attention to the second word, which serves to identify the type of food they wish to eat and/or informs their choice of restaurant. Even where the word BOAR in the contested mark is not seen as a reference to an animal but as foodstuff it will still be sufficient to avoid the marks being directly confused.

92. In so far as indirect confusion is concerned, I recognise that such a finding should not be made merely because the competing marks share a common element. However, in this regard I have already found that the addition of the word SEXY does not alter the meaning of the second word in each mark, nor does it create a new meaning in combination over the meaning of the individual words when taken separately. The use of the word SEXY in relation to the goods and services at issue is unusual. This unusual application enhances this element’s distinctive character and gives it a greater degree of distinctiveness than it would otherwise possess when used in contexts in which its ordinary meaning is more readily apparent, for example, when describing a person or items of clothing. With this in mind and taking all the global factors into account, if consumers note that the marks are different, as a result of the unusual use of the word SEXY in relation to foodstuff and the provision of food and

drink/restaurant services, they will conclude that the goods/services are provided by one and the same or related undertaking.

93. In my view consumers will see the goods and services under the contested mark as being provided by an undertaking under the SEXY brand within the same chain of restaurants or an undertaking producing and selling the restaurant's SEXY branded produce within a retail setting.

94. For those consumers that are already accustomed to SEXY FISH's restaurant services, when coming across the later mark for services in the same or similar fields they will consider that it is a different type of restaurant, offering different menu choices, either based on pig related meat or just under a different menu. The fact that the word BOAR is not directly descriptive of a foodstuff does not alter this finding.

95. In so far as the goods, in my experience many restaurants also sell packaged foodstuffs such as for example branded sauces, coffee beans and baked goods, all under the same brand. Therefore, in terms of the goods, it is entirely plausible that consumers seeing the contested mark SEXY BOAR on foodstuff, would assume that it was the Opponent diversifying and selling its signature products under another mark or a related undertaking selling the restaurant's SEXY branded produce. I come to this conclusion despite having found that some of the goods/services are similar only to a low degree. As a result of the interdependency principle, there is sufficient similarity between the marks aurally, visually and conceptually for confusion to arise, particularly in relation to the Opponent's marks which I found as wholes to be inherently distinctive to a slightly above medium degree. The identical common use of the word SEXY will offset the differences arising from the second word. Consumers when seeing the word BOAR in combination with the word SEXY, will assume that the Opponent is showcasing its products and selling signature foodstuff under the same brand.

96. Consequently, I find that there would be a likelihood of indirect confusion.

97. The opposition under section 5(2)(b) succeeds save for those goods that I found to be dissimilar as identified in paragraph 62.

Section 5(3)

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

“A trade mark which-

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

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

99. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, given that the Opponent relies solely on its first earlier mark for this ground it must show that this mark is similar to the contested mark. Secondly, the Opponent must show that the first earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods/services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. For the purposes of section 5(3) the relevant date for the assessment is 29 February 2024.

Similarity between the marks

100. In light of my earlier findings where I found the marks to be visually, aurally and conceptually similar, this first condition is met on the same basis and for the same reasons.

Reputation

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

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

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

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

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

102. In assessing whether the first earlier mark has a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”³³

103. I note that the assessment of whether the Opponent holds a reputation for the services claimed is a different test to the one undertaken for an enhanced level of distinctive character, but in reality, they rarely produce different outcomes. I have already summarised and assessed the Opponent’s evidence earlier in my decision

³³ *General Motors* para 27

when considering whether it had shown genuine use of its mark and whether it had enjoyed an enhanced level of distinctive character through use.

104. In light of my earlier findings regarding the Opponent's failure to demonstrate that the first earlier mark enjoyed an enhanced degree of distinctive character, I consider that those findings apply equally to the assessment of whether the Opponent holds a reputation. For the same reasons I find the inadequacies highlighted in terms of the lack of financial details means that I am unable to assess with any degree of precision the scale and extent of the reputation claimed. The height of the evidence to show that it holds a reputation is a small selection of press releases referring to celebrities frequenting the restaurant and a self generated table outlining the number of covers the London restaurant is said to have sold. In my view whilst the cover figures establish that the business was trading, they are insufficient to measure the commercial success of the business in absence of turnover, revenue, or market share figures. The way in which the evidence has been presented makes it impossible for me to assess with any degree of precision the economic strength, market penetration and the degree of consumer recognition of the business. The covers merely tell me how many diners were served and whether consumers purchased the services, but it does not show me whether a significant part of the relevant public recognises the brand.

105. For these reasons the evidence falls short of establishing that the Opponent holds a reputation as claimed.

106. Without being able to establish a reputation the Opponent's claim under section 5(3) falls at the first hurdle.

Conclusion

107. The opposition under section 5(2)(b) succeeds in part. Subject to appeal the applications numbered 4020649 and 4020671 shall be refused registration for all the goods and services applied for as set out in the Annex, save for those goods outlined below.

108. The Applications shall proceed to registration for the following goods:

UKTM no. 4020649

Class 30: Flour; wheat flour; yeast, baking-powder.

UKTM no.4020671

Class 30: Flour; wheat flour; yeast, baking-powder.

Costs

109. The Opponent has had the greater share of success overall and therefore is entitled to a contribution towards its costs based on the scale as set out in Tribunal Practice Notice 1/2023. Following this guidance, I award costs to the Opponent as follows:

Preparing a Notice of opposition and statement of grounds (x2):	£500
Preparing and filing evidence and submissions:	£700
Preparing for and attending the Hearing:	£800
Official fees (x2):	£400
Total:	£2,400

110. I order Linhope International (UK) Limited to pay Caprice Holdings Ltd the sum of £2,400 as a contribution towards its costs. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an (unsuccessful) appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2026

Leisa Davies

For the Registrar

Annex

UKTM no. 4020649

Class 29: Foods prepared from a combination of meat, fish and fish products, shellfish and shellfish products, poultry and game, fruit and vegetables, salads including vegetable salads, milk products and other dairy products, edible oils and fats, pickles, pre-prepared uncooked, semi-cooked foods and desserts.

Class 30: Flour and preparations made from cereals; bakery products; pies; pies containing meat, fish, shellfish, poultry or game; vegetable pies; bread, brioche, pastry, pastries, croissants, bread buns, patisserie; muffins; tarts; biscuits; cookies; cakes; oatcakes; biscuits for cheese; wheat flour; vermicelli, rice, pasta; pizzas; sandwiches; honey; sugar; treacle; yeast, baking-powder; salt; cooking salt; pepper; mustard; vinegar, sweetened vinegar; sauces; (condiments); ketchup; relish; brown sauce; spices; chutneys; mayonnaise; seasonings; flavourings; marinades; meat tenderizers for household purposes; gravy; fish gravy; seasonings; essences for foodstuffs; condiments; salad dressings; food dressings; food pastes; coffee, coffee substitutes; tea, tea substitutes; tea infusions; iced tea; iced coffee; cocoa, drinking chocolate; sugar, rice, ice creams; ice cream products, puddings; desserts.

Class 31: Fresh fruit and vegetables.

Class 32: Non-alcoholic beverages, fruit juices, syrup and other preparations for making beverages, mineral water, smoothies, carbonated beverages, beer, non-alcoholic beer and water.

Class 33: Alcoholic beverages, wine, cider and perry.

Class 35: The bringing together for the benefit of others a variety of goods in connection with the sale of prepared foods, prepared meals, snack foods, foodstuffs,

meat, fish, shellfish, fruit and vegetables, dairy products, bread and pastry products, edible oils, tea, coffee, milk, beverages, alcoholic beverages enabling customers to purchase those goods from an internet web site, online advertising.

Class 39: Delivery of food and drink prepared for consumption, food delivery, food transport services, packing of food.

Class 43: Bar services, cocktail bar services, cocktail lounge services, provision of alcoholic and non-alcoholic cocktails, restaurants, snack bars, cafeterias, road-houses, takeaway or fast food outlets and restaurant chains.

UKTM no. 4020671

Class 29: Foods prepared from a combination of meat, fish and fish products, shellfish and shellfish products, poultry and game, fruit and vegetables, salads including vegetable salads, milk products and other dairy products, edible oils and fats, pickles, pre-prepared uncooked, semi-cooked foods and desserts.

Class 30: Flour and preparations made from cereals; bakery products; pies; pies containing meat, fish, shellfish, poultry or game; vegetable pies; bread, brioche, pastry, pastries, croissants, bread buns, patisserie; muffins; tarts; biscuits; cookies; cakes; oatcakes; biscuits for cheese; wheat flour; vermicelli, rice, pasta; pizzas; sandwiches; honey; sugar; treacle; yeast, baking-powder; salt; cooking salt; pepper; mustard; vinegar, sweetened vinegar; sauces; (condiments); ketchup; relish; brown sauce; spices; chutneys; mayonnaise; seasonings; flavourings; marinades; meat tenderisers for household purposes; gravy; fish gravy; seasonings; essences for foodstuffs; condiments; salad dressings; food dressings; food pastes; coffee, coffee substitutes; tea, tea substitutes; tea infusions; iced tea; iced coffee; cocoa, drinking chocolate; sugar, rice, ice creams; ice cream products, puddings; desserts.

Class 31: Fresh fruit and vegetables.

Class 32: Non-alcoholic beverages, fruit juices, syrup and other preparations for making beverages, mineral water, smoothies, carbonated beverages, beer, non-alcoholic beer and water.

Class 33: Alcoholic beverages, wine, cider and perry.

Class 35: The bringing together for the benefit of others a variety of goods in connection with the sale of prepared foods, prepared meals, snack foods, foodstuffs, meat, fish, shellfish, fruit and vegetables, dairy products, bread and pastry products, edible oils, tea, coffee, milk, beverages, alcoholic beverages enabling customers to purchase those goods from an internet web site, online advertising.

Class 39: Delivery of food and drink for consumption, food delivery, food transport services, packing of food.

Class 43: Bar services, cocktail bar services, cocktail lounge services, provision of alcoholic and non-alcoholic cocktails, restaurants, snack bars, cafeterias, road-houses, takeaway or fast food outlets and restaurant chains.