O-0925-23

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 3644482
IN THE NAME OF MOO2YOO LTD TO REGISTER

MOO2YOO

AS A UK TRADE MARK IN CLASS 32

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 427677
BY JOHN EDWARD COWPE

BACKGROUND AND PLEADINGS

1. On 20 May 2021 Moo2Yoo Ltd ("**the Applicant**") applied to register MOO2YOO as a trade mark in respect of the following goods:

   Class 29: *milks; milkshakes; milk dispensed from vending machines*
   Class 32: *syrup for beverages; syrups for milkshakes*.

2. The application was published for opposition purposes on 23 July 2021, and on 21 October 2021 John Edward Cowpe ("**the Opponent**") filed a notice of opposition. The Opponent is the proprietor of trade mark registration No. 2424440:

   Filing date: 7 June 2006
   Registration date: 19 January 2007

3. The Opponent relies on the following goods specified under his registration: Class 29: *milk drinks; smoothies* and Class 30: *ice cream*, in respect of which the Opponent states that it has used its mark, including in the period of 5 years up to the filing date of the opposed application. The opposition is based on the following grounds under the Trade Marks Act 1994, as amended ("**the Act**"):

   (i) **Section 5(2)(b)** – the Opponent claims that the parties' marks are almost identical and the respective goods are identical and similar, such that there exists a likelihood of confusion;

   (ii) **Section 5(3)** – a claim that the Opponent's mark also has a reputation in respect of *milk drinks; smoothies* and *ice cream*, and that use of the applied-for mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Opponent's earlier registration. The statement of grounds premised those damaging consequences on the likelihood of confusion, but also on the risk of contamination in the supply of dairy products and the jeopardy

that may pose to the reputation of the Opponent's mark were it wrongly associated with such an incident.

4. The Applicant submitted a notice of defence, including a counterstatement, from which I note the following points:

(i) The Applicant filed a Form TM21B to delete its application in respect of the Class 29 goods, and to continue with the application only for the goods specified in Class 32;

(ii) The Applicant denies that the marks "are highly similar, or indeed similar";

(iii) It denies that the applied-for goods in Class 32 are identical, similar or complementary to the goods relied on by the Opponent;

(iv) The Applicant submits that the earlier mark MOO 2 YOU (figurative) possesses, at best, a low distinctive character in relation to the earlier goods - *milk drinks; smoothies; ice cream* – relied on by the Opponent;

(v) The Applicant submitted that there is no likelihood of confusion or association because "the low distinctive character of the mark moo 2 you is evident given the number of third-party moo 2 you-formative marks registered in classes 29 and 30 (among others), all coexisting in the UK trade marks register and in the marketplace";

(vi) It requested proof that the Opponent is the proprietor of the earlier trade mark and submitted that it is not John Edward Cowpe who is using the mark, but Moo 2 You Limited. It submitted that the opposition is unfounded because claims under sections 5(2)(b) and 5(3) must be brought by the proprietor of the earlier registered trade mark;

(vii) The applicant denied that the earlier mark is a mark with a reputation;

(viii) It requested proof of use of the earlier mark for the goods relied on.

5. The Applicant is represented in these proceedings by inbrandgible; the solicitor for the Opponent is Rob Kellock. During the evidence rounds, the Opponent filed evidence in chief and in reply; the Applicant filed evidence and written submissions. A hearing took place remotely via Teams video-conference on 17 May 2023. Jonathan King of counsel attended for the Opponent; Dale Campbell of inbrandgible attended for the Applicant. Both sides filed

skeleton arguments ahead of the oral hearing. I have read all the papers filed and refer to them where I consider it warranted to do so in this decision.

STATUTORY PROVISIONS

6. Sections 5(2)(b) and 5(3) of the Act are set out below, followed by other applicable provisions:

> **Section 5** A trade mark shall not be registered if because—
>
> **(2)(b)** it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> 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".
>
> **(3)** A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or 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.]

7. **Section 6** of the Act defines what is meant by an "earlier trade mark" for the purposes of section 5, and there is no dispute that the Opponent's trade mark registration No. 2424440 is an earlier trade mark, since its filing date predates that of the Applicant's contested application.

8. Under **section 6A** of the Act, since the Opponent's earlier mark had been registered for more than five years when the Applicant filed its contested application, the Opponent may rely on its earlier mark only to the extent that the use conditions are met. Section 6A provides that the use conditions are met if—

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

For these purposes—

- 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
- 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.
- 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.

9. The Applicant has requested that the Opponent prove its claimed use of the earlier mark. Section 100 of the Act makes it clear that the onus lies on the Opponent to provide evidence to support its claimed use during the relevant period and in the relevant territory.

10. The relevant period is the period of 5 years ending with the filing date of the application,[1] i.e. from **21 May 2016 to 20 May 2021**. The relevant territory is the United Kingdom.

MY APPROACH TO THE EVIDENCE AND CLAIMS

11. The substance of the grounds under sections 5(2) and 5(3) may only be considered if the Opponent's evidence satisfies the use provisions under section 6A of the Act. For the section 5(3) ground, the evidence of use must additionally bear out the Opponent's claimed reputation. The evidence of use therefore serves the discrete (if related) purposes of genuine use and reputation. I find it convenient to summarise the evidence filed and to draw conclusions and make findings at relevant points in dealing with the subsequent grounds.

1 Section 6A(1A) of the Act.

THE EVIDENCE

The Opponent's evidence in chief

12. The Opponent's evidence in chief comprises a witness statement by the Opponent himself, dated 22 August 2022. I note the following from his evidence:

Proprietor and Moo2You Limited

(i) Mr Cowpe confirms that he (the Opponent) is the proprietor of the earlier mark. He is a dairy farmer who started making ice cream in 1998, selling it both wholesale and directly to the public through his farm shop.

(ii) He has also been a director of Moo2You Limited since April 2016, and from its formation in February 2006 until April 2014, and is a person with significant control of that company, owning more than 25% of its shares and voting rights. He states that he traded as a sole trader as Moo2You before the incorporation of the company and has traded as Moo2You Limited since 2013.

(iii) Use of the mark by Moo2You Limited (and by his previous farm shop business) has always been with the consent of the Opponent. The position has since been formalised by way of signed formal agreement dated August 2022 licensing Moo2You Limited to use the mark with the permission of the Opponent.[2]

Goods sold

(iv) The witness states that Moo2You Limited sells ice-cream and milk shake mix,[3] and his customers are now "largely milkshake bars, ice cream parlours, hotels and restaurants."

(v) He states "we sell approximately 900 litres of milkshake mix a week and all our ice cream is branded "Moo2You", we don't sell under any other branding or make ice cream for other companies."

2 Exhibit JEC9
3 Paragraph 8 of Mr Cowpe's witness statement. Schedule 2 of the licence agreement identifies the goods as ice cream and milk shake mix.

(vi) **Exhibit JEC1** is said to show photographs of the trade mark used on the Opponent's product labelling. The photographs show a range of ice-creams bearing the earlier mark. It is not stated when the photographs were taken so it is not evident that they are from within the relevant period, but taken with the witness's narrative, which is framed in the present tense, I accept that the opponent's earlier mark is used on ice cream.

Turnover

(vii) The witness provides turnover figures for Moo2You Limited for each of the years 2017 – 2021, which range from around £190k – £285K. **Exhibit JEC2** shows the company's accounts that corroborate such figures for the sale of goods; the accounts identify the principal activity of the company as being the manufacture of ice cream.[4]

(viii) The witness states that "approximately 20% of its sales are for milkshake mix, the rest for ice cream".[5]

(ix) **Exhibit JEC3** shows 32 pages of sales invoices from Moo2You Limited, each invoice bearing the earlier mark. The invoices are addressed to towns and cities in the North West of England such as Preston, Clitheroe, Southport, Liverpool and Manchester, ranging in date from March 2018 to July 2022. Only the invoices from page 15 onwards are dated within the relevant period; all of those invoices relate to the sale of ice cream of various flavours and since some of the invoices are to the same customer such that it is only shown that seven different customers received invoices during the relevant period. Only one of the invoices is in respect of 80 x "MILK SHAKE BASE MIX 2.5 GALL" at a value of £640 net of VAT.[6] However, this sole invoice for milk shake mix is dated 10 December 2021, which is outside the relevant period.

Brand promotion

(x) The witness states that within the last five years the company has not spent money on advertising and relies on social media and "word of mouth reputation".

4 See for example page 4 of Exhibit JEC2.
5 Paragraph 8 of Mr Cowpe's witness statement.
6 Page 9 of Exhibit JEC3.

(xi) **Exhibit JEC4** shows a series of screenshots from the website moo2you.co.uk. The website does not appear to offer sales directly but invites trade customers to use Moo2You Limited as their supplier. The website refers to its offering ice-cream in a wide range of flavours and describes Moo2You as "one of the largest ice cream suppliers in the North-West" supplying "wholesale across the north of England and beyond". No other goods are specifically mentioned, though there is a reference in the website extracts to the company being able to "supply everything else you need to go with [ice cream]". The website screenshots are not dated, so it is not evident that their contents date from the relevant period and no information is provided about numbers of visitors to the site in the relevant period (or at all).

(xii) **Exhibit JEC5** shows the Moo2You Facebook page homepage, showing 254 followers. However, the page is not dated so it is not evident that it is from the relevant period, nor are any posts shown to have been made (let alone positively received). A second Facebook page is shown, which is said to be of a customer of Moo2You, promoting that customer's milkshakes, which the post states are "all made with Moo2You dairy ice cream". This latter Facebook page is dated 9 August 2022, which is after the relevant date. I find **Exhibit JEC5** to be of virtually nil evidential value.

(xiii) **Exhibit JEC7** shows pictures of the Moo2You mark on a promotional A-board sign, on a transit van belonging to the Opponent, and on freezers that are used by "some of our customers". No detail is discernible as to where, when or to what extent consumers will have been exposed to the mark by those means.

(xiv) **Exhibit JEC8** is a copy of Moo2You Limited's brochure, which the witness states is available to download from the company's website, and which is also available in print version. No details are given of when the brochure was made available or how many times it has been downloaded, or how widely or when it has been circulated in print form. What Exhibit JEC8 does show is that the content of the brochure is exclusively on ice cream. The brochure states (at page 10 of the exhibit): "We have everything you will need to retail our ice cream from cones, pots, topping sauce, flakes, scoops, etc... (Please see enclosed Price List for more information)." There is no reference to milk shake mix.

(xv) The witness also refers to routine attendance at trade shows and food festivals, and states that the goods have been "the official ice cream of the Blackpool Illuminations". He states "one recent major promotion was to supply ice cream to Virgin trains, who were giving it away to passengers who were delayed during a period of disruptions caused by ongoing works."[7] The detail of these references is insufficient to determine when and to what extent consumers were exposed to the mark.

Media and awards

(xvi) **Exhibit JEC6** shows the front cover of *Lancashire Magazine* from July 2008, which features the earlier mark. The article inside profiled Mr Cowpe and his farm shop offerings at that time and refers to "the home of Moo2You ice cream". No information is given about the circulation of that magazine and the article is anyway from quite some years ago.

(xvii) Mr Cowpe states "we have been members of the Ice Cream Alliance, the UK trade association for ice cream manufacturers and retailers for some 20 years" and that "our ice cream has won countless awards"[8] - however no further evidence of those awards is provided.

Evidence of confusion

(xviii) The witness states that on average the Opponent receives ten enquiries a month that in fact concern the goods of the Applicant. He states that this is perhaps unsurprising as a Google search for "Moo2You" has his company as results 1, 2 and 5-9, but results 3 and 4 are for the Applicant. (**Exhibit JEC10** shows such Google search.) He refers too to an articulated lorry arriving at his farm in 2021 with thousands of glass milk bottles destined for the Applicant.

The Applicant's evidence and submissions

13. The Applicant's evidence comes from a witness statement by Cristina Crossman, the Director of Moo2Yoo Ltd (the Applicant). Ms Crossman explains that the Applicant is a dairy farmer that sells milk from vending machines and also syrups to flavour drinks. The witness statement does little more than submit that there is no likelihood of confusion and no risk to

7 Paragraph 20 of his witness statement
8 Paragraph 16 of his witness statement

reputation “as a syrup is different to an ice-cream” and the parties have different commercial interests.

14. During the evidence rounds **submissions** were filed by the Applicant’s representative, from which I note the following points:

(i) Issues are raised regarding whether use by Moo2You Ltd has been ‘continuous’ as the Opponent had claimed. Exhibits CC1 and CC2 to Ms Crossman’s witness statement are extracts from the Companies House register indicating that Moo2You Ltd was dormant for a few years since the formation. However, since this relates to a period prior to 2015 it does not diminish the Opponent’s evidence of use during the relevant period. The submissions also question whether use by Moo2You Ltd (a legal entity separate from the Opponent) is relevant for assessing genuine use.

(ii) Criticisms are made of the evidence, much in line with the comments I have noted in my summary, such as that many exhibits are undated or are outside the relevant period, there is no advertising expenditure, no information on website access, a lack of granular detail, a near exclusive focus on ice cream etc. I have such criticisms in mind as I set down my assessment of genuine use.

(iii) There is elaboration of the Applicant’s position that the Opponent’s goods in evidence (ice cream) are not similar to the contested syrups - I will refer further where I compare the goods later in this decision.

ASSESSMENT OF GENUINE USE

15. I have previously set out the legislative provisions under section 6A of the Act relating to proof of use, and the evidential burden on the opponent under section 100. In determining what conclusions I may draw from the evidence filed, I bear in mind the principles of the law relating to genuine use of a registered trade mark summarised by Arnold J (as he then was), in *Walton International Ltd & Anor v Verweij Fashion BV.*[9] This summary includes, inter alia, that genuine use means actual use of the trade mark by the proprietor or a third party acting with consent to use the mark, and that such use must be by way of real commercial exploitation of the mark on the market, for the relevant goods or services, sufficient to create

9 [2018] EWHC 1608 (Ch), paragraphs 114 and 115 detail the summary in full.

or maintain a market share for those goods or services.[10] The use must be more than merely token, although there is no *de minimis* rule in relation to genuine use, but it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. The use must be consistent with the essential function of a trade mark which includes, for example, affixing the mark to the relevant goods in way that guarantees to the consumer that the goods come from a single undertaking which controls the manufacture of those goods, and which is responsible for their quality.

16. In determining whether there is real commercial exploitation of the mark, all the relevant facts and circumstances must be taken into account, which include: (1) 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; (2) the nature of the goods or services; (3) the characteristics of the market concerned; (4) the scale and frequency of use of the mark; (5) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (6) the evidence that the proprietor is able to provide; and (7) the territorial extent of the use.

17. A finding of genuine use does not depend on economic success or large-scale commercial use;[11] rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods and services.

18. While the onus is on the Opponent to have filed evidence of genuine use of its mark, I must consider what the evidential picture as a whole shows me, not whether each piece of evidence by itself shows genuine use.[12] Whilst there is no requirement for the Opponent to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council,*[13] the Appointed Person stated that:

> *22.* […] *if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of*

10 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.
11 *MFE Marienfelde GmbH v OHIM*, Case T-334/01.
12 *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.
13 Case BL O/236/13, paragraph 22 and 28.

use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

[…]

28. […] *Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered* […].*"*

19. Firstly, I am satisfied that to the extent that the evidence shows use of the earlier mark by Moo2Yoo Limited, such use has been with the consent of Mr Cowpe as the proprietor of the earlier mark, and director of that company. I am also satisfied that by the filing date of the contested application, the earlier mark had been used in respect of ice cream for at least 12 years.[14] Mr Cowpe states that during the five years of the relevant period sales total turnover exceeded £1 million, and this statement is corroborated by a range of invoices at **Exhibit JEC3**. Nearly all of the evidence relates to the sale of ice cream – the references in the livery of the company van(s), the branding of freezers, the branded tubs of ice cream, the website and brochure and so on. I find, based on the scale of the use over the relevant period, to businesses across towns and cities primarily in the North West of England, that the evidence in the round demonstrates genuine use in respect of ice cream.

20. In addition to *ice cream* (in Class 30), the Opponent's earlier mark is registered in respect of *milk drinks; smoothies* in Class 29. There is no evidence at all in respect of those goods as such, but there are references to "milk shake mix". Mr Cowpe states that approximately 20% of sales are for milk shake mix, selling around 900 litres of milk shake mix a week, but given Mr Cowpe's use of the present tense in those statements, it is not clear what level of sales were made during the relevant period. The single invoice that refers to milk shake mix is from after the relevant period and is of no assistance. Nor is it clear that the mix is sold

14 This is clear for instance from the 2008 cover of Lancashire Magazine at Exhibit JEC6.

by reference to the earlier mark; there are no images of the labelled milk shake and whereas Mr Cowpe states expressly that "all of our ice cream is branded 'Moo2You', we don't sell under any other branding or make ice cream for other companies", it is not clear that that statement extends to milk shake mix. Taking the evidence in the round, I find it to be insufficient to establish genuine use of the earlier mark in respect of milk shake mix; it is therefore not necessary for me to make a finding as to whether actual use in respect of "milk shake mix" could anyway be considered as actual use in respect of *milk drinks; smoothies*, the earlier specified goods in Class 29.

DECISION ON THE SECTION 5(2)(b) CLAIM

21. I turn next to consider whether the opposition succeeds based on the claim that the marks are similar and the goods are similar such that there is a likelihood of confusion.

22. An assessment under section 5(2)(b) is multi factorial and the claim must be determined in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.[15] The relevant principles are:

(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

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

his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

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

Comparison of the goods

23. Section 60A(1)(b) of the Act provides that for the purpose of the Act goods and services are not to be regarded as being dissimilar from each other on the ground that they appear in the different classes under the Nice Classification.

24. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[16]

i. the physical nature of the goods;

ii. their intended purpose;

iii. their method of use / uses;

iv. who the users of the goods and services are;

v. the trade channels through which the goods reach the market;

vi. in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

vii. whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);

viii. whether they are complementary to each other. Complementary has been described as meaning that *"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"*.[17] Complementarity is an autonomous criterion capable of being the sole basis for the

16 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

17 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

existence of similarity.[18] Complementarity may be distinguished from 'use in combination', where goods are merely used together, whether by choice or convenience but are not essential or important to one another's use such that they would be assumed to share a source.[19]

25. I bear in mind too that when interpreting terms in a specification that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"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"*.[20]

26. For the purposes of making a comparison, goods can be grouped together where the same reasoning applies.[21]

27. The goods to be compared are:

Contested goods of Applicant	Class 32: *syrup for beverages; syrups for milkshakes*
Goods on which Opponent can rely	Class 30: *ice cream*

28. The Applicant argued that "the curve of a relationship of similarity would be overstretched" if there were found to be similarity between all foodstuffs and beverages. I agree with that submission. For example, there would in my view be no similarity between say tonic water or cordial on the one side and cake or cauliflower on the other. However, in other circumstances, a finding of similarity between a foodstuff and a beverage may be legitimately sustained. For instance, in the appeal decision in *Monster Munch*,[22] the Appointed Person upheld a finding that "energy bars" (in Class 30) were "similar to at least a low degree" to the opponent's "non-alcoholic beverages, namely energy drinks" (in Class

18 *Kurt Hesse v OHIM, Case C-50/15 P*
19 As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13 - *"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."*
20 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
21 *Separode Trade Mark* BL O/399/10, paragraph 5
22 Case BL O/521/20, Professor Phillip Johnson sitting as the Appointed Person.

32). Shared factors identified by the hearing officer in that case had included intended purpose, end-user, channels of trade and the goods being in competition with each other. (I note that the same appeal decision found energy drinks to be dissimilar to "nut-based food bars".) Clearly assessment of similarity turns on the particulars of each case.

29. The Applicant submits that "syrups for beverages" are dissimilar to "ice creams" for want of sufficient relevant aspects in common.[23] The other contested goods are *syrups for milkshakes.* I find that the average consumer will understand a milkshake to be a beverage whose principal constituent is typically milk, to which some form of flavouring, sweeteners and perhaps other ingredients have been added and where the whole mixture has been agitated in some way so that it is thicker than simply flavoured milk. *Syrups for beverages* includes *syrups for milkshakes* and that the former, broader term does not appear to include any other syrups which are closer, so I will deal with the two terms together. I also bear in mind that the contested goods are neither beverages nor milkshakes, but *syrups* for those goods. I'll address the relevant factors from case law as I set out at my paragraph 24(i) – (viii) above.

Nature, intended purpose and method of use/uses

30. The Applicant submits that the goods are different in nature, intended purpose and method of use/uses. I agree. As the Applicant submits, syrups are typically water-based solutions containing high concentrations of sugar and usually also contain added flavours and colours. A syrup is a liquid sweetener that dissolves more quickly and easily than sugar, so it is used in beverages (including milkshakes). Syrups for beverages/milkshakes are goods drunk only when mixed with other components (such as milk); they are not for stand-alone consumption. Ice cream is a dairy product, and is typically eaten frozen as a consumable good in itself, as a dessert or snack; it is not liquid, but more solid notwithstanding that it begins to melt once served.

Users of the goods

31. The Applicant submits that the intended consumers of the goods are different. In my view, the average consumer for ice cream is the general public at large, though I acknowledge that businesses such as cafés, milk bars and restaurants may buy ice cream to sell to their

23 Paragraphs 29 – 34 of Applicant's submissions during evidence rounds, and 19 – 30 of Applicant's skeleton arguments.

own customers (the public at large). The average consumer for syrups for beverages/milkshakes will include members of the general public who wish to add those goods to a beverage (including milk) at home, as well as businesses such as cafés, milk bars and restaurants who wish to add those goods to prepare milkshakes or other drinks for their customers. Therefore, contrary to the Applicant's submission, the users / consumers of the goods are not different. However, in my view, the mere fact that the respective goods may be bought by the general public is not a sufficient basis to warrant a finding that those goods are similar; after all, the general public represents the average consumer for almost any goods offered for sale. While I acknowledge that a business (such as a café) may buy both ice cream (for onward sale) and syrups (as an ingredient component of a served beverage), I am not satisfied that that factor is sufficiently strong, in the face of far stronger counter-factors, to warrant a finding of similarity in this case.

Trade channels and location in stores

32. The parties filed no evidence on trade channels for syrups for beverages/milkshakes. The Opponent stated in evidence that he is a dairy farmer and has sold milk shake mixes (in litres and gallons weekly). I accept that evidence, notwithstanding that the evidential deficiencies in clarity - as I set out previously - as to the period of use and as to the mark under which those goods were sold were factors that led to my concluding against genuine use of those milk shake mixes. However, it is not clear from the evidence what is the nature and composition of a milk shake mix as sold by the Opponent - it is, for instance, not clear that it is a syrup or even involves syrups. While the Applicant is also a dairy farmer and demonstrates a commercial interest in syrups for beverages/milkshakes, I note that the Applicant argues such goods are not commonly produced by the same undertakings.[24] I decline to make a finding that the source of trade channels for ice cream and syrups for beverages/milkshakes are in general the same.

33. Ice cream is sold through various outlets – including ice cream parlours, cafés, theatres and restaurants from vans. Syrups for beverages/milkshakes are not sold from those outlets. Ice cream is also sold in supermarkets and even newsagents, but a great variety of goods are sold in such retail outlets. Ice cream will invariably be found in freezers. Syrups for beverages/milkshakes will not be in a freezer or the frozen section of a supermarket. Syrups

24 Paragraph 24 of Ms Campbell's skeleton argument.

for beverages/milkshakes are for use with beverages/milkshakes - not for use with ice cream; it is understandable therefore that syrups for beverages/milkshakes would not be sold alongside ice cream.

Competition

34. Syrups for beverages/milkshakes are not an alternative to ice cream. One is not chosen in preference over the other. They are not in competition.

Complementarity

35. Syrups for beverages/milkshakes are not important or indispensable to ice cream, nor vice versa. They cannot therefore be complementary. The fact that ice cream and syrups may both feature in milkshakes does not alter this. I accept Ms Campbell's argument that use in combination, where goods are merely used together, whether by choice or convenience is not sufficient for a finding of complementarity. Ms Campbell referred me to the decision of the General Court in *Naty's trade mark*,[25] from which I note the following extract:

> 34 "…. even if certain goods covered by the mark applied for, in particular jams, jellies, fruit and syrups, may be used as a filling for waffles, their use as such is optional and is absolutely not indispensable. The applicant has not shown how such products are indispensable for filled waffles within the meaning of the case-law referred to in paragraph 33 above, especially since, as the Board of Appeal correctly found in the contested decision, the products at issue are not presented on the same shelves or in the same areas of a supermarket.
>
> 35 The same applies to the applicant's argument that the goods covered by the trade mark application are an essential ingredient of the goods covered by the mark. The fact that such products may occasionally be present in filled waffles cannot suffice to conclude that the former and second products are similar, let alone very similar. According to the case-law, the mere fact that a given product is used as a part, equipment or component of another is not sufficient in itself to prove that the final products, including those components, are similar, since, inter alia, their nature, their intended purpose and the customers concerned may be quite different (judgment of 27 October 2005, Éditions

25 26/10/2011, T-72/10, Naty's, EU:T:2011:635

Albert René v OHIM — Orange (MOBILIX), T-336/03 [MOBILIX] ECR II-4667, paragraph 61).

36 It follows that the Board of Appeal correctly established that there was only a weak link of complementarity for some of the goods at issue. The applicant's argument that filled waffles are available with many toppings in the list of goods in Classes 29 and 30, covered by the application for the mark applied for, so that consumers could conclude that other products bearing a name almost identical to the name designating waffles come from the same undertaking cannot compromise that conclusion. Suffice it to note, in that regard, that the lack of similarity of the goods at issue excludes in itself any likelihood of confusion …"

36. Having considered all relevant factors concerning the goods, I find there is no similarity between them. Where there is no similarity, there is no likelihood of confusion to be considered.[26] In the circumstances, I need consider no further the merits of the parties' claims or submissions in relation to this ground.

37. **OUTCOME UNDER SECTION 5(2)(b):** The opposition under section 5(2)(b) fails because the goods are not similar.

THE SECTION 5(3) CLAIM

38. The statutory provision is set out at my paragraph 6 above. The Opponent claims that when the Applicant filed its trade mark application (20 May 2021 – "**the relevant date**"), the Opponent's earlier mark had a reputation in respect of Class 29: *milk drinks; smoothies* and Class 30: *ice cream*. Since I have found the evidence fails to establish genuine use in respect of Class 29: *milk drinks; smoothies*, this ground can proceed only on the basis of the claimed reputation for ice cream.

39. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: General Motors, C-375/97, EU:C:1999:408; *Intel Corporation Inc. v CPM United Kingdom Ltd*, C252/07, EU:C:2008:655; *Adidas-Salomon & Anor v Fitnessworld Trading Ltd*, C-408/01, Page 34 of 61 EU:C:2003:582; *L'Oréal v Bellure*, C-487/07, EU:C:2009:378); and

26 See for instance, Lady Justice Arden at paragraph 49 *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

Marks and Spencer v Interflora, C-323/09, EU:C:2011:604.. The law appears to be as follows:

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

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

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

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

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

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

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

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

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

40. The function and value of a trade mark are not confined to its being an indicator of origin of goods or services (which section 5(2)(b) safeguards); a trade mark can also convey messages, such as a promise or reassurance of quality or a certain image of, for example, lifestyle or exclusivity ('advertising function').[27] Section 5(3) aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided that it can be demonstrated that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

Reputation

41. Case law provides guidance on the assessment of whether a trade mark has a reputation:[28]
    i. It must have been known to a significant part of the relevant public at the relevant date:
    ii. The relevant public are those concerned by the products covered by the trade mark.
    iii. The relevant date is the date on which the defendant first started to use the accused sign.

27 Judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378
28 See Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC), reflecting principles previously set out inter alia by the Court of Justice of the European Union in *General Motors*, Case C-375/97.

iv. From a geographical perspective, the trade mark must have been known in a substantial part of the territory.

v. There is no fixed percentage threshold which can be used to assess what constitutes a significant part of the public; it is proportion rather than absolute numbers that matters. Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria.

vi. All relevant facts are to be taken into consideration when making the assessment, 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 undertaking in promoting it.

vii. The market for the goods or services in question, and from this the identity of the relevant public, ought to assume a paramount role in the assessment.

42. Whether or not reputation is made out is of course entirely dependent on the facts of a given case. In the appeal decision in the *Spirit Solar* case,[29] the opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in those proceedings and during the 5 years prior to the relevant date, had generated nearly £13m in income. There was in that case limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was <u>not</u> sufficient to establish a reputation for the purposes of section 5(3).

43. In the present case, taking the stated figures in full,[30] the turnover of the Opponent's company was around £250,000 annually during the relevant period, totalling around £1.2 million. These are not figures that indicate that the Opponent's earlier mark was known for ice cream by a significant part of the relevant public - the general public in the UK. I do not overlook that the witness states that by the relevant date, the earlier mark had been used in respect of ice cream for over two decades, but the evidence is not clear as to the scale or reach of that use. I note the extremely limited evidence of promotion of the goods and the admitted absence of expenditure on advertising. The witness refers to "countless awards"

29 *Spirit Energy Limited* v *Spirit Solar Limited* - BL O/034/20, Professor Phillip Johnson as the Appointed Person.
30 Though, as I have noted, the witness attributes only 80% of the sales income to ice cream.

for its ice cream, but that statement is without any detail or corroboration. The Opponent's ice cream is only shown to have been sold in places largely limited to the North West of England. While Manchester and Liverpool are large cities, there are no firm figures as to the numbers of different customers buying the ice cream, seemingly wholesale, from the Opponent. The invoices show only around seven different customers up to the relevant date. Nor does the evidence show the goods to have been sold for example in supermarkets where the public reach may have been greater. In my view the evidence of use satisfies neither the geographical aspect of the test nor the economic one, and is not sufficient to establish that the Opponent's earlier mark had a reputation in respect of ice cream at the relevant date.

44. Since I find that the Opponent's evidence has not established the claimed reputation, which is a required component of section 5(3), it follows that the claim must fail. In the circumstances it is not necessary for me to consider whether the necessary mental link would arise, nor the claimed bases of damage.

45. **OVERALL OUTCOME:** The opposition has failed under both grounds. The application may proceed to registration in respect of Class 32: *syrup for beverages; syrups for milkshakes*.

COSTS

46. The opposition has failed and the Applicant is entitled to a contribution towards its costs in defending its application. The costs are estimated in line with the scale set out in Tribunal Practice Notice 2/2016.

Considering the opponent's statement of case and preparing counterstatement - £200
Considering the other side's evidence and preparing response - £500
Preparing for and attending a hearing - £500
Total: £1200

47. I order John Edward Cowpe to pay Moo2Yoo Ltd the sum of £1200, to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 29th day of September 2023

Matthew Williams
For the Registrar