

BL O/1148/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION



NOS.UK00003698329

AND UK00003698369



IN CLASS 30

IN THE NAME OF INTERNATIONAL FOODSTUFFS CO. LLC (“APPLICANT/RESPONDENT”)

AND CONSOLIDATED OPPOSITION NOS. OP000431144 AND OP000431145 THERETO
BY NOMAD FOODS EUROPE LIMITED (“OPPONENT/APPELLANT”)

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF
MS. LEISA DAVIES (O/0139/23) DATED 8 FEBRUARY 2023

International Foodstuffs Co LLC was represented by
Ms Jacqueline Reid of Counsel, Instructed by Fox Williams LLP

Nomad Foods Europe Limited was represented by
Ms Stephanie Taylor of Bristows LLP

Hearing date: 13 July 2023.

Introduction

1. This is an appeal by Nomad Foods Europe Limited (“the Opponent”) against decision BL O/139/23 of Ms Leisa Davies, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 8 February 2023.



2. The Applicant’s applications Nos. UK00003698329 and UK00003698369



were both filed on 21 September 2021 with priority dates of 10 August 2020 and a common specification of “ice creams” in class 30 (“the Contested Marks”).

3. The applications were opposed by the Opponent based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Whilst there was an appeal against the Decision in respect of S. 5(3) this was dropped at the Hearing. As for S. 5(2)(b), this provides as follows:

5 Relative grounds for refusal of registration.

...

(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

4. The Opponent relied on the following Earlier Trade Marks (table taken from the Hearing Officer's decision):

(i) UKTM no. 905740238 IGLO

Filed: 7 March 2007

Registered: 25 February 2008

Class 29 & 30

(ii) UKTM no. 909314261 IGLO

Filed: 13 August 2010

Registered: 19 October 2012

Classes 29 & 30

The specifications are reproduced in full in the Annex.

5. Both of the Earlier Trade Marks relied on had completed the registration process more than 5 years before the publication of the Contested Marks. The Applicant exercised its option to require the Opponent to prove that the Earlier Marks had been put to genuine use. Without such evidence, the Opponent could not rely on the Earlier Trade Marks.
6. Only the Opponent filed evidence. Neither party requested to be heard on the matter at first instance but both parties filed submissions in lieu of a hearing.
7. After considering the papers the Hearing Officer dismissed the Oppositions in full.

8. On 8 March 2023 the Opponent filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.
9. No Respondent's Notice was filed.

The Hearing Officer's Decision

10. In summary, the Hearing Officer decided (to the extent relevant to this appeal) as follows:
 - a) That the Opponent had only proved genuine use of the Earlier Trade Marks, and thus could only rely on them, for the following fair specification:

Class 29: Meat, fish, poultry; frozen prepared meals; chilled foods consisting predominately of fish; chilled meals made from fish; cooked meals consisting principally of fish; fish cakes; frozen fish cakes; fish fillets; frozen fish fillets; fish fingers; frozen fish fingers; fish products; fish products being fresh; fish products being frozen; fish products being preserved; fish with chips; frozen cooked fish; frozen fish; frozen prepared meals consisting principally of fish; pre-cooked dishes incorporating [predominantly] fish; processed fish; frozen scampi; steaks of fish; frozen steaks of fish; chicken; chicken pieces; chicken products; cooked chicken; frozen chicken; deep frozen chicken; fried chicken; frozen fried chicken; prepared meals containing [principally] chicken; chicken nuggets; frozen prepared meals consisting principally of chicken; garden peas; frozen peas; vegetarian frozen foods; frozen prepared meals consisting principally of vegetables; frozen vegetables; frozen vegetables packed in single portions; burgers; frozen burgers; meat burgers; frozen meat burgers; meat products being in the form of burgers; vegetable burgers; frozen vegetable burgers; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals consisting wholly or substantially wholly of fish; frozen ready cooked meals consisting wholly or substantially wholly of fish; ready cooked meals consisting wholly or substantially wholly of meat; frozen ready cooked meals consisting wholly or substantially wholly of meat; ready cooked meals consisting wholly or substantially wholly of poultry; frozen ready cooked meals consisting wholly or substantially wholly of poultry; ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready meals;

Class 30: deep frozen pasta; ready cooked meals consisting wholly or substantially wholly of pasta; frozen ready cooked meals consisting wholly or substantially wholly of pasta.

- b) As regards the oppositions under S. 5 (2) (b) the parties' goods were dissimilar.
- c) Consequently, without assessing the other elements relevant to a likelihood of confusion, the oppositions under S. 5 (2) (b) failed.
- d) As the unsuccessful party, the Opponent was ordered to pay costs of £1400.

Grounds of Appeal

11. The Grounds of Appeal pursued at the Appeal hearing were, in summary, as follows:

Proof of Use/Fair Specification

- 1) The Hearing Officer wrongly concluded that the IGLO mark had not been put to genuine use relation to desserts and puddings, which goods should have been retained in the fair specification.

S. 5 (2) (b)

- 2) Even allowing for the fair specification settled on by the Hearing Officer, they wrongly concluded that the goods relied on by the Opponent were dissimilar to the goods covered by the Applications.

"General flaws"

- 3) The Hearing Officer had failed to assess the similarity of the marks at issue at any point in the Decision when assessing the grounds of opposition under Sections 5(2)(b).
- 4) The Hearing Officer erroneously failed to consider the Earlier Trade Marks' inherent and enhanced distinctive character.
- 5) The Hearing Officer ought to have followed equivalent EUIPO Decisions between the parties which were favourable to the Opponent.

Standard of Review

12. I did not detect any divergence between the parties as to the applicable standard and principles, the core being that an appeal is by way of review, not re-hearing. Numerous cases set out the standard and authorities in equally numerous and occasionally nuanced ways. Ms Reid referred me in particular to the judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24], which I also consider to be an appropriate summation:

“24. Although I was referred to numerous cases on the subject the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing;
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible";
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi- factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions.
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible;

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account.

13. I keep these principles in mind.

Merits

Proof of Use & Fair Specification

14. The Opponent accepted the Hearing Officer had instructed herself properly on the law and principles but submitted that the Hearing Officer had erred or was wrong in their application to, and in their interpretation and analysis of, the evidence of use as regards "desserts and puddings".

15. The Opponent approached this in two ways. First, criticizing the Hearing Officer's interpretation of specific parts of the evidence, so I shall deal with those issues first simply to dispose of them.

16. The Opponent had put forward narrative and exhibit evidence from a Ms Rosanna Darcy and the Hearing Officer reviewed it at [8-33]. Ms Darcy's uncontested evidence included:

- a) pictures from websites illustrating dessert-style and many other goods in various EU territories.

- b) Sales figures for, amongst other goods, “desserts/puddings” in the Netherlands/Germany.
- c) Market value/share for “frozen fish and seafood” in the EU.
- d) EU market share/value for the business as a whole.
- e) Invoices copies said by Ms Darcy to relate to sales in “Germany, Belgium and the Netherlands”.
- f) Press releases

Witness’s Exhibit 4 – Fish and Seafood Sector Market Share

17. First, it was said that the Hearing Officer failed to understand and properly take into account this table of the Opponent’s market share/value in the “frozen fish and seafood sector” included as Exhibit 4 Ms Darcy’s evidence:

- P9 2019 Nielsen/IRI data showing the Opponent’s market value and market share in the Frozen Fish & Seafood sector. Data for Austria, Belgium, Germany, the Netherlands and Portugal show market share and value under the IGLO brand.

Period Ending: P09 2019	Market Value Sales €		Nomad Value Sales €		Nomad Value Share	
	Size	% Δ vs YA	Size	% Δ vs YA	Share %	Share Δ p
	Latest 52wks	52wks	Latest 52wks	52wks	52wks	52wks
Austria	135,426,822	-1.0%	59,463,645	5.8%	43.9%	2.8pp
Belgium	210,007,981	-1.6%	27,904,091	1.1%	13.3%	0.3pp
France	772,875,841	-3.0%	185,843,579	1.9%	24.0%	1.2pp
Germany	1,281,449,858	2.1%	276,167,809	5.2%	21.6%	0.6pp
Ireland	26,226,605	-5.3%	8,126,017	-9.0%	31.0%	-1.2pp
Italy	1,026,915,828	1.2%	321,653,226	1.4%	31.3%	0.1pp
Netherlands	156,515,538	-2.8%	41,639,808	8.4%	26.6%	2.7pp
Norway	164,775,809	-0.8%	67,440,579	-6.3%	40.9%	-2.4pp
Portugal	294,794,272	5.0%	22,074,572	-11.0%	7.5%	-1.3pp
Spain	1,112,209,032	5.1%	8,270,789	-10.4%	0.7%	-0.1pp
Sweden	274,527,282	5.0%	64,397,101	7.0%	23.5%	0.5pp
UK	780,411,477	-0.5%	184,023,134	-0.3%	23.6%	0.0pp
Category Footprint	6,236,136,345	1.3%	1,267,004,350	1.8%	20.3%	0.1pp

18. The Hearing Officer said of this table:

“16. I am unclear as to why some figures are displayed as a negative or highlighted in red. No information or explanation is given to interpret the figures and the difference

between market value sales and Nomad value sales, but if I am to take the % figures in the right hand column of each section as an indication of the Opponent's market share then they range between -5.3% and 5.1% throughout the various territories. The sales figures only relate to fish and seafood."

19. Ms Reid submitted that the Hearing Officer had misunderstood this table. What the Hearing Officer interpreted as market share of "between -5.3% and 5.1% throughout the various territories" was, Ms Reid said, a clear error, not least because a negative market share is nonsensical. In fact, the highlighted figures represent fluctuations in market/value share. The actual figure for market share for each listed country could be found in the left column of the column headed Nomad Value Share.
20. I sympathise with the Hearing Officer. No information about the interpretation of this table was given to her by the Opponent in evidence or submission. I also had difficulty making sense of it. Nevertheless, I agree with Ms Reid that the interpretation given in [16] is wrong. Thus, for example, the Opponent's market share for fish and seafood in Austria for 2019 was 43.9%.
21. The question, though, is whether this makes any material difference on appeal, bearing in mind that the Opponent is seeking to relate this to findings in relation to desserts and puddings.
22. Ms Reid urged on me in her skeleton that *"This error feeds into the HO's perception of the overall strength of the IGLO brand and the impact on the average consumer and therefore this impact is not restricted to fish and seafood products"*. Ms Reid pressed this further in the Hearing.
23. For the Applicant, Ms Taylor submitted these figures were irrelevant for ground 1, since this evidence related only to the frozen fish and seafood sector.
24. In my judgment, whilst there is an error here it is not sufficiently substantial or material to affect the ultimate outcome. First, as Ms Taylor said, the figures relate to the frozen fish and seafood sector only, not to desserts or puddings. Secondly, the Hearing Officer generally accepted that the remainder of the evidence showed use in relation to fish, if not seafood

more generally. Thirdly, at [62] the Hearing Officer said (notwithstanding her apparent earlier difficulty in interpreting Exhibit 4):

“I am unable to clearly interpret the market share table produced at exhibit 4 other than it appears to show a significant market share for frozen fish which is supported by the remaining evidence within Ms Darcy’s statement.”

25. It therefore seems to me that by this point the Hearing Officer was alert to the evidence of the Opponent’s market share in the fish and seafood sector, at least to the extent the evidence showed use for fish and notwithstanding the apparent misunderstandings in [16]. This was also reflected in the fair specification at [69], wherein fish at large was retained.
26. Thus, although I agree that on the face of [16] the Hearing Officer appears to have misunderstood Exhibit 4, I am satisfied that this made no material difference to her overall assessment of the issues and that this error alone does not warrant appellate intervention.

Witness’s Exhibit 5 - Invoices

27. The Hearing Officer noted at [20] that Ms Darcy’s Exhibit 5 contained:

“Various invoices from the relevant period ... showing the final invoice amount and the country where the goods have been sold but only those relating to Germany, Belgium and the Netherlands”.

28. For the Opponent Ms Reid submitted that this was wrong, because in fact Exhibit 5 contains invoices “for” Iglo Austria GmbH and these invoices referenced various “desserts and puddings”, additional use which seemed to have been overlooked. Some of the invoiced sales were described by Ms Reid, veering into evidence, as being made to Billa AG, “*one of the biggest supermarkets in Austria*”. I discount that.
29. Ms Taylor submitted that whatever the flaws (if any) in the Hearing Officer’s analysis of this evidence, it remained insufficient to prove genuine use for desserts and puddings.
30. The difficulty for the Opponent is that its own witness, Ms Darcy, states :

“12. Shown to me at Exhibit 5 are copy invoices from the Relevant Period (which have been redacted but show the final invoice amount and the country where the goods have been sold by the Opponent) and **relate to sales made in Germany, Belgium and the Netherlands**” (emphasis added).

31. It is not obvious on the face of it that the addressee of the disputed invoices, or the delivery destination for the goods, was in Austria, (given the invoices are redacted) as opposed to (for example) Germany. It has never been suggested that the witness was in error in not including Austria as a country to which Exhibit 5 referred. It is entirely credible, on the face of it, that they support use in the stated countries, notwithstanding the point of origin is Austria.
32. The Witness is best placed to say what the invoices show and what they are putting them forward to prove, and Ms Darcy expressly stated what that was – sales in Germany, Belgium and the Netherlands. Presumably the Opponent’s professional advisers reviewed the evidence and were satisfied with it in that respect.
33. Furthermore, the Applicant specifically mentioned the limited “territoriality” of the invoices in its submissions below on the proof of use.
34. Had the Opponent wished to point to the invoices as showing additional use in Austria it would have been expected to do so in its own submissions, or to correct Ms Darcy’s evidence if an error had been made but again there was silence on this point. In effect, it is now raised on appeal for the first time, without explanation or justification, as if it has only been noticed now.
35. In the circumstances, there was no reason for the Hearing Officer to question Ms Darcy’s evidence and still less reason for me to question the Hearing Officer’s assessment of it. Thus, I do not agree with the Opponent that the Hearing Officer made any error in this respect. If this was an issue, it should have been addressed or corrected “in rehearsals”. The Hearing Officer was therefore entitled to treat the Exhibit as evidence for sales in Germany, Belgium and the Netherlands, but nowhere else.

Genuine Use - Desserts and puddings – Fair Specification

36. Overall, the Hearing Officer concluded at [63]:

“63. The evidence is not without its faults and lacks the specificity one would expect to have been filed. For example I am not told the number of units sold for each category of goods, nor specifically the revenue figures other than in general terms across all products. However, the Opponent has clearly been using its mark for a number of years across Europe, particularly in Germany and the Netherlands. I am satisfied, looking at the evidence as a whole, that it has used its mark for frozen foods, vegetables and ready meals.”

37. The Hearing Officer then moved on to consider the extent to which the use was “genuine” for desserts and puddings.

“64. I must now consider whether and to what extent the evidence shows use for the earlier marks to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

65. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, *in Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

66. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs. Although these are foodstuff products and not pharmaceuticals, the principles remain the same regarding subcategories. I shall go through the category of goods following the approach identified by Ms Darcy as falling into five groups namely Poultry, Fish, Desserts/Puddings, Vegetables and Snacks and Meals.

67. I do not consider that the Opponent has shown genuine use in relation to the broad term **Desserts/Puddings**. Some use has been shown for sweet dumplings, pastry including fruit and custard-based pastries, but this is mainly by way of photographs on its own generic and country specific website and in some invoices. No revenue or market share figures are produced specifically for goods **in this category** other than €75,000 of sales over a two-year

period relating to Germany. Over a five-year period I consider this figure to be insufficient to be regarded as genuine use” (*emphasis added*).

38. The Opponent’s case, as developed in Ms Reid’s skeleton and at the Hearing, is that standing back and looking at the evidence as a whole, the Hearing Officer was “wrong” in an appellate sense, in finding that there was insufficient evidence to support a finding of genuine use, if not for of the broad category “desserts and puddings”, then for an independent sub-category.
39. For the Applicant Ms Taylor submitted that the Hearing Officer’s decision was correct, based on the evidence before her.
40. Whether or not use is genuine can be assessed not just by reference to the specific goods alone, but to how they sit within the wider activities of a party. Is the use somehow “standalone” or exceptional, or does it fit within a general pattern of commercialisation within a wider sector? The former might well require more convincing evidence than a use on goods consistent with, as here, numerous common product lines within a common marketing strategy, where it is not unusual to have more-or-less successful ranges at the granular level.
41. The clinching factor for the Hearing Officer seems to have been the small level of sales for these specific goods over a 5-year period. However, as Ms Reid submitted, there is no need to “average” the use over 5 years – the requirement is use “within”, not “over” the relevant period. The Hearing Officer should have considered whether the use shown in two years was sufficient of itself rather than diluting its impact by “averaging”. In principle, use in two years is perfectly capable (taken with the other factors) of amounting to genuine use if it is nevertheless “*by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d’être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29]*”.
42. Furthermore, after reviewing the Decision I am left with the clear impression that the Hearing Officer did not fully take into account the evidence as a whole in deciding what that could tell them about the Opponent’s “real commercial exploitation” of the Earlier Trade Marks.

Instead, the Hearing Officer focussed on the identified categories individually, without taking the overall context into account.

43. I recall that in R 543/2019-4 *BIG MAC*, the EUIPO 4th Board of Appeal noted:

“In addition, the turnover and the volume of sales of goods marketed under the contested mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity *or the degree of diversification of the undertaking using the mark* and the characteristics of the products or services on the relevant market” (emphasis added).

44. In other words, one of the factors to take into account is the context of the Opponent’s overall business in the wider sector.

45. The overall context in this case, is that the evidence shows the Opponent is a major frozen foods company which commercially exploits its marks in a consistent way across many categories of goods in the frozen foods market. The Hearing Officer did not dispute that the Opponent does actually sell “sweet dumplings, pastry including fruit and custard-based pastries”. Furthermore on the evidence it commercializes these goods in the same way that it commercializes its other goods, the only evidential difference of any significance being volume/value.

46. Looked at within the context of the evidence as a whole the use for “sweet dumplings, pastry including fruit and custard-based pastries” is consistent with the overall efforts of the Opponent in selling and creating markets for its goods across a wide range of categories in the frozen food sector for the purpose of the *real commercial exploitation of the mark*. The use is not token, nor is it minimal. The focus on sales figures as the determining factor ignores, or at least “crowds out”, the wider picture. Isolating this use from the wider context introduces a degree of artificiality into the assessment of genuine use. In short, the focus was too closely on a specific tree, rather than the wood as a whole.

47. That is not to say, of course, that low figures cannot speak to non-genuine use. It is ultimately a matter to be decided “case -by – case” and in that respect I must be very cautious in reviewing the Hearing Officer’s decision.

48. I bear in mind the various warnings on appellate intervention. Reasonable tribunals can, of course, differ especially on facts such as those in this case where the evidence is flawed and, presumably, despite the Opponent's efforts this is the best evidence it could find. I am very conscious that in the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, I should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle and that special caution is required before overturning such decisions.

49. I also bear in mind the words of Mr Daniel Alexander KC in *TT EDUCATION* [2017] RPC 17 @ [5 (v)]:

"Situations where the registrar's decision would be treated as wrong encompassed those in which a decision was (a) unsupportable, (b) simply wrong, (c) where the view expressed by the registrar was one about which the Appointed Person was doubtful but, on balance, concluded was wrong. It was not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision would not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adhered to his or her view that the registrar's decision was wrong, should the appeal be allowed".

50. It is my view that the Hearing Officer's decision on this issue falls – just - into the last category, namely that it is a "doubtful decision". Is it a case of mere doubt or disagreement on my part? If so, that is not enough. It must be "*outside the bounds within which reasonable disagreement is possible*".

51. However, I have given this matter (very) anxious consideration over a considerable period of time, and no matter how I approach it I find I adhere to my first assessment.

52. This is that, contrary to the Hearing Officer's view, looked at in the round, on balance the evidence does show that the use in relation to the goods identified by the Hearing Officer, namely sweet dumplings, pastry including fruit and custard-based pastries, whilst commercially small, was genuine. Standing back it fits into and is consistent with the Opponent's commercial exploitation of its marks for these goods in common with its efforts across the frozen food sector, and in context it is "warranted in the economic sector

concerned to maintain or create a share in the market for the goods and services in question". To find otherwise would be to consider the evidence in an artificial vacuum and would be - just – "*outside the bounds within which reasonable disagreement is possible*".

53. For these reasons, therefore, and not without a degree of reluctance given the flaws in the evidence and the appellate cautions, I conclude that in this respect the Hearing Officer's decision was wrong. The evidence shows genuine use for at least "sweet dumplings, pastry including fruit and custard-based pastries". This ground of appeal, overall, succeeds.

Fair Specification – Desserts and Puddings

54. Genuine use for "sweet dumplings, pastry including fruit and custard-based pastries" having been shown, that leaves open the second question, namely how that translates into the fair specification – those goods alone, for the wider category "desserts and puddings" or some other sub-category? On that issue, I consider the proper course is to remit the matter to the Registrar.

55. To be clear, the remainder of the fair specification determined by the Hearing Officer stands.

Genuine Use - Snacks

56. Although this was raised for the first time in the Opponent's Skeleton, I shall dispose of it for the sake of completeness.

57. Ms. Reid submitted that the Hearing Officer should also have found genuine use for "snacks". The Hearing Officer disposed of "snacks" thus:

"68 I am unclear what is meant and covered by the term Snacks included within Ms Darcy's evidence and the Opponent's specification. This term is generally used to describe small portions of prepacked or processed foodstuff, eaten between meals. I cannot see anything in the Opponent's evidence that could be taken to be included within this term. Even if the Opponent's dumplings for example could be regarded as snacks, insufficient evidence has been produced to amount to genuine use for these goods in any event."

58. Despite Ms Reid's valiant efforts, on this I am in full agreement with the Hearing Officer.

Comparison of Goods – S. 5 (2) (b)

59. The Ground of Appeal in this respect focussed on the fair specification as settled on by the Hearing Officer. This may be a moot point in the light of my findings above on “genuine use” but I shall deal with it in any event.

60. The Opponent complained in two ways.

61. First, that even if the Opponent's goods primarily relate to frozen fish or vegetables, the goods still pertain to the same trade sector of frozen food, being normally offered in the same sections of supermarkets and require the same conditions of sale (i.e., a freezer) and were therefore similar to the Applicant's goods.

62. Ms Taylor submitted that this was far too sweeping an approach to similarity of goods

63. This was dealt with by the Hearing Officer at [77-78]:

“77. The case of *2nine Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-363/08* stated as follows in relation to the similarity of class 25 goods to certain goods in classes 9,14 and 26:

“40. It must, moreover, be pointed out that the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (*PiraÑAM diseño original Juan Bolaños*, paragraph 30 above, paragraph 44; see also, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).”

78. Other than both parties' goods being frozen foodstuff and directed at the general public, consumers will not consider that these goods are similar. Even if they happen to be sold in the frozen section of retail premises they are unlikely to be in the same cabinets; ice creams would be displayed in separate units to savoury foodstuff. The goods may well be sold together in supermarkets and will thus on a very general level overlap in trade channels, but this is insufficient in accordance with the caselaw. The goods are manufactured from different ingredients, via different processes. The goods differ in nature

and purpose, they do they compete with one another. There is no complementarity between them, where one could be used or was indispensable to the other, so that consumers would think that the same or linked undertakings were responsible. The goods are dissimilar. No consumer would determine that there would be any identity or similarity in the goods other than the fact that they are consumables. The fact that they are all foods found in the frozen compartments of supermarkets is not enough for similarity”.

64. The Appeal on this point is no more than mere disagreement with the Hearing Officer. I dismiss it.
65. The Opponent also complained that some of the specific goods in the fair specification are arguably similar to the Applicant’s goods. The example mentioned in the Grounds of Appeal was “vegetarian frozen foods”. Somewhat to my surprise, this was not pressed with any vigour at the Hearing, still less in Ms Reid’s skeleton, but it is nevertheless a point for determination.
66. For her part Ms Taylor argued that “vegetarian frozen foods” referred to savoury products which were not similar to “ice creams”.
67. The Hearing Officer dealt with the comparison *en masse*, which makes sense if all the goods are part of the same category(ies). As per Mr Geoffrey Hobbs KC at [5] BL O/399/10 *SEPARODE* “if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision”. Here, the vast majority of goods in the list were indeed comparable, being frozen meat, fish or vegetable products, and to that extent the finding of dissimilarity was sound.
68. However, “vegetarian” foods are not necessarily comparable to “vegetable” foods, at least without further reasoning, and to me (and I stress I make no determination of the point) there is at least a discussion to be had as to whether vegetarian frozen foods are, or are not, similar to ice cream.
69. To be fair to the Hearing Officer, the term is buried in an otherwise lengthy specification and no attention was drawn to it by the Opponent at first instance. If a party wants to ensure a

particular element in the specification is given particular consideration, ideally it should draw that to the express attention of the Hearing Officer and make submissions to them.

70. Nevertheless, the Hearing Officer must still give proper consideration to a specification in full and be alert to the fact that terms which seem to be otherwise comparable and properly grouped together might conceal an outlier placed out of context, as here.

71. In my view the Hearing Officer should have extracted this term and considered it for similarity on a stand-alone basis.

72. On this, once again, the appeal succeeds.

General Flaws

Failure to assess similarity of marks/enhanced distinctive character.

73. These two grounds of appeal are moot. Neither factor was considered at first instance because the assessment under S. 5 (2) (b) did not proceed beyond a comparison of goods. Since I shall be remitting the case, I leave it to the Registrar to consider such matters as thought fit.

EUIPO Decisions

74. Insofar as the Opponent complains that the Hearing Officer should have taken into account certain decisions favourable to it and annexed to its submissions, EUIPO decisions are not binding in such matters and, besides, different tribunals can reach different conclusions on the same evidence. I have not looked at the referenced decisions myself in reaching this Decision.

Overall Conclusion

75. The Appeal succeeds as regards:

- a) Proof of genuine use as regards “sweet dumplings, pastry including fruit and custard-based pastries”;
- b) The failure to compare “vegetarian frozen foods” with the Contested Goods.

76. Given their findings on proof of use/similarity of goods, the Hearing Officer did not proceed to consider the other elements of the Opponent’s case under S. 5 (2) (b). It is not appropriate

for me to determine them for the first time on Appeal. The case is therefore remitted to the Registrar for determination, by a different hearing officer, as regards the Opponent's case under S. 5 (2) (b) only in the light of:

- a) The amendment of the fair specification (which otherwise stands) to include a category reflective, as the Registrar shall determine, of my finding of genuine use of the Earlier Trade Marks in relation to sweet dumplings, pastry including fruit and custard-based pastries.
- b) The similarity, if any, of "vegetarian frozen foods" to the Applicant's "ice creams".

Costs

77. The Opponent has succeeded on Appeal, so the Hearing Officer's costs award is set aside. Since the matter has been remitted the question of costs is reserved to be dealt with by the Registrar in all respects, subject to any further appeal..

Philip Harris

Appointed Person

4 December 2023

ANNEX

Specification of UKTM no. 905740238 IGLO

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; puddings; rice-based snack food; sandwiches; spring rolls.

Specification of UKTM no. 909314261 IGLO

Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried

and cooked fruits and vegetables; Jellies, jams, compotes; Eggs, milk and milk products; Edible oils and fats; frozen prepared meals; instant meals and snack products; chilled foods consisting predominately of fish; chilled meals made from fish; cooked meals consisting principally of fish; fish cakes; frozen fish cakes; fish fillets; frozen fish fillets; fish fingers; frozen fish fingers; fish products; fish products being fresh; fish products being frozen; fish products being preserved; fish with chips; frozen cooked fish; frozen fish; frozen prepared meals consisting principally of fish; pre-cooked dishes incorporating [predominantly] fish; processed fish; scampi; frozen scampi; steaks of fish; frozen steaks of fish; shelled prawns; chicken; chicken pieces; chicken products; cooked chicken; frozen chicken; deep frozen chicken; dehydrated chicken; fried chicken; frozen fried chicken; prepared meals containing [principally] chicken; pieces of chicken for use as a filling in sandwiches; chicken nuggets; frozen prepared meals consisting principally of chicken; chicken kiev; frozen chicken kiev; garden peas; green split-peas; marrowfat peas; peas, preserved; peas, processed; frozen peas; soya beans; preserved soya beans; frozen soya beans; vegetarian frozen foods; frozen prepared meals consisting principally of vegetables; frozen vegetables; frozen vegetables packed in single portions; sweetcorn [cooked]; sweetcorn [preserved]; sweetcorn [frozen]; burgers; frozen burgers; meat burgers; frozen meat burgers; meat products being in the form of burgers; vegetable burgers; frozen vegetable burgers; steaks of meat; frozen steaks of meat; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals consisting wholly or substantially wholly of fish; frozen ready cooked meals consisting wholly or substantially wholly of fish; ready cooked meals consisting wholly or substantially wholly of game; frozen ready cooked meals consisting wholly or substantially wholly of game; ready cooked meals consisting wholly or substantially wholly of meat; frozen ready cooked meals consisting wholly or substantially wholly of meat; ready cooked meals consisting wholly or substantially wholly of poultry; frozen ready cooked meals consisting wholly or substantially wholly of poultry; ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready cooked meals consisting wholly or substantially wholly of vegetables; potato snack products in the form of fried

pieces; frozen potato snack products in the form of fried pieces; potato snack products in the form of pieces capable of being fried; shepherd's pie; frozen shepherd's pie; dairy desserts; cream desserts; fruit desserts; soya desserts; dairy puddings; desserts made wholly or principally of dairy products; dairy products; cream (whipped-); cream (dairy products); flavoured dairy desserts in the form of mousse layered onto flavoured sauce; flavoured dairy desserts in the form of vanilla flavoured mousse with strawberry flavoured sauce; flavoured dairy desserts in the form of chocolate flavoured mousse with caramel flavoured sauce and dark chocolate curls; desserts made from milk; desserts made from milk and gelatine; desserts made from milk products; desserts made from yoghurt; desserts made wholly or principally of milk products; instant desserts having a milk base; milk based desserts [milk predominating]; milk desserts; yoghurt desserts; fruit puree; egg based foodstuffs; frozen dairy desserts; frozen desserts made wholly or principally of dairy products; milk containing ice cream; artificial milk based desserts; cream preparations containing milk and fruits; dairy products containing milk; desserts in the form of puddings with a milk base; desserts made principally of milk; edible jellies made from milk and vegetable products; food made principally from milk; food preparations consisting wholly or substantially wholly of milk; food preparations containing anhydrous milk fats; food preparations containing soya and milk protein; food preparations having a base of milk; food products consisting principally of skimmed milk solids; foods made from milk products; foods prepared from milk; half-fat milk products; milk based desserts (milk predominating); milk cream; milk jellies; milk products for food; milk protein; milk protein products; preparations made from milk; preparations with a milk base for use as desserts; prepared desserts (milk based); prepared desserts made from milk products with fruit or herbs or pastry additives; prepared desserts made from milk with fruit additives; prepared desserts made from milk with herbs or pastry additives; prepared desserts made from milk with pastry additives; products based on milk; products made wholly or principally of milk; ready prepared desserts consisting of milk with gelatine as a binding agent; ready prepared desserts consisting of milk with starch as a binding agent; artificial milk based desserts; cream preparations containing milk and fruits; cream products; creams

containing dairy products; dairy products being half cream and half milk; double cream; edible cream; imitation cream, milk cream; frozen ready meals; frozen dairy desserts; frozen desserts made wholly or principally of dairy products.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice; sauces for frozen fish; sauces for chicken; frozen pastry stuffed with meat and vegetables; frozen pastry stuffed with vegetables; frozen prepared rice with seasonings and vegetables; bread rolls containing burgers; chilled ready meals; individual ready meals; ready cooked meals; pies containing fish; frozen pies containing fish; pies containing game; frozen pies containing game; pies containing meat; frozen pies containing meat; pies containing poultry; frozen pies containing poultry; pies containing vegetables; frozen pies containing vegetables; waffles; frozen waffles; deep frozen pasta; ready cooked meals consisting wholly or substantially wholly of pasta; frozen ready cooked meals consisting wholly or substantially wholly of pasta; dessert preparations in the nature of mousse, all being preserved by a quick-freezing process; frozen desserts; frozen fruit desserts; frozen mousse desserts; frozen mousse; frozen mousse confections; mousse (sweet); mousse confections; vanilla flavoured mousse; vanilla flavoured mousse with strawberry flavoured sauce; chocolate flavoured mousse; chocolate flavoured mousse with caramel flavoured sauce and dark chocolate curls; dessert puddings; puddings [desserts]; puddings for use as desserts; preparations for making desserts; prepared desserts [chocolate based]; prepared desserts [confectionery]; caramel; caramel sauce; strawberry sauce; chocolate sauce; sauces for ice cream; chocolate; chocolate based produces; chocolate chips; chocolate curls; chocolate flavoured confectionery; foods with a chocolate base; ice cream; ice cream desserts; ready-to-eat puddings; desserts having a reduced calorie content; desserts; ice desserts; non-dairy frozen dessert products; prepared desserts (chocolate based); prepared deserts (confectionery); confectionery; confectionery (non-medicated); confectionery bars; confectionery containing jam; confectionery containing jelly; confectionery in frozen form; confectionery

items (non-medicated); confectionery items coated with chocolate; confectionery products (non-medicated); dairy confectionery; frozen confectionery; frozen confectionery containing ice cream; frozen confections; ice confectionery; ice confections; ice cream confectionery; ice cream confections; non-medicated confectionery; non-medicated confectionery containing milk; non-medicated confectionery for use as part of a calorie controlled diet; non-medicated confectionery products; preparations for making confectionery products; prepared desserts (confectionery); frozen dairy confections; strawberry flavoured sauce; caramel flavoured sauce; foodstuffs flavoured with caramel [caramel predominating]; frozen confections in the form of cylindrical rolls consisting of ice cream covered with sponge cake; frozen confections in the form of cylindrical rolls consisting of ice cream covered with jam and sponge cake; dairy ice cream; frozen confectionery containing ice cream; frozen confectionery containing ice cream and jam; fruit ice cream; ice cream bars; ice cream cones; ice cream confectionery; ice cream confections; ice cream gateaux; ice cream products; ice cream sandwiches; ice cream with fruit; ice cream with pastry; ice creams; ice creams containing chocolate; ice creams flavoured with chocolate; imitation ice cream; non-dairy ice cream; soya based ice cream products; substances for binding ice cream; cakes; frozen cakes; sponge cakes; sponge puddings; puddings (desserts); sponge puddings; prepared desserts (pastries); puddings (desserts); bakery confectionery being chilled; bakery confectionery being frozen; confectionery (non-medicated); confectionery bars; frozen confectionery; frozen confectionery containing ice cream; frozen confections; ice confectionery; ice confectionery in the form of lollipops; ice confections; ice cream confectionery; ice cream confections; ingredients for confectionery; mixtures for making frozen confections; mixtures for making ice cream confections; non-medicated confectionery; non-medicated confectionery containing milk; non-medicated confectionery for use as part of a calorie controlled diet; non-medicated confectionery in jelly form; non-medicated confectionery products; preparations for making confectionery products; preparations for making ice cream confectionery; prepared desserts (confectionery); frozen confectionery containing jam; desserts; chilled desserts; desserts having a reduced calorie

content; dessert puddings; flavoured desserts; vanilla flavoured desserts;
strawberry flavoured desserts; chocolate flavoured desserts; caramel flavoured
desserts.