

O-608-20

TRADE MARKS ACT 1994

DECISION IN THE CONSOLIDATED PROCEEDINGS:

- (1) **OPPOSITION No: 410597** BY GOYA FOODS, INC
AGAINST APPLICATION No. 3242636 BY GOYA GMBH
TO REGISTER “**GOYA**” AS A UK TRADE MARK
IN CLASSES 26, 38, 44 & 45
- (2) APPLICATION No. **CA501965** BY GOYA GMBH TO **REVOKE** UK TRADE MARK
No. 2278362 REGISTERED IN THE NAME OF GOYA FOODS, INC.
FOR “**GOYA**” IN CLASSES 29, 30 AND 32
- (3) APPLICATION No. **CA502003** BY GOYA FOODS, INC. FOR A DECLARATION OF
INVALIDITY AGAINST UK TRADE MARK No. 3229977
REGISTERED IN THE NAME OF GOYA GMBH
FOR “**GOYA**” IN CLASSES 5, 9, 25, 39, 41 & 43
- (4) APPLICATION No. **CA502001** BY GOYA FOODS, INC FOR A DECLARATION OF
INVALIDITY AGAINST UK TRADE MARK No. 3229979
REGISTERED IN THE NAME OF GOYA GMBH
FOR “**GOYA YOGA**” IN CLASSES 25, 35, 39, 41 & 43

BACKGROUND AND PLEADINGS

1. As set out on the cover, this decision deals with four sets of consolidated proceedings, where the parties are Goya Foods Inc (“**Foods Inc**”) and Goya GmbH (“**GmbH**”).¹
2. **Outline summary of these consolidated proceedings:** in 2017, GmbH applied for three UK trade marks – two for “GOYA”, one for “GOYA YOGA”; the latter mark and one of the former GOYA marks achieved registration; the other GOYA mark is still at application stage. Foods Inc **opposes** GmbH’s trade mark application and **seeks to cancel** GmbH’s two registrations. In those three actions, Foods Inc relies (in part) on its ownership of three earlier-filed GOYA marks - two EU trade marks, and a UK trade mark. All three of Foods Inc’s earlier marks are put to proof of use, and this decision also deals with the **application** by GmbH **to revoke** for non-use the earlier UK trade mark relied on by Foods Inc. Relevant details are set out below.

GmbH’s application to revoke for non-use (CA501965)

3. GmbH applied, on 31 January 2018, to revoke, on the grounds of non-use under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“**the Act**”), Foods Inc’s UK trade mark registration No. 2278362, as detailed here:

Foods Inc’s UK trade mark	
Registration No. 2278362	
Mark:	“GOYA”
Filing date:	17 August 2001
Registration date:	6 September 2002
Class 29:	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats
Class 30:	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice

¹ Goya GmbH was known formerly as Future GmbH (including at the filing dates of its contested applications/registrations), but changed its name as of 6 September 2017 (as confirmed by its attorney on 13 June 2018).

Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

4. GmbH claims that Foods Inc's UK trade mark was not put to genuine use in the UK, neither in the five-year period after its registration i.e. 7 September 2002 – 6 September 2007, nor in the five-year period from 1 January 2012 – 31 December 2016. (As explained later in this decision, the date on which GmbH filed its application for revocation is also relevant.)

Foods Inc's opposition and cancellation proceedings

5. **Opposition No. 410597**: On 23 October 2017, Foods Inc filed a notice of opposition against the application by GmbH to register the following UK trade mark:²

GmbH's trade mark application	
Application No. 3242636	
Mark: "GOYA"	
Filing date: 10 July 2017	Published for opposition: 21 July 2017
Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair.	
Class 38: Telecommunications	
Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services	
Class 45: Legal services; security services for the physical protection of tangible property and individuals; personal and social services rendered by others to meet the needs of individuals namely, agency services for arranging personal introductions, astrological and spiritual services, bra fitting services, cat feeding services [in owners absence], clothing rental, consultancy services relating to health and safety, consulting in the field	

² Inc had Informed GmbH of its intention to oppose the trademark application, having filed a notice of threatened opposition on 21st September 2017.

of personal relationships, fashion information, marriage agency services, mentoring [spiritual].³

6. Foods Inc opposes GmbH's trade mark application based on grounds under **sections 5(2)(a), s5(3) and 5(4)(a) of the Act**.
7. Foods Inc relies for its **section 5(2)(a) and 5(3) claims** on the following UK and EU trade mark registrations:

(i) **Foods Inc's UK trade mark (No. 2278362) "GOYA"**

(as detailed at paragraph 3 above, which GmbH seeks to revoke for non-use).

(ii) **International Registration ("IR") No. 982166 designating the EU:
"GOYA"**

Designation date: 10 October 2008

Granted protection in the EU: 13 October 2009

Class 29: Applesauce; Artichoke paste; Bouillon; Cheese; Cheese food; Chili; Cranberry sauce; Dairy products excluding ice cream, ice milk and frozen yogurt; Dried fruit and vegetables; Dried fruit mixes; Dried fruits; Dried meat; Edible fats; Edible oils; Fish; Fish croquettes; Frozen fruits; Frozen vegetables; Fruit paste; Fruit preserves; Fruit-based snack food; Instant or pre-cooked soup; Jams; Lard; Meat; Meat extracts; Milk; Olive oil; Pickled vegetables; Pork; Pork rinds; Poultry; Preserved fruits; Processed artichokes; Processed coconut; Processed meat; Processed olives; Processed vegetables; Seafood; Snack mix consisting primarily of processed fruits, processed nuts and/or raisins; Soups; Vegetable chips; Vegetable oils; Vegetable-based snack foods; vegetable, fish, and meat croquettes.

Class 30: Alimentary paste; Bakery desserts; Bakery goods; Barbecue sauce; Burritos; Candy; Capers; Chocolate; Chocolates and chocolate based ready to eat candies and snacks; Cocoa; Coffee; Corn fritters; Custards; Dumplings; Empanadas; Enchiladas; Fajitas; Fish dumplings; Flour; Food seasonings; Frozen

³ (Trade mark application no. 3242636 had originally included goods in Class 33, but on 5 December 2019, GmbH filed a Form TM21B to delete Class 33 in its entirety.)

confections; Grain-based food beverages; Grain-based snack foods; Hominy; Honey; Hot sauce; Marinades; Mixes for bakery goods; Mixes for making baking batters; Mixes for making batter for hushpuppies; Mixes for making batters for fried foods; Noodles; Pastries; Pepper; Picante sauce; Rice; Rice-based snack foods; Salsa; Sauces; Seasoned coating for meat, fish, poultry; Seasoned coating mixtures for foods; Seasonings; Snack cakes; Spices; Taco chips; Tacos; Tamales; Tapioca; Tomato sauce; Tortilla chips; Tortillas; Vinegar; Wine vinegar

Class 32 Fruit nectars; Fruits drinks and fruit juices; Non-alcoholic malt beverage; Soft drinks; Syrups for making soft drinks; Vegetable juice

(iii) **EU trade mark No. 4845772**



Mark:

Filing date: 19 January 2006 (Priority date 9 August 2005 Spain)

Registration date: 6 June 2008

Class 29: Meat, fish, poultry and game; meat extracts; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

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

Class 32: Mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages

8. **The claim under section 5(2)(a)** is that each of the above three marks is identical to the mark applied for by GmbH and that the contested application is in respect of similar goods, such that there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. Shortly before the oral hearing of these proceedings, Foods Inc reduced the scope of its claims, such that the opposition

on this ground is targeted only against some of the goods and services applied-for, namely.

Class 26: artificial flowers

Class 38: Telecommunications

Class 44: Medical services; agriculture, horticulture and forestry services

9. **The claim under section 5(3)**, is that Foods Inc has used its the earlier marks “extensively in the United Kingdom since at least 2001, 2006 or 2009 as applicable, in relation to the goods and services covered by those earlier trade marks” and that “on the basis of massive use and extensive marketing .. has developed a reputation in respect of all the earlier trade marks in relation to all the goods and services [sic] covered.” Foods Inc claims to have “invested enormously in creating the GOYA brand with its strong distinctive character”; it alleges that “the public strongly associates it with the earlier trade marks” and that use of the contested application would be detrimental to the distinctive character and repute of the earlier trade marks, and would take unfair advantage by free-riding on the reputation of the marks, exploiting a transfer of image of the marks projected to the goods and services under GmbH’s identical or similar sign.⁴ The claim under section 5(3) is directed against the whole of the contested application.
10. Foods Inc also bases its opposition on a **claim under section 5(4)(a)** of the Act, where it claims to have earlier rights based on use in the UK of the sign “GOYA” since 2001 in relation to “food and drink”. This ground is directed against all the applied-for goods and services.

⁴ At paragraphs 6 – 13 of the statement of grounds in the opposition.

11. **Cancellation No. CA502003**: On 5 March 2018 Foods Inc applied for a declaration of invalidity in relation to GmbH's UK trade mark registration No. 3229977:

GmbH's trade mark registration No. 3229977	
Mark:	"GOYA"
Filing date:	9 May 2017
Published for opposition:	21 July 2017
Registration date:	3 November 2017
Class 5:	Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
Class 9:	Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software
Class 25:	Clothing, except clothing accessories, namely scarfs, gloves, belts and ties
Class 39:	Travel arrangement
Class 41:	Education; providing of training; entertainment; sporting and cultural activities
Class 43:	Services for providing food and drink; temporary accommodation

12. Foods Inc seeks to cancel GmbH's above trade mark registration based on grounds under **sections 5(2)(a), 5(2)(b) and 5(3) of the Act**. Foods Inc relies on the same three earlier registrations as for the opposition and makes comparable claims. Whereas the section 5(3) claim is again directed against the whole registration, Foods Inc narrowed the scope of its **section 5(2)(a) and 5(2)(b)** in this cancellation action, such that those grounds target only some of the goods and services applied-for, namely:

- Class 5:** dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals
- Class 9:** magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; computer software
- Class 25:** clothing, except clothing accessories, namely scarfs, gloves, belts and ties.
- Class 39:** Travel arrangement.
- Class 41:** Education; providing of training; entertainment; cultural activities.
- Class 43** Services for providing food and drink; temporary accommodation

13. **Cancellation No. CA502001**: On 5 March 2018, Foods Inc applied for a declaration of invalidity in relation to GmbH's UK trade mark registration No. 3229979:

GmbH's trade mark registration No. 3229979	
Mark:	"GOYA YOGA"
Filing date: 9 May 2017	Published for opposition: 14 July 2017
Registration date: 29 September 2017	
Class 25: Clothing, footwear, headgear	
Class 35: Advertising; business management; business administration; office functions	
Class 39: Transport; travel arrangement	
Class 41: Education; providing of training; entertainment; sporting and cultural activities	
Class 43: Services for providing food and drink; temporary accommodation	

14. Foods Inc seeks to cancel GmbH's above trade mark registration based on grounds under **sections 5(2)(b) and 5(3) of the Act**. Foods Inc relies on the same three earlier registrations as for the other two proceedings and makes comparable claims. Whereas the section 5(3) claim remains directed against the whole registration, Foods Inc narrowed the scope of its **section 5(2)(b)** in this cancellation action, such that that ground does *not* target the following applied-for services: Class 35: "*office functions*", nor Class 41: "*sporting activities*".

Defences, proof of use requests and papers filed

15. In the opposition and two cancellation actions, GmbH filed notices of defence, with counterstatements, denying the claims under all of the grounds. The three earlier marks relied on by Foods Inc had been registered for over five years when GmbH's contested marks were published for opposition and GmbH requested that Foods Inc provide proof of use of each of those earlier marks. To be able to rely on its earlier trade mark registrations, Foods Inc is consequently required to show evidence of use during various relevant periods in relation to the EU or the UK as applicable.
16. In the revocation proceedings, Foods Inc filed a notice of defence with a counterstatement that it had used its UK trade mark during the relevant periods for revocation purposes.⁵
17. During the evidence rounds Foods Inc filed evidence in relation to use of its marks. GmbH filed evidence, including submissions and comment on the Foods Inc's evidence in chief. Foods Inc then filed evidence in reply. This decision includes a summary account of the evidence. Both parties filed skeleton arguments. I have read all the papers filed.

Representation and hearing

18. GmbH had initially been represented in these proceedings by James Love Legal (latterly acquired by Womble Bond Dickinson (UK) LLP), but in the later stages of the proceedings, legal representation was handled in-house. For Foods Inc, Stobbs IP provided professional representation throughout these proceedings. An oral hearing took place before me on 15 September 2020, where Dr Oliver Baustian (attorney at law and Head of Legal Affairs) attended for GmbH and Julius Stobbs attended for Foods.⁶

MY APPROACH IN THIS DECISION

19. Given the overlap of the four sets of consolidated proceedings, I consider it warranted, if only to aid navigation, to outline here the forthcoming path of this decision.
20. **Evidence:** I identify the evidence, including a brief description of it; I also identify the various purposes it needs to serve. I refer to parts of the evidence where relevant as I deal with aspects of the claims and only to the extent that I consider it necessary.

⁵ Revocation for non-use is likewise sought in respect of the other two marks relied on but those proceedings are before the EUIPO.
⁶ Chris Hawkes and Emma Hewson of Stobbs IP also attended.

21. **The revocation claim:** I deal first with the revocation claim, setting out the applicable legislation and the relevant periods in which genuine use of the earlier UK mark must be established. I set out the case law principles on genuine use and determine the revocation claim accordingly by reference to the evidence.
22. **The opposition:** I then deal with the section 5(2)(a), 5(3) and 5(4)(a) claims against GmbH's trade mark application for "GOYA" in respect of goods and services in classes 28, 38, 44 and 45. As well as identifying the relevant period for proof of use for opposition purposes, this involves consideration of the evidence of use in the EU and additional applicable case law on proof of use in the EU.
23. **Invalidity claim against "GOYA":** I deal next with the section 5(2)(a), 5(2)(b), and 5(3) claims against GmbH's trade mark registration for "GOYA" in respect of goods and services in classes 5, 9, 25, 39, 41 and 43. This includes identifying the relevant period for proof use for the purposes of the two cancellation actions.
24. **Invalidity claim against "GOYA YOGA":** I deal finally with the section 5(2)(b) and 5(3) claims against GmbH's trade mark registration for "GOYA YOGA" in respect of goods and services in classes 25, 35, 39, 41 and 43.

THE EVIDENCE (OUTLINE)

Foods Inc's evidence in chief

25. **Witness statement of Conrad Colon dated 27 September 2019 (18 pages) - plus Exhibits CC1 to CC37:** Mr Colon is Vice President, Sales & Marketing at Goya Foods, Inc. His witness statement includes information relating to: the history of the company; its revenue, including at a global level; EU operations; Goya products – catalogues and invoices; awards; advertising and marketing; sponsorship and endorsements; and its online presence and social media profile.
26. **Witness statement of Cesar Valbuena dated 1 October 2019** – Mr Valbuena is director of a business in London called La casa de Jack. He states that he has "been a customer of Goya since 2016".

GmbH's's evidence

27. The evidence from GmbH comprised: A **witness statement** from **Dr Oliver Baustian** (attorney for GmbH) dated 8 January 2020, together with **Exhibit OB1**. Exhibit OB1 comprises 29 pages making various submissions on the claims in the proceedings and commenting on Foods Inc's evidence, contesting its sufficiency in establishing genuine use or reputation. Exhibit OB1 included **four appendices**. Dr Baustian states that a search was conducted of the website of La Casa de Jack for Goya-branded products. **Appendix 1** shows La Casa de Jack appears to be affiliated with La Chatica,⁷ and its business focuses on providing Latin cuisine ingredients such as empanadas, arepas, fruits and pulps; it comprises several pages of screenshots of the website of La Casa de Jack using the historical internet search tool wayback.org, dating from 5 – 16 April 2016 and which reveal no Goya-branded goods. **Appendix 2** shows that by December 2019 La Casa de Jack sold goods – beans and flour - bearing the brand Goya. **Appendix 3** shows a screenshot of results using the wayback tool showing that the website referenced at Mr Colon's Exhibit CC33 (www.goya.es) was not online at all for more than ten years between 2003 and 2016.

Foods Inc's evidence in reply

28. **Second Witness statement of Conrad Colon (dated 17 March 2020)** – (herein "**CCWS#2**"). CCWS#2 included two further exhibits, labelled **Exhibits CC1** and **CC2**, but which I shall refer to as **Exhibit CC1#2** and **Exhibit CC2#2** to distinguish them from the exhibits to Mr Colon's first witness statement. This evidence provides supplementary evidence relating to invoices addressed to businesses in the UK.

Translations

29. Since many of the exhibits filed by Mr Colon are in Spanish, Foods Inc's evidence also includes translations exhibited under witness statements by Dalia Kadoch and Eliza Graham.
30. **Dalia Kadoch** provided **two witness statements: one dated 15 April 2020** with **Exhibits DK1 and DK2**. DK2 gives English translations of Pages 1-15 of Exhibit CC2#2 to the CCWS#2; her second witness statement is **dated 30 July 2020**, with **(different)**

⁷ (which name appears in some of the invoice evidence)

exhibits DK1 and DK2. These provide translations of the following exhibits to the First Witness Statement of Conrad Colon : Exhibits CC11, CC13 (partial translation – Exhibit pages 1-24), CC18, CC19, CC25, CC29, CC30, CC31, CC32, CC33, CC36 and CC37.

31. The **witness statement of Eliza Graham** is also **dated 30 July 2020** and is accompanied by **Exhibits EG1 and EG2** translating pages 25 -33 of Exhibit CC13 to the first Witness Statement of Conrad Colon, which are copies of invoices for the UK for 2017 and 2018.

Purposes of the evidence

32. The evidence is to be assessed in relation to the obligations on Foods Inc to show:
- (i) whether it has used its mark in the UK in relation to the full extent of the goods under its UK trade mark registration or whether all or some may be liable to be revoked;
 - (ii) proof of use within the relevant territories (EU and UK), of the earlier marks on which it relies for its various grounds in the opposition and cancellation proceedings;
 - (iii) whether (and/or to what extent) it had actionable goodwill in the UK at the relevant date for the purposes of its section 5(4)(a) claim (i.e. when GmbH's contested trade mark application was filed);
 - (iv) whether (and/or to what extent) it had a reputation at the relevant dates and in the relevant territory for the purposes of its section 5(3) claims.

THE REVOCATION CLAIM (CA50196)

Applicable legislative provisions

33. Section 46 of the Act deals with revocation. The following extracts reflect the statutory law at the time when these proceedings were commenced.

34. The relevant provisions are:

46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.

35. Section 100 of the Act is also relevant and reads: *“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”* It is therefore plain that the burden of proof falls on the Foods Inc to show genuine use of its earlier mark(s) (not only in defence of the revocation action, but also of the opposition and cancellation actions).

36. I also note that the non-exhaustive list of acts that constitute use for the purpose of trade mark infringement as set out at section 10(4) of the Act includes:

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign;

(ca) uses the sign as a trade or company name or part of a trade or company name;

(d) uses the sign on business papers and in advertising;

The relevant periods for revocation

37. GmbH has challenged Foods Inc to show genuine use of its earlier word mark “GOYA” in respect of its registered goods on the UK market in relation to two relevant periods. The first of those relevant periods, under section 46(1)(a), is the five years from the registration date of that earlier UK mark (6 September 2002), thus: **7 September 2002 – 6 September 2007**. Secondly, under section 46(1)(b), GmbH has challenged Foods Inc to show genuine use of the mark on the UK market in the five-year period from **1 January 2012 – 31 December 2016**.
38. I note that paragraph 15 of the skeleton argument filed on behalf of Foods Inc states that no evidence has been filed of use in the UK for the period 7 September 2002 – 6 September 2007. However, Foods Inc invokes the provisions of section 46(3), and submits that it has filed evidence of use after that first contested period, i.e. in relation to the second relevant period (1 January 2012 – 31 December 2016) and that the mark is therefore not liable for revocation under the section 46(1)(a) ground.
39. For the purposes of the revocation action, I therefore bear in mind the provisions of section 46(3) and my consideration of the evidence will extend to whether it establishes in any event that use had commenced or resumed prior to 31 January 2018 (the date on which GmbH filed its application for revocation). Accordingly, while I note the skeleton argument submission or admission that no evidence of use has been filed in respect of use in the UK for the five years under section 46(1)(a), the application for revocation may only succeed to the extent that the evidence fails to show that there has been genuine use of the mark in the UK by the date of the application for revocation.⁸

Case law on genuine use

40. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR

⁸ Inc had informed GmbH on 23rd September 2017 of its intention to oppose the trademark application; this could lead to the inference that Inc might potentially have been aware of the prospect of the revocation application. I am therefore alert to the stipulation that if use started or resumed only within the period of three months before the date of the application for revocation, such use would be disregarded.

I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37].

Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

- (5) The use must be 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].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:
 - (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question;
 - (b) the nature of the goods or services;
 - (c) the characteristics of the market concerned;
 - (d) the scale and frequency of use of the mark;
 - (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;
 - (f) the evidence that the proprietor is able to provide; and
 - (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

41. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*⁹, Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

42. In *Dosenbach-Ochsner*¹⁰, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be

⁹ Case BL O/230/13

¹⁰ *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Evidence of use in the UK

43. The onus on Foods Inc is to have filed evidence of genuine use of the word “GOYA” in respect of the goods registered under UK Trade Mark Registration No. 2278362, namely:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats

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

Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages

44. The skeleton argument filed on behalf of Foods Inc applied a colour coding – text in black, blue, green or red - in relation to terms appearing in the specifications of the various earlier marks. Whereas certain terms in other earlier marks were presented in blue (signifying reference to those goods within the catalogue evidence at Exhibit CC11), the terms under the earlier UK registration were marked only black, green and red. Those it marked in red were goods where use is simply claimed as having been made, but where it was apparently acknowledged that no evidence was proffered in respect of the UK. As is clear from comments of the Appointed Persons in the appeal authorities I cited above, it is incumbent on a proprietor of a trade mark to show genuine use, not merely to claim it.¹¹ **I therefore find no genuine use shown in the UK in relation to the following goods, which terms were marked in red and in respect of which the application for revocation on the grounds of non-use therefore succeeds:**

Class 29: *Meat, poultry and game; meat extracts, eggs*

¹¹ The cases of *Awareness Limited v Plymouth City Council* and *Dosenbach-Ochsner*

Class 30: *tapioca, sago honey, treacle; yeast, baking powder; salt, mustard; vinegar honey, treacle; yeast, baking powder; salt, mustard; vinegar; ice*

45. Evidence of use in respect of the goods presented in black text was submitted in the skeleton argument to be provided in the form of invoices – I give close consideration to that evidence later in this part of my decision.
46. Other terms were presented in green, which signified their inclusion in the list of goods given by Cesar Valbuena, in his witness statement dated 1 October 2019. As mentioned above, Mr Valbuena is director of La Casa de Jack, a business with a London address. He states that he has “been a customer of Goya since 2016” and goes on to state that he has “continually bought products from them since that date, in particular the following types of products:

Chili; chocolate; chocolates and chocolate based ready to eat candies and snacks; cocoa; coffee; compotes; flour; flour and preparations made from cereals; flour preparations made from cereals; food seasonings; frozen confections; frozen fruits; frozen vegetables; fruit drinks and fruit juices; fruit nectars; fruits and drinks and fruit juices; grain-based food beverages; hominy; instant or pre-cooked soup; jams; jellies; and other non-alcoholic drinks; mixes for bakery goods; non-alcoholic malt beverage; pastry and confectionery; pepper; picante sauce; sauces (condiments); seafood seasonings; processed fruits; soft drinks; soups; spices; syrups for making soft drinks tortillas.

47. Mr Valbuena states that in “every instance, the invoices received featured the trade mark:



; he also states that “the goods themselves have prominently displayed the same mark on them.”

48. I recognise that this is evidence, given by a third party, under a signed statement of truth. However, in my view, there are reasons not to accept that list of goods in Mr Valbuena’s statement as sufficient, without more, for the purposes of showing genuine use of the challenged mark in relation to those listed goods. In particular, other parts of the evidence filed indicate that what are characterised as Goya products - by Mr Colon and, it seems, by Mr Valbuena – are not goods that themselves bear the Goya mark. I will say more on that matter (which I consider important), but I will first mention three related points: the

first is to do with use of the mark with the consent of Foods Inc; the second relates to variant use; the third concerns use of a mark as part of a composite mark or in conjunction with another mark.

Use of mark "GOYA" with consent of Foods Inc

49. Mr Colon's first witness statement includes various information about Foods Inc's EU operations. He refers to the establishment in 2006 of a company known as Goya Nativo, via the 80% acquisition of Productos Nativo, "a Madrid-based distributor that specialised in Andean-area products, complementing Goya's specialisation in Caribbean products." At paragraphs 23 and 24 of that witness statement, Mr Colon refers as follows to the inter-parties relationship whereby Goya Products have been manufactured, distributed and sold under the GOYA brand:

"(a) Goya Nativo, since 2007, being a distributor of Goya Products across the EU; and (b) Goya en España, since 1974, being a producer of Goya Products which are then sold by Goya en España or Goya Nativo, or shipped to another Goya Foods, Inc.'s distribution centre. This company owns the majority shareholding in Goya Nativo (as discussed above), and is under common ownership with Goya Foods, Inc. Collectively, the associated companies of Goya Foods, Inc., including Goya Nativo and Goya en España are being referred to herein as "Goya".

50. Similarly when introducing **Exhibits CC1#2** and **CC2#2**, Mr Colon describes that evidence as "additional invoices for Goya Products sold within the UK from January 2013 to September 2017, by the opponent's group companies Goya España SAU and Productos Goya Nativo SL under licence from the opponent."
51. Section 46(1)(a) is concerned with genuine use of the trade mark by the proprietor or with its consent. Use of the earlier marks by such entities as Goya España or Productos Nativo is clearly acceptable for purposes of genuine use, because it is with the consent of Foods Inc.

Variant form

52. As noted, the legislation provides for use of a mark in a variant form differing in elements which do not alter the distinctive character of the mark as registered.¹² Each of the earlier marks is either the plain word GOYA (as is the case for mark challenged for revocation), or that single word presented in a certain font and with a particular colour scheme i.e.



, and all are registered for various foodstuffs/drinks in classes 29, 30 and 32. A plain word mark is afforded protection for use in different formats and cases, and

in my view there is no question that the earlier mark  is an acceptable variant of the plain word (and vice versa).

Use in conjunction with another mark

53. The Court of Justice of the European Union (“**the CJEU**”), in *Colloseum Holdings AG v Levi Strauss & Co.*, ruled that “the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark” and that “... a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ ...”.¹³ I note that the evidence includes use of the mark



alongside the brand Nativo, or in conjunction with other words such as ESPAÑA or Productos Nativo. In my view, such use falls within the scope of the wording of *Colloseum*.

54. Having addressed those three points, I return now to say more about the important point that many of the goods that are characterised (by Mr Colon, and likewise by Mr Valbuena) as Goya products are goods that are shown in fact to be goods that do not themselves bear the Goya mark. This is apparent from invoice and catalogue evidence filed as Foods Inc’s evidence in chief – notably Exhibits CC11 - CC13, to which I make further reference later in this decision, where I deal with proof of use in the EU. The issue is also apparent

¹² Section 46(2) of the Act above – and sections 47(2C)(a) and 6A(4)(a) of the Act as set out later in this decision.

¹³ Case C-12/12, at paragraphs 32 and 35.

from the supplementary evidence of invoices for the UK, filed as part of Foods Inc's evidence in reply as **Exhibit CC1#2** and **Exhibit CC2#2**.

55. Exhibit CC1#2 appears to be extracts from a database or spreadsheet. It runs to seven pages and includes reference to around 30 invoice numbers where the territory is identified as the UK and the invoices have various dates from the years 2013 – 2017. Some of those 30 invoices are shown to be for very low sums (e.g. zero, or for sums in euros around twenty, 180, or 412); other sums are shown to range as high as around 22,000 euros – that particular invoice being dated 11 September 2017 in respect of 1224 boxes of *Goya Yellow Chili Paste* sent to Theale (which is a village near Reading). This Theale invoice had been referenced in the evidence in chief within pages 25-33 Exhibit CC13 (presented in translation as Exhibit EG2). Those pages 25-33 of Exhibit CC13 comprised 5 UK invoices, but only this one to Theale fell within the relevant period for revocation purposes.
56. The Theale invoice shows that many of the items listed in the table at Exhibit CC1#2 are named as Goya. As another example, I note that the first listed invoice in the table is dated 15 January 2013 in the amount of 860.86 euros, where the goods there identified include: *Adobo without pepper Goya jar; guava Goya can pasta; total seasoning Goya jar; Goya donuts – case blend; Goya wafer cookies; Goya milk sweet*. These examples strike me as good evidence of genuine use of the contested mark in relation to those branded goods.
57. However, that invoice (15 January 2013) also includes goods where the nature of the goods is not immediately clear and involves apparently different brands, such as “*Coco Mr Creole cover*”. This issue is all the more apparent in others of the listed invoices. For example, page 4 refers to an invoice for 15,581.84 euros where in the list of over 70 products, only one is discernibly branded Goya, namely “*total seasoning Goya jar*” (page 5). Most of the rest of the products are expressly identified as *Nativo*, others as *Postobon*.
58. This issue – of the goods themselves appearing not to be branded as Goya, notwithstanding that those goods feature under invoices where the Goya mark is applied – is also consistently exemplified in the context of **Exhibit CC2#2**. Exhibit CC2#2 is a selection of the actual invoices that were listed in tabular form in Exhibit

CC1#2. Mr Colon states at paragraph 9 of CCWS#2 that there is a “vast number of additional invoices for this period, as set out in Exhibit CC1, that have not been submitted in Exhibit CC2, due to procedural efficiency” (my emphasis), but that the further invoices detailed in CC-1 could be provided if they would assist the tribunal. I have noted that Exhibit CC1#2 referenced around 30 invoices – which does not strike me as a “vast number”, and which I have noted include some very low sums. Exhibit CC2#2 presents eleven invoices of the 30, by way of examples. Most of the example invoices are shown



to have this mark at the header: **PRODUCTOS GOYA NATIVO S.L.**; the invoices relating to extra virgin olive



oil have the mark **GOYA**, but with the word “ESPAÑA”. The invoices are in Spanish, but a translation is provided at Exhibit DK2 to the first witness statement of Dalia Kadoch (dated 15 April 2020). The UK invoice evidence is important, especially in the defence of the revocation action, and it is worth recording here some of the detail of those invoices:

Date; Addressee in UK; invoice amount (approx.)	Goods (themselves) identified as Goya
15 January 2013; Cuban Cuisine; 860 euros	Adobo with/without pepper; seasoning; guava paste; wafer; guava jam; custard; tamarind nectar; manioc flour case Also features other marks that are not “Goya” e.g. <i>Nativo</i> and <i>Ancel</i>
11 April 2013; La Chatica-La Casa de Jack; 4,545.79 euros	Cilantro package (total 68 euros - only) The rest of the invoice is largely goods identified as <i>Nativo</i> – including the two greatest amounts listed, which between them account for over 3700 euros.
2 August 2013; La Chatica-La Casa de Jack; 8,097.07 euros	2 types of seasoning goods (total under 100 euros) The rest of the invoice includes other goods either not overtly branded or else identified as <i>Nativo</i> – including the two greatest amounts listed, which between them account for over 5800 euros.

4 November 2013; La Chatica-La Casa de Jack; 15,581.84 euros	<i>Goya total seasoning</i> (in the amount of 45 euros). The rest of that large invoice relates to other goods either not overtly branded or else identified as <i>Nativo</i> .
1 June 2015; Cool Chile Co; 2049 euros	No Goya branded goods – only <i>Nativo</i> .
20 July 2017; La Casa de Jack; 17,376.16 euros	The invoice sum relates to 28 pallets of 8 different goods listed in the invoice, plus the cost of transport (2,500 euros). Of those 8 different goods, only one is identified as Goya, namely, “Malta Goya Bottle Crystal”, of which the invoice appears to be for just a single box, involving 24 units, and where no invoice amount appears at all. Each of the other seven goods are for amounts ranging from 1,128.96 euros to 3,628.80 euros. However, six of those goods are identified as different types of fruit drinks seemingly branded <i>Postobon</i> , and the seventh identified as “lulo <i>HIT</i> juice”.
5 x very similar invoices to “Light Academy LMT” for <i>Goya brand Spanish Extra Virgin Olive Oil</i> : 19 September 2013 (approx. 9000 euros); 24 January 2014 (approx. 8500 euros); 2 April 2015 (approx. 8000 euros); 20 January 2016 (approx. 9700 euros); 20 June 2017 (approx. 10,900 euros).	

59. Use must be shown to be in relation to particular goods and/or services under the registration relied on. Case law allows that even where the sign is not physically affixed to the goods, it is possible that there may be use “*in relation to goods*” for these purposes where a sign is used in such a way that a link is established between the sign and the goods marketed.¹⁴ However, if the goods bear only other trade marks the public are likely to assume that it is the users of those marks who are the source of the goods and responsible their quality. Although the evidence shows use of the contested mark on the invoices, the above summary of the invoice evidence shows that the goods were marked under different brands – Dr Baustian highlighted that the goods bear other

¹⁴ See paragraphs 17 to 20 of the decision Daniel Alexander Q.C. as the Appointed Person in *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11 and the further case law there referenced.

brands (such as PAN) and that it is not possible to determine from the invoices alone what marks may have been on the delivered goods.¹⁵ While I note the statements by Mr Valbuena, the invoice evidence, notably the invoice dated 20 July 2017 relating to La Casa de Jack (where Mr Valbuena is a director), utterly fails to provide corroboration, since the invoice is primarily in respect of goods seemingly under the brand *Postobon*. And likewise the invoice marked to La Chatica-La Casa de Jack – albeit dated 4 November 2013, which is several years before Mr Valbuena claims to have become a customer of Goya – shows only 45 euros worth of Goya-branded goods (seasoning), the invoice being primarily in respect of goods seemingly under the brand *Nativo*.

60. I also note that **Exhibit CC11**, shows images from GOYA NATIVO catalogues from the relevant period where it is clear that some products are branded “Nativo” and others as GOYA. Moreover, still other products within the catalogues are branded Aunt Jemima, QUAKER, Carnation, P.A.N., Ancel, Choco Listo, DUCAL, FACUNDO, Gloria, Jet, Corona, Campesino. While the catalogues are marked GOYA (alongside *Nativo* – like



this: , it seems to me that many of the goods within the catalogues would not be perceived as Goya products by the average consumer – rather those goods would be perceived in response to the public-facing branding – be it *Nativo*, Quaker, P.A.N. etc.

61. It is in light of these various points that I decline to accept, without corroboration, the list of goods in Mr Valbuena’s statement as sufficient evidence of genuine use of the contested mark for the goods there listed. The skeleton argument identified, by reference to its green text colour coding, the following goods as evidenced (only) by Mr Valbuena’s witness statement. **I therefore find no genuine use shown in the UK in relation to these goods, in respect of which the application for revocation on the grounds of non-use therefore succeeds:**

Class 29: *Jellies; fruit sauces*

Class 30: *cocoa; artificial coffee; ices*

Class 32: *syrops and other preparations for making beverages*

62. In terms of what such corroboration may be, the evidence does not, for example, include sales figures for Goya-branded goods, nor any reference to advertising in the UK; instead,

¹⁵ See for instance Dr Baustian’s skeleton argument at pages 2 and 4 and OB1 at page 15.

the main piece of supporting evidence is essentially whatever may be gleaned from relevant invoice evidence. As I set out above, the UK invoice evidence rests within Exhibit CC1#2 and Exhibit CC2# to CCWS#2 (as translated at Exhibit DK2). In the table below, I list the remaining specified terms under the contested UK registration and indicate whether the invoices provide evidence supporting genuine use in relation to those goods in the UK. I have not overlooked Exhibit CC37, which shows screenshots from various websites in the EU, shown to be selling Goya products. Three of the screenshot websites – abiglobal foods, SOYEN and shopasap – are shown to be selling Goya Extra Virgin Olive Oil, offered for sale in pounds sterling, but zero reviews are shown, and more significantly, the exhibits are not dated and so have no clear relevance since they may be from outside the relevant period and from after the start of these proceedings. There is also a screenshot from eBay offering around ten Goya food stuffs such as olives, cookies, beans and tapioca starch, where again the prices are in pounds sterling. However, the postage price is strikingly high and the goods are identified as sold from the United States. And again no date is apparent. Likewise a screenshot is shown of a page from Amazon.co.uk showing various GOYA branded seasonings for sale in pound sterling, but again no date is apparent and the exhibit relates only to goods that are anyway covered by the invoice evidence (i.e. seasonings).

Class 29		UK invoice evidence?
	<i>fish</i>	None for UK
	<i>preserved, dried and cooked fruits and vegetables</i>	Numerous references e.g Goya black stewed beans and red stewed beans (8/10/2013 Invoice No. 13FRV60524 – invoice shows
	<i>jams</i>	8 October 2013 - <i>Guayaba Goya Jam Jar</i>
	<i>milk and milk products;</i>	e.g 15 January and 8 October 2013 references to <i>Goya milk sweet</i> ; 27 July – <i>Coco Goya Lata Milk</i> ; 15 January 2013 – <i>Natilla Panela Goya – blend case (custard)</i>
	<i>edible oils and fats</i>	The Goya extra virgin olive oils in the invoices to Light Academy LMT
Class 30	<i>Coffee</i>	No clear Goya branded goods
	<i>tea</i>	No clear Goya branded goods
	<i>sugar</i>	No clear Goya branded goods
	<i>rice</i>	No clear Goya branded goods
	<i>flour preparations made from cereals, bread, pastry and confectionery</i>	e.g 15 January 2013 references to <i>Goya donuts – case blend</i> ; <i>Goya wafer cookies</i> ; <i>manioc flour case</i> 25 April 2013 – <i>Goya wheat tortillas</i> 8 October 2013 – <i>Wheat tortillas Goya UD case</i>

		11 September 2015 – <i>Goya White Corn Arepa Cover</i> and <i>yellow corn arepa Goya cover</i>
	<i>sauces (condiments);</i>	8 October 2013 – <i>Goya Hot Spicy liquid season jar</i> and <i>Typical liquid season Goya jar</i>
	<i>spices</i>	Numerous references to seasonings e.g 15 January 2013 – <i>adobo with chile habanero Goya jar</i> ; 2 August 2013 and 5 June 2015 – <i>Goya cilantro and anchiote package</i> ; 4 November 2013 – <i>total seasoning Goya jar</i> ; the 2017 Theale invoice for <i>yellow chili paste</i> etc
Class 32	<i>Mineral and aerated waters and other non-alcoholic drinks</i>	No clear Goya branded goods
	<i>fruit drinks and fruit juices</i>	8 October 2013 – <i>Juice Goya Guayaba can</i> ; 25 June 2014 – <i>Juice Goy Guanabana can</i> ;

63. The skeleton argument filed on behalf of Foods Inc states that the total of the invoices for “Goya Products” sold within the UK 2013 – 2017 is 125,480.57 euros, but, as I explained above, the goods within those invoices that are identifiably marked as GOYA account form a much smaller part of that total. However, taking the evidence in the round, I find it sufficient to establish genuine use of the contested mark “GOYA” in the UK in relation to such goods that the average UK consumer would regard as having been placed on the market under the GOYA mark, as reflected in the evidence. **I therefore find genuine use shown, sufficient fairly to cover the following goods:**

Class 29: *preserved, dried and cooked fruits and vegetables; jams; milk and milk products; edible oils and fats;*

Class 30: *flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices*

Class 32: *fruit drinks and fruit juices*

OUTCOME FOR THE REVOCATION (CA501965)

64. **UK trade mark registration No. 2278362** is to be **revoked in part**. The goods scored through below are to be removed from the protection of the registration. Since no use has been shown in relation to either of the relevant periods under sections 46(1)(a) or s46(1)(b) or before the date of the application for revocation, then in line with the provisions of section 46(6)(b) (as addressed in Tribunal Practice Notice TPN 1-2007) the partial revocation is effective from the day following the fifth anniversary of the registration date i.e. **7 September 2007**.

Class 29: ~~Meat, fish, poultry and game; meat extracts;~~ preserved, dried and cooked fruits and vegetables; ~~jellies, jams, fruit sauces;~~ eggs, milk and milk products; edible oils and fats

Class 30: ~~Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee;~~ flour preparations made from cereals, bread, pastry and confectionery, ~~ices;~~ honey, ~~treacle;~~ yeast, ~~baking powder;~~ salt, ~~mustard;~~ vinegar, sauces (condiments); spices; ~~ice~~

Class 32: ~~Mineral and aerated waters and other non-alcoholic drinks;~~ fruit drinks and fruit juices; ~~syrups and other preparations for making beverages~~

THE OPPOSITION CLAIM (No. 410597)

65. Foods Inc opposes GmbH's trade mark application is based on grounds under **sections 5(2)(a), s5(3) and 5(4)(a) of the Act**. Foods Inc relies for its section 5(2)(a) and 5(3) claims on its UK trade mark, which I have above found to have been put to genuine use only in respect of certain goods. It also relies on two other earlier marks, protected in relation to the EU from a date more than 5 years before the publication date of the opposed mark; each of those two earlier marks is also subject to proof of use.¹⁶

Proof of use in the opposition proceedings

66. Section 6A of the Act deals with the requirements for proof of use in opposition proceedings. The relevant provisions are:

Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

¹⁶ (EUTM No. 4845772 and IR 982166 designating the EU)

- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if -
 - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
- (4) For these purposes -
 - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

67. For the purposes of opposing GmbH's trade mark application Foods Inc is able to rely on its three earlier marks as the basis for its section 5(2)(a) and 5(3) claims only to the extent that the evidence establishes, in respect of its registered goods, genuine use of its earlier word mark "GOYA" in the UK and/or the EU, and/or of its mark  in the EU.

Case law on genuine use

68. The case law principles on genuine use that I set out for the revocation action above, apply equally for proof of use purposes under the opposition and invalidity proceedings. However, since two of the earlier marks relied on by Foods Inc are registered or protected in respect of the European Union, it is also necessary to bear in mind judicial comment in leading cases that have considered the geographic extent of the use required to be shown.
69. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU stated that a Community trade mark (equivalent to what is now an EU trade mark) is put to 'genuine use' when "used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it" and that the assessment of whether the conditions are met is to take "account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."¹⁷ The CJEU also stated:

"36. ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors."

And

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single

¹⁷ Paragraph 58 of that judgment.

Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

70. The conclusion of Arnold J in *The London Taxi Corporation Limited v Frazer-Nash*, having reviewed the case law since the *Leno* case, confirmed that the assessment is a multi-factorial one which includes the geographical extent of the use.¹⁸

The relevant period in this opposition

71. The relevant period is the five years ending with the date on which GmbH’s contested trade mark application was published for opposition purposes. The relevant period for proving use in the opposition is therefore **22 July 2012 to 21 July 2017**.

Evidence of use in the EU

72. All three of the earlier marks are registered for goods in classes 29, 30 and 32. While there are some differences of detail in the specifications (as set out under the background and pleadings section of this decision), I consider the revocation action to have dealt sufficiently with proof of use of the word mark in the UK – certainly the differences in detail

have no material impact for a fair specification. I have also found  and the word mark to be acceptable variant forms of one another. Much of the evidence of use filed by Foods Inc related to use of the mark(s) elsewhere in the EU (than the UK). By way of illustration, while having in mind procedural economy, I note the following points from the evidence.

Catalogue evidence

73. Mr Colon describes **Exhibit CC11** as containing “extracts from the catalogues of the Goya Products sold in the EU by Goya year by year from 2013 to 2018, with the 2018 catalogue

¹⁸ *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 – at paragraph 230, but see also paragraphs 228 -230.

including the Goya Products currently still sold to date.”¹⁹ While I accept, as Mr Colon states, that Exhibit CC11 shows that the Goya product range included various “foodstuffs, drinks, seasoning, and condiments”, the catalogue evidence has significant weaknesses. I have already noted that many of the goods visible within the catalogues are not branded as Goya, but in fact bear different marks. It is also not entirely clear whether the evidenced catalogue content is meant to show the full range of products specifically sold in the EU, or whether the extracts are illustrative and further products were sold in the EU. There is no information on who may have received the catalogues and it is notable that they are largely in Spanish.

Sales evidence

74. Mr Colon states that “**Exhibit CC12** comprises of a summary table detailing a sample of invoices for Goya Products sold by Goya in the EU from 2012 to 2017” and that the exhibit “details the specific Goya Products sold and the corresponding number of boxes of the Goya Products sold, the number of the corresponding invoice, the date of the invoice and the EU territory in which the Goya Products were sold. The Marks appear on every page of every invoice that is detailed in this table.” Looking at the exhibit itself, I found its contents difficult to make out; it comprises over 20 pages, each page presents six tables that appear to be extracts from a database or spreadsheet table; each of the six tables has over 25 rows. The text is so small that it is barely legible, but I can make out references to various GOYA-branded foodstuffs, various named countries (including Italy, Germany, Luxembourg, Portugal and Slovakia) and some figures.
75. Mr Colon states at paragraph 45 that **Exhibit CC12** shows that “in just the 2012 - 2017 period, Goya sold the Goya Products to a range of 15 different EU countries, including (but not limited to) the United Kingdom; Spain, Poland, Italy, Austria, Belgium, France, Sweden, Hungary, Portugal ... Luxembourg, Holland, Germany, Slovakia.” Mr Colon states that based on the sample invoices detailed at Exhibit CC12, the total number of invoices issued by Goya for the Goya Products in the EU for the period 2012 - 2017 is 3,640. It seems this figure reflects the sum of the rows, tables and pages I indicated. He also states that based on Exhibit CC12, “the total value of the sales of the Goya Products in the EU for the five year period of 2012-2017 equalled €626,698.83. This

¹⁹ paragraph 40 of his first witness statement.

equates to roughly over €125,000 of sales of the Goya Products in the EU for each year.” Exhibit CC13 shows examples of actual invoices for various EU countries.

76. Across the invoice evidence it is not consistently clear precisely to which goods the invoices relate, or whether the goods are branded as Goya; it is clear that some of the goods are branded Goya and equally clear that some bear other marks. For example, the first invoice at Exhibit CC13 is dated 17 February 2017, shipping to Italy goods to the value of over 17,000 euros, which are various flavours of coconut water, and which are listed in the invoice as Goya (which also reflects the catalogue information). However, the first invoice on page 2, dated 15 April 2015, shipping to Italy goods to the value of over 14,000 euros, but which are listed in the invoice as *ChocoListo* and *Chocolate Taza Corona*. Such branded goods also appear in the catalogues exhibited at CC11, but those goods are not apparently branded as Goya.²⁰ As with the UK invoice evidence discussed earlier, the total figure ascribed to “Goya products” is substantially greater than that attributable to goods apparently bearing the Goya mark.
77. The evidence does not provide information on sales totals or market share; Mr Colon refers to the evidence of invoices as a sample, but the evidence does not reveal the full extent of sales in the EU under the mark or whether the total number of invoices for the relevant period extends significantly beyond than that totalled from the tables in Exhibit CC12.

Advertising and marketing

78. Mr Colon states that “Goya engages in extensive advertising and marketing of its GOYA brand both in the EU and across the world. Alongside more standard advertising practices (through posters and other similar advertisements), Goya engages in a number of more focused advertising and marketing means, including events, radio, television, publications and others.” In support of that he refers to **Exhibit CC16**, which is a summary table of the investment made by Goya for the years 2017 - 2019, in Spain and Germany. I note, however, that most of that evidence falls outside the relevant period for proof of use for opposition purposes, which ended on 21 July 2017.

²⁰ see for example pages 6 and 11 of DK2

79. Rather than deal with this evidence again later in this decision, I here note that the relevant period for the invalidity actions ended on 5 March 2018. Even based on that longer basis, my rough calculation indicates that whereas the total spend given in the table at Exhibit CC16 exceeds 197,000 euros, over 35,000 euros appears to be outside the relevant period even for invalidity purposes. Of the spending that is within the relevant period I note, for example, that the table records an invoice relating to the 12 September 2017 for over 47,000 euros for setting up a GOYA stand at trade fair in Germany. Various other notes in the table indicate further catering and events costs in Germany and Spain (such as “Madrid Fusion” 2018 and 2017). Other evidence gives more information on the German event, for example **Exhibit CC20** identifies it as held in Cologne and described as the “world’s largest trade fair for food and beverages” with the 2017 event attracting 7405 exhibitors and 165,000 visitors, mainly from across the EU (**Exhibit CC21**).
80. The evidence also shows that in 2017 and 2018 Goya invested over 44,000 euros in advertising Goya Products (namely coconut water, beans and quinoa) on three national Spanish radio networks/broadcasters, including, Cadena SER, which is the most listened-to radio station in Spain (**Exhibits CC22 - CC23**). The evidence shows other advertising in primarily Spanish national magazines and newspapers.

Conclusion on genuine use of earlier EUTM and IR(EU)

81. Taking the evidence in the round, including the above points, I find that there has been genuine use of the Goya mark in the EU. The evidence of use extends beyond Spain, although Spain is a particularly important part of the market.
82. Where proof of use of an earlier mark is validly requested and the submitted evidence is sufficient only for part of the goods listed, the earlier mark is deemed registered for only those goods and any analysis as part of an opposition or invalidity action is consequently restricted. In *Euro Gida*²¹, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person explained that “... *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.*”

²¹ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10. See also Carr J in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

83. Genuine use has already been established in relation to specified goods in the UK, which goods are types of food and drink in classes 29, 30 and 32. The two EU-protected marks likewise specify goods in those classes. The goods under the IR designating the EU (“GOYA”) are expressed in more particular terms than the goods in the same classes under the figurative EUTM. Any differences in coverage between the IR and the EUTM do not strike me as especially material in these proceedings. I do find that the evidence was richer in relation to the EU and extends the range of goods for which genuine use has been shown. I note, in particular, the reference to advertising for quinoa and promotion of coconut water. There are also more references to Goya branded foods in the invoices at Exhibit CC13 – for example, as proof of use for “fish” Mr Stobbs drew my attention to one of the invoices in Exhibit CC13 (dated 30 June 2014 to France) which includes Goya-branded “*sardines in tomato sauce*”. I am content to frame a fair specification in respect of the EU marks, as covering all of the goods for which I have found genuine use in the UK (under the revocation proceedings), but supplemented by the EU evidence, to cover *grains, tinned fish and coconut water*. Had I considered the catalogue evidence sufficient to substantiate, genuine use in relation, for example, to preserved meats or a slightly wider range of Goya-branded goods than indicated by the above fair specification, any such differences could not be such as to materially affect my analysis (or conclusions) below.

The section 5(2)(a) claim

84. Section 5(2)(a) of the Act, reads as follows:

“5. – [...]

(2) A trade mark shall not be registered if because –

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

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

Foods Inc's earlier marks	GmbH's applied for mark
<p style="text-align: center;">GOYA</p> <p style="text-align: center;">International registration (IR) 982166 and UK trade mark (No. 2278362)</p>	<p style="font-size: 2em;">GOYA</p>
<div style="text-align: center;">  </div> <p style="text-align: center;">EUTM No. 4845772</p>	

85. Fair and notional use would allow GmbH's word mark to be presented in another typeface and font, and I note the broad protection for word marks both when comparing for similarity²² and in relation to variants for establishing genuine use²³. However, in considering the two marks in the context of whether they are identical I must have in mind the guidance of the Court of Justice of the European Union ("the CJEU") in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*²⁴, where it held that "... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."
86. Clearly the earlier word mark registered in the UK and protected in the EU (IR 982166) is identical to the mark that GmbH has applied for. Since I have afforded both word mark IR 982166 and the figurative EUTM (4845772) the same fair specification, the claims under section 5(2)(a) and 5(3) may adequately proceed solely on the basis of the earlier word mark. Nonetheless, having regard to the guidance in *Sadas Vertbaudet*, I anyway find that the figurative mark may also be considered identical to the applied-for word mark.

²² See T-211/03 *Faber v OHIM* [2005] ECR II-1297, paragraph 37 and T-434/07 *Volvo v OHIM* [2009] ECR II-4415 at paragraph 37

²³ See T-333/15 *Josel v EUIPO*, EU:T:2017:444, the General Court held that "the font that the sign might be presented in must not be taken into account" (at paragraph 38) and this was reiterated in T-24/17 *La Superquímica v EUIPO*, EU:T:2018:668 at paragraph 39. See too Professor Phillip Johnson as the Appointed Person in the appeal decision in the *Dreams* case (BL O/091/19).

²⁴ Case C-291/00 at paragraph 54

Comparison of the goods

87. Having found the parties' marks identical, thereby satisfying an initial essential requirement under section 5(2)(a), it is necessary to compare and assess the respective goods and services in relation to the further essential requirement under section 5(2)(a) that they be similar. For the purposes of that comparison exercise, since the fair specification for the earlier EU marks more than covers the goods for which I have found genuine use of the earlier UK mark, I shall assess similarity based on that fair specification.
88. The respective goods and services contested under section 5(2)(a) are as follows:

GmbH's contested goods and services
<p>Class 26: <i>artificial flowers</i></p> <p>Class 38: <i>Telecommunications</i></p> <p>Class 44: <i>Medical services; agriculture, horticulture and forestry services</i></p>
Fair specification of Foods Inc's goods
<p><i>tinned fish; preserved, dried and cooked fruits and vegetables; grains; jams; milk and milk products; edible oils and fat; flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices; fruit drinks, fruit juices and coconut water</i></p>

89. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law. Thus, in *Canon* the Court of Justice of the European Union ("**the CJEU**") stated that:

*"In assessing the similarity of the goods ... all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".*²⁵

²⁵ Case C-39/97, at paragraph 23.

90. In *Boston Scientific*, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking*”.²⁶ I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.²⁷
91. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case²⁸ for assessing similarity were:
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of service;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
 - (f) The extent to which the respective goods or services are competitive.
92. I also bear in mind that terms used to specify services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.²⁹
93. *Artificial flowers* – comparing these contested goods with the goods under the earlier marks I find that they differ in their nature, their intended purpose and their method of use, do not compete with each other and nor are they complementary. There is nothing to suggest they share channels of trade and they are not found alongside each other in a

²⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06
²⁷ Case C-50/15 P

²⁸ *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

²⁹ See, for example, Lord Justice Arnold at paragraph 47 of *Sky v Skykick* [2020] EWHC 990 (Ch).

supermarket. There is no particular connection based on the users of the respective goods. The goods are entirely dissimilar.

94. *Telecommunications* - Foods Inc argued that the coverage of the term “telecommunications” is wide, and could include, for example, ‘providing access portals on the Internet’. It was submitted as follows: *“Food producers use portals (online shops) to sell their own brand products. For example, TESCO, WAITROSE, SAINSBURY, ASDA. Alongside those products often sit portals which have information (e.g. technical food information, recipes, etc). This is a common practice. Average consumers are used to interacting with these food brands online through their portals, particularly in these COVID-stricken times, and to seeing the brand of these companies’ foods alongside their provision of such information, recipes, etc.; An average consumer on a food manufacturer’s portal branded GOYA may therefore think that responsibility for the portal lies with the same undertaking.”* I noted no evidence on that point, but in my view it would anyway be irregular to find material similarity based on that line of reasoning. Comparing these contested services with the goods under the earlier marks I find that they differ in their nature, their intended purpose and their method of use, do not compete with each other and nor are they complementary. There is no particular connection based on users. These contested services are dissimilar.
95. *Medical services; forestry services* - comparing these contested services with the goods under the earlier marks I find that they differ in their nature, their intended purpose and their method of use, do not compete with each other and nor are they complementary. There is no particular connection based on users. These contested services are also dissimilar.
96. *agriculture services and horticulture services* - comparing these contested services with the goods under the earlier marks I find that they differ in their nature, their intended purpose and their method of use, do not compete with each other and there is no particular connection based on users. I note that the evidence indicates that Goya en España has a production centre near Seville to meet the demand for olive oil and olives.³⁰ The agricultural service of growing olives would be a service provided to food

³⁰ Exhibit CC3

manufacturers or supermarkets. Growing and selling one's own olives is just trading in goods whether the buyer is the public or a supermarket. Although food and drink goods may ultimately be the products of processes of agriculture or horticulture, the average consumer who buys the goods under the earlier marks is simply buying different types of foodstuffs (or drinks); they are not buying agriculture or horticulture services. In my view, the earlier goods and these services are not complementary in the sense described in *Boston Scientific*. I find these services dissimilar to the earlier goods.

97. I note the following observation of Patten J in *Intel Corp*³¹: *"It is clear that the flexibility inherent in [the] global approach [to assessment of likelihood of confusion] leaves intact the threshold requirement for a recognisable degree of similarity between the goods and services in question. The distinctiveness and strength of the earlier mark may lessen the degree of similarity required, but it does not eliminate it."* I also note the later observation by Lady Justice Arden in *eSure v Direct Line*³² that she did "... considered that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."
98. **Outcome:** Since some similarity of goods/services is essential to a claim under section 5(2)(a) of the Act, Foods Inc's opposition based on this ground must fail, since I have found all of the goods and services to be dissimilar.

The section 5(3) claim

99. Section 5(3) of the Act reads as follows:

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b)

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would

³¹ *Intel Corp v Sihra* [2004] ETMR 44 at [12]

³² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, at paragraph 49. See too *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

100. Section 5(3A) states that those provisions apply “irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.” In contrast to the 5(2)(a) ground, the opposition under section 5(3) is directed against all of the applied-for goods and services. The relevant date at which Foods Inc must establish reputation is again the date of 10 July 2017 (the relevant date).
101. General relevant case law principles can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*, Case C-383/12P. The law appears to be as follows.
- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
 - (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
 - (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
 - (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42
 - (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a

serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, para. 40.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

102. The section 5(3) claim in this opposition is based on Foods Inc's same three earlier marks. Success under this ground requires several conditions, (i) identity or similarity between the contested mark and the earlier mark(s); (ii) evidence that the earlier registered

mark(s) has/have a reputation in the relevant territory (which in this case, is the EU for two of the earlier marks and the UK for the third); (iii) that use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark; and (iv) that such use must be without due cause. These conditions are cumulative and failure to satisfy any one of them is sufficient to defeat the claim. As to requirement (i), I have found the earlier marks identical, but if there were any doubt as to whether the earlier figurative is identical with the applied-for mark, they are clearly at least similar to the highest degree. As to the other conditions, it seems to me that the central issue is the question of reputation and whether the relevant public will make a mental link to the earlier mark(s). In addressing this central issue, I hold in mind various questions, including: (a) as to which goods may have a reputation (b) the territories in which reputation should be assessed (c) guidance on at what threshold, and on what evidential basis, reputation may be found and may lead to the necessary mental link.

103. Each of the earlier marks may be relied on only to the extent that it has been shown that they have been put to genuine use. In the case of the UK mark, I have found genuine use only in relation to the following goods Class 29: *preserved, dried and cooked fruits and vegetables; jams; milk and milk products; edible oils and fats*; Class 30: *flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices*; Class 32: *fruit drinks and fruit juices*. It is only in respect of those goods that I must consider the reputation insofar as the section 5(3) claim is based on the earlier UK registration. Assessment of that reputation is formally limited to the UK; I note, however, that the same plain word GOYA is also one of the other earlier marks, where the relevant territory is the EU and where the fair specification of goods is wider, extending to *grains, tinned fish and coconut water*. My consideration of reputation will therefore also need to address those goods and that territory.

Evidence and threshold for reputation

104. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is **known by a significant part of the public**. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.

105. In *Enterprise Holdings Inc. v Europcar Group UK Ltd*,³³ Arnold J stated that proving a reputation “is not a particularly onerous requirement.” However, the evidence before Arnold J in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation “is not a particularly onerous requirement.” He had no reason to turn his mind to situations where the claimant had only a small and/or unquantified share of the relevant market.
106. Professor Phillip Johnson, as the Appointed Person in the SACURE appeal decision,³⁴ stated to the effect that it is not the case that a party relying on an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the other party. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.
107. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.” That said, such evidential factors are only examples of relevant evidence; other “detailed and verifiable evidence” may be sufficient to establish reputation.³⁵

UK reputation

108. While clearly each case must be determined on its facts, I note the following recent UK case law as illustrative. In *Spirit Energy*, the opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13 million in income. However, there was limited evidence of advertising and promotion, and

³³ [2015] EWHC 17 (Ch)

³⁴ Case BL O/360/20

³⁵ *Farmeco AE Dermokallyntika v OHIM* Case T-131/09 at paragraph 59.

the amount spent promoting the mark had fallen in the years leading up to the relevant date. Moreover, the mark had been used only in South East England and the Midlands. Taking account of all the relevant factors, Professor Phillip Johnson as the Appointed Person concluded that such use of the mark was not sufficient to establish a reputation for the purposes of section 5(3).³⁶

109. In so far as any reputation is claimed in the territory of the UK, I consider the comments I made earlier in relation to the claimed enhanced distinctiveness to be similarly pertinent: thus, while I have allowed that the evidence filed is sufficient to establish a limited degree of genuine use, there are notable aspects in which the evidence is lacking. There is, no information at all on overall UK turnover or sales volume under the mark or UK market share, no apparent advertising expenditure in the UK and scant evidence of the general public in the UK having encountered the marks. The invoice amounts are very modest for such goods. Taken in the round the evidence falls hopelessly short of what would be needed to conclude that the marks benefit from a reputation among the UK general public.

EU reputation

110. Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria.³⁷ In so far as reputation is claimed in the territory of the EU, I note the following case law comment by the CJEU in *Pago* (in the context of the Community trade mark, of course since replaced by the European trade mark).³⁸ The CJEU stated: “Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community.” In *Pago*, reputation had been established throughout the territory of one Member State (Austria), which in the circumstances of those proceedings, satisfied the territorial requirement for reputation.

111. A greater part of the evidence filed for Foods Inc related to use in the EU (as opposed to the UK). In particular there is an emphasis on its presence and promotion in Spain. This is not surprising given the Hispanic emphasis of the goods in evidence. It cannot be ruled

³⁶ *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20

³⁷ See Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC (IPEC), at paragraph 69.

³⁸ *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, paragraph 27

out that Spain could constitute a substantial part of the territory, all the more so when coupled with evidence relating to other member states, including a trade event in Germany. The Spanish emphasis is bolstered by the fact that in 2010 Goya Nativo had a distribution centre outside Madrid (Toledo) and a production centre in Seville (Goya en España) (Exhibit CC3) - however, it refers to the USA as its principal market, notwithstanding that “Goya-branded olives and extra-virgin olive oil continued to be prized in many European and American markets.” I also note that Exhibit CC3 states that it was only around 2004 that Goya products were sold for “the first time on Spanish soil”. Mr Colon presents evidence that Foods Inc is a large, long-standing US food company, with an annual worldwide revenue stated to be \$1.5 billion.

112. That Foods Inc is a substantial food company viewed globally is again emphasised at **Exhibit CC6** and **Exhibit CC7**. **Exhibit CC6** is an industry report on the Bouillon market share, which describes Goya Foods as a “key player” among a dozen or so other companies including famous names such as Nestle and Unilever. The report refers to five regions Asia-Pacific, Europe, North America, Middle East and Africa and to various product segmentation including vegetable, fish, meat, poultry. It is not possible to discern precise information about Goya’s use of its brand in respect of bouillon in Europe, (let alone UK). **Exhibit CC7** is a screenshot of a digest of a report entitled "Hispanic Foods Market - Global Industry Analysis, Size, Share, Growth, Trends and Forecast 2016 - 2024".³⁹ The Report Digest lists a range of the types of foods products considered in the report, on such as tortillas, tacos, salsa, refried beans, nachos, burritos, Tex-Mex cuisine. Goya is again listed as a "Key Player" in the global Hispanic foods market. The digest reveals no information about the size of the relevant EU (let alone UK) market nor about market share.

113. The evidence notably includes annual turnover at an EU level. The 2012-2017 invoice evidence at Exhibit CC12, which I referred to earlier is said to equate to around €125,000 of annual sales of the Goya Products in the EU. Even setting aside that many of those goods will not strike the consuming public as Goya goods (since they bear different brands), such sums are wholly inadequate to sustain a claimed reputation for the food and drink goods at issue. Evidence of industry recognition may potentially contribute to

³⁹ conducted by Transparency Market Research

establishing a reputation and I do not overlook that **Exhibits CC14** and **CC15** show evidence of award recognition for Goya-branded goods. This relates mainly to Goya olive oil which has won various awards worldwide since 2017 (mainly from 2018 or later). Some of the awards were in Spain in 2018, but I do not consider the awards evidence of a scale or profile sufficient to warrant a finding of reputation. Mr Colon refers at paragraphs 99 – 105 of his first witness statement (with reference to Exhibits 29 - 32) to endorsements and sporting sponsorships in the EU to promote the GOYA brand (for example in relation to an international Spanish basketball player). I do not consider such evidence of a sufficient detail, scale or profile sufficient to warrant a finding of reputation. I also note, for example, that the invoices relating to sponsorship of Gol de Oro best football goal of the day, relate to dates after the relevant date. Taken in the round and considering the guidance from the case law I cited earlier, I find the evidence fails to show a reputation in the EU, even when I focus on the evidence relating to Spain. The earlier marks therefore have no reputation neither on the basis of the UK nor the EU. In the absence of a reputation, the section 5(3) ground cannot succeed.

114. Even if I had found that the evidence filed sufficed to establish a reputation in the EU, driven by use in Spain, I would have concluded that the section 5(3) would still not succeed. Where an EUTM has a reputation outside the UK, it is more difficult to show the necessary 'link'. This is because the relevant territory for assessing unfair advantage/detriment to the earlier marks is the UK. Therefore, the reputation must be sufficient to stimulate a link amongst UK consumers. The strongest evidence related to Spain, where there was at least some evidence of some goods – albeit largely limited to coconut water, fruit drinks, beans and quinoa – benefiting from a degree of promotion in magazines and newspapers and in radio adverts. Case law guidance also indicates that a mark with a qualifying reputation must be known to more than a commercially non-negligible part of the relevant public.
115. In the *Iron & Smith* case,⁴⁰ the CJEU was asked whether a CTM (now an EUTM) with a reputation 'in the Community' (now the European Union), but not in the Member State where infringement was alleged, was capable of being infringed under the European

⁴⁰ *Iron & Smith kft v Unilever NV*, Case C-125/14

legislative provisions broadly equivalent to section 5(3) of the Act. The court answered that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

116. It is apparent from the court’s judgment that “*a commercially significant part of the [relevant] public*” is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. This is confirmed by versions of the judgment in other languages. The French version says that a “*commercially non-negligible*” part of the relevant public in the Member State must be aware of the earlier CTM (now EUTM) and make a link with the later national trade mark.

117. It follows that where there is no awareness of the EU trade mark in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary ‘link’ between the EU mark and the later national mark. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the [EU] reputation and/or the distinctive character of the EU trade mark.

Outcome: The opposition based on section 5(3) of the Act fails.

The section 5(4)(a) claim

118. Section 5(4)(a) of the Act provides that: “... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.” Section 5(4) also states that “A person thus

entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.”

119. Foods Inc claims an earlier right in relation to the GmbH’s application arising from use of GOYA as an unregistered sign throughout the UK since 2001 in relation to “food and drink”. Case law highlights the need for a degree of cogency in the evidence of reputation (goodwill in the UK) and its extent.⁴¹ In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Thomas Mitcheson QC, as the Appointed Person, emphasised that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

120. At the hearing Mr Stobbs acknowledged that the section 5(4)(a) ground was likely to take matters no further than any success that may be achieved in reliance on the registered rights under sections 5(2) and 5(3) of the Act. I agree that that is the case, and in the interests of procedural efficiency I do not consider it warranted to deal with this ground in detail. I find that the evidence of use in the UK is very small and not sufficient to give rise to actionable goodwill (as is the claim) for food and drink at large. Even if there were goodwill to the extent of the food and drink goods in respect of which I have found genuine use in the UK, it would not lead to misrepresentation. Any such goodwill would be very small, and, as I have previously found, the contested goods and services of GmbH are not similar. The absence of a common field of activity, is not fatal of itself; but it is an important and highly relevant consideration.⁴² Where parties do not operate in a common field of activity the burden of establishing misrepresentation and damage is all the greater. Despite the identity of the parties’ sign/marks, in view of the dissimilarity of the goods and services, taken with (at most) a small quotient of goodwill, I do not find that when GmbH applied for its contested mark, its use would have been liable to have been prevented by the law of passing off.

Outcome: The opposition based on section 5(4)(a) of the Act fails.

⁴¹ See for example Pumfrey J at paragraph 27 of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC)

⁴² See, for example, Millet L.J. in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

121. OVERALL OUTCOME OF THE OPPOSITION

The trade mark application under No. 3242636 may proceed to registration in respect of all of the goods and services applied-for in classes 26, 38, 44 and 45.⁴³

THE INVALIDITY CLAIMS (CA502003 and CA502001)

Applicable legislative provisions

122. Section 47 of the Act deals with invalidity. The following extracts reflect the statutory law at the time when these proceedings were commenced.

Invalidity

123. Section 47 of the Act deals with invalidity. The relevant provisions are:

47. –[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if -

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

⁴³ (Trade mark application no. 3242636 had originally included goods in Class 33, but on 5 December 2019, GmbH filed a Form TM21B to delete Class 33 in its entirety.)

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

...

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

Proof of use in the invalidity actions

124. For the purposes of the invalidity actions against GmbH’s registrations for the marks “GOYA” and “GOYA YOGA”, Foods Inc is able to rely on its three earlier marks as the basis for its section 5(2)(a), 5(2)(b) and 5(3) claims only to the extent that the evidence establishes, in respect of its registered goods, genuine use of its earlier word mark



“GOYA” in the UK and/or the EU, and/or of its mark  in the EU, during the five year period ending with the date of application for invalidation, which in both instances is 5 March 2018. **The relevant period for proving use in the invalidity actions is therefore 6 March 2013 to 5 March 2018.** I find that the evidence warrants no material divergence from my earlier findings as to genuine use. And once again, since the fair specification for the two earlier EU marks more than covers the goods for which I have found genuine use of the earlier UK mark, I shall assess the respective goods and services based on the fair specification: *tinned fish; preserved, dried and cooked fruits and vegetables; grains; jams; milk and milk products; edible oils and fat; flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices; fruit drinks, fruit juices and coconut water.*

CA502003 AGAINST UK TRADE MARK No. 3229977

125. Foods Inc seeks a declaration of invalidity, based on claims under section 5(2)(a), 5(2)(b), and 5(3), against GmbH's trade mark registration for “GOYA” in respect of goods and services in classes 5, 9, 25, 39, 41 and 43.
126. I will deal first with the claims under section 5(2)(a) and 5(2)(b). I have previously set out the provisions of section 5(2)(a) of the Act. Section 5(2)(b) of the Act, reads 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”.
127. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case

C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

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

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods

128. Having found the parties’ marks identical, satisfying the need for identity or similarity of marks for the section 5(2) grounds, it is necessary to compare and assess the respective goods and services in relation to the further essential requirement that they be at least similar.⁴⁴ For the purposes of that comparison exercise, since the fair specification for the earlier EU marks more than covers the goods for which I have found genuine use of the earlier UK mark, I shall assess similarity based on the fair specification.

129. The respective goods and services contested under section 5(2) are as follows:

GmbH’s contested goods and services	
Class 5:	dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals
Class 9:	magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; computer software
Class 25:	clothing, except clothing accessories, namely scarfs, gloves, belts and ties.
Class 39:	Travel arrangement.
Class 41:	Education; providing of training; entertainment; cultural activities.
Class 43	Services for providing food and drink; temporary accommodation

⁴⁴ Under the opposition, I previously found the earlier marks identical, but if there were any doubt as to whether the earlier figurative is identical with the applied-for mark, they are clearly at least similar to the highest degree (and identical aurally and conceptually).

Fair specification of Foods Inc's goods

tinned fish; preserved, dried and cooked fruits and vegetables; grains; jams; milk and milk products; edible oils and fat; flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices; fruit drinks, fruit juices and coconut water

130. In considering the extent to which there may be similarity between the goods and services, I take account of the guidance from relevant case law as I have set out previously. I also note Foods Inc's submissions as to similarity with the earlier goods.

131. **Class 5: *dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals***

Foods Inc contends that the goods under its earlier registrations have the same relevant public and distribution channels as "*dietetic food and substances adapted for medical or veterinary use; dietary supplements for humans and animals*". It is not clear to me that the respective relevant goods do share channels of trade and no evidence was filed in support of the submitted points. The relevant consumer for the earlier goods is the public at large, rather than a specialised consumer base, so I do not consider that an especially strong point for similarity. Nonetheless, although the contested goods may be targeted at medical, veterinary or dietary professionals, I agree that the general public are also consumers of the dietetic foods and supplements. *Dietetic food* does have a degree of overlap with the earlier goods in as much as they are both to be consumed by humans for nutritional purposes. However, the adaptation for medical purposes creates a point of difference. Insofar as the contested goods are for animals or for veterinary use, I consider them to be unlike. Comparing the goods under the earlier marks with the contested Class 5 goods, I find a degree of similarity in relation to *Dietetic food adapted for medical use*; yet the goods have different focuses of purpose, are not in clear competition with each other and nor are they complementary in the sense described in *Boston Scientific*. Overall, I consider the goods of the fair specification to be **similar to dietetic food and substances adapted for medical use, but only to a low degree**.

"*Food for babies*" tends to be processed in a particular manner to meet the nutritional and eating strictures of the very young; nonetheless, it is produced from things like milk, fruit

and vegetables, although in supermarkets food for babies tends to be sold from shelves quite separate from the goods under the fair specification. Overall, I find **similarity with food for babies, but only to a degree between low and medium**. **Dietary supplements for humans** may include, for example, protein drinks or certain vitamin products in liquid or powder form, such that there is some similarity with, say, milk products, **but only to a degree between low and medium**. The other contested goods in Class 5 are in my view **dissimilar**, namely: **dietetic food and substances adapted for veterinary use; dietary supplements for animals**.

132. **Class 9: magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; computer software.**

Foods Inc's submissions argued that "magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media ... include content carriers featuring food, which have the same relevant public. I have already commented on the generality of the consumer. These goods differ in their nature, their intended purpose and their method of use, do not compete with each other and nor are they complementary. In my view all of the contested goods in Class 9 are **dissimilar** from those under the earlier marks.

133. **Class 25: clothing, except clothing accessories, namely scarfs, gloves, belts and ties**

Foods Inc's submissions argued that that "clothing" (Class 25), includes clothing for catering, which would have the same relevant public. As above, I do not consider that to generate a material similarity; the contested goods in Class 25 are **dissimilar**.

134. **Class 39: Travel arrangement** – these services are manifestly **dissimilar** to the earlier goods.

135. **Class 41: Education; providing of training; entertainment; cultural activities**

Foods Inc submitted that "Education; providing of training" includes food-related education and training, which have the same relevant public as the earlier goods. I do not consider that to generate a material similarity; they differ in their nature, intended purpose and method of use, do not compete with each other and nor are they complementary. These contested services are **dissimilar**.

136. Foods Inc submitted that “entertainment” and “cultural activities”, include food shows and food-related cultural events, which have the same distribution channels, relevant public and producer/provider. In my view this again stretches an ordinary understanding of similarity. Services and goods are essentially different in nature. Whereas entertainment and cultural activities entail the arrangements for the diversion and social engagement or enrichment of the consumers of those services, the earlier goods are substances to be eaten or drunk. They differ in their nature, intended purpose and method of use, do not compete with each other and nor are they complementary. The earlier goods are typically sold in shops and supermarkets, who acquire them from growers and manufacturers – none of these are typically providers of entertainment or cultural activities – the trade channels are different. I find the contested services **entertainment** and **cultural activities** to be **dissimilar** from the goods under the earlier marks.

Class 43 Services for providing food and drink; temporary accommodation

137. Foods Inc submitted that **services for providing food and drink** include takeaway services, which have the same relevant public as the earlier goods. In my view, although services and goods differ in nature, there is a degree of similarity between, for example, the earlier *pastry and confectionery* and *fruit drinks* and the applied-for *services for providing food and drink*. A consumer may buy goods falling within the fair specification from a provider of those services, which gives rise to aspects of shared channels of trade, competition and purpose and potentially of complementarity. **I consider the degree of similarity to be no more than medium.**

138. Comparing **temporary accommodation** services with the earlier goods I find that they differ in their nature, intended purpose and method of use, do not compete with each other and nor are they complementary. There is no particular connection based on users. These contested services are **dissimilar**.

139. Since at least some similarity between goods or services is essential to a claim under sections 5(2)(a) or 5(2)(b), Foods Inc’s application for invalidity based on these grounds must fail in relation to the goods and services that I have concluded are not at all similar. However, since I have found some degrees of similarity in respect of **dietetic food and substances adapted for medical use; food for babies; dietary supplements for**

humans and **services for providing food and drink**, it is still necessary for me to address the global assessment of likelihood of confusion.

The average consumer and the purchasing process

140. In *Hearst Holdings Inc*,⁴⁵ Birss J explained that “... *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 relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical*”.
141. The average consumer for the goods under Foods Inc’s fair specification will be a member of the general public.⁴⁶ Although certain ingredient foods or spices and so on may be bought for particular purposes or styles of cuisine, they are essentially fairly casual and frequent purchases, involving modest expense. Foods Inc submitted that the average consumer “will afford a low to reasonable degree of attentiveness and circumspection to their involvement with the relevant mark”. I find that the average consumer will pay no more than a medium degree of attention.
142. The average consumer will purchase the goods either by self-selection from a retail outlet, or from a website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase, given the potential for oral recommendations and that advice may be sought from retail assistants.
143. The average consumer for *dietary supplements for humans; dietetic food and substances adapted for medical use* will include medical professionals, but also the general public. Selection of these goods may entail a higher than medium level of attention given the attendant health considerations. The average consumer for *food for babies* will be the general public and selection of these goods may again entail a higher than medium level of attention given the particular care parents often give to the feeding of their young. The average consumer for *services for providing food and drink* will include the general public;

⁴⁵ *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), at paragraph 60.

⁴⁶ Paragraph 27 of the skeleton argument for Foods Inc concurs. I also note that Exhibit CC4 states that “Foods Inc’s products include a full range of grocery, and frozen foods aimed at the general public as well as people of Latin American or Iberian birth or ancestry”.

the level of attention may vary, but, for example, buying food or drink to take away may be a casual interaction where the level of attention of may be fairly low – no more than medium.

Distinctiveness of the earlier mark

144. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.⁴⁷ In *Lloyd Schuhfabrik*, 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-2779, 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)”.

145. The earlier marks involve little or no more than the single word GOYA. The word has no meaning in the English language although many among the average consumer group will be aware that it is the surname of a famous (though long-dead) Spanish artist and the name by which he is commonly referenced. From knowledge of that artist, some may perceive the word as a Spanish surname more generally. At any rate it is certainly not a common name in the UK and the word has no degree of allusiveness in relation to the

⁴⁷ *Sabel BV v Puma AG*, Case C-251/95 at [24]

contested goods or services. **I consider the earlier mark to be inherently distinctive to a reasonably high degree.**

146. Were Foods Inc to have any prospect of benefiting from a claim of enhanced distinctiveness, the evidence would need to show use of the earlier marks, in relation to the relevant goods, sufficient to have enhanced the distinctiveness of the mark among the average consumer in the UK, and to have done so by the date that the GmbH applied for its marks i.e. by 10 July 2017 (the relevant date).⁴⁸ As implied by the extract from *Lloyd Schuhfabrik* above, evidence going to enhanced distinctiveness may include elements such as turnover and sales, advertising expenditure, market share, duration and reach of use and so on. While I have allowed that the evidence filed is sufficient to establish genuine use (to the extent that I have), there are notable aspects in which the evidence is lacking. There is, no information at all on overall UK turnover or sales volume under the mark or UK market share, no apparent advertising expenditure in the UK and scant evidence of the general public in the UK having encountered the marks. The invoice amounts are very modest for such goods. Taken in the round the evidence falls very far short of what would be needed to conclude that the marks benefit from enhanced distinctiveness through use.

Conclusion as to likelihood of confusion

147. In my global assessment of likelihood of confusion, I take account of all of my findings relevant to this ground. The factors operate interdependently. I have found that there is similarity between the earlier goods and *dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans* and *services for providing food and drink*. I bear in mind that a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and in this case the contested word mark is identical to the earlier word mark (and at least aurally and conceptually identical with the earlier figurative mark) and the earlier marks are distinctive to a reasonably high degree. Whereas a high degree of attention paid in the purchasing process for goods or services may, in some instances, have the potential to mitigate against a likelihood of confusion, no such factor operates in this case. The attention by

⁴⁸ Enhanced distinctiveness is claimed at paragraph 26 of the skeleton argument filed for Foods Inc.

the general public during the purchasing process includes levels of attention pitched only at “higher than medium” (not high); moreover since the marks are identical, they give nothing to distinguish the sources. I conclude that there is a risk that the public will wrongly believe that the respective goods or services come from the same or economically linked undertakings, i.e. there is a likelihood of confusion if the contested mark were used in relation to *dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and services for providing food and drink.*

148. **Outcome:** The application for cancellation based on sections 5(2)(a) and (b) succeeds in relation to *dietetic food and substances adapted for medical use; food for babies; dietary supplements for humans and services for providing food and drink.*

The section 5(3) claim

149. The cancellation proceedings are based on the same earlier marks relied on for the purposes of the opposition; my earlier conclusions as to whether Foods Inc has shown that it has the necessary reputation from which the UK consumer will make a mental link are therefore directly and equally applicable. The earlier marks therefore have no reputation neither on the basis of the UK nor the EU. And even if there is a reputation in the EU, there will be no link made between the marks by UK consumers. In the absence of a reputation or link, the section 5(3) ground fails.

150. **OVERALL OUTCOME OF CA502003**

The application for cancellation against trade mark registration 3229977 **succeeds to a limited extent only**. The goods and services scored-through below are deemed to have never formed part of the registration and are cancelled as from the filing date of the registration i.e. **9 May 2017**. The rest of its goods and services remain intact.

Class 5: Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; ~~dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals;~~ plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; data processing equipment, computers; computer software

Class 25: Clothing, except clothing accessories, namely scarfs, gloves, belts and ties

Class 39: Travel arrangement

Class 41: Education; providing of training; entertainment; sporting and cultural activities

Class 43: ~~Services for providing food and drink;~~ temporary accommodation

CA502001 AGAINST UK TRADE MARK No. 3229979

151. Foods Inc seeks a declaration of invalidity, based on claims under section 5(2)(b), and 5(3), against GmbH's trade mark registration for "GOYA YOGA" in respect of goods and services in classes 25, 35, 39, 41 and 43. I have explained why the section 5(3) ground fails, so have only to consider the challenge based under section 5(2)(b).

Comparison of the goods

152. It is necessary to compare and assess the respective goods and services in relation to the essential requirement under section 5(2)(b) that they be similar or identical. As previously explained, I assess similarity based on the fair specification.

153. The respective goods and services contested under section 5(2)(b) are as follows:

GmbH's contested goods and services
Class 25: Clothing, footwear, headgear
Class 35: Advertising; business management; business administration
Class 39: Transport; travel arrangement
Class 41: Education; providing of training; entertainment; cultural activities
Class 43: Services for providing food and drink; temporary accommodation.

Fair specification of Foods Inc's goods

tinned fish; preserved, dried and cooked fruits and vegetables; grains; jams; milk and milk products; edible oils and fat; flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices; fruit drinks, fruit juices and coconut water

154. Some of the contested goods and services under this registration align with those I considered in the CA502001 above and I can deal with them here swiftly.

Class 25: *Clothing, footwear, headgear* - these contested goods in Class 25 are **dissimilar**.

Class 39: *Transport; travel arrangement* - these services are **dissimilar** to the earlier goods.

Class 41: *Education; providing of training; entertainment; cultural activities* - these services are dissimilar to the earlier goods.

Class 43: *Services for providing food and drink* – these services are similar to the earlier goods, but to no more than a **medium degree**. The services of *temporary accommodation* are not at all similar.

155. **Class 35:** *Advertising; business management; business administration*. In relation to these services in Class 35, Foods Inc submitted that business management would cover food-related businesses, which have the same relevant public. I do not consider that to generate a material similarity; these services differ in their nature, intended purpose and method of use, do not compete with each other and nor are they complementary. There is no particular connection based on users. These contested services are **dissimilar**.

156. Foods Inc's application for invalidity based on section 5(2)(b) must fail in relation to the goods and services that I have concluded are not at all similar. Consequently, I need only to address the global assessment of likelihood of confusion in relation to *Services for providing food and drink* were they to be provided by reference to the contested mark "GOYA YOGA".

Previous relevant findings

157. My previous findings as to the distinctiveness character of the earlier marks remain applicable in the context of the challenge to this registration; so too do my findings as to the average consumer and purchasing process both for the goods under Foods Inc's fair specification and for *services for providing food and drink*.

Comparison of the marks

158. 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 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.*"⁴⁹

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

The earlier trade marks:	
The contested mark:	GOYA GOYA YOGA

160. The non-figurative earlier mark is closer to the contested mark, since they are both plain word marks; the earlier plain word is therefore the stronger basis on which to consider

⁴⁹ *Bimbo SA v OHIM, Case C-591/12P* (at paragraph 34)

Foods Inc's claim for similarity of the marks at issue and I shall compare only the respective plain word marks.

161. The overall impression of the earlier word mark is that it is simply the single word GOYA, which has no meaning in the English language.
162. The overall impression of the contested mark is that it is the non-English word GOYA followed by the well-known word YOGA – since they are of equal length and each makes up half of the mark, I do not consider either word notably dominant. Neither word has any allusive message in relation to the contested *services for providing food and drink*, so on that basis neither word is more distinctive than the other. To afford Foods Inc its best case, I acknowledge that GOYA is the opening word in the contested mark, and also take into account that it is not a standard English word; taking account of those two factors, I will allow that the word GOYA may benefit from the marginally greater degree of dominance and distinctiveness.

Visual similarity

163. The contested mark is visually different in that it is twice the length of the earlier mark. However, the first half of the contested mark is identical to the earlier mark and the second word of the contested mark has a visual overlap in that the words GOYA and YOGA differ only in the exchanged positions of the G and Y. The marks may be considered visually similar to medium degree.

Aural similarity

164. The shared word creates an element of aural identity; the additional word in the contested mark creates a notable aural difference. The marks may be considered aurally similar to a medium degree (at most).

Conceptual similarity

165. In line with my previous comments in relation to the distinctiveness of the earlier marks, from a conceptual perspective the earlier mark has no meaning in the English language although many among the average consumer group will know it to be the name of a Spanish artist and perceive the word as a Spanish surname more generally.

166. The same word is the first half of the contested mark, but since it is coupled with the familiar word YOGA – which as the skeleton argument for Foods Inc observed, is a form of stretching exercise with elements of meditation and philosophy – it seems less likely to retain the conceptual reference specifically to the Spanish artist but will more likely be seen simply as a name. At any rate, the well-known meaning in English of the second word, creates a notable point of conceptual difference from the earlier mark, especially noting that YOGA has no immediately graspable connection to the contested *services for providing food and drink*. I find that from a conceptual perspective the marks may be considered similar **to no more than a medium degree**.

Conclusion as to likelihood of confusion

167. I now turn to reach a conclusion as to a likelihood of confusion as between “GOYA” in respect of “tinned fish; preserved, dried and cooked fruits and vegetables; grains; jams; milk and milk products; edible oils and fat; flour preparations made from cereals, bread, pastry and confectionery; sauces (condiments); spices; fruit drinks, fruit juices and coconut water” and “GOYA YOGA” in respect of “services of providing food and drink”.

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

169. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public;⁵⁰ occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.⁵¹ The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to

⁵⁰ Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

⁵¹ See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

how the public might react to the presence of two trade marks in ordinary use in trade and, it is often very difficult to make such prediction with confidence.⁵²

170. Determining whether a likelihood of confusion exists is not an arithmetical or scientific process; it is a matter of making a global assessment of all relevant factors in accordance with case law principles, especially those outlined at paragraph 127 above. The marks in this instance have some similarity since they are partly identical. Moreover, the earlier mark is inherently distinctive to a reasonably high degree. On this basis the levels of similarity between the marks may be considered to rise as high as medium, but I also take into account the notable visual, aural and conceptual differences created by the second word. The goods and services are similar to no more than a medium degree. The general public, as the average consumer, will pay no more than a medium degree of attention.

171. Even allowing for the possibility that a mark may be imperfectly recalled and that marks are rarely directly compared side by side, I find no likelihood that the average consumer, deemed reasonably well informed, and reasonably circumspect and observant, will mistake one mark for the other. GmbH's mark comprises two words – including a standard English word with no allusiveness to the contested services and which is therefore reasonably distinctive for those services. The earlier mark is a single non-English word. I have borne in mind the distinctiveness of the earlier mark, but in my view the differences between the marks are such that were the marks used in relation to goods or services that are similar to no more than a medium degree, there will be no direct confusion.

172. I turn therefore to consider whether there is a risk of indirect confusion. It was argued on behalf of Foods Inc that the contested mark will be seen as one of its sub-brands. Iain Purvis QC, sitting as the Appointed Person, considered indirect confusion (and the difference between direct confusion) in *L.A. Sugar Limited v By Back Beat Inc*,⁵³ stating as follows:

⁵² Again see comments of Iain Purvis as the Appointed Person, *ibid*.

⁵³ Case BL-O/375/10

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

173. The crux of the indirect confusion is the consumer perception of “GOYA YOGA”. Sitting as the Appointed Person in *Eden Chocolat*⁵⁴, James Mellor QC stated as follows:

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was

⁵⁴ Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

explaining⁵⁵ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

174. It was argued on behalf of Foods Inc that the contested mark will be seen as one of its sub-brands. I do not accept that. No likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). I acknowledge that the earlier mark GOYA (alone) is reasonably highly distinctive for the goods it is able to rely on, but the word is not “so strikingly distinctive that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all” – it is after all a name. The addition of the word YOGA has a significant impact on the overall impression. YOGA has nothing to do with the earlier registrations; and YOGA is distinctive in relation to the contested services. In such circumstances I see no reason why the average consumer would consider the contested mark a logical and consistent brand extension of the earlier mark, particularly given the differences between the respective goods/services. In my view, there will be no indirect confusion on any basis.

175. **OVERALL OUTCOME OF CA502001:** The application for a declaration of invalidity fails and trade mark registration No. 3229979 remains intact.

COSTS

176. Across the four consolidated proceedings, both Foods Inc and GmbH have had various measures of success. However, the much greater balance of success is in favour of GmbH and it is entitled to a contribution towards its costs in defending the proceedings against it and in pursuing revocation of the earlier UK mark. I therefore make the following determination of costs in line with the scale published in the annex to Tribunal practice notice (2/2016) and apply a reduction to reflect the extent to which my decision has upheld the positions taken by Foods Inc. and to reflect the overlap between the proceedings.

⁵⁵ In *L.A. Sugar* – above.

Official fee for filing the application for revocation	£200
Preparing statement of grounds and reviewing the counterstatement:	£200
Reduction of 50% for partial success	-£200
Reviewing the statement of grounds and preparing counterstatement in the opposition	£200
Reduction of 10% for partial success	-£20
Reviewing the statement of grounds and preparing counterstatement in the CA502003	£200
Reduction of 15% for partial success	-£30
Reviewing the statement of grounds and preparing counterstatement in the CA502001	£200
Preparing evidence and considering and commenting on the other side's evidence across the proceedings (reflecting that Foods Inc's partial success)	£1000
Preparing for and attending a hearing (reflecting that Foods Inc's partial success)	£600
Total	£2350

177. I order Goya Foods Inc to pay Goya GmbH the sum of £2350 (two thousand three hundred and fifty pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 2nd day of December 2020

Matthew Williams

For the Registrar
