O/0543/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3745382
IN THE NAME OF EXPO FOODS LIMITED
IN RESPECT OF THE SERIES OF FOUR TRADE MARKS

EXPO FOODS LTD

Expo Foods Ltd

Expo Foods Limited

EXPO FOODS LIMITED

IN CLASSES 29, 30, 32, 33 & 39

AND

THE OPPOSITION THERETO UNDER NO. 434882
BY EXPO FOODS MIDLANDS LTD

Background and pleadings

1. Expo Foods Limited ("the applicant") applied to register the series of four trade marks shown on the cover page of this decision, in the UK on 20 January 2022, under application no. 3745382. The application was accepted and published in the Trade Marks Journal on 15 April 2022 in respect of goods and services in classes 29, 30, 32, 33 & 39 as set out at paragraph 32 of this decision.

2. On 8 July 2022, Expo Foods Midlands Ltd ("the opponent") opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK Trade Mark no. 3389883 for the mark below:

3. The opponent relies upon all of its services registered under this mark, namely those in class 43 as set out at paragraph 32 of this decision. The earlier mark was filed on 5 April 2019 and registered on 21 June 2019, and it therefore constitutes a valid earlier mark in accordance with section 6 of the Act.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are similar, and that as such the provisions of section 5(2)(b) (i.e. that there is a likelihood of confusion on this basis) are satisfied.

5. The applicant filed a counterstatement denying a likelihood of confusion between the marks, as well as stating the parties have an unwritten agreement that the applicant may continue to use its name as "a protectable trading name".

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Both sides filed written submissions which will not be summarised in full but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. Both parties are represented in these proceedings. The applicant is represented by London IP Ltd. The opponent is represented by BY Law.

8. 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.

Evidence

9. The opponent did not file any evidence in chief in this opposition. The applicant, on the other hand, chose to file evidence in the form of two witness statements.

10. The first witness statement is by Metin Kuzu, the finance manager of the applicant. Within this statement Mr Kuzu explains that he believes the opposition should fail because, amongst other reasons, the parties have shared similar but different names since the incorporation of the respective companies, which were related to each other until 2015.[1] He goes on to discuss the former relationship of the parties as well as the verbal agreement he believes was in place allowing each to use its own mark. He states "I believe therefore that Expo and Midlands agreed since 2008 to permit each other to use their respective names trading styles and since 2015 this agreement continued without change. Therefore, I believe that this opposition should be rejected as Midlands have agreed to our using and protecting the name Expo Foods Ltd as we have allowed them to use their name."[2]

11. The witness statement introduces a single exhibit, namely Exhibit MK1. This exhibit is 235 pages long and contains various items including companies house documents and invoices, attesting to the history of the parties and their relationship since 2007 onwards.

12. The second witness statement filed in is the name of Irfan Degirmendereli, company secretary for the applicant. Mr Degirmendereli explains in his statement that the parties separated on an amicable basis in 2015, but that the terms of the separation were not written down.[3] He explains that it was agreed that the two

[1] See paragraph 6 of the witness statement of Mr Kuzu
[2] See paragraph 24 of the witness statement of Mr Kuzu
[3] See paragraph 9 of the witness statement of Mr Degirmendereli

businesses would become separate and would thereafter continue to use the names used prior to this, namely Expo Foods Limited for the applicant and Expo Foods (Midlands) Ltd for the opponent.[4] He states that '[a]t no point has the agreement about the two companies using their names changed or another agreement made about use of each other's names. Therefore I believe that Expo is entitled to continue to use and protect its name."[5] The witness statement introduces a single exhibit, namely Exhibit ID1 which provides Companies House print outs of annual returns in the name of Expo Foods Ltd from 2008, 2014 and 2016.

13. The opponent filed evidence in reply. This was in the form of a witness statement from Ozgur Yilmaz, the managing director for the opponent. This statement reiterates the former relationship of the parties. He states the structure of the companies was set up in order to create separate warehouses trading across the UK[6] and that they could work together or independently, but the agreement was always that each company would operate in a separate region in the UK, although this was never set out in writing.[7] He explains the businesses split, and that this split was conditional on each business operating exclusively in a defined geographical area and they did not compete.[8] Mr Yilmaz goes on to state that the applicant began to operate in breach of this agreement, there was an attempt at mediation, but ultimately the opponent withdrew its consent for the applicant to use the "EXPO FOODS mark". The opponent then subsequently registered its trade mark. [9]

14. The statement introduces a single exhibit, namely Exhibit OY1. This provides correspondence between the parties' legal representatives. The letter sent by the opponent's legal representative accuses the recipient of deliberately causing confusion and alleging that its client's invoices have incorrectly been paid to that recipient, amongst various other accusations. The response provided either denies, or denies any knowledge of the claims made. It also invites the opponent to change its name. It is disputed by the applicant that the original letter is directed at the applicant, and I note the opponent's original letter is directed to 'Expo Foods North Limited'. The

[4] See paragraph 10 of the witness statement of Mr Degirmendereli
[5] See paragraph 13 of the witness statement of Mr Degirmendereli
[6] See paragraph 6 of the witness statement of Mr Yilmaz
[7] See paragraph 8 of the witness statement of Mr Yilmaz
[8] See paragraph 12 of the witness statement of Mr Yilmaz
[9] See paragraph 16 of the witness statement of Mr Yilmaz

response appears to have been written on behalf of both the applicant and Expo Foods North Limited. Both letters date from 2020.

Procedural issues and Case Management Conference ("CMC")

15. As explained above, the opponent opted not to file any evidence during the initial evidence round within these proceedings. However, following the receipt of the applicant's evidence, the opponent filed evidence in reply. Following the opponent's evidence in reply, the applicant requested permission from the Registry to file further evidence in reply. This request was provisionally refused and a CMC took place with a Hearing Officer on 4 October 2023 to consider this further. Following the CMC, the Hearing Officer wrote to the parties with the following directions:

> "At the case management conference held earlier today, I confirmed the Registry's preliminary view to refuse the applicant leave to adduce further evidence in respect of the scope of a claimed oral agreement with the opponent that permitted the applicant to use its trade mark.
>
> The issue in these proceedings is whether the contested application to register a trade mark should be denied under section 5(2) of the Trade Marks Act 1994. I explained that the registration of this mark would create a UK-wide property right and could be used to prevent third parties from infringement (including the opponent). Therefore, the registration creates a right that goes beyond a right to use and, consequently, even if I were to find that use was agreed between the parties (something that appears to be common ground between the parties), in the absence of an agreement that permitted registration of the mark, the evidence cannot assist the applicant. Further evidence going to the conditions of agreed use would, therefore, not advance the applicant's defence."

16. I agree with the Hearing Officer's assessment above. A verbal agreement between the parties allowing the applicant to continue to *use* its mark will not have any bearing on whether the opponent may object to the *registration* of the applicant's mark, for the reasons the Hearing Officer has set out above.

17. For clarity, I note at this stage section 5(5) of the Act reads:

5 Relative grounds for refusal of registration.

[…]

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

18. It is evident from the wording above that a mark may not be refused registration under section 5 where consent to *register* a mark has been granted. However, there is nothing in the Act stating that an objection to register a mark shall be overcome on the basis of consent to use the mark.

19. In this instance, no evidence has been provided demonstrating that the opponent has consented to the registration of the applicant's mark in the UK (or elsewhere). Whilst I note the statements of Mr Kuzu and Mr Degirmendereli that they believe the consent to use entities the applicant to use *and* protect the mark, they make no statement confirming this is what has been agreed. No challenge has been brought against the earlier mark in these proceedings, and I therefore consider it to be a valid earlier right for the purpose of this opposition. I therefore find that the evidence filed by the applicant (and the reply evidence filed by the opponent) discussing the terms of the agreed use between the parties has no relevance to the decision I must make in accordance with section 5(2)(b) of the Act.

20. For completeness, I also note at this point the extensive written submissions filed by the applicant in lieu of a hearing on this matter. These go into considerable detail regarding "Estoppel by Convention". These submissions detail aspects of the law regarding shared goodwill following the split of a partnership, the restriction against enforcing that goodwill against former members of the partnership, and the right for a party to continue to use a sign and maintain the status quo. I consider these arguments to be misplaced in the context of this opposition against its application under section 5(2)(b). Whilst I note the applicant submits that by filing the application it is merely taking steps on the assumption that it may enforce its rights against third parties but not against each other, I disagree with this statement. The submissions made by the applicant refer to aspects of common law rights regarding goodwill in a business under

a sign. Obtaining a UK wide trade mark registration is not 'maintaining the status quo' in respect of the use of the sign. As such, the defence that the application to gain registration of a UK wide trade mark right was made in order to continue the status quo cannot succeed in the face of an objection under section 5(2)(b) based on what I must, in the absence of any challenge against the same, take to be a valid earlier mark in the context of the Act. I do not consider the opponent to be "[…] estopped from preventing the registration by Expo of the trade mark EXPO" as claimed by the applicant.

21. I also note briefly at this stage Mr Yilmaz's statement within the opponent's evidence that he does "not believe that the Applicant is proceeding with its registration in good faith and this should be refused in its entirety".[10] The opponent has not pleaded that the application has been filed in bad faith under section 3(6) of the Act, and as such this will not be considered any further in this decision.

22. I will now continue with this decision by considering the factors that are relevant to an opposition under section 5(2)(b) of the Act only.

Proof of use

23. As the earlier mark in these proceedings had been registered for less than five years on the date at which the application was filed, the opponent is not required to prove use of this mark in these proceedings, in accordance with section 6A of the Act. It may therefore continue to rely upon all of its services as registered under its earlier mark.

Decision

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

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

[10] See paragraph 22 of the witness statement of Ozgur Yilmaz for the opponent.

(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".

25. Section 5A of the Act is as follows:

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

The Principles

26. 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.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

27. 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 of its judgment 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".

28. 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.

29. 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."

30. 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 Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated there is "complementary" where:

> "...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".

31. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC 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 fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

32. With the above in mind, the goods and services for comparison are as follows:

Earlier services	**Contested goods and services**
Class 43: Ethnic and continental food and drink wholesale and supply to the corner shops ,super market, off-licences; Serving food and drinks; Take away food and drink services; Takeaway food and drink services; Providing food and beverages; Providing food and drink; Providing of food and drink; Catering of food and drink.	Class 29: Chilled dairy desserts; Dairy products; Dairy-based beverages; Chilled foods consisting predominately of fish; Meat and meat products; Meat, frozen; Crisps. Class 30: Chocolate confectionary; Pasta; Chocolate flavoured beverages; Food seasonings; Food dressings [sauces]. Class 32: Beer; Soft drinks. Class 33: Wines. Class 39: Storage of food; Transport of food.

33. I note the applicant submits that the marks are used in different markets. However, the comparison of the goods and services is a notional assessment, comparing the services as registered and relied upon under the earlier mark with the goods and services applied for by the applicant (rather than the goods and services that the respective marks are actually used for). The activities of the parties in the market are, in this instance, irrelevant to that notional assessment and will have no bearing on the outcome of this opposition based on section 5(2)(b) of the Act.

Class 29: *Chilled dairy desserts; Dairy-based beverages; Crisps.*

Class 30: *Chocolate confectionary; Chocolate flavoured beverages; Food dressings [sauces]; Food seasonings.*

Class 32: *Beer; Soft drinks.*

Class 33: *Wines.*

34. The opponent holds protection for the earlier services *Providing food and drink.* The applicant's goods above are all prepared items of food and drink. Clearly the nature and method of use of the opponent's services and the applicant's goods above will differ. However, I consider that the prepared food and drink goods themselves are essential to the services for the provision of food and drink to the consumer. Further, I consider that the consumer will find it likely that the prepared food goods above may commonly be offered by the same undertaking as the services for the provision of these goods, and as such I find them to be complementary. Further, there is a level of competition existing between the goods and services, for example where the consumer chooses between purchasing ready made food from the shop for example, or engaging services to provide food for them. The users will clearly be shared, as will the ultimate purpose, for providing the consumer with something to eat or drink. Considering all of these factors, I find the goods and services to be similar to between a medium and high degree. In case I am wrong to include *Food dressings [sauces]* and *Food seasonings* in this assessment, I have considered these again at paragraph 36 below.

Class 29: *Dairy products; Chilled foods consisting predominately of fish; Meat and meat products.*

35. I consider that the above categories of goods may include those which are prepared and ready to eat. I note this finding is supported by the comments of Emma Himsworth QC (as she then was) sitting as the appointed person in *SAINSBURY'S TOP DOG, BL* O/044/16. In that decision, and in the context of comparing food goods

with services for the provision of food in class 43, Ms Himsworth QC confirmed a distinction could not be made in respect of the broader categories of meat, poultry and game for example, and the prepared foods that clearly fall within those categories. I apply this reasoning to the goods above and therefore find these to be similar to the opponent's services for *providing food and drink* to between a medium and high degree, for the same reasons as set out above.

Class 29: *Meat, frozen; Food dressings [sauces]; Food seasonings.*

36. I note that the opponent's services include *ethnic and continental food and drink wholesale and supply to the corner shops ,super market, off-licences.* In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Whilst I note here I am considering wholesale rather than retail services, I find these factors to apply equally here. The nature, intended purpose and method of use of these goods will differ. However, I consider that the goods including meat in its frozen form, as well as food seasonings and sauces will be essential for the wholesale provision of these goods. Further, I note that the users, including store owners for example, may well conclude that the goods and services will be offered by the same entity. I therefore find the goods to be complementary. I consider that users, particularly those store and business owners, will be shared. Overall, I consider the above goods to be similar to the to the earlier wholesale services to a medium degree.

Class 39: *Storage of food; Transport of food.*

37. Again, I note that the opponent's earlier mark covers the services *ethnic and continental food and drink wholesale and supply to the corner shops ,super market, off-licences.* The nature, method of use and intended purpose of these services and the applicant's services above will differ. However, I consider that users, such as those running supermarkets, will likely be shared. Further, I consider that parties offering the wholesale of food goods to large supermarkets may well also offer the services for the storage and transportation of that food, and as such trade channels may well overlap.

I do not consider the goods to be strictly complementary or in competition. Overall, I consider these services to be similar to the opponent's earlier wholesale food services to a low degree.

Comparison of marks

38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

39. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

40. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
	EXPO FOODS LTD Expo Foods Ltd Expo Foods Limited

	EXPO FOODS LIMITED

41. Although the applicant has applied for a series of four different marks, it is my view that the use of all uppercase lettering vs the standard variation of upper and lower case lettering will make no difference when comparing these to the opponent's earlier marks. As the contested marks are filed as word marks, I must consider that fair and notional use of the same allows these to be used in either form. For ease, I will therefore consider only the applicant's marks Expo Foods Ltd and Expo Foods Limited in my assessment below. However, my findings in relation to these variations will apply identically to their counterparts filed in all uppercase lettering.

42. The earlier mark comprises a number of elements. There is the large red lettering EXPO FOODS in the middle of the mark, and the smaller red lettering spelling Midlands below this. These are placed over the top of what appears to be a blue and white coloured illustration of a globe. It is my view that the large red lettering in the middle of the mark plays the most dominant and distinctive role in the same, however, I also find the globe to play a role in the overall impression of the mark. The small wording 'Midlands' plays a far lesser role in the overall impression of the mark, both due to its size and the fact it appears simply to indicate the location of the services.

43. The contested marks include the three words Expo Foods Ltd and Expo Foods Limited. The use of 'Ltd' and 'Limited' will simply convey to the consumer that it is a limited company, and in turn 'Expo Foods' conveys the name of that limited company. Clearly, the word 'Foods' is descriptive of the good and services and as such 'Expo' is the most distinctive element, however it is clear this is to be read alongside foods to form the company name. All elements of the mark play a role in its overall impression, although for the reasons explained Ltd and Limited plays a lesser role that than 'Expo Foods' itself.

Expo Foods Limited

Visual comparison

44. Visually, the earlier mark shares the most dominant element EXPO FOODS with the contested mark. They differ by way of the large blue and white globe device in the earlier mark which is not present in the later mark, and the different words Midlands and Limited. I consider that the applicant's contested mark is filed in black and white because it is not accompanied by a colour claim, and as such it may be used in any standard colour including red. Overall, considering the similarities and differences, I find the marks to be visually similar to between a medium and high degree.

Aural comparison

45. The elements that can be verbalised in the earlier mark include 'Expo Foods Midlands'. I note the size and descriptive nature of the word 'Midlands' means there may be a portion of consumers who will not verbalise this element, in which case it will simply be verbalised as 'Expo Foods' The later mark will most likely be pronounced in full as Expo Foods Limited. Aurally, the marks coincide by way of the first two identical words and the first three syllables EX-PO-FOODS. They differ by way of the use of the three syllable LIM-I-TED in the later mark, whether or not the two syllable word MID-LANDS is pronounced in the earlier mark. In both instances, by way of the aural identity at the beginning of the marks where the consumer tends to pay more attention, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

46. It is my view that the word 'Expo' in both marks may be construed conceptually by the consumer in one of two ways. I note the word Expo describes of a large, international exhibition. I consider it is likely to convey this meaning to at least a significant portion of consumers. However, it is my view that in the context of the goods, some consumers may also consider the word 'expo' to allude to the concept of export,[11] suggesting to a further significant proportion of consumers an international

[11] See *Usinor SA v OHIM,* Case T-189/05 in which the General Court found that the consumer will note elements of a mark that resemble words or suggest a concrete meaning, even if those signs are technically meaningless.

element to the goods and services. I note the word foods will convey its ordinary meaning to the consumer, and together both words appear to allusive of the concept of international or exported foods. The use of Midlands in the earlier mark will convey to the consumer that the opponent's business is based in the Midlands, whereas the use of the word Limited in the later mark will convey to the consumer that the applicant is a limited company. These create points of conceptual difference. I note the use of the globe in the earlier mark reinforces the concept of an international element to the opponent's business. Overall, noting the points of conceptual similarity and difference, I find the marks to be conceptually similar to a relatively high degree.

Expo Foods Ltd

Visual comparison

47. The points of visual similarity between this mark and the opponent's earlier mark are shared with the applicant's other mark Expo Foods Limited. The only part of the applicant's mark above that differs with the earlier mark is that it uses the shortened version of the word 'Limited'. Considering the points of visual similarity and difference, I do not find this makes a meaningful difference to the visual comparison of this mark and the opponent's earlier mark, and again I find them to be visually similar to between a medium and high degree.

Aural comparison

48. It is my view the applicant's mark above will be pronounced identically to its other mark Expo Foods Limited. Again, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

49. I do not find the use of Ltd (rather than Limited) in the mark above has any impact on the concept created by this mark, when compared to the applicant's other mark. Again, I find this mark to be conceptually similar to the opponent's mark to a relatively high degree.

Average consumer and the purchasing act

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

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

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

51. The general food goods and the services for providing goods food and drink will be targeted primarily at the general public. I consider that flavour, quality and possibly origin will likely be considered by the consumer when purchasing food or food services, and as such a medium level of attention is likely to be paid in respect of the same. I note that in respect of the food goods there will also be a group of professional consumers including retail store owners for example, and these consumers may pay a slightly higher level of attention when purchasing these items due to the increased liability involved in passing them on to their own customers, and the impact the goods purchased may have on their business.

52. In respect of both the wholesale services and the food transport and storage services, I find the consumer will primarily be professionals, including those looking to stock retail stores or offering catering services. These consumers will likely pay a slightly above medium level of attention to the wholesale services, due to the fact that both the quality and price point of the foods they stock or pass on to end users may

have a direct impact on their business. I also consider an above medium level of attention will be paid in respect of the food storage and transport services, as it will be essential to these businesses that any food passed on to the consumer has been stored and transported in the correct conditions to avoid damage to the goods and wasted profits, or the potential to become liable for making consumers unwell by providing food that has been stored or transported incorrectly.

53. The general consumer goods and services will likely be purchased visually, either being displayed on the shelves of retail stores, or advertised on shop frontages or via website advertisements. In addition, I consider the food wholesale, transport and storage services may also be primarily advertised visually on websites or via brochures. However, I note that in both cases there is the possibility of word of mouth recommendations as well as aural assistance being offered when purchasing the goods or services. I therefore cannot completely ignore the aural comparison.

Distinctive character of the earlier trade mark

54. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 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)."

55. The opponent has provided a small amount of evidence relating to its business. However, most of the evidence provided appears to be directed at explaining the relationship between the opponent and the applicant. There are references made to the opponent's mark being created around June 2008,[12] and confirming that trading in the opponent's 'designated region' has taken place since then.[13] Further, there is a comment in the letter included as Exhibit OY 1 written by the opponent's legal representatives that the opponent "[…] has for approximately 11 years owned and operated a food and drink wholesale business under the company of Expo Foods (Midlands) Ltd" and that they are "[…] now a leading wholesale supplier of international food and beverages." However, I have not been provided with any evidence relating to the opponent's turnover under the mark, market share, advertising spend or to the general level of exposure of the mark to the UK consumer prior to the earlier mark being filed. The evidence supplied is clearly not sufficient to find that the distinctive character of the opponent's mark has been enhanced through use.

56. I will therefore consider the level of inherent distinctive character held by the earlier mark. As previously noted, I find the word EXPO to be somewhat allusive of export or an international element to the services. Clearly the word FOODS is descriptive of the services themselves. Together I note these words hold a relatively low degree of distinctive character. I do not find the use of the globe (alluding again to an international nature of the goods) or the small word 'Midlands' (alluding to the location of the business) to add significantly to the distinctive character of the earlier mark, and overall I consider it will hold only a relatively low degree of inherent distinctiveness in respect of the services.

[12] See paragraph 9 of the witness statement of Ozgur Yilmaz
[13] See paragraph 10 of the witness statement of Ozgur Yilmaz

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

57. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 26 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[14] I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

58. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[15]

59. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this

[14] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[15] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

60. Whilst I am aware that the applicant has applied for a series of four slightly different marks, considering I have found identical outcomes for these when comparing them to the opponent's mark, it is my view that any finding on likelihood confusion that applies to one mark in the series will inevitably apply to all four. For ease, I will therefore continue by grouping the applicant's marks and referring to these collectively within my assessment below.

61. I consider firstly, the likelihood of direct confusion between the marks. I note the medium to high degree of visual and aural similarity between the marks and the relatively high degree of conceptual similarity in respect of the same. I also note that the dominant element EXPO FOODS is replicated identically in each of the marks, although I note this element holds only a low degree of distinctive character in relation to the opponent's earlier services. I note the similarity of the goods and services varies from low to high, and that the degree of attention paid by the consumer will also vary from medium to above medium. Whilst I acknowledge the large globe device in the earlier mark which is not present in the later mark, I consider this plays a lesser role in the mark than the wording, has no verbal element, and is not particularly distinctive or memorable in the context of the services. I keep in mind the consumers imperfect recollection, and considering all of the factors, and notwithstanding the low level of distinctive character held by the shared element, it is my view that where the similarity between the goods and services is at least medium, and the consumer is paying a medium degree of attention, there will be a likelihood of direct confusion between the marks. This is primarily due to the shared dominant and distinctive elements of the marks, and also because there is little in the way of additional memorable distinctive matter for the consumer to recall and use to differentiate between the marks where these circumstances arise.

62. However, where the consumer is paying an above medium degree of attention, such as is the case in respect of the services applied for, bearing in mind the similarity between those services is low, it is my view that the consumer is more likely to recall and notice the differences between the marks. I will therefore go on to consider if there will be a likelihood of indirect confusion in those circumstances.

63. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

64. I note that the examples above were intended to be illustrative and are not exhaustive. However, I also note *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

65. I consider again the shared dominant and distinctive elements of the marks, namely Expo Foods. Whilst I note the distinctiveness of this element is only low, I consider that it appears in both marks to be the key identifier of the origin of the goods.

Whilst I do not consider this case to be a strictly textbook example of category b) as outlined in L.A. Sugar above, it does fall loosely into this example. The use of Limited or Ltd in the later mark does not appear to be a distinctive element. The same can be said for the use of the word 'Midlands' in the earlier mark. The former simply indicates the company type and the latter the location of the services. Whilst the earlier mark also includes other differences, mainly the globe image behind the mark, it is my view that the addition or omission of this element in the mark would likely be seen as a stylistic choice between brand variants, rather than an indicator that the marks are the property of separate economic entities. I find it highly likely that where the differences between the marks are noticed, even where the similarity between the services is low and the consumer is paying an above medium level of attention, that same consumer would conclude that the marks both derive from the same 'Expo Foods' operation, with one version of the mark choosing to name the location of the business and one the company type. Alternatively, and at the very least, it is my view that they would be considered to indicate marks deriving from the same 'Expo Foods' group to indicate different branches of the economically linked undertaking, perhaps with one operating in the Midlands and the other dealing with the UK wide affairs. I therefore find a likelihood of indirect confusion between the marks in respect of all of the goods and services.

Final Remarks

66. The opposition had succeeded in full, and the application is refused in its entirety.

COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing and filing the TM7 and considering the TM8:	£200
Preparing and considering the evidence:	£500

Preparing and filing written submissions:	£300
Total:	**£1100**

68. I therefore order Expo Foods Limited to pay Expo Foods Midlands Ltd the sum of £1100. 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 13th day of June 2024

Rosie Le Breton

For the Registrar