O/1169/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATON NO. 3754560
BY BARE BAKED
TO REGISTER AS A TRADE MARK:

IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433926
BY BARE FOODS CO.

BACKGROUND AND PLEADINGS

1. On 14 February 2022, Bare Baked ("the applicant") applied to register the trade mark displayed on the cover page of this decision, under number 3754560. The application was published for opposition purposes on 4 March 2022 in respect of the following goods:

Class 30: Cereal breakfast foods

2. On 1 June 2022 Bare Foods Co. ("the opponent") filed a notice of opposition. The opposition is brought under s. 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the goods in the application.[1]

3. Under s. 5(2)(b), the opponent relies upon its earlier UK Trade Marks:

UKTM No.	3499386 (386 mark)
Mark	'BARE'
Filing date	18 February 2019
Registration date	10 December 2021

Goods and services

Class 30**:** Ready to eat snack foods consisting primarily of grains, corn, cereal or combinations thereof; crackers; tortilla chips; flour-based chips; grain-based chips; cereal-based snack food; cereal-based food bars; cereal bars and energy bars; rice-based snack food; rice chips; rice crisps; rice crackers; puffed rice; cakes (rice-); snack foods made from corn; processed corn; popcorn; puffed corn snacks; maize-based snack products; extruded snacks containing maize; poppadoms; pretzels; granola; granola-based snack bars; granola-based snack foods; cereal seeds, processed; snack bars containing a mixture of grains, nuts

[1] The opposition was originally based upon Section 5(3) and 5(4)(a) of the Act in addition to Section 5(2)(b). However, the opponent withdrew reliance on these particular grounds in its submissions of 15 March 2023 and requested for the opposition to proceed on the basis of Section 5(2)(b) only.

and dried fruit [confectionery]; grain-based ready-to-eat food bars, also containing dried fruits, chocolate, nuts, seeds and/or soy; snack food products made from potato flour; snack food products made from rice flour.

UKTM No.	3623816 (816 mark)
Mark	bare
Filing date	9 April 2021
Registration date	24 September 2021

Goods and services

Class 29: Ready to eat snack foods consisting primarily of fruits, vegetables, potatoes, chips, nuts, nut products, seeds, or combinations thereof; apple chips, crisps, slices and chunks; fruit chips, crisps, slices and chunks; dried fruit; dried fruit snacks; snack mixes consisting of baked fruit; fruit-based snack food; fruit-based food bars; potato chips; potato crisps; sweet potato chips, crisps, slices and chunks; yucca chips; legume-based snacks and spreads; nut-based snack foods; nut-based food bars; mixtures of fruit and nuts; yogurt-based snack foods; bean-based snack foods; seed-based snack foods; vegetable based snack foods.

Class 30: Ready to eat snack foods consisting primarily of grains, corn, cereal or combinations thereof; crackers; tortilla chips; flour-based chips; grain-based chips; cereal-based snack food; cereal-based food bars; cereal bars and energy bars; rice-based snack food; rice chips; rice crisps; rice crackers; puffed rice; cakes (rice-); snack foods made from corn; processed corn; popcorn; puffed corn snacks; maize-based snack products; extruded snacks containing maize; poppadoms; pretzels; cereal seeds, processed; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; grain-based ready-to-eat food bars, also containing dried fruits, chocolate, nuts, seeds and/or soy; snack food products made from potato flour; snack food products made from rice flour.

4. Under s. 5(2)(b), the opponent relies on all the goods in classes 29 and 30 for which the earlier marks are registered.

5. Given the respective filing dates, the opponent's marks are earlier marks in accordance with s.6 of the Act. As the earlier marks had not completed their registration process more than five years before the filing date of the contested mark, they are not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods of the earlier marks, without having to demonstrate genuine use.

6. The Opponent contends that the competing marks are highly similar and that the parties' goods are identical or highly similar, giving rise to a likelihood of confusion, including the likelihood of association.

7. The applicant filed a defence and counterstatement, denying the grounds of opposition. The applicant argues that it offers 'entirely different' food (*granola, being a breakfast cereal*) to that of the opponent (*dried fruit chips/crisps*), which also have different ingredients. It operates in a different market sector 'free from allergens' to that of the opponent, and its branding and packaging are different. The applicant also contends that it will only use the words 'bare baked' together and will never use the word 'bare' alone.

8. The opponent has been professionally represented throughout these proceedings by D Young and Co LLP. The applicant has not been professionally represented.

9. Neither of the parties have filed evidence. Neither asked for a hearing and both filed submissions in lieu of a hearing; however, the applicant's submissions were filed a day after the deadline of 26 July 2023, after it had said that it was not going to file any final written submissions. The opponent requested that these submissions were struck out. However, the applicant's submissions largely repeat points it had already made in the counterstatement. The additional submission (that it uses several other words including 'Baked' after the word 'Bare' on its products) is not a relevant factor to be considered when assessing whether there is a likelihood of confusion between the

marks at issue here. In coming to my decision, I have taken account of submissions where they are relevant and will refer to them as necessary.

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

PRELIMINARY ISSUES

11. In its counterstatement and written submissions, the applicant describes the different goods and market sector it feels the opponent and the applicant operate within, asserting that this defeats any possibility of confusion. For reasons which I will now explain, the applicant's points about the difference in the actual goods offered by the parties will, as a matter of law, have no bearing on the outcome of this opposition.

12. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, Section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

13. The marks relied upon by the opponent have not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove use for any of the goods for which the earlier marks are registered. The earlier trade marks are entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of those earlier marks for all the goods listed in the registration.

14. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

> "22. … It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

15. So far as the applicant's claimed use of its applied for mark is concerned, I remind myself that, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, and the goods for which it will be used, my assessment later in this decision must take into account only the applied for mark – and its specification – and any potential conflict with the opponent's earlier marks.

DECISION

Section 5(2)(b): legislation and case law

16. Sections 5(2)(b) and 5A of the Act read 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."

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

17. The following principles are gleaned from the decisions of the EU courts *in Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 OHI*M, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion

Comparison of goods

18. The goods to be compared are displayed at paragraphs one and three above.

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) set out the approach to interpreting terms in specifications:

> "12. … 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."

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

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark"

21. I consider the opponent's goods *granola* (386 mark) and *Cereal-based food bars* (816 mark) to be identical to the goods of the application (*Cereal breakfast foods*),

based upon the principle in *Meric*. This is because *granola* is a cereal-based food that is usually eaten for breakfast and so would be included in the applicant's broader *cereal breakfast foods*. The applicant's term would also include the opponent's *cereal-based food bars*, as the latter term includes bars that are intended to be eaten at breakfast.

The average consumer and the nature of the purchasing act

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

23. In Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

24. The opponent submits that the average consumer of the goods at issue in these proceedings is a member of the general public. I agree. The goods are everyday consumables. They are likely to be purchased relatively frequently for consuming at breakfast time. The purchasing act will not require an overly considered thought process as they are inexpensive products. Nonetheless, the average consumer will consider factors such as type, taste, nutritional content, and dietary requirements. Overall, I find that the general public would demonstrate a medium level of attention during the purchasing process. The goods are typically sold in brick-and-mortar retail

establishments or their online equivalents, where they are likely to be self-selected from shelves or after viewing information on the internet. In these circumstances, visual considerations would dominate. Nonetheless, as such goods may also be the subject of, for instance, word of mouth recommendations or oral requests to store assistants, I do not discount aural considerations entirely.

Comparison of marks

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

26. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

27. The competing marks are as follows:

The earlier marks	The contested mark
The 386 mark: BARE The 816 mark: bare	

Overall impression

28. The earlier 386 mark is in word-only format and consists of the word 'BARE'. As there are no other elements, the overall impression of the mark lies in the word itself. The earlier 816 mark comprises the word 'bare', presented in a slightly stylised font, which appears in black. The particular font used is unremarkable and would make a minimal contribution to the overall impression. As such, the overall impression of the second mark overwhelmingly rests in the word 'bare', with the font used playing a minimal role.

29. The contested mark is figurative and consists of the words 'Bare Baked' in a black, slightly stylised font. Underneath it appear the words 'DELICIOUS, FREE & LOW CALORIEEEE' in a smaller, slightly stylised, orange font. The words are presented on a pale orange, circle background. The word 'Bare' will be perceived as meaning 'not covered'; 'without addition; basic and simple', and the word 'Baked' would be perceived as a reference to the goods being baked. The former is allusive and the latter descriptive of at least some of the goods. The words 'delicious, free & low calorieeee' will be understood as descriptive references to characteristics of the goods i.e., goods which are highly pleasant to taste, free from anything unwanted and low in calories. The elongation of the word 'Calorie' will not alter that perception. For this reason, in addition to their relative sizes and positions, it is my view that the words 'Bare Baked' dominate the overall impression of the mark, while the other words play

a much lesser role. In my view, these words do not hang together as a unit, and I consider that the word ‘Bare’ has an independent role within the mark. I also remind myself that in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02*,* the GC, stated that in general the average consumer tends to pay more attention to the beginnings of words. Additionally, English speakers read from left to right, so the beginnings of marks will generally be more significant than the ends. Even though it is allusive, I find the word ‘Bare’ to make the greatest contribution to the overall impression of the contested mark, with a lesser role played by ‘Baked’ given its descriptive nature. The circle background and use of colour will be perceived as decorative and, therefore, play much lesser roles in the overall impression. The particular font used plays a minimal role in the overall impression.

Visual comparison

30. Visually, the competing marks are similar in that they share four letters in the same order. The competing marks are visually different insofar as the contested mark also contains additional words, namely ‘Baked’ and ‘DELICIOUS, FREE & LOW CALORIEEEE’, as well as the decorative background; these elements have no counterparts in the earlier marks, though I remind myself that they play lesser roles in the overall impression of the contested mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparison

31. The earlier marks consist of one syllable i.e., ‘bare’. The contested mark also contains the words ‘Baked DELICIOUS, FREE & LOW CALORIEEEE’, however, given the size, positioning, and descriptive nature of the strapline ‘DELICIOUS, FREE & LOW CALORIEEEE’, it is unlikely that the average consumer would articulate these words. Thus, the contested mark is likely to be articulated in two syllables ‘bare-baked’. The competing marks aurally coincide in that their respective first syllable is identical. They differ insofar as the contested mark also contains an additional syllable. Overall, I find that there is at least a medium degree of aural similarity between the competing marks.

Conceptual comparison

32. As previously outlined, the earlier marks are likely to be understood as meaning not covered'; 'without addition; basic and simple'. As regards the contested mark the additional words 'Baked' and 'DELICIOUS, FREE & LOW CALORIEEEE' will be understood as descriptive references to the goods. The circle background carries no semantic content. Thus, the competing marks conceptually coincide in the word 'bare'. The competing marks differ in that the contested mark provides an additional meaning emanating from the words 'Baked' and 'DELICIOUS, FREE & LOW CALORIEEE'. Nevertheless, bearing in mind my assessment of the overall impressions, I find that that there is a medium degree of conceptual similarity between the competing marks.

Distinctive character of the earlier marks

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

 commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

34. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

35. The opponent has asserted that the earlier marks have at least, an average degree of inherent distinctive character. The applicant has not commented on the distinctiveness of the earlier marks.

36. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the opponent has filed no evidence of use. Consequently, I have only the inherent position to consider.

37. The first earlier mark is in word-only format and consists of the word 'BARE' with no other elements. The distinctive character of the mark lies indivisibly in the word itself. The second earlier mark comprises the word 'bare', presented in a slightly stylised font, which appears in black. The particular font used is unremarkable and is likely to go unnoticed by consumers, the mark essentially presents as a plain word. The word 'Bare' is likely to be perceived by the relevant consumer as meaning 'not covered'; 'without addition; basic and simple'. Thus, the word 'Bare' may be mildly suggestive of cereal foodstuffs that are relatively unprocessed with no, or few, additives. Therefore, the expression 'bare' would be mildly allusive at best for the goods at issue. Overall, I find that the earlier marks possess a low to medium level of inherent distinctive character.

Likelihood of confusion

38. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e., a lesser degree

of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

40. Earlier in this decision, I concluded that:

- The applicant's goods are identical to those in class 30 of the earlier marks;

- The average consumer is a member of the general public, who will demonstrate a medium level of attention during the purchasing process;

- The purchasing process for the goods will be primarily visual in nature, though aural considerations have not been excluded;

- The earlier marks possess a low to medium level of inherent distinctive character;

- The overall impression of the earlier marks is dominated by the word 'Bare', being the only element of the marks;

- The words 'Bare Baked' dominate the overall impression of the contested mark, while the words 'DELICIOUS, FREE & LOW CALORIEEEE', the circle background, fonts and use of colour play lesser roles;

- The earlier marks and the contested mark are visually, aurally and conceptually similar to a medium degree.

41. Given my findings on the mildly allusive nature of the earlier marks, and in the event that the distinctive character of these marks is towards the lower end of the spectrum, I have considered the approach set out by Ms Emma Himsworth KC to assessing the likelihood of confusion where the only common element between the marks has a low degree of distinctiveness. The relevant case is *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, BL O/0368/23. In paragraph 44, she said:

> "(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
>
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.
>
> (4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.
>
> (5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.
>
> (6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

42. Based on my earlier findings, I consider that the non-coinciding elements of the contested mark are of a lower degree of distinctiveness and will not indicate trade

origin to the average consumer. I also find that the overall impression of the marks is similar.

43. Considering the overall levels of similarity between the competing marks, I am of the view that the aforementioned differences are likely to be insufficient to distinguish the applicant's goods from those of the opponent, particularly considering that the parties' goods are identical. Considering imperfect recollection, it is entirely foreseeable that the average consumer, demonstrating a medium level of attention during the purchasing process, may not recall the respective marks with sufficient accuracy to differentiate between them. In my view, it is highly likely that the average consumer may misremember whether the contested mark is accompanied by the descriptive words and unremarkable decorative elements. For the reasons previously outlined, I consider it far more likely that the average consumer will retain and recall the word 'Bare'. On seeing the opponent's goods, the average consumer may think that it is the contested mark. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ (as he then was) confirmed that it did not necessarily matter which way round the confusion arose.[2] Consequently, I find that there is a likelihood of direct confusion.

44. If I am wrong in this finding, I now go on to consider indirect confusion. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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

[2] Paragraphs 78-80.

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)."

45. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach. This was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands LLC and others* [2021] EWCA Civ 1207. Regarding the explanation given in *L.A. Sugar* about how indirect confusion arises, Arnold LJ said:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an

economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing)."

46. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark, this is mere association not indirect confusion.[3] I also bear in mind that a finding of a likelihood of indirect confusion is not a "consolation prize" for those who fail to establish a likelihood of direct confusion.[4]

47. Having regard to all the above principles, in the event that the average consumer immediately notices and recalls the differences between the competing marks, they will also recognise the word 'Bare', which has an independent distinctive character within the contested mark, and which consists of the whole of the earlier marks. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. The inclusion of the word 'Baked' will be perceived as an alternate brand of the earlier marks which informs consumers that the goods produced or sold under the mark are baked products, with the words 'DELICIOUS, FREE & LOW CALORIEEEE' acting as a descriptive promotional strapline accompanying the brand. Further, the circle background, fonts and use of colour are likely to be perceived as a variation of the earlier marks with additional decorative elements. Taking all of the above into account, I am satisfied that the average consumer – paying medium level of attention – would assume that the marks belonged to the same undertaking. This is particularly the case, considering the respective goods are identical. Accordingly, I find that there is a likelihood of indirect confusion.

CONCLUSION

48. The opposition under section 5(2)(b) of the Act has succeeded. Subject to any appeal against my decision, the application will be refused.

[3] *Duebros limited v Heirler Cenovis GmbH,* BL O/547/17
[4] *Cheeky Italian Limited v Ahish Sutaria*, BL O/219/16

COSTS

49. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent **£650** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing written submissions and considering those filed by the applicant	£350
Official fee	£100
Total	**£650**

50. I therefore order Bare Baked to pay Bare Foods Co the sum of **£650**. 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 (subject to any order made by the appellate tribunal).

Dated this 12th day of December 2023

Lee Scott
For the Registrar
The Comptroller-General