

O-458-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003396612

IN THE NAME OF MUMUM LIMITED FOR THE TRADE MARK

MUMUM

IN CLASSES 5, 18, 25, 29 & 30

AND

THE OPPOSITION THERETO UNDER NUMBER OP000417996

BY WAN THAI FOODS INDUSTRY CO., LTD

Background and pleadings

1. Mumum Limited (the applicant) applied to register the trade mark MUMUM in the UK on 02 May 2019. It was accepted and published in the Trade Marks Journal on 5 July 2019. Following the amendment to the goods on 12 March 2020, the following goods the goods remain as follows:

Class 5: Food for babies and infants, namely, purees of fresh vegetables only, fresh vegetables and fruit, fresh fruit, lentils, fresh herbs, spices, cooking oils, cheese and/or butter; food for infants, namely, snacks of oats, cocoa, nuts, nut flour, dried fruits, seeds, coconut, coconut oil and/or fresh vegetables; food for infants, namely, pasta and risottos; tumeric milk beverages for babies and infants.

Class 18: Bags; tote bags.

Class 25: Clothing; headgear; footwear; aprons; bibs.

Class 29: Preserved, frozen, dried and cooked fruits and vegetables; vegetable purees; jams and conserves; eggs; prepared meals and snacks made from the aforesaid products for children and toddlers.

Class 30: Desserts for children; pasta; pasta sauces; sauces; preparations made from rice namely risotto; prepared meals and snacks made from the aforesaid products for children and toddlers.

2. Wan Thai Foods Industry Co., Ltd (the opponent) partially opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The applications are opposed in respect of the following remaining goods:

Class 29: Preserved, frozen, dried and cooked fruits and vegetables; vegetable purees; jams and conserves; prepared meals and snacks made from the aforesaid products for children and toddlers.

Class 30: pasta; pasta sauces; sauces; preparations made from rice namely risotto; prepared meals and snacks made from the aforesaid products for children and toddlers.

3. Following the amendment made to the applicant's specification of goods, the Office contacted the opponent to inform them of the amendments made stating:

"Please inform the registry within 28 days, that is on or before 28th April 2020 whether this allows your opposition to be withdrawn."

4. The opponent responded to the letter on 28 April 2020 stating as follows:

"The amendments of the specification in classes 5, 29 and 30 of the Application Mark do not allow our opposition to be withdrawn. Hence, the goods of main concern, namely

"pasta; pasta sauces; sauces; preparations made from rice, namely risotto; prepared meals and snacks made from the aforesaid products for children and toddlers

still are contained in the specifications."

5. For the avoidance of doubt, the goods included in the applicant's class 5 were not included within the opponent's TM7 document and will therefore not be treated as opposed in these proceedings. Further, it should be noted that with no official request to drop the opposition in respect of the goods outside those stated to be of "main concern" to the opponent in its letter of 28 April 2020, all the goods in classes 29 & 30 shown in paragraph 2 of this decision will continue to be treated as opposed.

6. The opposition is on the basis of, amongst others, the opponent's earlier European Union trade mark no. 012834991 for the mark  . The following goods are relied upon in this opposition:

Class 29: Meat, especially pork and beef; fish, especially shrimps; poultry, especially chicken and duck; preserved, dried and cooked vegetables.

Class 30: Instant noodles; noodles; spices; instant meals, especially instant noodles meals.

7. The opponent also relies upon a second EU trade mark registration no. 017363391 for the mark  under Section 5(2)(b) of the Act. The following goods are relied upon in this opposition:

Class 29: Fish paste, olive paste, fruit paste, vegetable paste, guava paste, tomato paste, meat paste, garlic paste, seafood paste, peanut paste, soup pastes, hummus; vegetable paste, meat paste.

Class 30: WOK sauce for frying with noodles and rice; sauces (liquid and paste type); savory sauces, chutneys and pastes; concentrated sauce; soy sauce; chicken sauce, shrimp sauce, vegetable sauce, beef sauce, chili sauce, spicy sauce, curry sauce, herb sauce, mushroom sauce, tomato sauce, meat sauce, sweet and sour sauce, sauces for food, sauces for rice and noodles, prepared foodstuffs in the form of sauces; bean paste, curry paste, almond paste, wasabi paste, sesame paste, curry paste, soya paste (condiment).

8. The opponent argues in its TM7 that the respective goods are identical or highly similar and that the marks are visually, aurally and conceptually highly similar.

9. The applicant filed a counterstatement denying that the marks are identical or similar, stating that the marks are not similar visually, aurally or phonetically. The applicant admits within its counterstatement that the goods are in part similar and in part identical with the opponent's, but states that due to the dissimilar marks there is no likelihood of confusion. The applicant argues there is no good reason why the application should be denied, has requested that the opposition be refused and that costs are awarded to the applicant.

10. Neither party filed evidence in these proceedings, and only the opponent filed submissions during the evidential rounds. Within these submissions, the opponent maintains that the marks are phonetically highly similar, and states they are visually similar to an above average degree. The opponent departs from its original statement that the marks are highly similar conceptually, stating that neither mark has a conceptual meaning and that the conceptual comparison is therefore irrelevant. The opponent requests that the application is refused and that costs are awarded in its favour.

11. Only the applicant 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. No hearing was requested and so this decision is taken following a careful perusal of the papers. Both parties have had professional representation in these proceedings. The opponent is represented in these proceedings by Würtenberger Rechtsanwälte (formally WürtenbergerKunze Rechtsanwälte), and the applicant has been represented by Laytons LLP.

Proof of use

12. The registrations upon which the opposition has been based registered in the EU on 23 September 2014 (012834991) and 26 February 2018 (017363391). As both registrations were under five years old on 2 May

2019, the date on which the application was filed, proof of use is not relevant in these proceedings under Section 6A of the Act.

DECISION

13. Section 5(2)(b)

Section 5(2)(b) of the Act is 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”.

14. Section 5A

Section 5A of the Act is as follows:

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

The Principles

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04,

Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

(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 and services

16. The opponent has submitted in its TM7 that the applicant's goods are highly similar and identical to those covered by its earlier mark. The applicant has, in paragraph 4 of its counterstatement, made an admission on this point stating "It is admitted that the goods in Classes 29 and 30 against which the Opposition has been directed are in part identical and in part similar to the goods of the Opponent's EU trade mark Nos. 12834991 and 17363391".

17. Within its submissions, the opponent claims this is an admission by the applicant of the claim in the TM7, stating the applicant has expressly agreed that all of the goods against which the opposition are based are either identical or **highly** similar [my emphasis] to the goods protected under the

earlier mark. I acknowledge that the applicant was responding to the claims made in the TM7 and that the applicant has not expressly denied this claim made by the opponent, instead making a positive statement about the similarity. However, I find it a stretch to state that the applicant's positive statement that the goods are similar or identical equates to the applicant having expressly admitted a minimum of a high level of similarity in respect of all of the goods. Indeed, the applicant goes on, within its written submissions filed to outline which of the goods it believes are identical, highly similar, share a moderate or low similarity or are dissimilar. I will consider this point in more detail should it be required later in the decision.

18. At this stage however, I find it has been agreed by both parties that the contested goods are similar (to some degree), or identical to those on which the opposition is based, with the exception of 'eggs', which the applicant finds to be dissimilar. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods listed above. Instead, the examination of the opposition will proceed on the basis that the contested goods are all identical to those covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar (or highly similar). Should the opposition not fail on this basis, then a full comparison of the goods will be conducted.

Comparison of marks

19. 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 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.”

20. 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.

21. In this case the opponent has based the opposition on both of its two earlier marks each covering a different specification of goods. However, it appears to me that both of the earlier marks themselves are identical. For this reason, as it will not detract from the opponent’s position, throughout the marks comparison I will refer only to the opponent’s earlier ‘mark’ as a singular when referring to the opponent’s two earlier identical marks.

22. The respective trade marks are shown below:

	MUMUM
Earlier trade mark	Contested trade mark

23. I agree with the opponent's submission that the most dominant element of the earlier mark is the wording YUM YUM. However, I find the distinctiveness of the words YUM YUM in respect of the goods in question, namely food products, to be at best fairly low. This is because YUM YUM is a phrase commonly used by English speakers in the UK to convey to others that food tastes nice, or that it looks or smells like it would taste nice. I therefore find the stylisation and colour, particularly the use of shading with the contrived colour combination including the yellow letter fill, the black outline and the use of green for the shadow to be a distinctive element of the earlier mark and to play a role in its overall impression alongside the wording.

24. It is the applicant's word mark in its entirety within which the dominant and distinctive elements are held, and it is the full mark, namely the word MUMUM that contributes to the overall impression of the same. It is well established that the choice of uppercase or lowercase lettering in a word mark does not add to its overall impression, and its registration as a word mark allows for use in the mark in any case.

Visual comparison

25. Visually the opponent's mark is made up of six letters y-u-m-y-u-m. Due to the distance between the top of the first 'm' and the top of the second 'Y', in addition to the fact that the two 'Y's used appear to be larger than the 'um' in each mark, these letters appear to be visually separated into two words, each starting with a capital letter, namely Yum Yum. As described above, the mark is made up of a combination of colours including yellow text with black outline and green shading, with a green curve within the bubble shaped flick of each Y.

26. On the other hand, the applicant's mark is made up of the five letters M-U-M-U-M, visually resulting in the single word MUMUM. The applicant's mark is similar in length to the opponent's (5 letters vs 6 letters), and as noted by the opponent within its submissions, both marks use the letter

combination UM twice within the marks. The use of the two UMs feature in roughly the same positions in each mark. The applicant's mark is a word mark, meaning it may be used in a variety of fonts, including those which may increase its similarity with the opponent's mark. However, the applicant's mark starts with an M, a letter which is visually very different to the letter Y as used by the opponent, and it is my view this would be true for the letter M in any font. Both marks are not particularly long, and the opponent uses the letter Y twice within the mark, once in replacement for the applicant's M and once as an addition rather than a substitution in the middle of the mark. The initial visual difference of the Y vs the M appears at the very beginning of the mark where the consumer is likely to pay most attention¹, increasing the visual differences between them, and the second adds significant visual feature to the opponent's mark that is not present in the applicant's.

27. I consider that notional and fair use of the applicant's word mark also allows for the use of the mark in a range of colours. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*, that registration of a trade mark in black and white covers use of the mark in colour.² This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).³ Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. I must therefore consider the possibility that the applicant's mark may be used in yellow or green for example. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. This is because it is necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the mark, and applying

¹ See paragraphs 81-83 of the judgement *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, in which the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends.

² Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

³ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

complex colour arrangements to a mark proposed to be registered without colour would not represent normal and fair use of the mark. On this occasion, I find that the specific colour combination contrived by the opponent, with a different colour used for the shading and letter fill is a combination that falls outside of what I consider to be normal and fair use of the applicant's word mark. I find therefore that the combination of colours used by the opponent adds to the visual differences between the marks on this occasion.

28. Within its submissions, the opponent states that the case law shows the word component usually has a stronger impact on the consumer than the figurative component. I agree that it has been established within the case law that this is usually the case. However, I do not find that this should lead me to assume this will always be the case, or lead me to dismiss the other features of the earlier mark where I have found these have an impact on a marks overall impression. Further, I find that there are visual differences between the word elements of the two marks.

29. Considering all of the factors above, I find the marks visually similar to between a low and medium degree. I note that within its submissions the opponent states the earlier mark is YumYum (stylised) without the addition of a space in the middle of the mark. For clarity, it is my view that conducting my visual comparison of the marks on this basis does not change my findings on their visual similarity.

Aural comparison

30. The marks both consist of two syllables, the second of which ends in an 'um' sound. In the case of the opponent's mark, the English speaking consumer will be well accustomed to the pronunciation of the mark as YUHM-YUHM with equal emphasis placed on both words. In respect of the applicant's mark, I find this is likely to be verbalised by the consumer as MUH-MUM, with the emphasis placed sometimes on the first, and sometimes on the second syllable of the mark, as there will be no obvious way to pronounce

this. Due to the similarities caused by the 'um' sound and the number of syllables, but with consideration to the differences outlined above, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

31. Within its submissions, the opponent argues that there is no conceptual meaning of either mark within the relevant territory and so the conceptual comparison is irrelevant. I disagree entirely with this submission. I find that the opponent's mark will clearly convey a conceptual meaning to the relevant consumer in respect of these goods, namely of a nice tasting product.

32. On the contrary, I find that to a portion of consumers, the applicant's mark MUMUM will convey no conceptual meaning. The applicant submits within its written submissions that its mark "alludes to a baby calling for his/her mother". I agree that to a further portion of consumers, the inclusion of the word MUM in the mark, as well as the fact that often different variations of the word MUM are used to refer to a mother by a child (such as mumma and mummy), will mean that the mark conceptualises a mother figure, and will be viewed as an informal name for such a figure, that would be used by a child or infant. In both instances where there is a conceptual meaning attributed to the applicant's mark, and instances where this is not attributed to the mark, I find the same to be conceptually dissimilar to the opponent's mark.

Average consumer and the purchasing act

33. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

34. 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. 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.”

35. The opponent has submitted “the relevant public is composed of the reasonably well informed and reasonably observant and circumspect average consumers in the UK”. Whilst I am unsure of the opponent’s choice of wording, I agree with what I believe to be the opponent’s sentiment, which has been echoed within the applicant’s submissions, that the relevant consumer of the goods in question includes members of the general public. I find it is the general public that will form the majority of the consumers of the goods, but also that a portion of the relevant consumer of the goods will be professionals, purchasing goods either for their own food business, or on behalf of others.

36. The applicant submits within its written submissions that the level of attention paid to the goods is likely to be “at least average”. The goods in question are food items that will be purchased frequently. There will be a range of price points for these goods, but they will often be low cost. I consider that in some instances the consumer may take care to consider the quality, nutritional and/or calorific content of the items they purchase, particularly where those products are being purchased on behalf of dependents. I also consider that there may be the occasional consumer who will pay an above average level of attention due to specific dietary

needs. In these cases, the consumer may take extra care to look to the trade mark, so that they may use this for reassurance of these qualities on a repeat purchase. However, my findings that a few consumers may pay particular attention in certain circumstances to these goods cannot be transferred to all goods in this sector. I find that generally, the level of attention paid by the consumer in respect of these items will range from low to medium at best.

37. In respect of the professional consumer I believe the level of attention paid will increase as the above factors are more carefully considered due to the additional pressure and liability surrounding the provision of foodstuff to others. In respect of the professional consumer I believe the level of attention paid in respect of the goods will be from medium to high.

38. I find the goods will primarily purchased following visual inspection on the shelves in self-service supermarkets and food stores. However, I consider that the verbal comparison cannot be completely discounted, as these items may be on occasion ordered over the counter for example in delicatessens, or with the verbal assistance of retail staff.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97

Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. The common elements found in the earlier mark and the application exist within the word elements of the earlier mark, namely YUM YUM. The words YUM YUM (with the exclusion of the additional stylisation) at best hold a low level of inherent distinctive character, on the basis that they allude to the fact the goods being provided will taste good. I note the colour combination and stylisation (that do not feature in the applicant’s mark) help to increase the earlier marks distinctive character, but only to a below medium level.

41. The opponent has filed no evidence and so I cannot find that the distinctive character of the earlier mark has been enhanced through use.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

42. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 15 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

43. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings⁴.

44. As mentioned previously, for the purpose of procedural efficiency, I have assumed that the goods for consideration are all identical. If it is found that there is no likelihood of confusion based on the identical goods (which both parties have agreed exist to some extent), there will be no likelihood of confusion between goods which are only similar. Should a likelihood of confusion be found on the basis of identical goods, a full goods comparison will be conducted.

45. I found that the marks were visually similar to between a low and medium degree, aurally similar to between a medium and high degree, and

⁴ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10,

conceptually dissimilar. I found the relevant consumer ranged from the general public paying a low degree of attention, all the way through to the professional consumer paying a high degree of attention. I found the goods are purchased primarily on visual inspection, but that the aural considerations cannot be completely discounted. I found the inherent distinctiveness of the earlier mark was below medium at best.

46. I consider that conceptual dissimilarities between marks should not, on any occasion, cause me to completely disregard all other relevant factors and come to a finding that there is no likelihood of confusion without full consideration of all aspects of a case. However, it is the case that on occasion, the conceptual dissimilarity between marks may outweigh the visual and aural similarities found. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

47. Professor Phillip Johnson, sitting as the Appointed Person, in *Wearwell Inc v. Work Well Mats Limited*, BL O/055/19, stated, at paragraph 29:

“Nevertheless, I will add briefly that when the passage from *Picasso* is read in context it is clear that the Court of Justice is not creating an additional hurdle that conceptual dissimilarity must be “obvious and pronounced” to overcome visual and aural similarity. It is simply reiterating the accepted principle that the overall impression of the mark must be considered and each factor must be weighed. If there is sufficient conceptual difference this can, in some cases, negate any

likelihood of confusion which might otherwise arise from the visual or aural similarity.”

48. Mr Iain Purvis QC, sitting as the Appointed Person in *JT International S.A. v Argon Consulting & Management Limited* (“Rochester”), BL O/049/17, having reviewed *The Picasso Estate v OHIM*, observed:

“39. The interesting point here is that the absence of a particular concept is said to ‘counteract’ confusion, by making the marks easier to distinguish. So lack of conceptual similarity is not merely a ‘neutral’ factor. That is the case even where one of the two marks has no particular meaning at all to the average consumer.”

49. Whether a conceptual difference between the marks is sufficient to counteract the visual and aural similarities is liable to depend on the strength of that difference and the degree of visual and aural similarity between the marks. In *Diramode S.A. v. Richard Turnham and Linda Turnham* (“PIMKIE”), BL O/566/19, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered an opposition to the mark PIMKIE based upon the earlier mark PINKIES, for identical goods (precious metals and jewellery). Mr Hobbs stated that there was a high degree of visual and aural similarity between the marks and, following the CJEU’s judgement in *C-437/16 P Wolf Oil Corp v EUIPO*, that

“28. ...there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It [the CJEU] insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to ‘*a finding of the conceptual differences between the signs at issue*’ and second being directed to ‘*assessment of the degree of conceptual differences*’ with a view to determining whether they ‘*may lead to the neutralisation of visual and phonetic similarities*’.

29. Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion.”

50. I have found earlier in this decision that the conceptual meaning of the opponent’s mark will be grasped immediately by the relevant public. It is my view that this meaning will fix in the consumers mind. On the other hand, I found the relevant public will either not see conceptual meaning in the applicant’s mark, creating a clear point of difference between the two, or they will view the conceptual meaning as completely different to that of the opponent’s mark (a nice tasting product vs a name for a mother figure). Where the consumer will not view the applicant’s mark as having a conceptual meaning, the degree of conceptual difference will be fairly strong, albeit perhaps not as strong as if the two marks both conjured an obvious and pronounced conceptual meaning completely at odds with one another. Where the consumer will associate the applicant’s mark with a mother figure, the conceptual differences will be very strong in the mind of the consumer.

51. I have considered the degree of conceptual difference found, alongside the degree of visual and aural similarity considered above, and in this instance I find that it is not only the degree of the conceptual difference that helps to counteract the similarities between the marks, but also the relatively low (between low and medium) level of visual similarity that lends itself to being easily neutralised by the conceptual difference. It is both of these factors, in addition to the no more than medium degree of inherent distinctiveness of the earlier mark, that lead me to find that even where the relevant consumer will pay a low level of attention to the goods, and where the goods are identical, they will not mistake the applicant’s mark for the opponent’s on visual inspection. I find this to be the case even where the

conceptual differences are less pronounced, with no meaning attributed to the applicant's mark by the consumer.

52. With reference to my earlier finding that the aural similarities cannot be completely discounted, it is my view that despite the aural similarities between the marks, on the occasion that these marks are verbalised, both the phonetic distinction (particularly at the beginning of the marks) alongside the conceptual differences will prevent these marks from being confused on that basis. For completeness, I add here that it is my view that the unlikely possibility of an instance in which that the marks may be sufficiently mumbled and misheard, in the already less common scenario that the goods are purchased aurally, does not suffice for a conclusion that the consumer is likely to be directly confused between the marks. Again, I find this to be the case even where the conceptual differences are less pronounced, with no meaning attributed to the applicant's mark by the consumer.

53. Further, I find no reason that the use of UM on two occasions within each mark would lead the consumer, upon noticing the differences between the marks, to believe the marks derive from the same economic undertaking. It is possible (although in my view unlikely) the double UM sound in the applicant's mark may bring to mind the opponent's mark in respect of identical goods, but as it has been established in the principles set out at paragraph 14 of this decision, this is not sufficient for a finding of likelihood of indirect (or direct) confusion. For the avoidance of doubt, it is my view that my findings of no likelihood of direct or indirect confusion between the marks would also apply in instances where the consumer viewed the text within opponent's mark without the addition of a space between the mark (namely YumYum).

Final Remarks

54. The opposition has failed in its entirety in respect of the identical goods.
For this reason, it is not necessary for a full comparison of the goods filed and registered to be conducted.

55. The application may proceed to registration in respect of all the goods.

COSTS

The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £650 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of grounds and preparing the counterstatement	£250
Preparing written submissions	£400

I therefore order Wan Thai Foods Industry Co., Ltd to pay Mumum Limited the sum of £650. The above 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 18th day of September 2020

Rosie Le Breton
For the Registrar