

O-0915-25

TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO.3892569  
BY SEXY COFFEE LTD  
TO REGISTER

**SEXY COFFEE**

AS A TRADE MARK  
IN CLASSES 30, 33, 35, 39 & 43  
AND OPPOSITION THERETO (UNDER NO. 443104)  
BY  
CAPRICE HOLDINGS LIMITED

## Background & pleadings

1. Sexy Coffee Ltd (“the applicant”) applied to register the mark **Sexy Coffee** on 23 March 2023. The mark was published for opposition purposes on 16 June 2023 in classes 30, 33, 35, 39 and 43. The applicant amended its class 43 specification by means of a form TM21B on 10 February 2025. The goods and services as they currently stand are set out in Annex 1 of this decision.

2. Caprice Holdings Limited (“the opponent”) opposed the application in full on 18 September 2023 under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on its comparable UK TM no. 912602868<sup>1</sup> and UK TM no. 3438926 under section 5(2)(b) and just the comparable mark under section 5(3). The details of both registrations and the services relied on are set out below.

Registration relied on:	Services relied on:
UK TM No. 912602868 (“the ‘868 registration”)  <b>SEXY FISH</b>  Filing date: 14 February 2014 Registration date: 5 July 2014	43: Services for providing food and drink: restaurant, bar and catering services; provision of food and drink for consumption both on and off premises; reservation services for booking meals.
UK TM No. 3438926 (“the ‘926 registration”)  <b>SEXY PIZZA</b>  Filing date: 24 October 2019 Registration date: 17 January 2020	43: Services for providing food and drink; restaurant services; restaurant, bar and catering services; provision of food and drink for consumption both on and off premises; catering services including mobile catering services and catering services provided online from a

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<sup>1</sup> Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all rights holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

	computer database or from the Internet; self-service restaurant services; bar, public house, snack bar, wine bar, wine club services, sandwich bar, cafeteria, canteen and café services; take away services; fast-food restaurant services.
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3. The applicant filed a counterstatement in which it denied both claims and put the opponent to proof of use.

4. Both sides have been represented throughout these proceedings. The applicant has been represented by Harper MacLeod LLP and the opponent by Boulton Wade Tennant LLP.

5. Both sides filed evidence in these proceedings and a hearing was requested. I heard the matter on 6 February 2025, via video conference. Mr Jamie Watt of Harper Macleod LLP appeared for the applicant and Ms Becky Knott of Counsel, appointed by Bout Wade Tennant LLP, appeared for the opponent.

6. I make this decision based on a reading of all the material before me and the submissions made at the hearing.

7. 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 that predate the UK's withdrawal from the EU.

### **Preliminary issues**

8. The opponent's two registrations have filing dates that are earlier than the filing date of the contested application and are therefore considered earlier marks, by virtue of section 6 of the Act. As the registration procedure for UK TM No. 912602868 was completed more than 5 years prior to the filing date of the contested application, it is

subject to the use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the services it relies on. The opponent's UK TM No. 3438926 has not been registered for five years or more before the filing date of the contested application, and therefore is not subject to the same proof of use requirements.

9. As the '926 registration is not subject to proof of use and has a broader specification than the '868 registration, I will proceed initially on the basis of this earlier mark.

## **DECISION**

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

10. Section 5(2)(b) of the Act reads as follows:

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

[...]

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

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

11. Section 5A is also relevant and reads:

“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”.

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord*

*GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods and services**

13. In *Canon*<sup>2</sup>, the CJEU stated at paragraph 23 of its judgment:

“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.”

14. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd (the Treat case)*<sup>3</sup>, 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;

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<sup>2</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97

<sup>3</sup> [1996] R.P.C. 281

- (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.

15. In addition I find the following case law to be helpful when in *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>4</sup> the General Court (“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 für 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.”

16. In *Kurt Hesse v OHIM*,<sup>5</sup> 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)*,<sup>6</sup> the GC stated that “complementary” means:

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

17. In *Sanco SA v OHIM*,<sup>7</sup> the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different – in that

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<sup>4</sup> Case T- 133/05

<sup>5</sup> Case C-50/15 P

<sup>6</sup> Case T-325/06

<sup>7</sup> Case T-249/11

case, *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:<sup>8</sup>

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

18. The applicant’s goods and services to be compared are set out in Annex 1 and the opponent’s relied on services are set out in paragraph 2 (for the ‘926 registration) of this decision.

### Class 30

19. The applicant’s class 30 goods consist essentially of a variety of coffee products, tea, cocoa and cakes. The opponent has no directly equivalent goods class but submits in its skeleton argument<sup>9</sup> that its class 43 services, which cover *services for providing food and drink*, are complementary and therefore similar on the basis that the goods and services overlap in purpose, in users and in trade channels. The goods and services are clearly different in nature but I agree that the purpose of both, is to provide beverages and food items for consumers. I also note that some coffeeshop chains do sell coffee or beverage related goods such as coffee beans or cocoa powder either from their own premises or through supermarkets. Nonetheless I do not think

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<sup>8</sup> BL-0-255-13

<sup>9</sup> Opponent’s skeleton argument, paragraph 36.

that the respective goods and services can be considered complementary simply because the beverage making goods are used in the provision of the services. I do not find that consumers would necessarily expect them to come from the same undertaking. However, I find that there is a degree of competitiveness between the goods and services as consumer may choose to purchase a beverage rather than making one at home. Taking this all into account I find there is a low degree of similarity between the applicant's class 30 goods and the opponent's class 43 services.

### Class 33

20. The applicant's class 33 goods broadly cover coffee based/flavoured alcoholic beverages but also contains cocktails at large. The opponent makes largely the same submissions as in the previous paragraph that the goods and services are complementary on the basis that there is overlap in purpose, in users and in trade channels. As previously stated, the opponent has the term *provision of food and drink* in its '926 registration which would cover alcoholic beverages and it also has *bar, public house, wine bar services*. It is settled case law<sup>10</sup> that there is a low degree of similarity between beer and bar services on account of the complementarity, target consumers and overlapping point of sales. I see no reason why the reasoning in *Group Lottus* would not extend to alcoholic beverage in class 33. I find therefore the applicant's class 33 goods and opponent's class 43 services are similar to a low degree.

### Class 35

21. The applicant's class 35 services can be divided in to a number of sub categories namely retail and wholesale services, promotional services and import/export services. The opponent conceded in its skeleton argument<sup>11</sup> that the following services in the applicant's specification are not similar to its class 43 services, namely *retail and wholesale services in relation to coffee fruit, unprocessed, agricultural crops and horticulture products, Seeds for planting, Seedlings for planting; Promoting the sale of goods and services of others; Distribution of advertising, marketing and promotional material*.

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<sup>10</sup> *Group Lottus Corp., SL v OHIM*, Case T-161/07

<sup>11</sup> Opponent's skeleton argument, paragraph 42 and Annex 1.

22. I will first assess the remaining retail and wholesale services. These include the retail of coffee based products including beans, essence, concentrates as well as coffee related products such as coffee roasters, makers, grinders and tableware. There are also retail services for alcohol, confectionary, cakes and foodstuffs at large. The opponent submits, as in previous paragraphs, that there is an overlap in users, a degree of complementarity and some overlap in trade channels as various large café chains sell their own branded products including drinking vessels.<sup>12</sup> I have considered the opponent's submission on the retail elements of this class, but I do not agree. Whilst there can be an overlap of user, i.e. consumers being members of the general public, there is not an overlap of purpose or trade channels. The provision of food and drink and restaurant/bar type services are fundamentally hospitality services, not a retail service. I accept that some café chains sell branded coffee beans or even mugs, but they do not routinely sell coffee pots, coffee makers or other related beverage apparatus. I do not consider there to be any complementarity or competitiveness between the respective services. The broad overlap of consumers is not sufficient to make a finding of similarity. Therefore I find the services to be dissimilar.

23. With regard to the applicant's terms *Provision of discount cards; Sample distribution*, the opponent submits the respective services share, users and trade channels and have an element of complementarity.<sup>13</sup> I disagree. In my view the applicant's terms are commercial business services which are dissimilar from the opponent's hospitality services.

24. Turning to the applicant's terms *Export and import agencies; Import and export services* I take the view that this is a service to facilitate the movement of goods across territorial borders and would involve the arranging of transport logistics for said goods and for the preparation of appropriate customs, excise and/or other territorial paperwork required. These services have a different nature and purpose from the opponent's services and are aimed at different end users. The respective services

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<sup>12</sup> Opponent's skeleton argument, paragraph 43.

<sup>13</sup> Opponent's skeleton argument, paragraph 45.

are not in competition nor are they complementary in the sense of one being essential or important to the other. Overall, I find the respective services to be dissimilar.

### Class 39

25. The applicant's class 39 services broadly cover distribution, delivery, transport, storage and cargo handling. Some, but not all, of these services relate to food and drink. The opponent makes a similar argument as in previous paragraph that the respective services overlap in users and are complementary to the extent that delivery of food and drink is necessary to the provision of food and drink off the premises.<sup>14</sup> As such I find that the applicant's terms *Food delivery services; Delivery of food; Delivery of food and drink prepared for consumption* may be considered as complementary to the opponent's *provision of food and drink for consumption off premises; take away services* in its '926 registration. However with regard to the remainder of the applicant's services namely *Distribution services relating to beverages; Delivery [distribution] of goods; Delivery, despatching, transport and distribution of goods in the form of food and drink; Packaging of food; Packaging and storage of goods; Transportation of goods; Mail delivery services; Courier services for the delivery of goods; Refrigerated storage; Refrigerated warehousing; Import and export cargo handling services; Information, consultation and advisory services relating to the foregoing* I find there is no similarity with the opponent's services. I consider the applicant's services to be commercial logistics services not hospitality services. These services have a different nature and purpose from the opponent's services and are aimed at different end users. The respective services are not in competition nor are they complementary in the sense of one being essential or important to the other. Overall, I find these respective services to be dissimilar.

### Class 43

26. The opponent has *restaurant, cafeteria and café services* in its '926 registration. In my view these terms are sufficiently broad to encompass the applicant's terms *Coffee shops; Coffee bar services; Coffee shop services*. They are therefore considered identical under the *Meric* principle.

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<sup>14</sup> Ibid. Paragraph 48.

27. With regard to the applicant's remaining term in class, namely *Leasing of coffee makers*, the opponent submits that term is highly similar due to an element of complementarity and competition between the respective services.<sup>15</sup> I disagree. To my mind, the applicant's service is about the leasing of equipment, which may be used in a food preparation environment, but is a step further away from the actual provision of restaurant type services. The respective services do not share a nature or purpose. The end user would be different as leasing of equipment would be done by restaurant owners or franchisees, but the end user of a restaurant service is the general public. Moreover I do not find any level of complementarity or competition between a leasing service and a hospitality service. As such, I find the services are dissimilar.

28. I have found the applicants services, as set out below, to be dissimilar, namely  
*35: Retail services and wholesale services in relation to Flavour improvers for coffee, Coffee makers, Coffee machines, Coffee roasters, Refillable coffee capsules, Coffee capsules, empty, for electric coffee machines, Refrigerated boxes, Paper filters for coffee, Coffee cups, Coffee mugs, Coffee grinders, Coffee scoops, Coffee stirrers, Coffee pots, Coffee services [tableware], Coffeepots, non-electric, Non-electric coffee drippers for brewing coffee, Coffee makers, non-electric, Non-electric coffee frothers, Hand-operated coffee grinders, Non-electric plunger style coffee makers, Coffee, Iced coffee, Coffee extracts, Coffee beverages, Coffee drinks, Decaffeinated coffee, Instant coffee, Coffee essence, Coffee beans, Chocolate coffee, Coffee concentrates, Coffee oils, Flavoured coffee, Ground coffee, Malt coffee, Coffee substitutes, Coffee flavourings, Unroasted coffee, Artificial coffee, Prepared coffee beverages, Coffee based drinks, Prepared coffee, Coffee based fillings, Mixtures of coffee, Freeze-dried coffee, Malt coffee extracts, Drip bag coffee, Roasted coffee beans, Coffee capsules, filled, Mixtures of coffee essences and coffee extracts, Sugar-coated coffee beans, Coffee in brewed form, Coffee in ground form, Coffee in whole-bean form, Coffee, teas and cocoa and substitutes therefor, Coffee [roasted, powdered, granulated, or in drinks], Coffee fruit, unprocessed, Agricultural crops and horticulture products, Seeds for planting, Seedlings for planting, Coffee-flavored beer and ale, Coffee-flavored soft drinks, Coffee flavoured spirits, Coffee based*

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<sup>15</sup> Opponent's skeleton arguments, paragraph 51.

*liqueurs, Alcoholic coffee-based beverages, including those conducted by means of post and telecommunications; Retail services and wholesale services in relation to Cocktails, Rum cocktails, Gin cocktails, Whisky cocktails, Whiskey cocktails, Vodka cocktails; Retail services in relation to foodstuffs; Retail services in relation to confectionary; Retail services in relation to cakes; Promoting the sale of goods and services of others; Provision of discount cards; Sample distribution; Distribution of advertising, marketing and promotional material; Export and import agencies; Import and export services; Information, consultation and advisory services relating to the foregoing.*

*39: Distribution services relating to beverages; Delivery [distribution] of goods; Delivery, despatching, transport and distribution of goods in the form of food and drink; Packaging of food; Packaging and storage of goods; Transportation of goods; Mail delivery services; Courier services for the delivery of goods; Refrigerated storage; Refrigerated warehousing; Import and export cargo handling services; Information, consultation and advisory services relating to the foregoing.*

*43: Leasing of coffee makers; Information, consultation and advisory services relating to the foregoing.*

29. Where there is dissimilarity between the terms in the respective specifications I have assessed, it follows that there is no likelihood of confusion to be considered for these services.<sup>16</sup>

## **EVIDENCE**

### **Opponent's evidence in chief**

30. The opponent filed a witness statement, dated 14 February 2024, in the name of Sigita Gliozere, who is the Head of Property Strategy – International, Franchise & IP for the opponent. Ms Gliozere attaches 12 exhibits.

31. Ms Gliozere states that the opponent is a restaurant group and has three restaurants under the SEXY FISH brand. Two of these restaurants are in the UK, namely London and Manchester, and the other is in the USA. The London SEXY

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<sup>16</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

FISH restaurant is located in Mayfair and was opened 19 October 2015. The Manchester restaurant opened on 12 October 2023. Ms Gliozere states that the London restaurant is an exclusive dining experience with an average three course meal costing around £100. The opponent has declined to give turnover figures but has given an indication of the number of “covers” below, i.e. customers eating at the London restaurant between January 2019 to January 2024.

2019	155,889
2020	75,984
2021	112,653
2022	179,686
2023	144,576
2024	7,217

32. Ms Gliozere has stated that the “covers” figures equates to an average of 710 diners per day using the London SEXY FISH restaurant.

33. Courtesy of the Wayback Machine Internet archive, Ms Gliozere exhibits screenshots of the opponent’s website, sexyfish.com, dated between 2018 and 2023. The mark is shown on the masthead and in the rubric for menu viewing and booking a table.<sup>17</sup> Ms Gliozere also exhibits the number of UK visitors to the opponent’s website between 2018 and 2023 which have been broken down by geographical regions all over the UK and runs into the low millions.<sup>18</sup>

34. In terms of publicity for the London Sexy Fish restaurant, Ms Gliozere exhibits a number of press reports from Mail Online, Daily Express online, Daily Star online and the London Evening Standard online dated between 2018 and 2023 about celebrity appearances at the location.<sup>19</sup> In addition Ms Gliozere exhibited a selection of press articles dated from 2019-2020 from The Metro, Mail Online, The Telegraph, City AM, London Evening Standard and The Independent online where the restaurant is

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<sup>17</sup> Exhibit SG11

<sup>18</sup> Exhibit SG12

<sup>19</sup> Exhibit SG10

featured in “best places to eat” lists or in articles focussed on venue re-openings post pandemic.<sup>20</sup>

### **Applicant’s evidence**

35. The applicant filed a witness statement dated 28 March 2024, in the name of Jamie Watt, of Harper Macleod, the applicant’s legal representative. Mr Watt attaches 11 exhibits. These exhibits comprise details of a number of trade mark registrations for food, beverage and associated service classes which use the word SEXY as part of their marks or brands and screenshots of said marks/brands in use in the UK.<sup>21</sup>

### **Opponent’s evidence in reply**

36. The opponent filed a witness statement dated 13 May 2024 in the name of Felicity Hide, a chartered Trade Mark Attorney and Partner at Boulton Wade Tennant LLP, legal representative of the opponent. Ms Hide’s evidence mainly rebuts Mr Watt’s state of the register evidence and points to several of his exhibits, namely JW5-7, where the subject of the exhibits did not appear to have a UK presence.

### **Relevant period**

37. My first task is to establish whether, or to what extent, the opponent has shown genuine use of its earlier registration no. 912602868 for the mark SEXY FISH within the ‘relevant period’. The relevant period is defined as being a period of five years ending with the filing date of the contested application. In this case the relevant period is 24 March 2018 to 23 March 2023.

### **Relevant statutory provision: Section 6A:**

38. “(1) This section applies where,

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

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<sup>20</sup> Exhibit SG08

<sup>21</sup> Exhibits JW1-11

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

39. As the opponent's earlier mark No. 909822751 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

40. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

41. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

*Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];

*Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

42. I also find the following case law to be helpful where in *Awareness Limited v Plymouth City Council*<sup>22</sup>, Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

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

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the

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<sup>22</sup> Case BL O/236/13

wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

43. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*<sup>23</sup>, Mr Geoffrey Hobbs Q.C. (as he was then) also sitting as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

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<sup>23</sup> Case BL O/404/13

evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

### **Sufficiency of use**

44. The opponent operated a single restaurant in London under the mark SEXY FISH during the relevant period. Although no turnover figures were exhibited in evidence, I note that the number of customers was specified as was the average price of a three course meal. The opponent’s restaurant is marketed as an exclusive dining experience, and Ms Gliozere makes clear that it is “constantly at capacity”.<sup>24</sup> I also note that London is the UK’s capital city and a major tourist and business destination and as such will attract a large number of visitors. I find the number of customers, meal prices and people accessing the website, when considered together, paints a picture of a busy London restaurant. With regard to services for providing food off the premises, there was only a single reference to SEXY FISH providing a takeaway service<sup>25</sup> in the evidence and it was not clear from the London Evening Standard article if takeaways were a regular service or simply a commercial reaction to the pandemic regulations relating to the hospitality sector, but have since been discontinued. Overall, I find that the opponent has demonstrated sufficient use of the mark **SEXY FISH** for *restaurant, bar and catering services; reservation services for booking meals.*

### **Average consumer and the purchasing process**

45. I next consider who the average consumer is for the goods and services at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>26</sup> For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>27</sup>

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<sup>24</sup> Sigita Gliozere witness statement, paragraph 13.

<sup>25</sup> Exhibit SG09, page 10

<sup>26</sup> *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)

<sup>27</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

46. The average consumer for the contested goods and services will be the general public and businesses. There are a number of contested goods and services so the price range will vary from the inexpensive, e.g. a beverage purchase, to the expensive e.g. refrigerated warehousing. For goods such as beverages, the level of attention paid be low to medium. For some of the services like transportation and warehousing the level of attention paid would be between medium and high.

47. The beverage related goods at issue will likely be selected visually from physical premises whereas the services are more likely to purchased not only from physical premises but their online equivalents as well as from other sales material. Consequently, the purchasing process for the contested goods and services will be predominately visual but I do not discount an aural element such as word of mouth recommendation or technical sales advice.

### **Mark comparisons**

48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>28</sup>, that:

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

49. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

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<sup>28</sup> Case C-591/12P

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

50. The respective trade marks to be compared are:

Opponent's earlier registrations	Applicant's mark
<b>SEXY FISH</b> <b>SEXY PIZZA</b>	<b>SEXY COFFEE</b>

51. The opponent's registrations are both word only and are formed by the same construction, namely the word SEXY followed by the words FISH and PIZZA respectively. They are presented in block capitals with no other aspect such as stylisation to them. The word SEXY can have laudatory connotations, although it is slightly unusual for restaurant services. In my view it is not very highly distinctive. The words FISH and PIZZA are types of food and also descriptive for types of restaurant, both of which are meaningful for the services registered. As such they play much less of a role in the overall impression than SEXY which I find is the dominant element.

52. The applicant's mark consists of the word SEXY followed by a descriptive word COFFEE with no other aspect to the mark. As previously stated, although SEXY can have laudatory connotations, given the descriptiveness of the second word in relation to coffee based goods and services, I find SEXY to be the dominant element.

53. In a visual comparison the word in common to all marks is SEXY. It is the first word in each mark. The points of difference come from the second words but as previously outlined these second words namely FISH, PIZZA and COFFEE are descriptive for foodstuffs and as types of restaurants/cafes. Moreover, it is settled case law<sup>29</sup> that the beginnings of words tend to have greater visual and aural impact on consumers and I find that to be the case here. Taking this into account I find the respective marks are visually similar to a medium degree.

54. Much of my reasoning above can be placed into the aural comparison. The word in common, SEXY, will be given the same pronunciation in each case. The points of

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<sup>29</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

difference again arise from the different second words. Given that each mark is short, i.e. only two words, it is likely that both words will be verbalised in each case. Overall, I find the respective marks are aurally similar to a medium degree.

55. In a conceptual comparison, the shared word SEXY will bring the same concept to mind, namely an adjective describing something that is attractive. The second word in all marks is a descriptive word for a foodstuff or type of restaurant/café. The addition of the first word SEXY does not alter the meaning of the second word nor does it create a new term which is more than the sum of its parts. The adjectival word SEXY in each case merely qualifies the word that follows. Taking all of this into account I find the respective mark to be conceptually similar to a high degree.

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

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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.

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>30</sup> the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

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<sup>30</sup> Case C-342/97

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).”

58. I will first consider the inherent distinctiveness of the earlier registrations. As previously stated, the earlier marks both consist of the same structure namely the word SEXY followed by FISH and PIZZA respectively. The word SEXY has laudatory connotations, and although is somewhat unusual for restaurant services, I find it is not very highly distinctive and the remaining second words are clearly descriptive. Overall I find the whole marks are inherently distinctive to a medium degree.

59. As evidence has been provided for the SEXY FISH registration, I must consider whether use made of this mark has enhanced its distinctiveness and I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

60. For enhanced distinctiveness, the market I must consider is the UK. At the relevant date the opponent had been operating a single restaurant in London since 2015. Although turnover figures and advertising expenditure were not disclosed, the opponent estimates that the restaurant runs at capacity and that it averages around 700 customers per day and the average price for a 3 course meal is approximately £100 which equates to an annual turnover in the millions of pounds. It is difficult to determine a geographical spread of customers, whilst web traffic statistics provided an indication that there were visits to the opponent’s website from all over the UK, there is only one restaurant location in London. I acknowledge that London has greater levels of visitors and tourists as the UK’s capital city. The press coverage of the restaurant and its celebrity diners does come from both London based and UK mainstream publications.

61. However overall I find that the evidence is not sufficient for me to find enhanced distinctiveness in the UK market. The opponent’s market share is likely to be

vanishingly small in the context of all restaurants in London and it has very little reach outside the capital.

### **Likelihood of confusion**

62. 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 undertakings 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 factors are interdependent, and include the principle that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alert to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

63. In *L.A. Sugar Limited*,<sup>31</sup> Iain Purvis K.C. sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

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<sup>31</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

64. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

65. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,<sup>32</sup> Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must

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<sup>32</sup> [2021] EWCA Civ 1207

be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

66. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark<sup>33</sup>. This is considered mere association not indirect confusion.

67. So far in this decision I have found:

- The goods and services are variously identical and similar, but some are dissimilar.
- The average consumer will pay between a low and high level of attention depending on the goods and services during the primarily visual purchasing process, but I do not discount that some aural considerations may play a part.
- There is a medium degree of visual and aural similarity between the respective marks.
- There is high degree of conceptual similarity between the respective marks.
- The opponent’s earlier registrations are inherently distinctive to medium degree.

68. Based on my assessment of the respective marks and their goods and services and considering the factors outlined above, I find that the dominant and distinctive element of all the marks is the identical word SEXY. The differences between the respective marks are all descriptive words for foodstuffs and types of restaurants/cafes. I do not disregard these words as each is the second word of the respective marks, but it is my view consumers will simply see them as a descriptor of the type of goods and services and will attach no greater significance to them than that. In any event, the conceptual hook provided by the marks to fix in the mind of a consumer is SEXY. As set out above a consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection of them. I consider that what they will recollect is SEXY plus a descriptive foodstuff word and as such I find that there is a likelihood of direct confusion.

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<sup>33</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

69. In case I am wrong in this finding, then I consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark.

70. I find that the average consumer on seeing SEXY COFFEE may note the additional second element but will likely assume that this is a brand extension, i.e. that it is an additional range of coffee related goods and services from the opponent's stable and as such is likely to be confused in to believing that it comes from the same economic undertaking. Therefore I find there is a likelihood of indirect confusion.

71. The opposition under section 5(2)(b) is partially successful for the following goods and services:

*30: Coffee; Iced coffee; Coffee extracts; Coffee beverages; Coffee drinks; Decaffeinated coffee; Instant coffee; Coffee essence; Coffee beans; Chocolate coffee; Coffee concentrates; Coffee oils; Flavoured coffee; Ground coffee; Malt coffee; Coffee substitutes; Coffee flavourings; Unroasted coffee; Artificial coffee; Prepared coffee beverages; Coffee based drinks; Prepared coffee; Coffee based fillings; Mixtures of coffee; Freeze-dried coffee; Malt coffee extracts; Drip bag coffee; Roasted coffee beans; Coffee capsules, filled; Mixtures of coffee essences and coffee extracts; Sugar-coated coffee beans; Coffee in brewed form; Coffee in ground form; Coffee in whole-bean form; Coffee, teas and cocoa and substitutes therefor; Coffee [roasted, powdered, granulated, or in drinks]; Cakes.*

*33: Coffee flavoured spirits; Coffee based liqueurs; Alcoholic coffee-based beverages; Cocktails; Rum cocktails; Gin cocktails; Whisky cocktails; Whiskey cocktails; Vodka cocktails.*

*39: Food delivery services; Delivery of food and drink prepared for consumption; Delivery of food;*

*43: Coffee shops; Coffee bar services; Coffee shop services; Information, consultation and advisory services relating to the foregoing.*

72. For those services which have survived the attack under section 5(2)(b), which I have set out below, I will go on and consider the opposition under section 5(3).

*35: Retail services and wholesale services in relation to Flavour improvers for coffee, Coffee makers, Coffee machines, Coffee roasters, Refillable coffee capsules, Coffee capsules, empty, for electric coffee machines, Refrigerated boxes, Paper filters for coffee, Coffee cups, Coffee mugs, Coffee grinders, Coffee scoops, Coffee stirrers, Coffee pots, Coffee services [tableware], Coffeepots, non-electric, Non-electric coffee drippers for brewing coffee, Coffee makers, non-electric, Non-electric coffee frothers, Hand-operated coffee grinders, Non-electric plunger style coffee makers, Coffee, Iced coffee, Coffee extracts, Coffee beverages, Coffee drinks, Decaffeinated coffee, Instant coffee, Coffee essence, Coffee beans, Chocolate coffee, Coffee concentrates, Coffee oils, Flavoured coffee, Ground coffee, Malt coffee, Coffee substitutes, Coffee flavourings, Unroasted coffee, Artificial coffee, Prepared coffee beverages, Coffee based drinks, Prepared coffee, Coffee based fillings, Mixtures of coffee, Freeze-dried coffee, Malt coffee extracts, Drip bag coffee, Roasted coffee beans, Coffee capsules, filled, Mixtures of coffee essences and coffee extracts, Sugar-coated coffee beans, Coffee in brewed form, Coffee in ground form, Coffee in whole-bean form, Coffee, teas and cocoa and substitutes therefor, Coffee [roasted, powdered, granulated, or in drinks], Coffee fruit, unprocessed, Agricultural crops and horticulture products, Seeds for planting, Seedlings for planting, Coffee-flavored beer and ale, Coffee-flavored soft drinks, Coffee flavoured spirits, Coffee based liqueurs, Alcoholic coffee-based beverages, including those conducted by means of post and telecommunications; Retail services and wholesale services in relation to Cocktails, Rum cocktails, Gin cocktails, Whisky cocktails, Whiskey cocktails, Vodka cocktails; Retail services in relation to foodstuffs; Retail services in relation to confectionary; Retail services in relation to cakes; Promoting the sale of goods and services of others; Provision of discount cards; Sample distribution; Distribution of*

*advertising, marketing and promotional material; Export and import agencies; Import and export services; Information, consultation and advisory services relating to the foregoing.*

*39: Distribution services relating to beverages; Delivery [distribution] of goods; Delivery, despatching, transport and distribution of goods in the form of food and drink; Packaging of food; Packaging and storage of goods; Transportation of goods; Mail delivery services; Courier services for the delivery of goods; Refrigerated storage; Refrigerated warehousing; Import and export cargo handling services; Information, consultation and advisory services relating to the foregoing.*

*43: leasing of coffee makers*

### **Section 5(3)**

73. The opponent opposed the application under section 5(3), based on its earlier '868 registration for SEXY FISH for which it claims a reputation. The opponent further claims that the application would take unfair advantage of the registered mark by riding on the coat tails of the opponent's reputation to benefit from its power of attraction, reputation and prestige and take advantage of the marketing effort expounded by the opponent. Moreover it could lead to tarnishment and dilution of the opponent's brand.

74. 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."

75. 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.”

76. The relevant case law can be found in the following judgments of the CJEU: Case C375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

77. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the application are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a

significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the contested mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

## **Reputation**

78. I must consider whether the opponent's '868 registration has met the test for reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

79. Having considered the factors set out above and weighing in the evidence that I assessed earlier in this decision, I find that the opponent has demonstrated a medium reputation for *restaurant, bar and catering services*.

### **Link**

80. Having found that the opponent has established the requisite reputation, I will go on to make the assessment of whether the public will make the required mental 'link' between the marks, taking account of all relevant factors. The factors identified in *Intel* (underlined below) are:

#### The degree of similarity between the conflicting marks

81. For the reasons given previously I find there is a medium degree of visual and aural similarity and a high degree of conceptual similarity.

#### The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

82. The services which survived the attack under section 5(2)(b) are a number of retail and wholesale services in addition to some commercial services in class 35, transport and logistical services in class 39 and leasing of coffee machines in class 43. The relevant consumer concerned with these services is very unlikely in my view to perceive some degree of closeness between these services and the opponent's restaurant and reservation services.

#### The strength of the earlier mark's reputation

83. I found that the opponent's evidence has demonstrated a medium reputation for *restaurant, bar and catering services; reservation services for booking meals*.

#### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

84. I found that the earlier mark is inherently distinctive to a medium degree.

#### Whether there is a likelihood of confusion

85. Previously in this decision, I found there was a likelihood of direct and indirect confusion for goods and services I had identified as identical and similar, but not for the services that remained and form part of the assessment under the 5(3) ground.

86. Taking the above factors into account, I find that the required link will not be made because of the difference between the services at issue. Therefore, as a link will not be made, then the section 5(3) grounds falls at this hurdle.

## **Conclusion**

87. The opposition has been partially successful. Subject to any appeal against this decision, the application will be refused for the following goods and services, namely:

- *30: All goods in class 30*
- *33: All goods in class 33*
- *39: Food delivery services; Delivery of food and drink prepared for consumption; Delivery of food.*
- *43: Coffee shops; Coffee bar services; Coffee shop services; Information, consultation and advisory services relating to the foregoing.*

88. The application can proceed to registration for the following services, namely:

- *35: All services in class 35*
- *39: Distribution services relating to beverages; Delivery [distribution] of goods; Delivery, despatching, transport and distribution of goods in the form of food and drink; Packaging of food; Packaging and storage of goods; Transportation of goods; Mail delivery services; Courier services for the delivery of goods; Refrigerated storage; Refrigerated warehousing; Import and export cargo handling services; Information, consultation and advisory services relating to the foregoing.*
- *43: Leasing of coffee makers; Information, consultation and advisory services relating to the foregoing.*

## **Costs**

89. The opponent has been partially successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the TPN, and factoring the partial nature of success, I award costs as follows:

£200	Official fee.
£400	Preparing Notice of Opposition and considering counterstatement.
£1000	Preparing evidence and considering other side's evidence.
£1000	Preparing for hearing.
<b>£2600</b>	<b>Total</b>

90. I order Sexy Coffee to pay Caprice Holdings Limited the sum of £2600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>th</sup> day of September 2025**

**June Ralph**  
**For the Registrar**  
**The Comptroller-General**

## **Annex 1**

### **Applicant's goods and services:**

30: Coffee; Iced coffee; Coffee extracts; Coffee beverages; Coffee drinks; Decaffeinated coffee; Instant coffee; Coffee essence; Coffee beans; Chocolate coffee; Coffee concentrates; Coffee oils; Flavoured coffee; Ground coffee; Malt coffee; Coffee substitutes; Coffee flavourings; Unroasted coffee; Artificial coffee; Prepared coffee beverages; Coffee based drinks; Prepared coffee; Coffee based fillings; Mixtures of coffee; Freeze-dried coffee; Malt coffee extracts; Drip bag coffee; Roasted coffee beans; Coffee capsules, filled; Mixtures of coffee essences and coffee extracts; Sugar-coated coffee beans; Coffee in brewed form; Coffee in ground form; Coffee in whole-bean form; Coffee, teas and cocoa and substitutes therefor; Coffee [roasted, powdered, granulated, or in drinks]; Cakes.

33: Coffee flavoured spirits; Coffee based liqueurs; Alcoholic coffee-based beverages; Cocktails; Rum cocktails; Gin cocktails; Whisky cocktails; Whiskey cocktails; Vodka cocktails.

35: Retail services and wholesale services in relation to Flavour improvers for coffee, Coffee makers, Coffee machines, Coffee roasters, Refillable coffee capsules, Coffee capsules, empty, for electric coffee machines, Refrigerated boxes, Paper filters for coffee, Coffee cups, Coffee mugs, Coffee grinders, Coffee scoops, Coffee stirrers, Coffee pots, Coffee services [tableware], Coffeepots, non-electric, Non-electric coffee drippers for brewing coffee, Coffee makers, non-electric, Non-electric coffee frothers, Hand-operated coffee grinders, Non-electric plunger style coffee makers, Coffee, Iced coffee, Coffee extracts, Coffee beverages, Coffee drinks, Decaffeinated coffee, Instant coffee, Coffee essence, Coffee beans, Chocolate coffee, Coffee concentrates, Coffee oils, Flavoured coffee, Ground coffee, Malt coffee, Coffee substitutes, Coffee flavourings, Unroasted coffee, Artificial coffee, Prepared coffee beverages, Coffee based drinks, Prepared coffee, Coffee based fillings, Mixtures of coffee, Freeze-dried coffee, Malt coffee extracts, Drip bag coffee, Roasted coffee beans, Coffee capsules, filled, Mixtures of coffee essences and coffee extracts, Sugar-coated coffee beans, Coffee in brewed form, Coffee in ground form, Coffee in whole-bean form, Coffee, teas and cocoa and substitutes therefor, Coffee [roasted, powdered, granulated, or in drinks], Coffee fruit, unprocessed, Agricultural crops and horticulture products, Seeds

for planting, Seedlings for planting, Coffee-flavored beer and ale, Coffee-flavored soft drinks, Coffee flavoured spirits, Coffee based liqueurs, Alcoholic coffee-based beverages, including those conducted by means of post and telecommunications; Retail services and wholesale services in relation to Cocktails, Rum cocktails, Gin cocktails, Whisky cocktails, Whiskey cocktails, Vodka cocktails; Retail services in relation to foodstuffs; Retail services in relation to confectionary; Retail services in relation to cakes; Promoting the sale of goods and services of others; Provision of discount cards; Sample distribution; Distribution of advertising, marketing and promotional material; Export and import agencies; Import and export services; Information, consultation and advisory services relating to the foregoing.

39: Distribution services relating to beverages; Delivery [distribution] of goods; Delivery, despatching, transport and distribution of goods in the form of food and drink; Packaging of food; Packaging and storage of goods; Transportation of goods; Mail delivery services; Food delivery services; Delivery of food and drink prepared for consumption; Delivery of food; Courier services for the delivery of goods; Refrigerated storage; Refrigerated warehousing; Import and export cargo handling services; Information, consultation and advisory services relating to the foregoing.

43: Coffee shops; Coffee bar services; Coffee shop services; Leasing of coffee makers; Information, consultation and advisory services relating to the foregoing.