

O/0980/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03780418
BY ABDIRAHMAN ALI
TO REGISTER AS A TRADE MARK:**



IN CLASS 30

AND

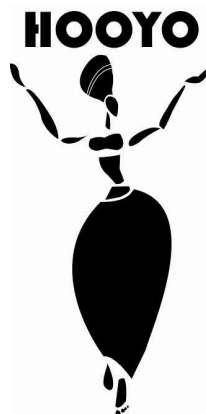
**OPPOSITION THERETO
UNDER NO. 60002560 BY
AMINA ELM I**

Background & Pleadings

1. Abdirahman Ali (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed on 23 April 2022 and was published on 29 July 2022 in respect of the following goods:

Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

2. Amina Elmi (“**the opponent**”) opposes (using the Fast Track provisions) the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the UK registration number 03483304 for the following mark:



4. Under Section 6(1) of the Act, the opponent’s mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent’s mark was

completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

5. The opponent, in her notice of opposition, claims that the competing marks are “extremely similar” for the same goods, giving rise to a likelihood of confusion.
6. The applicant filed a defence stating in his counterstatement that the marks are entirely different “in appearance, color, style, pronunciation.” However, the applicant did not address whether the competing goods in question are similar or dissimilar.
7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
8. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. No leave was sought to file any evidence in respect of these proceedings.
9. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
10. A hearing was neither requested nor was it considered necessary. Both parties filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this

decision. This decision has been taken following a careful consideration of the papers.

11. In these proceedings, the opponent is unrepresented, and the applicant is represented by United Legal Experts.

Preliminary Issues

12. In his submissions, the applicant raised that the opponent “did not provide any evidence of use or sales material which shows that the mark did not acquire distinctiveness through the use which is why applicant believes that the mark is descriptive.” However, it should be noted that the opponent was not required to submit evidence of use of the earlier mark in these fast-track proceedings. Moreover, the opponent has not made any claim regarding acquired distinctiveness, and this does not form part of the assessment I am required to conduct and will not be considered any further.
13. The applicant also submits that:

“The proprietor failed to provide "notice of threatened opposition" prior to filling [sic] of Opposition therefore, cannot request for any monetary relief.”

I note that such a contention is unfounded and without proper basis. According to Section 3 of the Trade Marks Manual and Rule 17(3) of the Trade Marks Rules 2008, the opponent can file a of Notice of Threatened Opposition (Form TM7a) when seeking to extend the opposition period to three months after the date of publication of the application. Yet, this is not applicable in this case since the opponent filed a Fast Track Opposition and Statement of Grounds (Form TM7F) within the initial two-month period, specifically on 26 September 2022, after the publication of the application. In any event, I note that the opponent is not precluded from seeking an award of costs in the present proceedings.

Decision

Section 5(2)(b)

14. Sections 5(2)(b) of the Act are as follows:

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

[...]

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

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

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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

16. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public 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 Goods

17. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. 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 complementary.”

18. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

19. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

22. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

23. Since the opponent’s specification is voluminous in nature, containing a wide range of terms from A to Z in relation to goods in Classes 29 and 30, I will not reproduce it here. Instead, this is annexed to this decision.

24. The applicant's goods are as follows:

Class 30: Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water).

25. The opponent, in her statement of grounds, claims that the goods are the same.

26. I note that the applicant, without putting forward a blanket denial for the competing specifications, is deemed to have accepted the opponent's contentions in relation to the competing terms.¹ Given the applicant's admission, strictly speaking, there is nothing for me to decide. That said, I will need to assess the degree of similarity between the goods.

27. The contested goods "*Coffee, tea, cocoa [...]; rice, pasta and noodles; bread, pastries and confectionery; sugar, honey, treacle; yeast; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments*" are identical to the opponent's, as they are either identically worded or ostensibly the same. Thus, I find them to be identical.

28. The contested terms "*tapioca and sago; baking-powder; [...] artificial coffee; flour and preparations made from cereals*" will be covered by the broad terms "*Vegetables; Mixes for making bakery products; coffee; flour*",

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

"The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

respectively, in the opponent's specification. Thus, I find them to be identical as per *Meric*.

29. The contested term "*chocolate*" is a broad term that would encompass the opponent's terms "*Preparations for making beverages [chocolate based]; Prepared desserts [chocolate based]*". Consequently, I find the respective goods to be *Meric* identical.
30. The contested specification contains the terms "*ice cream, sorbets and other edible ices*" for which, in my view, the closest comparable term in the earlier specification is "*Chilled dairy desserts*" in Class 29. I find that the competing goods are similar to a medium degree overlapping in nature, users, method of use, and trade channels, and there is a degree of competition.
31. Given the applicant's admission, although there is no close comparable term in the opponent's specification, the contested term "*ice (frozen water)*" is deemed to be similar to a low degree.

Average Consumer and the Purchasing Act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

"The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of

that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

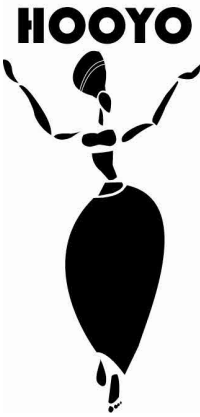

33. The goods at issue are various food or drink items, all of which would be purchased and consumed by the general public. These are inexpensive goods purchased through primarily visual means, most often selected from shops or supermarket shelves or on their online equivalents. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Whilst the average consumer will predominantly purchase them following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing them will be no more than average as the average consumer is likely to consider dietary requirements, flavour and/or nutritional information.

Comparison of Trade Marks

34. 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 Court of Justice of the European Union (“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.”

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

Opponent's Mark	Applicant's Mark
	

Overall Impression

37. The contested mark consists of the word elements “HOOYO” and “FOODS”, in white upper case font and standard typeface encased in a red oval shape. The word element “HOOYO” is the largest element, which is located in the centre of the mark, while “FOODS” appears smaller underneath it. Above the word “HOOYO”, there is the figurative element of a cup with a spoon significantly smaller than the verbal elements. I consider that the word element “HOOYO” will be the dominant element having the greatest weight in the overall impression due to its size and position in the mark. The word “FOODS” and the device have descriptive qualities of the goods, playing a secondary role in the overall impression. I do not consider that the decorative white lines together with the red oval shape will play any role in the overall impression as they will be ignored by the average consumer.

38. The earlier mark consists of the word element “HOOYO”, appearing at the top of the mark in a black font and upper case. Underneath it, there is a device of a female figure with the hands extending across the word element. The figurative element and the verbal element “HOOYO” make a roughly equal contribution and have the greatest weight in the overall impression. I note that the word element “HOOYO” will be more distinctive as the eye will also be drawn to the verbal element of the mark as the average consumer more easily refers to marks by the word than by describing a figurative element.²

Visual Comparison

39. The competing marks share the same dominant word element “HOOYO”. The presence/absence of the additional verbal element “FOODS” and the figurative elements in the competing marks are points of visual differences. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a medium degree.

Aural Comparison

40. The competing marks share the same word element, “HOO-YO”, with the same number of syllables. The presence of the additional verbal element “FOODS” in the contested mark, which have less weight in the overall impression, create an aural difference in the case where the average consumer attempts to verbalise it. However, I do not consider that the figurative elements, including the female figure, in the earlier mark will be articulated. Thus, I find that the marks are aurally similar to a high degree (though lower than a high degree where the word “FOODS” is spoken).

² *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

Conceptual Comparison

41. The opponent submitted that the earlier mark is:

“representative of a Somali woman, in Somali dress, holding the Somali word for mother “hooyo”. Everything about this trademark is about this ethnicity.”

42. The applicant submitted that:

“The word HOOYO has a literal meaning in the Somali language as **“Mother”**, therefore the word HOOYO is weak in this matter, hence create no likelihood of confusion. The dominant part of the Opponent mark is BIG BEE which is of a big size and hide the word impression of HOOYO, whereas the Applicant mark comprises of oval shape with multiple colors.”

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

44. Both parties agree to the meaning of the common word “HOOYO” in Somali language. Although it is possible that some consumers who are more versed in the Somali language would understand the meaning of the word, I am unconvinced that this would be the case for the vast majority of consumers in the UK. To my mind, it is more reasonable to find that the average consumer would have no understanding of the word in English. Thus, it is my view that it may be perceived as a foreign or an invented word. Similarly, I do not consider that a significant proportion of the UK consumers would immediately conceptualise the figurative element in the earlier mark as being a Somali woman in a Somali dress or a BIG BEE. Instead, it is my view that they would most likely conceptualise it as a generic female figure. Further, the contested mark contains the word

element “FOODS” and the cup device, which could be perceived as descriptive of the applicant’s products, namely foodstuff items. Taking into account the above and the overall impressions, I find that the marks are conceptually dissimilar.

Distinctive Character of the Earlier Trade Mark

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

46. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent

distinctive character, such as invented words which have no allusive qualities.

47. The opponent did not file evidence and so I only need consider the inherent distinctiveness of the earlier mark. The earlier mark consists of the word element “HOOYO”, which will be seen as an invented or foreign word by the vast majority of the UK consumers. I find that the inherent distinctiveness of the mark to be of a high degree, boosted slightly by the female figure device.

Likelihood of Confusion

48. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.³ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁴
49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

³ See *Canon Kabushiki Kaisha*, paragraph 17.

⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

50. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁵

51. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

52. In *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities

⁵ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

previously established (see, to that effect, Case C-16/06 *P Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

53. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“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).”

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.”

54. Earlier in this decision I have concluded that:

- the competing goods at issue are identical or similar ranging from medium to low degree;
- the average consumer for the goods at issue will be a member of the general public, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid will be no more than average;
- the competing marks are similar visually to a medium degree, aurally to a high degree (though lower than a high degree where the word “FOODS” is spoken), and conceptually dissimilar;
- the earlier mark has a high degree of inherent distinctiveness, boosted slightly by the device.

55. Taking into account the above factors and considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding the principle of imperfect recollection, the average consumer would not overlook the presence/absence of the prominent female figure device by virtue of its position and size in the opponent’s mark. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.

56. Nevertheless, I consider the marks would be indirectly confused. Having identified that the marks are different, the consumers will assume that the respective marks originate from the same or economically linked undertakings. This is because both marks contain the identically shared

word element “HOOYO” which is the dominant and distinctive element in both marks with the greatest weight in the overall impression. Although the applicant’s mark includes the non-distinctive and descriptive word element “FOODS” and the cup device, the average consumer may perceive the mark as a sub-brand or brand extension of the opponent’s mark. In these circumstances, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. As a result, I find there is a likelihood of indirect confusion. This finding extends to the competing goods which I found to be similar at any degree.

Outcome

57. The opposition under Section 5(2)(b) of the Act is **successful in its entirety**. Therefore, subject to appeal, the application will be refused.

Costs

58. The opponent has been successful and is entitled to a contribution towards her costs. The opponent was not professionally represented and was invited to submit a completed cost proforma to the Tribunal, outlining the number of hours spent on these proceedings.
59. On 10 October 2023, the opponent submitted a pro-forma for an award of costs. I have set out below my assessment on the claim made. However, it should be noted that a costs award is intended to be a contribution towards costs rather than full compensation. I will make the award of costs on the basis of £19.00 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).
60. The opponent claimed the following:

- 1 hour for filing her notice of opposition; 2 hours for considering forms filed by the other party. I believe that these claims are reasonable.
- The opponent has claimed a total of 7 hours for filing submissions and considering those of the other party. Taking into account the length of both parties' submissions, I consider that it would be excessive to make an award for all the hours claimed. Therefore, I award 4 hours in total.

61. I therefore award costs to the opponent on the following basis:

Official filing fee (TM7F)	£100
Time spent on notice of opposition (1 hour)	£19
Time spent considering forms filed by the other party (2 hours)	£38
Filing submissions and considering those of the other party (4 hours)	£76
Total (7 hours + filing fee)	£233

62. I, therefore, order Abdirahman Ali to pay Amina Elmi the sum of £233. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of October 2023

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General

Annex

Opponent's Specification

Class 29: Animal fats for food; Beans; Beef; Beef fat; Beef meatballs; Beef slices; Beef steaks; Beverages having a milk base; Blended oil [for food]; Blended oil for food; Boiled and dried fish; Boiled potatoes; Bottled cooked meat; Bottled fish; Bottled fish products; Bottled vegetables; Broth; Broth concentrates; Broth [soup]; Canned beans; Canned cooked meat; Canned fish; Canned meat; Canned pulses; Canned soups; Carrots; Chicken; Chicken balls; Chicken breast fillets; Chicken burgers; Chicken croquettes; Chicken jerky; Chicken legs; Chicken meatballs; Chicken nuggets; Chicken pieces; Chicken salad; Chicken sausages; Chicken stock; Chicken wings; Chilled dairy desserts; Chilled foods consisting predominately of fish; Chilled meals made from fish; Chilli beans; Codfishes, not live; Cods [not live]; Cods, not live; Coleslaw; Compote; Compotes; Concentrates (Bouillon -); Concentrates (Broth -); Condensed tomatoes; Cooked chicken; Cooked fish; Cooked meals consisting principally of fish; Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Cooked seafood; Cooked vegetables; Cooking fats; Cooking oil; Cooking oils; Cows' milk; Dairy desserts; Dairy products; Dairy products and dairy substitutes; Dairy puddings; Dairy spreads; Dairy-based beverages; Dates; Deep frozen chicken; Deep-frozen poultry; Dehydrated chicken; Dehydrated vegetables; Desserts made from milk products; Desserts of yogurt; Dishes of fish; Dried beans; Dried beef; Dried dates; Dried fish; Dried fish meat; Dried lentils; Dried meat; Dried okra; Dried pulses; Dried vegetables; Drinking yoghurt; Drinking yoghurts; Drinking yogurts; Drinks based on yoghurt; Drinks based on yogurt; Drinks made from dairy products; Edible fat-based spreads for bread; Edible fats; Evaporated milk; Extra virgin olive oil; Extra virgin olive oil for food; Extracts for soups; Extracts of meat; Extracts of poultry; Extracts of vegetables [juices] for cooking; Extra-virgin olive oil; Fish; Fish balls; Fish, canned; Fish extracts; Fish (Food products made from -); Fish in olive oil; Fish paste; Fish, preserved; Fish preserves; Fish products being frozen; Fish products prepared for human consumption; Fish (Salted -); Fish steak; Fish steaks; Fish stock; Fish, tinned; Fish-based foodstuffs; Fishmeal for human consumption; Flavoured milk; Flavoured milk beverages; Flavoured oils; Food products made from fish; Foods made from fish; Foods prepared from fish; Freeze-dried meat; Fresh chicken; Fresh meat; Fresh poultry; Fried chicken; Fried meat; Frozen appetizers consisting primarily of chicken; Frozen appetizers consisting primarily of seafood; Frozen chicken; Frozen cooked fish; Frozen fish; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of fish; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat; Frozen meat products; Frozen poultry; Frozen pre-packaged entrees consisting primarily of seafood; Frozen prepared meals consisting principally of vegetables; Frozen seafood; Frozen vegetables; Fruit marmalade; Fruit preserves; Fruit, processed; Fruit-based concentrate for cooking; Fruit-based fillings for cakes and pies; Garlic butter; Garlic paste; Garlic [preserved]; Garlic-based spreads; Ghee; Goat cheese; Goat milk; Grilled chicken (Yakitori); Grilled fish fillets; Grilled vegetables; Ground

meat; Hummus; Instant soup; Jams; Juices (Vegetable -) for cooking; Kefir [milk beverage]; Lamb products; Lamb skewers; Legume salads; Legume-based snacks; Legume-based spreads; Lemon spread; Lentils; Lentils, preserved; Liver; Liver pastes; Liver pate; Liver pâté; Meat; Meat and meat products; Meat burgers; Meat, canned; Meat extract; Meat extracts; Meat, frozen; Meat paste; Meat, preserved; Meat [preserved]; Meat preserves; Meat products being in the form of burgers; Meat spreads; Meat stocks; Meat, tinned; Meat, tinned [canned (Am.)]; Meatballs; Meat-based snack foods; Meats; Meats (Salted -); Milk beverages; Milk drinks; Milk-based beverages containing coffee; Milk-based snacks; Minced meat; Mincemeat [chopped meat]; Mixed vegetables; Mixes for making broths; Mixes for making soup; Noodle soup; Oils and fats; Oils and fats for food; Oils for food; Olive oil; Olive oil for food; Olive oils; Pâté (Liver -); Peeled potatoes; Peeled tomatoes; Peeled vegetables; Poultry; Poultry extracts; Poultry meatballs; Poultry, not live; Poultry salads; Powdered goat milk; Powdered milk for food purposes; Pre-cooked curry stew; Pre-cooked soup; Pre-cut vegetable salads; Pre-cut vegetables for salads; Preparations for making broths; Preparations for making soup; Preparations for making soups; Preparations for making yoghurt; Prepared beef; Prepared dishes consisting primarily of fishcakes, vegetables, boiled eggs, and broth (oden); Prepared dishes consisting principally of meat; Prepared dried fruit mixes; Prepared fish dishes; Prepared fruits; Prepared meals consisting primarily of chicken; Prepared meals consisting primarily of fish; Prepared meals consisting primarily of kebab; Prepared meals consisting primarily of meat; Prepared meals consisting primarily of meat substitutes; Prepared meals consisting primarily of poultry; Prepared meals consisting primarily of vegetables; Prepared meals consisting principally of vegetables; Prepared meals containing [principally] chicken; Prepared meals made from meat [meat predominating]; Prepared meals made from poultry [poultry predominating]; Prepared meat; Prepared meat dishes; Preserves of poultry; Processed beans; Processed dates; Processed fish; Processed fish products for human consumption; Processed fruits, fungi, vegetables, nuts and pulses; Processed lamb; Processed legumes; Processed lemons; Processed meat; Processed meat products; Processed tomatoes; Processed vegetables; Ready cooked meals consisting primarily of chicken; Ready cooked meals consisting primarily of meat; Ready cooked meals consisting primarily of poultry; Ready cooked meals consisting primarily of turkey; Ready cooked meals consisting wholly or substantially wholly of meat; Ready cooked meals consisting wholly or substantially wholly of poultry; Roast beef; Roast beef flavoured extract; Roast chicken; Roast lamb; Roast meat; Roast poultry; Roast turkey; Salmon [not live]; Salmon, not live; Salted fish; Salted meat; Salted meats; Sea basses [not live]; Sea basses, not live; Sea bream, not live; Sheep milk; Smoked fish; Smoked meats; Smoked salmon; Soup; Soup concentrates; Soup cubes; Soup mixes; Soup pastes; Soup powders; Soup (Preparations for making -); Soup preparations (Vegetable -); Soups; Soups and stocks, meat extracts; Spiced nuts; Spiced oils; Steaks of fish; Steaks of meat; Stock; Stock cubes; Stock in the form of granules; Stock [prepared]; Tagine [prepared meat, fish or vegetable dish]; Tahini; Tahini [sesame seed paste]; Tajine [prepared meat, fish or vegetable dish]; Tinned fish; Tinned fruits; Tinned meat; Tinned meats; Tinned tomatoes; Tinned vegetables; Tomato concentrates [puree];

Tomato extracts; Tomato juice for cooking; Tomato paste; Tomato preserves; Tomato purée; Tomatoes [preserved]; Tuna fish; Tuna fish [not live]; Tuna fish, not live; Tuna fish [preserved]; Tuna in oil; Tuna, not live; Turkey; Turkey burger patties; Turkey burgers; Turkey meat; Turkey pieces; Turkey products; Vegetable oils for food; Vegetable pastes; Vegetable pate; Vegetable powders; Vegetable preserves; Vegetable puree; Vegetable purees; Vegetable salads; Vegetable soup preparations; Vegetable spreads; Vegetable stock; Vegetables, canned; Vegetables, cooked; Vegetables, dried; Vegetables (Prepared -); Vegetables, preserved; Vegetables preserved in oil; Vegetables, processed; Vegetables, tinned; Vegetables, tinned [canned (Am.)]; Yoghurt; Yoghurt based drinks; Yoghurt beverages; Yoghurt desserts; Yoghurt drinks; Yoghurt made from goats milk; Yoghurt-based beverages; Yoghurts; Yogurt; Yogurt drinks; Yogurt-based beverages.

Class 30: Barbecue sauce; Beverages made of tea; Beverages (Tea-based -); Beverages with a tea base; Beverages with tea base; Bibimbap [rice mixed with vegetables and beef]; Biscuits; Black tea; Black tea [English tea]; Bread flavored with spices; Bread flavoured with spices; Breads; Brown rice; Brown sauce; Brown sugar; Canned pasta foods; Canned sauces; Cappuccino; Carbonated and non-carbonated tea based beverages; Chicken gravy; Chicken pies; Chili oil for use as a seasoning or condiment; Chili oils being condiments; Chili paste for use as a seasoning; Chili pepper paste being condiment; Chili pepper pastes being condiments; Chili powder; Chili powders; Chili sauce; Chili seasoning; Chili seasonings; Chutney; Chutneys; Chutneys [condiment]; Chutneys [condiments]; Cinnamon; Cinnamon powder [spice]; Cinnamon [spice]; Clove powder [spice]; Cloves; Cloves [spice]; Coffee; Coffee bags; Coffee based beverages; Coffee based drinks; Coffee based fillings; Coffee beans; Coffee beverages; Coffee beverages with milk; Coffee extracts; Coffee flavorings; Coffee, teas and cocoa and substitutes therefor; Concentrated sauce; Condiments; Condiments in powder form; Cooked rice; Cooked rice mixed with vegetables and beef (bibimbap); Cooking sauces; Coriander, dried; Curried food pastes; Curry mixes; Curry paste; Curry pastes; Curry powder; Curry powder [spice]; Curry powders; Curry sauces; Curry [seasoning]; Curry [spice]; Curry spice mixes; Curry spices; Dessert puddings; Dough; Dough flour; Dough for cakes; Dough mix; Dried cooked-rice; Dried coriander; Dried coriander for use as seasoning; Dried coriander seeds for use as seasoning; Dried cumin seeds; Dried herbs; Dried herbs for culinary purposes; Dried noodles; Dried pasta; Dried pasta foods; Dried sauce in powder form; Dry and liquid ready-to-serve meals, mainly consisting of pasta; Dry and liquid ready-to-serve meals, mainly consisting of rice; Dry condiments; Dry seasoning mixes for stews; Dry seasonings; Edible salt; Edible spices; Edible turmeric; Fish sauce; Flavorings [flavourings], other than essential oils, for beverages; Flavorings [flavourings], other than essential oils, for cakes; Flavourings and seasonings; Flavourings for beverages; Flavourings for foods; Flavourings for soups; Flavourings for soups [other than essential oils]; Flavourings in the form of concentrated sauces; Flavourings in the form of dehydrated sauces; Flavourings made from fish; Flavourings made from fruits; Flavourings made from meat; Flavourings made from poultry; Flavourings of lemons; Flavourings of tea;

Flavourings of tea for food or beverages; Flour; Flour of rice; Fresh bread; Frozen pastries; Frozen pastry; Frozen pastry sheets; Frozen pastry stuffed with meat; Frozen pastry stuffed with meat and vegetables; Frozen pastry stuffed with vegetables; Frozen prepared rice; Frozen prepared rice with seasonings; Frozen prepared rice with seasonings and vegetables; Garden herbs, preserved [seasonings]; Garlic powder; Ginger paste [seasoning]; Ginger [powdered spice]; Ginger puree [condiment]; Ginger [spice]; Gravy; Gravy mixes; Hot chili bean paste; Hot chili pepper sauce; Hot pepper powder [spice]; Hot sauce; Instant black tea; Instant rice; Instant tea; Instant tea [other than for medicinal purposes]; Instant yeast; Mate [tea]; Meals consisting primarily of pasta; Meals consisting primarily of rice; Meat gravies; Meat pies; Meat pies [prepared]; Meat tenderizers, for household purposes; Meat tenderizers for household purposes; Mixed flour for food; Mixed spice powder; Mixed spices; Mixes for making bakery products; Mixes for making cakes; Mixes for making puddings; Mixes for preparing sauces; Mixes for the preparation of bread; Naan bread; Nan bread; Natural honey; Noodle-based prepared meals; Noodles; Paprika; Pasta; Pasta containing eggs; Pasta containing fillings; Pasta containing stuffings; Pasta dishes; Pasta for soups; Pasta products; Pasta salad; Pasta sauce; Pasta sauces; Pasta-based prepared meals; Pastries; Pastries, cakes, tarts and biscuits (cookies); Pastries consisting of vegetables and fish; Pastries consisting of vegetables and meat; Pastries consisting of vegetables and poultry; Pastries containing creams; Pastries containing creams and fruit; Pastries containing fruit; Pastries filled with fruit; Pastries with fruit; Pastry; Pastry cases; Pastry dough; Pastry mixes; Pepper; Pepper powder [spice]; Pepper sauces; Pepper spice; Pepper vinegar; Peppercorns; Pitta bread; Powdered sugar; Pre-packaged lunches consisting primarily of rice, and also including meat, fish or vegetables; Preparations for making bakery products; Preparations for making beverages [chocolate based]; Preparations for making beverages [cocoa based]; Preparations for making beverages [coffee based]; Preparations for making beverages [tea based]; Preparations for making gravy; Preparations for making sauces; Preparations for making up into sauces; Prepared desserts [chocolate based]; Prepared desserts [confectionery]; Prepared desserts [pastries]; Prepared foodstuffs in the form of sauces; Prepared meals consisting primarily of pasta; Prepared meals consisting primarily of rice; Prepared meals containing [principally] pasta; Prepared meals containing [principally] rice; Prepared pasta; Prepared rice; Prepared rice dishes; Preserved herbs; Processed garlic for use as seasoning; Processed grains; Processed herbs; Puddings; Ready-made baking mixtures; Rice; Rice based dishes; Rice mixed with vegetables and beef [bibimbap]; Rice mixes; Rice-based prepared meals; Rice-based pudding dessert; Salad dressing; Salad dressings; Salad dressings containing cream; Salad (Dressings for -); Salad sauces; Salsa; Salsa sauces; Salsas; Samosas; Sauce [edible]; Sauce mixes; Sauce powder; Sauce powders; Sauce (Tomato -); Sauces; Sauces [condiments]; Sauces containing nuts; Sauces flavoured with nuts; Sauces for barbecued meat; Sauces for chicken; Sauces for frozen fish; Sauces for pasta; Sauces for use with pasta; Savory food flavourings for food [other than essential oils]; Savory sauces; Savory sauces, chutneys and pastes; Savory sauces used as condiments; Savoury pancake mixes; Savoury pancakes; Savoury sauces; Seasoned coating for meat, fish, poultry;

Seasoning marinade; Seasoning mixes; Seasoning mixes for stews; Seasonings; Skin for spring rolls; Skin [pastry] for spring rolls; Spaghetti; Spaghetti and meatballs; Spaghetti sauce; Spaghetti [uncooked]; Spaghetti with meatballs; Spice extracts; Spice mixes; Spice preparations; Spice rubs; Spiced salt; Spices; Spices in the form of powders; Spicy sauces; Spring rolls; Sriracha hot chili sauce; Steamed rice; Stew seasoning mixes; Syrup for food; Tea; Tea bags; Tea bags for making non-medicated tea; Tea bags (Non-medicated -); Tea based beverages (Non-medicated -); Tea beverages; Tea beverages (Non-medicated -); Tea for infusions; Tea leaves; Tea mix powders; Tea mixtures; Tea-based beverages; Teas; Tomato based sauces; Tomato sauce; Turmeric for food; Vegetable concentrates used for seasoning; Vegetable pastes [sauces]; Vegetable pulps [sauces - food]; Vegetable purees [sauces]; Vermicelli; Vermicelli [noodles]; Vermicelli (Ribbon -); Wholemeal pasta; Wholemeal rice; Wild rice [prepared]; Yeast; Yeast extracts for food; Aerated beverages [with coffee, cocoa or chocolate base]; Allspice; Artichoke sauce.