

O/652/20

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3416642  
BY PLENTIFUL SOLUTIONS LIMITED  
TO REGISTER AS A TRADE MARK:**

**BeeBae**

**IN CLASSES 16, 21 & 24**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 418258  
BY BEEBEE WRAPS LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 25 July 2019, PLENTIFUL SOLUTIONS LIMITED (“the applicant”) applied to register the trade mark **BeeBae**, under number 3416642 (“the application”). It was accepted and published in the Trade Marks Journal on 2 August 2019 in respect of the following goods:

Class 16: Food wrappers; Food wrapping plastic film; Food wrapping plastic film for household use; Films for wrapping foodstuffs.

Class 21: Food storage containers.

Class 24: Cotton cloths; Cotton fabric; Cotton fabrics; Textiles made of cotton; Textiles for food wrapping.

2. On 29 October 2019, BeeBee Wraps Limited (“the opponent”) filed a notice of opposition. The opposition is brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application.

3. In relation to its section 5(2)(b) claim, the opponent relies upon its United Kingdom trade mark number 3240341 (“the earlier mark”), which consists of the following:



4. The earlier mark was filed on 28 June 2017 and was entered into the register on 22 September 2017 for ‘*beeswax food wraps*’ in class 24.

5. The opponent contends that the competing trade marks are similar and the respective goods are identical or similar, giving rise to a likelihood of confusion, including a likelihood of association.

6. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified in Section 6A of the Act. Consequently, the opponent is entitled to rely upon its goods without having to establish genuine use.

7. Turning to the section 5(4)(a) claim, the opponent relies upon its alleged unregistered rights in the signs **BEEBEE WRAPS** and **BEEBEE**. It claims that the signs have been used throughout the UK since April 2017 and January 2018, respectively. Both signs, according to the opponent, have been used in relation to *'beeswax wraps, food wrappers, textiles for food wrapping'* and *'retail services in relation to beeswax wraps, food wrappers, textiles for food wrapping'*. The opponent claims to have acquired goodwill under the signs and contends that use of the contested mark would, therefore, be a misrepresentation to the public. The opponent argues that this would result in damage to the aforementioned goodwill.

8. The applicant filed a counterstatement denying the grounds of opposition. The applicant argues that the competing marks are different in appearance and composition. Moreover, the applicant submits that it is common for undertakings that sell beeswax food wraps to use marks containing the word 'bee' or figurative representations thereof. Based on these factors, the applicant denies that there is a likelihood of confusion and asserts that there are no "deceptive similarities" between the competing marks.

9. The opponent has been professionally represented throughout these proceedings by Ward Trade Marks Limited, whereas the applicant is unrepresented. Only the opponent filed evidence, which will be summarised to the extent that is considered necessary. Both parties were given the option of an oral hearing but neither requested to be heard on this matter and neither elected to file written submissions in lieu of a

hearing. Therefore, this decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

## **EVIDENCE**

### **Witness statement of David Hollingsbee**

10. Mr Hollingsbee's witness statement is dated 14 April 2020 and is accompanied by Exhibits DH1 to DH15. Mr Hollingsbee is a Director of the opponent company.

11. Mr Hollingsbee explains that the opponent manufactures and sells beeswax food wraps, consisting of organic cotton infused with beeswax, resin and organic jojoba oil. He also outlines that the founder of the company, Kath Austin ("KA"), developed an ecologically friendly formula after conceptualising the business in 2016. Thereafter, KA began to make and sell food wraps under the sign 'BeeBee Wraps' and the earlier mark. Initially, in April 2017, Mr Hollingsbee explains, business was conducted by KA via an online shop on the e-commerce website 'Etsy'. Mr Hollingsbee states that KA assigned all of her rights in the earlier mark, as well as any common law rights, to the opponent on 16 September 2019.

12. Mr Hollingsbee continues by outlining that the sale of the food wraps through the Etsy store was successful and, as a result, KA launched a website. From the summer of 2017, KA conducted business through the website. A print obtained from the internet archive 'archive.org' of the website [beebeewraps.com](http://beebeewraps.com) from 2 September 2017 is evidenced.<sup>1</sup> A post on the website from 11 May 2017 which discusses how plastic is problematic can be seen; the post also describes 'BeeBee' food wraps as "100% organic cotton, reusable food wraps infused with beeswax and plant oils".

13. According to Mr Hollingsbee, sales of BeeBee food wrap products continued to grow throughout 2017, especially during the Christmas period. These sales were further boosted by coverage of the brand in the Guardian newspaper. An extract of an

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<sup>1</sup> Exhibit DH3

online article from The Guardian dated 17 January 2018 is provided.<sup>2</sup> The article is titled 'Is it possible to live without plastic?' and includes readers tips on the topic. The 'BeeBee Wraps' brand is mentioned in the article, as is KA, and the opponent's food wrap products are recommended as an alternative to plastic.

14. From January 2018 through to the summer of that year, Mr Hollingsbee explains, KA incorporated the opponent company, moved into commercial premises and purchased waxing equipment. During the same period, sales of food wraps continued via the [beebeewraps.com](http://beebeewraps.com) website and through food/kitchen suppliers such as Aga Cookshop. A print obtained from the internet archive 'archive.org' of the website [beebeewraps.com](http://beebeewraps.com) from 12 April 2018 is exhibited.<sup>3</sup> Images of the opponent's food wrap products can be seen, which are described as "reusable beeswax food wraps that offer a sustainable alternative to plastic". The earlier mark as registered is visible on the website, as is the word-only mark 'BeeBee Wraps'. At that time, the website claimed that the brand had received media coverage from, inter alia, The Guardian, The Daily Mail, ITV News Anglia and BBC Radio 5live.

15. Mr Hollingsbee outlines that in the spring and summer of 2018, the company and its products gathered more publicity as a consequence of appearing in national newspaper articles. An extract of an online article from The Guardian dated 24 February 2018 is evidenced.<sup>4</sup> The article, titled 'Should I remove plastic from my life?', mentions 'BeeBee Wraps' in the context of swapping clingfilm for reusable waxed paper. Although Mr Hollingsbee also refers to an article dated 31 May 2018 in The Express, this does not appear to feature within the evidence.

16. During 2018, explains Mr Hollingsbee, the opponent began to use 'BeeBee' as its principle brand, both as a word-only mark and within another figurative mark. In this regard, he provides a print obtained from the internet archive 'archive.org' of the website [beebeewraps.com](http://beebeewraps.com) from 30 August 2018.<sup>5</sup> The print demonstrates that the

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<sup>2</sup> Exhibit DH4

<sup>3</sup> Exhibit DH5

<sup>4</sup> Exhibit DH6

<sup>5</sup> Exhibit DH7

word-only mark 'BeeBee' was used at this time, as well as the following figurative mark ("the figurative 'BeeBee' mark"):



17. I note that the word-only mark 'BeeBee' and the figurative 'BeeBee' mark can also be seen elsewhere in the evidence, demonstrating use in 2018 and 2019.<sup>6</sup>

18. Furthermore, Mr Hollingsbee explains that the opponent worked with Sky Ocean Rescue in order to produce a bespoke range of plastic-free food wraps. These, according to Mr Hollingsbee, were designed by celebrities such as Fearne Cotton, Cara Delevingne, Sienna Miller and Kate Moss as part of Sky's #PassOnPlastic campaign. An extract from the [beebeewraps.com](http://beebeewraps.com) website dated 30 November 2018 is exhibited which provides details of this collaboration.<sup>7</sup> The extract contains images of reusable food wrap products in Sky Ocean Rescue branded packaging.

19. In addition, Mr Hollingsbee states that the success of the opponent's brand has been recognised on a local and national level. In this connection, KA was named the SME Cambridgeshire Entrepreneur of the Year in June 2018 and the SME National Entrepreneur of the Year in December 2018. YouTube videos of the award ceremonies confirm both of these accolades.<sup>8</sup> A print obtained from the internet archive 'archive.org' of the website [beebeewraps.com](http://beebeewraps.com) from 31 March 2019 is also evidenced;<sup>9</sup> SME Cambridgeshire Business Awards 2018 winner, WISE100 and SME National Business Awards 2018 winner are listed as awards for 'BeeBee Wraps'.

20. Since 2018, Mr Hollingsbee outlines, the opponent's food wrap business has continued to grow. By 16 February 2019, its products had numerous local, national and international stockists. In this regard, he provides a print obtained from the internet

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<sup>6</sup> Exhibits DH10, DH11 & DH13

<sup>7</sup> Exhibit DH8

<sup>8</sup> Exhibit DH9

<sup>9</sup> Exhibit DH9

archive 'archive.org' of the website [beebeewraps.com/pages/stockists](http://beebeewraps.com/pages/stockists) from 16 February 2019.<sup>10</sup> The print lists national and regional stockists of the wraps including Booths Supermarkets, as well as smaller retailers in, inter alia, Cambridge, York, Sheffield, Pembrokeshire, Lincoln, Brighton, London and Glasgow. The print also shows that the products were available through purely online stores, as well as retailers in France, Belgium and the Faroe Islands.

21. According to Mr Hollingsbee, the opponent's product listing has also continued to grow. A print obtained from the internet archive 'archive.org' of the website [beebeewraps.com](http://beebeewraps.com) from 31 March 2019 is exhibited;<sup>11</sup> this shows 'BeeBee' branded beeswax food wraps in various sizes. Another extract from the [beebeewraps.com](http://beebeewraps.com) website is provided and, although it is undated, Mr Hollingsbee advises that it is from March 2020.<sup>12</sup> The figurative 'BeeBee' mark is visible at the top of the extract, as well as on the packaging of various food wrap products. There is also very limited evidence of 'BeeBee' branded wipes. The word-only mark 'BeeBee Wraps' is also visible in the extract.

22. Moreover, Mr Hollingsbee explains that KA appeared on the BBC programme 'Dragon's Den' in 2019. Extracts of articles from Business Weekly and Cambridge Independent are evidenced,<sup>13</sup> which confirm KA's appearance on the programme that aired on 8 September 2019. The articles refer to the 'BeeBee Wraps' brand and that its food wrap products were showcased on the programme.

23. The opponent's UK sales figures relating to food wrap products, as provided by Mr Hollingsbee, are as follows:

<b>Year</b>	<b>Units</b>	<b>Turnover (£)</b>
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<sup>10</sup> Exhibit DH10

<sup>11</sup> Exhibit DH11

<sup>12</sup> Exhibit DH13

<sup>13</sup> Exhibit DH12

2017	1,348	17,183
2018	17,312	160,838
2019	62,678	452,193

24. Sample invoices concerning the sale of the opponent's products in the UK from November 2017 to July 2019 have been provided.<sup>14</sup> The invoices were sent from the opponent to customers including, inter alia, Cambridge Cheese Company, Anything But Plastic (Glasgow), Aga Cook Shop (Telford), EH Booth (Preston), Abel & Co (London) and University of Manchester. The word-only mark 'BeeBee Wraps' appears on all of the invoices, while some feature the earlier mark as registered and others contain the figurative 'BeeBee' mark. The invoices clearly demonstrate sales of beeswax food wrap products under these marks.

25. In addition to the aforementioned newspaper and media coverage, Mr Hollingsbee states that KA and the opponent's products have been featured in magazines. An undated print from the beebewraps.com website has been provided,<sup>15</sup> which refers to coverage in Woman & Home in July 2019 and Marie Claire in April 2019. The print contains extracts from these publications; the former consists of an interview with KA about 'BeeBee Wraps', while the writer of the latter encourages readers to purchase 'BeeBee Wraps' instead of clingfilm. Furthermore, Mr Hollingsbee states that most of the promotion of the opponent's products in the UK has been executed by word-of-mouth recommendation. However, the opponent has spent the following on advertising its products:

<b>Year</b>	<b>Promotional Expenditure (£)</b>
2017	360
2018	5,675
2019	22,692

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<sup>14</sup> Exhibit DH15

<sup>15</sup> Exhibit DH14

26. Additionally, Mr Hollingsbee outlines that the number of annual visits to the opponent's website was 2,359 in 2017, rising to 42,920 in 2019. He argues that this exemplifies the success of the opponent's advertising strategy.

### **Witness statement of Rachel Ward**

27. Ms Ward's witness statement is dated 14 April 2020 and is filed together with Exhibits REW1 to REW9. Ms Ward is a Chartered Trade Mark Attorney in the employ of the opponent's representatives, Ward Trade Marks Limited. Ms Ward explains that she has conducted these proceedings for the opponent.

28. A great deal of Ms Ward's witness statement contains written submissions rather than evidence of fact, and I intend to consider them as such. However, Ms Ward's evidence includes the following:

- Undated prints from Collins English Dictionary for the words 'caesium' and 'paean', which state that the correct pronunciation of the words is "si:ziəm" and "pi:ən", respectively;<sup>16</sup>
- An undated extract regarding the name 'Naeve', suggesting it is pronounced "NIYV".<sup>17</sup> While it is not clear from the evidence, Ms Ward says the extract is from babynamespedia.com;
- An undated print from Collins English Dictionary featuring the definition for the word 'clingfilm', which states that it is used for wrapping food;<sup>18</sup>
- A print obtained from the internet archive 'Wayback Machine' of the website beebewraps.com from 31 March 2019.<sup>19</sup> The figurative 'BeeBee' mark is visible on the webpage, which describes the opponent's products as reusable food wraps and "the compostable alternative to clingfilm";

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<sup>16</sup> Exhibit REW3

<sup>17</sup> Exhibit REW3

<sup>18</sup> Exhibit REW4

<sup>19</sup> Exhibit REW5

- An undated print from the 'Made in Stroud shop', which displays tea towels, bags, food wrap products (including those made using beeswax) and non-plastic storage containers offered for sale by the same undertaking.<sup>20</sup> Ms Ward suggests that the print is from 21 March 2020, while the copyright is dated 2020;
- An undated print from 'LIONSHOME', which displays search results from the website for the term "food storage".<sup>21</sup> Containers, cups, bowls and beeswax food wraps are shown together in the search results. The copyright information is dated 2014 – 2020;
- An extract from 'Organic authority', dated 28 March 2018 (updated 22 October 2018).<sup>22</sup> The article discusses the environmental impact and health implications of plastic wrap. It suggests alternative storage containers such as glass jars, steel containers, paper bags and reusable food wrap. I note a number of references to Vermont and Toronto, which are suggestive of a non-UK readership;
- An undated print from the [beebeewraps.com](http://beebeewraps.com) website.<sup>23</sup> The print shows the figurative 'BeeBee' mark displayed at the top of the webpage; it also describes the opponent's products as a reusable alternative to clingfilm. The ingredients of the products are listed as organic cotton, British beeswax, organic jojoba oil and resin. The copyright is dated 2020.

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<sup>20</sup> Exhibit REW6

<sup>21</sup> Exhibit REW7

<sup>22</sup> Exhibit REW8

<sup>23</sup> Exhibit REW9

## **DECISION**

### **Section 5(2)(b)**

#### **Legislation and case law**

29. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

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

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

31. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

32. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

34. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

35. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed at paragraph 5 that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

36. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

37. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
Class 24: Beeswax food wraps.	<p data-bbox="719 365 1361 562">Class 16: Food wrappers; Food wrapping plastic film; Food wrapping plastic film for household use; Films for wrapping foodstuffs.</p> <p data-bbox="719 640 1225 674">Class 21: Food storage containers.</p> <p data-bbox="719 752 1361 891">Class 24: Cotton cloths; Cotton fabric; Cotton fabrics; Textiles made of cotton; Textiles for food wrapping.</p>

Class 16

38. The opponent has argued that, although its goods fall within a different class to those in class 16 of the application, the competing goods ought to be considered highly similar. In this connection, the opponent has submitted that the competing goods have a common use and, as such, are competitive. I have no submissions from the applicant in respect of the similarity or dissimilarity of the respective goods.

39. The term *'beeswax food wraps'* in the opponent's specification refers to pieces of fabric which are coated in beeswax and used for wrapping food to keep them fresh. The raw materials used in the production of these goods are different to those used in the production of the applicant's *'food wrappers; food wrapping plastic film; food wrapping plastic film for household use; films for wrapping foodstuffs'* and, accordingly, the nature of the respective goods can be said to differ to some extent. Nevertheless, the respective goods share an intended purpose, namely, to preserve foodstuffs. Moreover, there is an overlap in the method of use of the respective goods insofar as they will be wrapped around items of food before they are stored. The respective users of the goods will also be the same, being those who wish to keep items of food fresh. Further, the trade channels through which the respective goods reach the market will

overlap as they are both sold in retail establishments such as supermarkets, whereby the goods will be self-selected by consumers. While I accept that it may not always be the case, the respective goods are likely to be located on the same shelves in those outlets. The respective goods are neither important nor indispensable to the use of one another and, thus, are not complementary. However, given the respective goods share an intended purpose and method of use, I consider them to be in direct competition; it is not uncommon for beeswax food wraps to be presented as a more environmentally-friendly alternative to plastic wrap and, therefore, consumers will regard the goods as interchangeable, selecting one over the other. In light of the above, I consider that these goods are similar to a high degree.

### Class 21

40. The opponent has contended that food storage containers feature in the same food storage category as its class 24 goods, leading to a close association between them. Moreover, the opponent has maintained that these goods would be sold alongside one another. As a result, the opponent has submitted that these goods are, at least, similar. Again, I have no submissions from the applicant regarding the similarity or otherwise of these goods.

41. '*Food storage containers*' in the applicant's specification describes airtight containers, ordinarily made from plastic or glass, which are used to store foodstuffs. The nature of these goods and the opponent's '*beeswax food wraps*' are quite different, owing to diverging physical attributes. There is, however, an overlap in the intended purpose of the respective goods as they can both be used to keep items of food fresh. Although food is ordinarily placed into a container before applying a lid and beeswax food wraps are wrapped around or placed over food, it is considered that there is an overlap in the method of use of the respective goods as they are used in the process of preparing food for storage. Moreover, the respective goods are likely to share users, namely, those who wish to preserve or store food. In addition, the respective goods will reach the market through the same trade channels as both are sold in retail establishments and supermarkets. In these circumstances, consumers will self-select the goods. While it is unlikely that the respective goods will be located on the same shelves, it is not uncommon for them to be found in the same food storage

section. The goods are not complementary in the sense outlined in the case law. However, as the respective goods can both be used to preserve food, I consider there to be a degree of competition between them; in certain circumstances, a consumer may select a food storage container to place their items of food in or, instead, select a beeswax food wrap with which to cover their items of food. Balancing the similarities and the differences, I consider the goods to be similar to a medium degree.

#### Class 24

42. The opponent has submitted that the goods in class 24 of the application are identical or, in the alternative, highly similar to its goods. In this regard, the opponent highlights that its goods are made using organic cotton. The applicant has not commented on whether its class 24 goods are similar to those of the opponent.

43. Firstly, it has been established that the mere fact that a particular good is used as a part or component of another does not suffice, in itself, to show that the goods containing those parts or components are similar.<sup>24</sup> This is because, for example, their nature, intended purpose and average consumers may be completely different. As such, I do not consider it appropriate to find the applicant's goods identical or similar to those of the opponent simply because one may be used in the production of the other.

44. Notwithstanding the above, the opponent's '*beeswax food wraps*' is, in my view, highly similar to '*textiles for food wrapping*' in the applicant's specification. There is an overlap in the nature of the respective goods as they both describe pieces of fabric, albeit the former being coated with beeswax. Crucially, the respective goods have the same intended purpose and method of use, namely, that they are for keeping food fresh and will be wrapped around items of food to this end. Consequently, the user of the respective goods will also be the same. Moreover, the respective goods are sold in retail establishments such as supermarkets and, therefore, the trade channels through which they reach the market overlap. In these circumstances, the respective goods will be self-selected by consumers. To my mind, it is highly likely that the goods

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<sup>24</sup> *Les Éditions Albert René v OHIM*, Case T-336/03

will be located on the same shelves, or at least in the same section of those outlets. The respective goods are neither important nor indispensable to the use of one another and, thus, are not complementary. Nevertheless, given the respective goods have the same purpose and will be used in the same way, I consider them to be in direct competition; consumers will regard the goods as interchangeable, selecting the opponent's goods over those of the applicant, or vice versa.

45. In respect of the applicant's '*cotton cloths*', there is a degree of overlap in the nature of these goods and the opponent's '*beeswax food wraps*', insofar as they both describe small pieces of fabric made from cotton. Moreover, users of the respective goods will be members of the general public. However, the intended purpose of the respective goods is different: the opponent's goods are used for preserving foodstuffs, while the applicant's goods are most commonly used for cleaning, drying and personal care. Likewise, the method of use of the respective goods is different: the opponent's goods will be wrapped around or placed over foodstuffs, whereas those of the applicant will, for example, be wiped over surfaces or the skin. The trade channels through which the respective goods reach the market will overlap as they are both sold in retail establishments such as supermarkets, whereby the goods will be self-selected by consumers. Though, in practice, the respective goods will not be located on the same shelves or in the same sections of those outlets. I do not consider there to be any meaningful competition between the respective goods, and neither are they complementary in the sense described in the case law. In view of the above, I consider that the goods are similar to a low degree.

46. I turn now to '*cotton fabric; cotton fabrics; textiles made of cotton*' in the applicant's specification. Applying the principles outlined in *YouView* and *Skykick*, I interpret these broad terms to describe a network of cotton threads which are woven together to produce a flexible, versatile material. In my view, giving the terms their ordinary and natural meanings, this is how the average consumer would understand them. Cotton fabrics and textiles come in a myriad of different forms and have numerous uses. The nature of these goods overlaps with that of the opponent's '*beeswax food wraps*' to the extent that they are fabrics made from cotton. However, the intended purpose of the respective goods differs as the opponent's goods are for keeping food fresh, whereas the applicant's goods are typically used to make, inter alia, clothing,

furnishings, books and bedding. Further, the method of use of the respective goods is different: beeswax food wraps are finished products which are wrapped around foodstuffs, while cotton fabrics and textiles are ordinarily used in a manufacturing or creative process. I am of the view that the respective goods will not always have the same users: users of the respective goods will be members of the general public, though users of the applicant's goods will also include businesses that are engaged in creating finished products. It is possible that the trade channels through which the respective goods reach the market may overlap, though I do not consider this to be the norm. Beeswax food wraps will be sold by supermarkets and other retail establishments, whereas textiles and fabrics typically reach the market through haberdasheries, suppliers and specialist retailers. To my mind, there is no obvious competition between the respective goods. Moreover, while cotton textiles and fabrics may be used in the production of beeswax food wraps, the connection between them is not such that customers would assume that the responsibility for the goods lies with the same undertaking. Therefore, the goods are not complementary. In light of the above, I find that the goods are similar to a very low degree, if at all.

### **Average consumer and the nature of the purchasing act**

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>25</sup>

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

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

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<sup>25</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. The opponent has contended that “the relevant consumer is the average UK consumer of food storage containers”. I have no submissions from the applicant as to the average consumer of the goods at issue.

50. The majority of the goods at issue in these proceedings are everyday purchases, consisting of food wrapping materials, food storage containers and cotton cloths. The average consumer of such goods will be members of the general public. Although the frequency that the goods are purchased would vary between those which are single-use and those which are reusable, overall, the goods are likely to be purchased relatively frequently for the purposes of keeping food fresh, storing food, cleaning or personal care. The purchasing act will not require an overly considered thought process as the goods are relatively inexpensive purchases. In this regard, the purchasing of the goods is likely to be more casual than careful. The average consumer will, however, consider factors such as cost, suitability and size as they will wish to ensure that what they are purchasing meets their needs. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium. The goods are typically sold in supermarkets and other brick-and-mortar retail establishments, or their online equivalents, where the goods are likely to be selected after perusing the shelves or viewing information on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as consumers may receive word of mouth recommendations or discuss the products with a sales assistant.

51. It is likely that some of the goods at issue, namely, ‘*cotton fabric; cotton fabrics; textiles made of cotton*’, will be purchased by businesses as well as members of the general public with an enthusiasm for crafts. In relation to the former, the goods are likely to be purchased frequently for the production of finished products for retail, such as clothing, curtains and the like. With regard to the latter, the goods are likely to be more occasional purchases. Cotton fabrics and textiles are relatively inexpensive and, as such, the purchasing act will not require an overly considered thought process for

either group of consumers. Nevertheless, both groups of consumers will consider the suitability, quality and price of the cotton fabrics in accordance with their specific needs; the business user may also consider the origin of the goods in accordance with sustainability and corporate social responsibility. In light of the above I find that the level of attention of members of the public in relation to these goods would be medium, while that of business users will be elevated slightly above medium. Fabrics and textiles are typically purchased by businesses through manufacturers or suppliers, where the goods are purchased after perusing product brochures, viewing information on the internet or a visual inspection of the product. In these circumstances, the purchasing process would be predominantly visual in nature, though I do not wholly discount aural considerations as business users may wish to discuss product suitability with a sales representative. Members of the general public would purchase fabrics and textiles from haberdasheries or specialist retailers, or their online equivalents, where the goods are likely to be selected after perusing the shelves or viewing information on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as consumers may receive word of mouth recommendations or discuss the products with a sales assistant.

### **Distinctive character of the earlier mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

53. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

54. The opponent has argued that the earlier mark has at least an average level of distinctiveness. Moreover, the opponent has claimed that “the level of distinctiveness has been increased by the use and promotion of beeswax food wraps under the earlier registered mark”.

55. Conversely, the applicant has intimated that the earlier mark is low in distinctive character, submitting that:

“Within the industry, it is very common to have the terms “Bee” in company names for business who sell beeswax wraps, in the same sense that the majority of companies in this industry may also have the term wraps in their name [...] Because of the nature of the product, it is important to understand that almost every company who sells bees wraps incorporates the words bee into their text along with an image of a bee [...] On Amazon in the UK alone,

there are over 1000 different companies and products with the words “bees wrap” in it [...] The prefix “Bee” has been derived from the product name “bees wrap”, and so the opponent has simply decided to use this word twice in their trademark. Of course the word bee is very common in the English dictionary [...]”

56. The earlier mark is figurative and comprises the words ‘BeeBee wraps’ in a grey, cursive font, along with a stylised bee device. The mark contains ordinary dictionary words and will be read as ‘Bee Bee wraps’. The word ‘Bee’ will be widely understood as referring to the honey-making yellow and black flying insect.<sup>26</sup> The word ‘wraps’ will be understood as referring to materials that are used to cover or protect objects.<sup>27</sup> Accordingly, I consider that the words ‘BeeBee’ are allusive of goods which are produced using beeswax, while the word ‘wraps’ is wholly descriptive of the goods. In this connection, while I am not prepared to accept the applicant’s assertion that the words are widely used in the industry (not least because there is no evidence before me to that effect), the words in combination are likely to be perceived as an allusive reference to the goods for which the earlier mark is registered. Notwithstanding the foregoing, the repetition of the word ‘Bee’ is somewhat unusual. Moreover, the words are presented in a cursive font and the two letter B’s are particularly stylised, which contributes to the distinctiveness of the mark. Above the verbal elements appears a stylised bee device; in my view, although it is not a lifelike representation of a bee, the device reinforces the allusive meaning of the words. The colour combination contributes to the distinctiveness of the mark yet is unremarkable. Given that the words in the mark are allusive and the device reinforces their meaning, the distinctive character of the mark arguably rests in the totality of the mark, i.e. all of the components together as a whole. However, due to the unexpected repetition of the word ‘Bee’, the extent of the stylisation to the two letter B’s and the relative size and position within the mark, I consider that the word ‘BeeBee’ provides the greatest contribution to the distinctiveness of the mark. In light of the above, taking the mark as a whole and weighing the components against each other, overall, I find that the earlier mark possesses a low to medium level of inherent distinctive character.

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<sup>26</sup> <https://dictionary.cambridge.org/dictionary/english/bee>

<sup>27</sup> <https://dictionary.cambridge.org/dictionary/english/wrap>

57. The opponent's evidence has been summarised above and I am now required to assess whether the opponent has demonstrated that the earlier mark had an enhanced degree of distinctive character at the relevant date of 25 July 2019 i.e. the filing date of the application.

58. No details have been provided by the opponent to indicate the size of the relevant market or its share of that market; neither is there any evidence before me to that effect. The market of beeswax food wraps is, arguably, relatively niche. However, the evidence provided by the opponent suggests that there are a number of different undertakings producing these products. Moreover, my perception is that the industry of reusable alternatives to plastic was rapidly growing at the relevant date and some of the evidenced publications are also indicative of this. There has been continuous, regular use of the earlier mark and the evidence shows that businesses across the UK were stocking the opponent's products prior to the relevant date. Nevertheless, use of the earlier mark has not been particularly longstanding and the opponent's turnover figures are considered modest. Further, the amounts spent on promoting and advertising the earlier mark prior to the relevant date are also modest. That being said, the general public have been exposed to the earlier mark through features in national newspapers and magazines, as well as a popular BBC programme. The opponent has won awards in relation to its beeswax food wrap business and was involved in a collaboration with Sky Ocean Rescue. Despite any potential brand awareness that has been generated through media coverage and business accolades, the evidence before me does not support a finding that the inherent distinctiveness of the earlier mark has been enhanced through use. Even if the distinctiveness of the mark has been enhanced above its inherent characteristics, it is not to any extent that will make a material difference.

### **Comparison of trade marks**

59. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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.”

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

61. The competing marks are as follows:

Earlier trade mark	Applicant's mark
	BeeBae

#### Overall impression

62. The earlier mark is figurative and consists of the words ‘BeeBee wraps’ in a stylised font accompanied by a bee device. As explained above, the verbal elements of the mark will, in combination, be perceived by consumers as an allusive reference to the goods. However, in accordance with my prior finding, I consider that the word ‘BeeBee’ provides the greatest contribution to the overall impression of the mark and has more impact than the other elements. This is a consequence of the unexpectedness of the

repeated word 'Bee', the extent of the stylisation to the two letter B's and its relative size and position within the configuration of the mark. Due to its exclusively descriptive nature, less weight will be attributed to the word 'wraps'. Moreover, the bee device will also provide a smaller contribution to the overall impression of the mark as it reinforces the allusive meaning of the words; in any event, the eye is naturally drawn to elements that can be read.<sup>28</sup> Further, the colour combination and cursive font will be seen as decorative and will, therefore, play reduced roles.

63. The contested mark is in word-only format and comprises the word 'BeeBae' with no other elements. The average consumer will identify the two individual words in the mark; with or without a space between them, it will still be perceived as the words 'Bee' and 'Bae'. This is because a natural break is created by the capitalisation of the word 'Bae'. Moreover, the word 'Bee' is a common, easily understood word in the English language, whereas the word 'Bae' is not. In my view, this will serve to increase the separation of the words in the perception of consumers. Furthermore, as the average consumer will be familiar with the word 'Bee' and not with the word 'Bae', it is considered that the word 'Bee' has a degree more impact, is slightly more dominant and provides an increased contribution to the overall impression of the mark. This is greatly assisted by the fact that the word 'Bee' appears at the beginning of the mark, to which the attention of consumers is usually directed. While still contributing to the overall impression, the word 'Bae' will play a slightly reduced role.

#### Visual comparison

64. The opponent has submitted that the principle comparison ought to be between the words 'BeeBee' and 'BeeBae'. Visually, the opponent has contended that these words are virtually identical, highlighting that they are both six letter words with five common letters. Furthermore, the opponent has argued that the difference between the words, i.e. the substitution of a letter 'a' for a letter 'e', is towards the end of the words and that, at any rate, these letters are, themselves, highly similar.

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<sup>28</sup> *Wassen International Ltd v OHIM*, Case T-312/03

65. Conversely, the applicant has argued that the “collection of words are different in appearance, and in composition”. When read or seen, the applicant has submitted, the marks “do not bear enough resemblance to each other”, highlighting that the “spelling is different”.

66. Visually, the competing marks are similar because they share a common five-letter string ‘B-E-E-B--E’; the letters are in the same order and occupy the same positions in both marks. The fifth letters of these respective word elements differ, the earlier mark containing a letter ‘e’ and the contested mark containing an ‘a’ in its place. Yet, as the opponent has highlighted, the different letters appear towards the end of these word elements. The marks are visually different as the earlier mark includes the word ‘wraps’ and a stylised bee device, neither of which have counterparts in the contested mark. However, I have already found that these elements play lesser roles in the overall impression of the earlier mark. The marks also diverge as a result of the stylisation present in the earlier mark. Nevertheless, while the stylisation does contribute to the distinctiveness and overall impression of the earlier mark, I do not consider this to be a point of significant difference between the marks as notional and fair use allows word-only marks to be presented in any standard font. Bearing in mind my assessment of the overall impressions, I consider there to be between a medium and high degree of visual similarity between the marks.

#### Aural comparison

67. The opponent has submitted that its earlier mark has a clear pronunciation and, while it is not clear how all consumers will pronounce the contested mark, a large proportion of consumers would pronounce it in the same way as the earlier mark. On this point, the opponent has suggested that some consumers will mistake the letter ‘a’ for an ‘e’, while others would pronounce the word ‘Bae’ in the same vein as ‘caesium’, ‘paean’, and the name ‘Naeve’.

68. In contrast, the applicant has argued that the competing marks are aurally different. In this regard, the applicant has contended that, when heard, the competing marks do not bare enough resemblance to each other to cause confusion.

69. Aurally, the contested mark consists of two syllables, i.e. (“BEE-BAY”). I do not agree with the opponent’s argument that the word ‘Bae’ would be pronounced as “BEE”, nor do I consider the opponent’s evidence in this regard compelling. While it is possible that the word ‘Bae’ would be pronounced in this way, I consider it more plausible that the average consumer, when met with a word they are not familiar with, would articulate the word phonetically, ending the word with a “Y” sound i.e. as “BAY”. In respect of the earlier mark, given that the word ‘wraps’ merely describes the goods for which the mark is registered, it is highly unlikely that it would be articulated by the average consumer. Nor would the bee device be articulated in any way. Consequently, the earlier mark comprises two syllables, i.e. (“BEE-BEE”). The first syllables of the competing marks are aurally indistinguishable, while there is only a subtle difference between the second syllables. Taking into account the overall impressions, I consider that the competing marks are aurally similar to a high degree.

#### Conceptual comparison

70. According to the opponent, the competing marks will both be associated with bees. In this connection, the opponent has argued that the presence of a bee device in the earlier mark will reinforce this concept. As for the contested mark, the opponent has submitted that the word ‘Bae’ will not detract from this concept. The applicant has not made any specific submissions in relation to the conceptual comparison, though appears to agree that the competing marks are both evocative of the flying insect.

71. Conceptually, the earlier mark contains two common words in the English language which will be given their ordinary and natural meanings. The average consumer would understand the words ‘Bee’ and ‘wraps’ to be the name of a flying insect and materials for covering or protecting objects, respectively. I agree that the conceptual message conveyed by the words ‘BeeBee’ will be reinforced by the stylised bee device. In respect of the contested mark, the word ‘Bee’ will be given the same meaning as in the earlier mark, that being the name of a flying insect. In contrast, the word ‘Bae’ does not have any clear and obvious meaning. As I have no evidence or submissions from the parties on this point, I conclude that the word ‘Bae’ would be perceived as a conceptually neutral invented word. On this basis, the competing marks are conceptually similar insofar as they are both evocative of the flying insect. The

earlier mark has an additional conceptual dimension provided by the word 'wraps' which is lacking from the contested mark. However, in consideration of my assessment of the overall impressions, I consider the marks conceptually similar to a relatively high degree.

### **Likelihood of confusion**

72. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

74. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

75. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

76. Earlier in this decision I concluded that:

- The applicant’s class 16 goods are similar to the opponent’s goods to a high degree;

- The applicant's class 21 goods are similar to the opponent's goods to a medium degree;
- The term '*textiles for food wrapping*' in class 24 of the application is similar to the opponent's goods to a high degree;
- '*Cotton cloths*' and '*cotton fabric; cotton fabrics; textiles made of cotton*' in class 24 of the application are similar to the opponent's goods to a low and very low degree, respectively;
- Average consumers of the goods at issue are likely to be members of the general public, who would demonstrate a medium level of attention during the purchasing act;
- Average consumers of '*cotton fabric; cotton fabrics; textiles made of cotton*' will also include business users, who would purchase the goods with a slightly higher than medium level of attention;
- The purchasing process for the goods would be predominantly visual in nature, though I have not discounted aural considerations;
- The earlier mark possesses a low to medium level of inherent distinctive character, which has not, at least to any material extent, been enhanced through use;
- The word 'BeeBee' would provide a greater contribution to the overall impression of the earlier mark, while the word 'wraps' and the stylised bee device would play lesser roles;
- The word 'Bee' in the contested mark would be slightly more dominant and have a degree more impact than the word 'Bae';

- The competing marks are visually similar to between a medium and high degree, aurally similar to a high degree and conceptually similar to a relatively high degree.

77. I acknowledge that the fifth letter of the applicant's mark is an 'a' rather than an 'e', and I appreciate that the earlier mark contains additional elements that are not present in the applicant's mark, namely, the word 'wraps', the stylised bee device and the cursive font. Nevertheless, taking into account the overall similarity between the marks and the similarity between the respective goods, I am of the view that the differences between the competing marks are insufficient to distinguish the majority of the applicant's goods from the goods of the opponent. As previously noted, the word 'wraps' in the earlier mark is wholly descriptive of the opponent's goods and the stylised bee device simply reinforces the meaning of the words 'BeeBee'. As such, it is considered that these additional elements will not allow the average consumer to differentiate between the marks. Further, the cursive font in which the words of the earlier mark are presented does not, in my judgement, create any material difference between the competing marks, not least because notional and fair use allows a word-only mark (such as the contested mark) to be presented in any standard typeface. While I have considered that the earlier mark only possesses a low to medium level of distinctive character, I am also aware that such a conclusion does not necessarily preclude a finding that there is a likelihood of confusion.<sup>29</sup> In this connection, despite any allusive meanings, the word 'BeeBee' provides the greatest contribution to the overall impression of the earlier mark and the word 'BeeBae' is the sole element of the contested mark. These word elements share five letters in the same order and are of an identical length. The beginnings of the word elements are identical, a position which is generally considered to have more impact due to consumers in the UK reading marks from left to right.<sup>30</sup> The only difference between the word elements is an altered vowel towards their respective endings; in my view, it is entirely foreseeable that the average consumer, paying no more than a medium degree of attention, could misremember an 'e' for an 'a', or vice versa. In light of the above and taking into account the imperfect recollection of the consumer, the average consumer may not

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<sup>29</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

<sup>30</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

recall the respective marks with sufficient accuracy to differentiate between them; consumers may misremember one for the other, assuming they are one and the same. Consequently, I consider there to be a likelihood of direct confusion.

78. That likelihood of confusion, though, does not, in my view, extend to '*cotton cloths; cotton fabric; cotton fabrics; textiles made of cotton*' in class 24 of the application. I have found these goods to be similar to those of the opponent to a low degree, at best. Despite the overall similarity between the marks, having regard to the low to medium level of distinctive character of the earlier mark, it is considered that the average consumer is not likely to mistake one mark for the other or assume that they are one and the same. In the context of these goods, the differences will enable consumers to differentiate between the competing marks. Further, the earlier mark is not considered sufficiently distinctive in order to counterbalance the very low level of similarity between these goods. To the contrary, the low levels of similarity between the respective goods engages interdependency in favour of the applicant as, to my mind, it offsets the overall similarity between the competing marks. Accordingly, notwithstanding the imperfect recollection of the consumer, it follows that there will be no direct confusion in respect of these goods. Neither can I see any reason why the average consumer would assume the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. The common element between the marks, i.e. the word 'Bee', is not so strikingly distinctive that consumers would assume that only the applicant would be using it in a trade mark. Moreover, the differences between the competing marks are not characteristic of any brand extensions with which consumers would be familiar. Therefore, there is no likelihood of indirect confusion in relation to these goods.

### **Section 5(4)(a)**

#### **Legislation and case law**

79. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) 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, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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.”

80. Subsection (4A) of Section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

81. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

*Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

82. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C. as the Appointed Person endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

83. There has been no claim by the applicant that the contested mark had been used prior to the earliest claimed use of the opponent’s alleged earlier signs ‘BEEBEE WRAPS’ and ‘BEEBEE’. Moreover, no evidence has been adduced by the applicant to this effect. As such, the relevant date for the assessment of the opponent’s claim under section 5(4)(a) is the filing date of the application, that being 25 July 2019.

### **Goodwill**

84. The first hurdle for the opponent is to show that it had the necessary goodwill in the signs ‘BEEBEE WRAPS’ and ‘BEEBEE’ at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

85. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

86. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

87. Goodwill arises as a result of trading activities. I am satisfied that the opponent had been trading prior to the relevant date. This is clear from the sales figures provided, the sample invoices and the number of outlets across the UK stocking the opponent's goods; there is also evidence of business being conducted via the *beebeewraps.com* website. The evidence demonstrates that the opponent had been continuously and regularly trading in the UK under the sign 'BEEBEE WRAPS' from 2017 up to the relevant date and under the sign 'BEEBEE' from 2018 up to the relevant date. Use of the signs has not been particularly longstanding and, combined with the modest turnover figures, I find that the opponent has a modest, though certainly not trivial, degree of goodwill in the UK in relation to *'beeswax food wraps'*. I am also satisfied that the signs relied upon were distinctive of that goodwill at the relevant date. The evidence does not, however, support a finding that the opponent had protectable goodwill in the signs in relation to the broader categories of *'food wrappers, textiles for food wrapping'* or other beeswax wraps. Rather, the evidence suggests that the opponent was exclusively trading in *'beeswax food wraps'*; there is no evidence that the opponent was trading in any other kinds of goods. The opponent's own marketing and information on its website also makes it clear that it trades specifically in these goods as a reusable alternative to plastic. Moreover, on the basis of the papers before me, I am unable to conclude that the opponent had protectable goodwill in any retail services. Although there is evidence that the opponent has conducted business via its website, there is nothing which demonstrates that it has gone over and above merely using its website as a vehicle to sell its own goods.

## Misrepresentation and damage

88. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton* in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

89. Later in the same judgment, Morritt L.J. stated that:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

90. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin L.J. concluded:

“[...] if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

91. Although this was an infringement case, the principles apply equally under section 5(2) of the Act.<sup>31</sup> In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. Certainly, I believe that to be the case here in respect of the goods that I have found to be similar to a medium or high degree. In relation to those goods, I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant’s goods in the mistaken belief that they were the goods of the opponent. Damage through diversion of sales, at least, is entirely foreseeable.

92. However, I do not consider that the same applies in respect of the goods that I have found to be similar to a low degree at best, namely, ‘*cotton cloths; cotton fabric; cotton fabrics; textiles made of cotton*’. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity.<sup>32</sup> Nevertheless, the closeness of the parties’ respective fields is a factor which must be taken into account. Where the applicant’s goods are only similar to those of the opponent to a low degree, I consider that this will offset the similarities between the marks. In my view, the differences between the goods, combined with the differences between the respective marks will be sufficient to avoid consumers purchasing the

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<sup>31</sup> *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)

<sup>32</sup> *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

applicant's goods in the mistaken belief that they are the goods of the opponent. In my view, this is even more pronounced when considering the opponent's services. In this regard, consumers are even less likely to purchase the applicant's goods in the mistaken belief that they are the services of the opponent.

## **CONCLUSION**

93. The opposition under sections 5(2)(b) and 5(4)(a) of the Act has been partially successful. Subject to any successful appeal against my decision, the application will be refused in respect of the following goods:

Class 16: Food wrappers; Food wrapping plastic film; Food wrapping plastic film for household use; Films for wrapping foodstuffs.

Class 21: Food storage containers.

Class 24: Textiles for food wrapping.

94. The application may proceed to registration in respect of the following goods, against which the opposition has failed:

Class 24: Cotton cloths; cotton fabric; cotton fabrics; textiles made of cotton.

## **COSTS**

95. The opponent has been largely successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. This decision has been taken from the papers without an oral hearing. The opponent filed evidence in these proceedings as well as written submissions included in the witness statement of Ms Ward. In the circumstances, I award the opponent the sum of **£1,500** as a contribution towards the cost of the proceedings. The sum, accounting for a reduction to reflect the measure of the opponent's success, is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£300
Preparing evidence and written submissions	£1,000
Official fee	£200
<b>Total</b>	<b>£1,500</b>

96. I therefore order PLENTIFUL SOLUTIONS LIMITED to pay BeeBee Wraps Limited the sum of **£1,500**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of December 2020**

**James Hopkins**  
**For the Registrar,**  
**The Comptroller General**