O/0218/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003749627

BY GOYA INTERNATIONAL LTD.

TO REGISTER THE TRADE MARK:

GOYA

IN CLASSES 3, 9, 14, 25, 35, 41, 43 AND 45

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 435948

BY GOYA FOODS, INC.

BACKGROUND AND PLEADINGS

1. On 31 January 2022, Goya International Ltd. ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The trade mark was published for opposition purposes on 27 May 2022 and registration is sought for the goods and services set out in Annex 1 to this decision.

2. On 31 August 2022, the application was partially opposed by Goya Foods, Inc. ("the opponent") based upon sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under section 5(1) of the Act, the opponent relies upon two earlier marks. The first of these is UKTM no. 3705322 ("the First Earlier Mark") for the mark GOYA which was filed on 30 September 2021 and relies on an earlier EU filing date of 22 February 2018 pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union ("the Withdrawal Agreement"). This aspect of the opposition is directed at the applicant's class 43 services only. The opponent relies upon the following services for which the First Earlier Mark is registered:

Class 43	Services for providing food and drink; temporary accommodation; provision of food and drink for consumption both on and off premises; food and menu planning; food preparation services; bar services; canteens; food and drink catering; rental of chairs, tables, table linen, tableware and glassware; rental of cooking apparatus; rental of drinking water dispensers; rental of lighting apparatus other than for theatrical sets or television studios; rental of meeting rooms; rental of temporary accommodation; rental of tents; rental of marquees; rental of transportable buildings; self-service restaurants; snack-bars; temporary accommodation reservations; wine bars; brassiere services; café services; delicatessens [restaurants]; fast food services; cocktail lounge services; tea room services; cafeteria services; restaurant services; banqueting services; provision of venues for parties, balls, weddings and events; hotel reservations; crèche services; information, advisory and consultancy services relating to the aforesaid services.

4. The second of these is UKTM no. 3705328 ("the Second Earlier Mark") for the mark GOYA, which was filed on 30 September 2021 and registered on 27 January 2023. Again, the opponent relies upon an earlier EU filing date of 21 December 2018 pursuant to Article 59 of the Withdrawal Agreement. This aspect of the opposition is directed at the applicant's class 41 services only and the opponent relies upon the following services for which the Second Earlier Mark is registered:

Class 41 Educational and entertainment services; organizing and conducting sport competitions and athletic events.

5. Under section 5(2)(a) of the Act,[1] the opponent relies upon the First Earlier Mark and the Second Earlier Mark. In addition to those marks, the opponent relies upon the following trade marks:

GOYA
UKTM no. 2278362
Filing date 17 August 2001; registration date 6 September 2002
("the Third Earlier Mark")

GOYA
UKTM no. 800982166[2]
Filing date 10 October 2008; registration date 13 October 2009
("the Fourth Earlier Mark")

Under this ground, the opponent relies upon <u>all</u> of the goods and services for which the earlier marks are registered. The full specifications for those marks can be found in Annex 2 to this decision. This ground of opposition is directed at the applicant's

[1] I return to this in the 'preliminary issues' section of this decision below.
[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing International registration designating the EU ("IREU"). As a result of the opponent having an IREU being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

goods and services in classes 3, 41 and 43. The opponent claims that the marks are identical and the goods and services are similar, with the result that there is a likelihood of confusion.

6. Under section 5(3) of the Act, the opponent relies upon all of the earlier marks. This ground of opposition is directed at the applicant's class 3, 41 and 43 goods and services. The opponent claims to have a reputation for all of the goods and services for which the earlier marks are registered. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

7. Under section 5(4)(a) of the Act, the opponent relies upon the sign GOYA which it claims to have used throughout the UK since 2001 in relation to "food goods and related services". Again, this aspect of the opposition is directed at the applicant's class 3, 41 and 43 goods and services only. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

8. The applicant filed a counterstatement. It does not appear to be disputed that the marks are identical. However, the identity/similarity between the goods and services is disputed. The applicant has also requested that the opponent provide proof of use of the Third and Fourth Earlier Marks.

9. The applicant is self-represented, and the opponent is represented by Stobbs. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in the form of the witness statement of Joseph Perez dated 16 May 2023, which is accompanied by 17 exhibits (JP1 to JP17). Mr Perez is the Senior Vice President of the opponent. His evidence goes to the use of the earlier marks.

11. The applicant filed undated written submission on 25 July 2023.

12. The opponent filed written submissions in lieu dated 23 August 2023.

13. The applicant filed undated written submission in lieu on 24 August 2023.

14. I have taken the evidence and submissions into account in reaching this decision and will refer to them below where necessary.

PRELIMINARY ISSUE

15. In the Form TM7, the opponent has selected the box to identify section 5(2)(b) as the relevant ground of opposition. Plainly, that cannot be the correct ground of opposition as that ground concerns similar marks, and those in the present case are plainly identical and would therefore be relevant to section 5(2)(a) of the Act.

16. However, in its Statement of Case, the opponent addressed section 5(2)(a) specifically, and not section 5(2)(b).

17. The applicant acknowledged this in its Form TM8 as follows:

> "It is noted that the opponent itself does not seem to know exactly which ground for refusal it wishes to invoke. For in the TM/ Art 5. (II) lit b) was selected, whereas in the statement of grounds it refers to Art 5 (II) lit a), see there p.2, points 6-9. In the present case we are guided by the information in TM7 and the grounds for refusal mentioned there."

18. The applicant continues:

> "In the present case, the opponent bases its claim under Art. 5(II) (a) on the following marks […]"

19. The drafting of the opponent's Form TM7 has plainly led to an unsatisfactory set of circumstances where we have contradictory pleadings in the Form TM7 and the Statement of Grounds. However, it seems plain on the face of it that the opponent

intended to rely upon section 5(2)(a) of the Act, and that the applicant understood that intention and responded accordingly. Consequently, I will proceed on the basis that the opposition is pleaded under section 5(2)(a) of the Act as that is the most just and proportionate way of disposing of these proceedings.

RELEVANCE OF EU LAW

20. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

DECISION

Section 5(1)

21. Section 5(1) of the Act states:

> “A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

22. By virtue of their earlier filing dates, the First and Second Earlier Marks qualify as earlier trade marks pursuant to section 6 of the Act. As the First and Second Earlier Marks had not completed their registration process more than 5 years prior to the application date for the mark in issue, they are not subject to the use provisions in section 6A of the Act. Consequently, the opponent can rely upon the full breadth of the specifications for which those marks are registered.

Identity of the marks

23. The marks are plainly identical.

Comparison of services

24. The competing services are as follows:

Opponent's services	Applicant's services
The First Earlier Mark Class 43 Services for providing food and drink; temporary accommodation; provision of food and drink for consumption both on and off premises; food and menu planning; food preparation services; bar services; canteens; food and drink catering; rental of chairs, tables, table linen, tableware and glassware; rental of cooking apparatus; rental of drinking water dispensers; rental of lighting apparatus other than for theatrical sets or television studios; rental of meeting rooms; rental of temporary accommodation; rental of tents; rental of marquees; rental of transportable buildings; self-service restaurants; snack-bars; temporary accommodation reservations; wine bars; brassiere services; café services; delicatessens [restaurants]; fast food services; cocktail lounge services; tea room services; cafeteria services; restaurant services; banqueting services; provision of venues for parties, balls, weddings and events; hotel reservations; crèche services;	Class 41 Entertainment, sporting and cultural activities; Computer education training; Education and training; Providing courses of training; Computerised training; Online education services; Online entertainment services; Online digital publishing services. Class 43 Accommodation services; Temporary accommodation.

information, advisory and consultancy services relating to the aforesaid services. **The Second Earlier Mark** Class 41 Educational and entertainment services; organizing and conducting sport competitions and athletic events.	

25. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, 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."

26. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

27. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court stated that:

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

28. I note that the applicant has made submissions about the specific activities undertaken by the respective parties. It has also filed a number of documents to support this with its written submissions in lieu. I note that these were not filed in the correct evidential format. However, they do not assist the applicant in any event. This is because I must undertake my comparison based upon the natural meaning of the terms within their respective specifications, on a notional basis, and not limited to the actual services offered by the parties.

<u>Class 41</u>

Entertainment services, sporting and cultural activities; Online entertainment services.

29. These services are all self-evidently, or could include types of, entertainment services. Consequently, they are identical on the principle outlined in *Meric* to "[…] entertainment services" in the specification of the Second Earlier Mark.

Computer education training; Education and training; Providing courses of training; Computerised training; Online education services.

30. These services are all types of educational service. Consequently, they are self-evidently identical, or identical on the principle outlined in *Meric,* to "educational […] services" in the specification of the Second Earlier Mark.

Online digital publishing services.

31. These cannot be described as either an entertainment or an educational service, nor are they related to the organising and conducting of events. Consequently, I do not consider them to be identical to the services for which the opponent has protection in class 41. However, in my experience, it is not unusual for providers of educational services (such as universities) to also be engaged in publication services (such as the publication of academic texts). The users may overlap. The nature, purpose and method of use of the services will differ. In my view, they are similar to a low degree.

<u>Class 43</u>

Accommodation services; temporary accommodation.

32. These terms are either self-evidently identical, or identical on the principle outlined in *Meric,* to "temporary accommodation" in the specification of the First Earlier Mark.

Conclusion

33. The opposition under section 5(1) of the Act succeeds in relation to the following services:

Class 41 Entertainment, sporting and cultural activities; Computer education training; Education and training; Providing courses of training; Computerised training; Online education services; Online entertainment services.

Class 43 Accommodation services; Temporary accommodation.

34. The opposition under section 5(1) of the Act fails in relation to the following services:

Class 41 Online digital publishing services.

Section 5(2)(a)

35. Section 5(2)(a) of the Act states:

> "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 trade mark is protected
>
> (b) […]
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

36. As noted above, the First and Second Earlier Marks qualify as earlier marks due to their earlier filing dates and are not subject to the use provisions of section 6A of the Act. The Third and Fourth Earlier Marks also qualify as earlier marks pursuant to section 6 of the Act, but they are subject to the use provisions in section 6A.

37. I note that in its written submissions in lieu, the applicant claims that the opponent should be deemed to have accepted that there is no genuine use of the Third and

Fourth Earlier Marks because the applicant's submissions filed in July 2023 were not specifically addressed in the opponent's written submissions in lieu. However, in its written submission in lieu, the opponent specifically states:

> "15. Despite the Applicant's assertion that the Opponent has not used Earlier Mark nos. 02278362 and 0800982166, the Opponent has already submitted to the UKIPO substantial evidence of use of these Earlier Marks in the UK, for the goods covered in classes 29, 30 and 32. The evidence of use submitted by the Opponent, clearly demonstrates that the Opponent has genuine use of the Earlier Marks in the UK in the relevant period of 31 January 2017 – 31 January 2022. The Applicant's claims are therefore unfounded.

38. The opponent has, therefore, maintained its position that the Third and Fourth Earlier Marks have been put to genuine use. The fact that it has chosen not to address each and every individual criticism raised by the applicant in its submission does not detract from that. In any event, I do not consider that anything will turn on the proof of use point. I will begin by assessing this ground on the basis of the First and Second Earlier Marks only, returning to the Third and Fourth Earlier Marks only if it is necessary to do so.

39. 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 greater 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 to mind the earlier mark, 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 goods and services

40. This ground of opposition is directed at the applicant's class 3, 41 and 43 goods and services. All of the class 43 services, and the majority of the class 41 services, have been successfully opposed under the section 5(1) ground of opposition. In relation to the services that survived the section 5(1) ground of opposition, I have already made a finding as to the degree of similarity with the opponent's specifications and I apply the same finding here. Consequently, I need only make further findings in relation to the applicant's class 3 goods.

41. I note in its written submission in lieu, the opponent has only sought to rely upon its goods in classes 5 and 29 (which are covered by the specification of the First Earlier Mark). Consequently, I have set out only those goods which are the most relevant in the table below:

Opponent's goods and services	**Applicant's goods**
The First Earlier Mark Class 5 Pharmaceuticals, medical and veterinary preparations. Class 29 Edible fats; edible oil.	Class 3 Perfumery and fragrances; Body cleaning and beauty care preparations; Soaps and gels; Deodorants and antiperspirants; Moisturising creams, lotions and gels; Liquid soaps for hands and face; Skin balms [cosmetic]; Balms (Non-medicated -); Beauty balm creams; Bergamot oil; Ethereal oils; Body oil; Perfume oils; Cosmetic oils; Massage oils; Aromatic oils; Aromatherapy oils; Essential oils; Aromatherapy oil; Organic cosmetics; Skincare cosmetics;

	Cosmetics for children; Beauty creams for body care; Essential oils for personal use; Perfumed oils for skin care; Massage oils and lotions; Face and body lotions.

[…] beauty care preparations; Moisturising creams, lotions and gels; Skin balms [cosmetic]; Balms (Non-medicated -); Beauty balm creams; Bergamot oil; Ethereal oils; Body oil; Cosmetic oils; Massage oils; Essential oils; Organic cosmetics; Skincare cosmetics; Cosmetics for children; Beauty creams for body care; Essential oils for personal use; Perfumed oils for skin care; Massage oils and lotions; Face and body lotions.

42. It seems to me that the stronger of the opponent's arguments lies in its class 5 goods. In this regard, I consider that the goods differ in purpose, with one being to treat an illness/medical condition and the other to improve the appearance of the user. I accept that there will be an overlap in trade channels as the goods can all be sold through the same retailers, such as large pharmacies. However, in my view, they would not be sold in the same section of the shop. There may be some overlap in method of use and nature to the extent that all may be applied to the body (such as where the pharmaceuticals are targeted at a skin-related condition and so are rubbed into the skin in the same way as the applicant's goods). There is no competition as the purpose differs. I do not consider the goods to be complementary, because one is not important or indispensable for the other.[3] The goods are similar to a low degree.

Perfumery and fragrances; Deodorants and antiperspirants; Perfume oils; Aromatic oils; Aromatherapy oils; Aromatherapy oil.

43. These are all goods that are typically used to fragrance the wearer. They plainly differ in purpose to the opponent's pharmaceuticals. However, again, I accept that they

[3] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

may be sold through the same retailers (such as pharmacies), albeit they will be in different sections of the shop. They are also likely to overlap in user. There may be some overlap in method of use and nature, as all of the goods may be applied to the skin. I consider the goods to be similar to a low degree.

Body cleaning […] preparations; Soaps and gels; Liquid soaps for hands and face.

44. These goods are all used for cleaning the body. I consider the same degree of overlap in trade channels, user, method of use and nature applies as set out above. In my view, the goods are similar to a low degree.

45. For the avoidance of doubt, I have considered the opponent's argument that "edible oils and fats" in class 29 of its registrations are also similar to the applicant's class 3 goods. However, I do not consider that this line of argument puts the opponent in a stronger position and, consequently, I do not need to consider it any further.

The average consumer and the nature of the purchasing act

46. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

47. The average consumer for the goods and services will be a member of the general public (as well as medical professionals for the opponent's goods). In my view, factors such as reliability and customer service standards are likely to be considered when purchasing the services, and factors such as aesthetic, fragrance and suitability for skin type will be taken into account when purchasing the applicant's goods. In respect of the opponent's goods, factors such as suitability for the medical condition in issue and ingredients are likely to be key considerations during the purchasing process. For the majority of the goods and services, I consider that a medium (or average) degree of attention will be paid. However, for the opponent's class 5 goods, a high degree of attention will be paid due to the potential impact upon the health of the user.

48. The goods and services are likely to be purchased following perusal of packaging, signage at physical premises and advertisements. Consequently, visual considerations are likely to dominate the purchasing process. However, I bear in mind that there is also an aural component to the purchase given that advice may be sought from retail assistants or medical professionals and word-of-mouth recommendations may play a part.

Identity of the marks

49. As set out above, the marks are identical.

Distinctive character of the earlier marks

50. 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 1-2779, 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)."

51. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are descriptive or highly allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

52. The earlier marks consist of the word GOYA. In my view, it is likely to be perceived as an invented word with no clear meaning. Consequently, it will have a high degree of inherent distinctive character. For reasons that will become clear, I do not need to consider whether this has been enhanced through use.

Likelihood of confusion

53. 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 and services down to the responsible undertaking being the same or related. 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. The first is the interdependency

principle i.e. a lesser degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. I have found as follows:

a. The goods and services that survived the section 5(1) ground of opposition are similar to a low degree.

b. The average consumer for the goods and services will be either a member of the general public or a medical professional (for the opponent's class 5 goods only) who will pay either a medium or high degree of attention during the purchasing process.

c. The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d. The earlier marks and the applicant's mark are identical.

e. The earlier marks are inherently distinctive to a high degree.

55. Bearing in mind the interdependency principle, I consider that these marks are likely to be directly confused even when used on goods and services that are similar to only a low degree. This is because the identity of the marks will offset the distance between the goods and services. I consider there to be a likelihood of direct confusion.

56. The opposition based upon section 5(2)(a) of the Act succeeds in its entirety.

57. As I have found in favour of the opponent on the basis of the First and Second Earlier Marks, I do not need to consider the opposition under this ground based upon

the Third and Fourth Earlier Marks. The use shown in the evidence by the opponent relates to a far narrower range of goods than those for which the opponent was able to rely upon in relation to the First and Second Earlier Marks, and so they could not have put the opponent in any stronger position.

Section 5(4)(a)

58. Section 5(4)(a) of the Act states as follows:

> "5(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".

59. 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."

60. I can deal with this ground relatively swiftly. The opponent claims to have goodwill in relation to a range of foodstuffs and it is these goods at which the evidence is directed. However, in my view, the applicant's cosmetic/fragrance goods in class 3, entertainment/education services in class 41 and accommodation services in class 43

are all dissimilar to those goods. I consider the distance between those goods and services to be too great for misrepresentation or damage to occur, notwithstanding the fact that the marks are identical.

61. The opposition based upon section 5(4)(a) of the Act is dismissed.

Section 5(3)

62. Section 5(3) of the Act states:

> "5(3) A trade mark which -
>
> > (a) is identical with or similar to an earlier trade mark, […] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

63. Section 5(3A) of the Act states:

> "Subsection (3) applies 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."

64. Again, I can deal with this ground relatively swiftly. Even if I accepted that the opponent had a modest reputation for certain foodstuffs (which, in my view, is the opponent's best case on the evidence filed), I do not consider that the opponent would succeed under this ground. Whilst I note that similarity of goods/services is not a requirement under section 5(3) of the Act, it is a relevant factor when assessing whether the relevant public will make the requisite link.[4] Given the distance between the opponent's foodstuffs and the applicant's class 3, 41 and 43 goods and services,

[4] *Intel*, Case C-408/01

I do not consider that the requisite link would be made notwithstanding the identity of the marks. If a link was made, it would be too fleeting for damage to arise.

65. The opposition based upon section 5(3) of the Act is dismissed.

CONCLUSION

66. The opposition against application no. 3749627 succeeds in its entirety and the application is refused for the following goods and services against which the opposition was directed:

Class 3	Perfumery and fragrances; Body cleaning and beauty care preparations; Soaps and gels; Deodorants and antiperspirants; Moisturising creams, lotions and gels; Liquid soaps for hands and face; Skin balms [cosmetic]; Balms (Non-medicated -); Beauty balm creams; Bergamot oil; Ethereal oils; Body oil; Perfume oils; Cosmetic oils; Massage oils; Aromatic oils; Aromatherapy oils; Essential oils; Aromatherapy oil; Organic cosmetics; Skincare cosmetics; Cosmetics for children; Beauty creams for body care; Essential oils for personal use; Perfumed oils for skin care; Massage oils and lotions; Face and body lotions.
Class 41	Entertainment, sporting and cultural activities; Computer education training; Education and training; Providing courses of training; Computerised training; Online education services; Online entertainment services; Online digital publishing services.
Class 43	Accommodation services; Temporary accommodation.

67. The application may proceed to registration for those goods and services against which the opposition was not directed, namely:

Class 9	Software; Collaboration software platforms [software].

Class 14	Gemstones, pearls and precious metals, and imitations thereof; Pearl; Precious metals and their alloys; Precious and semi-precious stones; Jewellery, including imitation jewellery and plastic jewellery; Fashion jewellery; Jade [jewellery]; Artificial jewellery; Body jewellery; Gold jewellery; Pins [jewellery].
Class 25	Clothing with the exception of ties, gloves, belts, slippers and headscarves; Head coverings with the exception of headscarves.
Class 35	Marketing, advertising and promotion services; Direct marketing services; Online advertising services; Online marketing; Promotional marketing; Online advertising; Event marketing; Internet marketing.
Class 45	Online social networking services; Dating services provided through social networking; Personal introduction services by computer; Mentoring [spiritual]; Internet dating services.

STATUS OF THIS DECISION

68. As part of this decision is based upon the First Earlier Mark, which is not yet registered, it must be provisional pending the registration of that mark. Consequently, I will issue a supplementary decision once the registrability of that mark is known to confirm the scope of the success and the matter of costs. The opponent should inform the Tribunal upon registration of the First Earlier Mark.

69. The appeal period will not begin to run until that supplementary decision is issued.

Dated this 14th day of March 2024

S WILSON
For the Registrar

ANNEX 1

Class 3

Perfumery and fragrances; Body cleaning and beauty care preparations; Soaps and gels; Deodorants and antiperspirants; Moisturising creams, lotions and gels; Liquid soaps for hands and face; Skin balms [cosmetic]; Balms (Non-medicated -); Beauty balm creams; Bergamot oil; Ethereal oils; Body oil; Perfume oils; Cosmetic oils; Massage oils; Aromatic oils; Aromatherapy oils; Essential oils; Aromatherapy oil; Organic cosmetics; Skincare cosmetics; Cosmetics for children; Beauty creams for body care; Essential oils for personal use; Perfumed oils for skin care; Massage oils and lotions; Face and body lotions.

Class 9

Software; Collaboration software platforms [software].

Class 14

Gemstones, pearls and precious metals, and imitations thereof; Pearl; Precious metals and their alloys; Precious and semi-precious stones; Jewellery, including imitation jewellery and plastic jewellery; Fashion jewellery; Jade [jewellery]; Artificial jewellery; Body jewellery; Gold jewellery; Pins [jewellery].

Class 25

Clothing with the exception of ties, gloves, belts, slippers and headscarves; Head coverings with the exception of headscarves.

Class 35

Marketing, advertising and promotion services; Direct marketing services; Online advertising services; Online marketing; Promotional marketing; Online advertising; Event marketing; Internet marketing.

Class 41

Entertainment, sporting and cultural activities; Computer education training; Education and training; Providing courses of training; Computerised training; Online education services; Online entertainment services; Online digital publishing services.

Class 43

Accommodation services; Temporary accommodation.

Class 45

Online social networking services; Dating services provided through social networking; Personal introduction services by computer; Mentoring [spiritual]; Internet dating services.

ANNEX 2

The Third Earlier Mark

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.

The Fourth Earlier Mark

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 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.