

O/0956/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003957783

IN THE NAME OF JUAN RODRIGUEZ

TO REGISTER THE FOLLOWING TRADE MARK:

CHEF-WORKS

IN CLASSES 9 AND 11

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000444776

BY CHEF WORKS BRANDING LIMITED

Background and pleadings

1. On 18 September 2023, Juan Rodriguez (“**Applicant**”) applied to register the trade mark shown on the cover page of this decision in the UK under number UK00003957783 (“**the Contested Mark**”). It was accepted and details of the application were published for opposition purposes in the Trade Marks Journal on 13 October 2023. Registration is sought for the following goods:¹

Class 9 Temperature sensitive testing apparatus for industrial use; Temperature indicators; Temperature sensors; Temperature switches; Temperature control apparatus [thermostats]; Temperature monitors [valves] for central heating radiators; transmitters.

Class 11 Broiling pans; Cooking stoves; Domestic cooking ovens; Electric cooking pots for industrial purposes; Electric deep fryers; Folding portable charcoal, propane and gas fired barbecues, stoves, and grills; Industrial cooking ovens; Microwave ovens for cooking; domestic multi-purpose, electric countertop food preparation apparatus for cooking, baking, broiling, roasting, toasting, searing, browning, barbecuing and grilling food, none of these apparatus featuring a mixing function; pressure cooking saucepans, electric; Roasting spits for cooking ovens.

2. On 18 December 2023, Chef Works Branding Limited (“**Opponent**”) opposed the application in full under section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“**the Act**”). Under sections 5(2)(b) and 5(3), the Opponent relies upon the following trade mark registration (“**the Earlier Mark**”):

UK Registration no. UK00002250676

Earlier Mark: CHEF WORKS

Filing date: 31 October 2000

Date of registration: 20 April 2001

Goods relied upon:

¹ The Applicant initially applied for registration in classes 7, 9 and 11. Subsequent the filing of various amendments by the Applicant, class 7 was ultimately removed and class 11 partially limited.

Class 25: Articles of clothing; workwear.²

3. By virtue of its earlier filing date of 31 October 2000, the registration set out above constitutes an earlier mark within the meaning of section 6(1) of the Act. As the Earlier Mark completed its registration procedure more than five years before the filing date of the Contested Mark, it is, in principle, subject to the use provisions set out in section 6A of the Act.
4. Under section 5(2)(b), the Opponent claims that the Earlier Mark is identical to the Contested Mark, but for the inclusion of a hyphen between the two words 'CHEF' and 'WORKS', and that the parties' respective goods are highly similar, resulting in a likelihood of confusion, including a likelihood of association.
5. Under section 5(3), the Opponent claims that its Earlier Mark has a reputation in the UK for all the goods relied upon and that use of the Contested Mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Earlier Mark.
6. On 28 February 2024 the Applicant filed a defence and counterstatement, denying all of the Opponent's claims under sections 5(2)(b) and 5(3) and requesting the Opponent to provide evidence of use.
7. The Applicant is represented by Bird & Bird LLP. The Opponent is represented by Harrison IP Limited.

Relevance of EU 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.

² Under section 5(3), the Opponent submitted, in its Form TM7, that whilst the Earlier Mark has a reputation in all the registered goods, for purposes of evidential economy in these proceedings, the Opponent exclusively relies on the reputation in "*Articles of clothing; workwear*" in class 25.

Evidence and submissions

9. The Opponent filed evidence in the form of a witness statement of Paul Gross, dated 3 May 2024, and exhibits PG1 – PG21. Mr Gross is the legal counsel and a director of Chef Works Branding Ltd., both positions he has held since 2008, as well as being the managing director of Chef Works Europe Limited and Chef Works International Limited. The Opponent also filed a witness statement of Mark Smith, dated 25 September 2024, and exhibits MS1 – MS4. Mr Smith is a solicitor of Harrison IP Limited. Both witnesses are duly authorised to provide evidence on behalf of the Opponent.
10. The Applicant filed evidence in the form of a witness statement of Daniel Anti, dated 26 July 2024, along with a related Annex. Mr Anti is a solicitor employed by Bird & Bird LLP. He is duly authorised to provide evidence on behalf of the Applicant.
11. Neither party requested a hearing, but they both filed submissions in lieu of a hearing.
12. I do not intend to summarise the parties' evidence or submissions at this stage. However, I confirm that I have taken all filed documents into account and will refer to and summarise them to the extent that I deem necessary.

Decision

Proof of use

Legislation

13. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (1) This section applies where

- (a) an application for registration of a trade mark has been published,

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

(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.”

14. Section 100 of the Act is also relevant, which 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.”

Case law

15. 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 Bunderversammlung 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].”

16. The onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the Earlier Mark is the five-year period ending with the filing date of the Contested Mark, i.e., **19 September 2018 to 18 September 2023.**

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Summary of the evidence of use

18. Mr Gross’s witness statement provides a brief introduction to the Opponent’s business submitting that the company ‘Chef Works Group’ dates back to 1960 and that ‘CHEF WORKS’ has been in use in the UK since mid-1990s. Mr Gross also states that the Opponent mostly operates in the field of clothing and markets workwear and apparel used for various applications (i.e., hospitality, catering industries, schools, food service, laundries, assisted living facilities, cinemas and private use). Mr Gross clarifies that the Opponent licenses its intellectual property to the group ‘Chef Works International Limited’ encompassing companies such as ‘Chef Works Group’ and ‘Chef Works Europe Ltd.’. Thus, evidence of use relating to these companies also amounts to use by the Opponent.

19. **Exhibit PG1** features screenshots from the Opponent’s website (‘www.chefworks.com’), extracted on 5 May 2022, listing the locations of the Opponent’s distributors in the UK (i.e., Dorset, Newcastle, Enfield, Stoke Poges, Manchester, Port Talbot, Reading, Thorncombe, East Horsley, Avonmouth, Bristol, Leighton Buzzard, Coventry, Dungannon, Dunkinfield, Roebuck).

20. Mr Gross says that the Opponent has consistently used the Earlier Mark on its website to market the relevant goods in the UK. **Exhibit GP2** shows an extract from the Wayback Machine database showing that the website ‘www.chefworks.co.uk’ has been consistently active between 2001 and 2024 along with two other screenshots of the same website, extracted from the Wayback Machine database and dated 10 July 2018, showing the Earlier Mark placed on what seems to be the website’s home page and a page of the website featuring pictures of some items of clothing (i.e., aprons) placed underneath the wording “CHEF WORKS CLASSICS”. This latter page also features the Earlier Mark at the page’s top left-hand side (Figure 1).

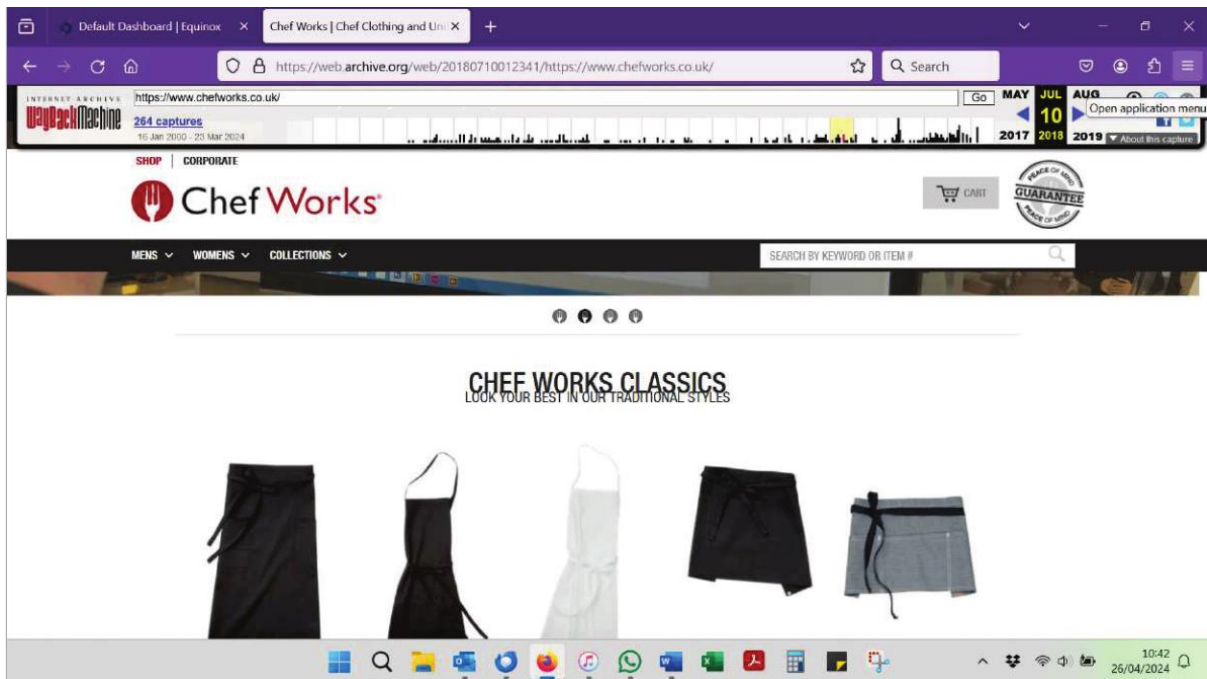


Figure 1

21. **Exhibit PG3** features a series of screenshots from the Opponent’s social media platforms (i.e., YouTube, Instagram, LinkedIn, Pinterest and Twitter). These consist of:

- One extract from the Opponent’s YouTube (GB) channel dated 1 December 2020. The channel has 863 subscribers, and the page received, at the time of extract, 124,751 views. The YouTube page shows the content of the ‘about’ heading. I note the extract reports that “*Chef Work is not your normal, routine uniform manufacturer. [...] we’ve been an industry leader in the design, development & management of uniform & culinary apparel programs across the globe*”. The Earlier Mark is featured twice on the page, and it is clearly visible.
- One post from the ‘Chef Works UK & Ireland’ LinkedIn account dated 30 November 2020. The evidence shows that the account had 1,955 followers at the time the evidence was extracted. The post featured in the evidence shows a picture of part of an apron along with the Earlier Mark on the side.
- One post from the ‘Chef Works UK & Ireland’ LinkedIn account dated 30 November 2020. The post features a picture of a few merchandise products

(i.e., a thermos, a baseball cap and a t-shirt). The thermos and the t-shirt carry the Earlier Mark. The post received 24 reactions and 3 comments.

- One post from the 'Chef Works UK & Ireland' LinkedIn account dated 30 November 2020. The post advertises the Opponent's goods offering a discount code along with a picture featuring the Earlier Mark. The post received 6 likes.

22. I note that although this evidence is dated November/December 2020 the posts themselves show they were posted, respectively, 9, 6 and 1 month prior to the date the evidence was extracted. In any case, the posts fall within the relevant period.

23. This exhibit also features:

- One screenshot from the 'chefworksukandireland' Instagram account dated 25 April 2018. The evidence features one post with a picture of a few aprons placed underneath the wording "WIN THE MUST-HAVE DORSET APRON". Below the wording the post shows the Earlier Mark. The post received, at the time it was extracted, 171 likes.
- One screenshot from the 'chefworksukandireland' Instagram account dated 29 May 2019 showing a picture of three workers, who seem to be waiters, standing in a bar and wearing aprons. The post received 9 likes.
- One screenshot from the '@chefworksuk' Twitter account, dated 20 October 2018, showing a post wishing a happy International Chef Day from the 'Chef Works' staff. The post received one retweet and one like.
- One screenshot from the '@chefworksuk' Twitter account, dated 3 December 2018, showing a picture of various workers mostly wearing aprons. The picture features the Earlier Mark twice. The post received two likes.
- Three screenshots from the 'Chef Works' Pinterest account, all dated 30 November 2020. The evidence shows the account ('chefworks.com') has 2,893 followers along with a series of images of aprons and men's shirts.

24. **Exhibit PG4** provides screenshots from the Chef Works Group's 2019 catalogue featuring the cover page and the first two pages of the catalogue. The cover page features the words "Chef Works PRODUCT CATALOG". The page features, in the background, the image of a man wearing working clothing (what seems to be a chef jacket) whilst working in a kitchen. The evidence also contains a screenshot showing the inside of the catalogue. I note the page lists the contents indicating the various types of clothing and products featured in the catalogue (i.e., coats, shirts, vests, accessories, pants, aprons and headwear). Mr Gross states that the catalogue is distributed globally, including the UK, and such catalogue can also be accessed online at 'www.publitas.com'. Mr Gross does not clarify and the evidence does not contain figures showing the distribution volume of the catalogue in the UK.
25. **Exhibit PG5** contains a series of pictures showing the Contested Mark used on the Opponent's packaging, labels, tags and goods themselves (i.e., aprons). The evidence is undated.
26. **Exhibit PG6** contains the Chef Work's Group 2016 corporate brand guidelines regulating the use of the Opponent's mark (and other distinctive elements). This evidence is dated March 2016 and, thus, it is placed outside of the relevant period. The exhibit also contains extracts from the 'Lookbook & New products' booklet for 2020. This part of the evidence shows a few drawings of waitstaff wearing different types of aprons (showing different styles). The Earlier Mark is featured on all the extracts at the bottom of the page. The evidence carries the 2020 copyright notice. The evidence also shows screenshots from a website ('www.caterkwik.co.uk') offering for sale a series of products (i.e., kitchen knives, aprons, chef trousers and chef jacket) under the page's title 'ChefWorks'. The prices are in pounds sterling and the evidence is dated 3 December 2020.
27. **Exhibit PG7** shows analytics data relating to the 'www.chefworks.co.uk' website for the period 1 January 2019 – 29 November 2020. The evidence shows the website registered a total of 63,939 visitors for a total of 82,306 sessions. The evidence also shows that an additional 0.73% (i.e., 466) of users accessed the

website in “general” English (i.e., without a specific definition of whether British, American or Irish).

28. Mr Gross states, in his witness statement, that the Opponent has maintained social media accounts for many years and provides in **Exhibit PG8** extracts from the account pages of the Opponent’s social media platforms (i.e., Facebook, LinkedIn, Instagram, Twitter (now X), Pinterest and YouTube). I note that the evidence is dated outside of the relevant period (i.e., 26 April 2024), however Mr Gross provides a table indicating when these social media accounts were created (i.e., Facebook in July 2017, LinkedIn, Instagram, Twitter and Pinterest in January 2018 and YouTube in 2011). Therefore, for the purposes of these proceedings, I find the evidence to show that the Opponent’s social media accounts have been active for a period between 2017/2018 (or 2011 for the YouTube channel) and 2024 including, thus, the relevant period. I also note that, in 2024, these social media platforms show an average of around 4,000 followers or subscribers (apart from Twitter that shows almost 2,000 followers in 2024). No further evidence on the number of followers/subscribers was provided for the relevant period.

29. Mr Gross says, in his witness statement, that the Opponent has substantially invested in marketing and promoting the Earlier Mark by, for example, purchasing services related to public relations, search engine optimisation, pay-per-click advertising and AdWords campaigns, as well as investing in printed marketing material, promotions, sponsorship and attendance at trade shows and expositions. In this regard, **Exhibit PG10** features the ‘Trail Balance’ report for the year 2020, showing a total expenditure of £33,349.14 relating to marketing and advertising services.

30. **Exhibit PG9** provides a few sample invoices issued by ‘Content Soup Ltd.’ to Chef Works Europe Ltd. for services relating to the Opponent’s social media presence. The invoices are summarised below:

Date	Nature of services	Value
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28 March 2018	<ul style="list-style-type: none"> • Social media management fees for April 2018 • Annual cost for Hootsuite scheduling tool 	£2,688.00
30 November 2018	<ul style="list-style-type: none"> • Social media management fees for December 2018 • 3 x Christmas campaigns across Facebook, Twitter and Instagram • Christmas campaigns advertising spend (boosting posts) 	£3,636.00
31 January 2018	<ul style="list-style-type: none"> • Social media management for February 2018 • Social media advertising for February 2018 	£3,000.00
31 July 2019	<ul style="list-style-type: none"> • Social media management for August 2019 	£1,800.00

30 March 2020	<ul style="list-style-type: none"> • Social media management for April 2020 (2 days) • Annual subscription to Hootsuite (social media scheduling tool) 	£1,476.48
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31. Mr Gross states that the Opponent principally markets through distributors rather than targeting end-consumers directly. For this reason, the Opponent takes part in business-to-business networking events (e.g., trade shows and expositions). Mr Gross reports that Chef Works Europe Limited attended the following events:

- 'Caffe Culture' (London – 2018)
- IFEX (Belfast – 2018)
- 'The Great Hospitality Show' (Birmingham – 2017)
- 'ScotHot' (2017)
- 'Hotel UK Forum' (2018)
- 'Hospitality Forum' (2018)
- 'Catering Equipment Forum' (Northampton – March 2019)

32. Mr Gross indicates that the Earlier Mark is prominently displayed at these events being placed on the Opponent's stand, exhibit materials, brochures, pamphlets and business cards. **Exhibit PG11** contains copy of one invoice, dated 19 October 2018, issued by EXD for a total value of £8,802.98 for the Opponent to take part in the 'Caffe Culture' event in London. The evidence contains another invoice issued by DP Business Events to the Opponent, dated 11 September 2018, for a total value of around £3,690.00 for the attendance of two of the Opponent's delegates at the 'Hospitality Forum 2018'.

33. Mr Gross explains, in his witness statement, that the Opponent has sponsored, over the years, the 'Chef Team of the Year' award which is run by Stadium Experience and annually held in Leeds. **Exhibit PG12** features a sample invoice issued by Stadium Experience to the Opponent, dated 20 November 2018, for a total value of £399,49 for the (partial) sponsor of this award.
34. Mr Gross says that the Opponent also sponsored the 'Edinburgh Restaurant Awards' in 2022 and the 'Scotsman Scran Awards' (category 'Scottish Chef of the Year') in 2023. **Exhibit PG13** shows an extract from the website 'www.Edinburghrestaurantawards.co.uk' showing the Earlier Mark and titled "*Sponsor of Edinburgh Chef of the Year*". I note that the evidence reports that "*Chef Works is the only true global hospitality uniform company [...]*". The exhibit also contains an article from 'The Scotsman' dated 20 June 2023 and titled "*Scotsman Scran Awards 2023: Full list of winners – from Scottish chef of the year to best whisky*". The article mentions 'Chef Works' among the event's sponsors.
35. Mr Gross reports, in his witness statement, that in early 2020 the Opponent acquired one of its major competitors (i.e., Bragard SAS). **Exhibit PG14** features a press release from 'www.markets.businessinsider.com', dated 24 February 2020, titled "*Hospitality apparel brand Chef Works acquires Bragard*". I note that the evidence indicates that "*Chef Works, the global leader in culinary and hospitality apparel [...] revolutionized the culinary and hospitality apparel industries with fashion-forward chef coats, aprons, shirts, pants and hats [...]. Chef Works dresses a diverse range of costumers for the culinary and hospitality industries including: International hotel chains, award-winning restaurants and bars, culinary schools, food service companies, laundries, assisted living facilities and upscale cinemas*".
36. Mr Gross says, in his witness statement, that the Opponent has been an official partner of the social media platform 'The Staff Canteen' (i.e., the UK's leading networking platform for chefs) since 2008 as well as an official partner of the platform 'The Chefs' Forum' (i.e., a UK platform for marketing, mentorship and networking targeted at British chefs) since 2019. **Exhibit PG15** provides extracts from these two platforms providing a description of such respective platforms. The

evidence also reports that the Opponent has been a 'Premium Supplier' since 2008 for 'The Staff Canteen' and a Sponsor for 'The Chefs' Forum' platform.³ I note all the evidence is dated outside the relevant period (i.e., May/June 2024).

37. Mr Gross, in his witness statement, explains that when carrying out a Google search in the UK for the words "chef works", the research engine automatically provides research autocomplete suggestions that mostly relates to the Opponent's goods (e.g., "chef works trousers", "chef works jackets", "chef works apron", "chef works pants"). Mr Gross argues that such results show the Earlier Mark's ability to function as a trade mark since the top suggestions the search engine provides relate to the Opponent's business and its products. **Exhibit PG16** shows a screenshot of the Google search bar indicating a drop-down list of suggestions following the entry "chef works" as Mr Gross indicates in his witness statement. The exhibit also contains an extract from the website 'www.support.google.com' explaining how the autocomplete predictions work.

38. **Exhibit PG17** shows a screenshot from Google ('www.google.com') featuring a list of results following a search into the Google search engine. The evidence shows the Google search bar at the top of the page with the words 'site:nisbets.co.uk "chef works"' and underneath a series of links from the 'nisbets.co.uk' website relating to various 'Chef Works' goods (e.g., chef coat, chef jacket, cargo chef trousers, aprons). The evidence indicates that the search was carried out in relation to the period 1 September 2018 – 1 September 2023. Mr Gross indicates that Nisbets Plc has been one of the Opponent's main distributors for the British and Irish markets.

39. **Exhibit PG18** contains a series of invoices issued by the Opponent to Nisbets PLC throughout the relevant period for a variety of goods. I note the Opponent provided a few invoices also dated prior to the relevant period (2016, 2017 and January/March 2018). With regard to the relevant period, I note the total value of all the invoices have been redacted. I also note that the goods being retailed and listed in the invoices are pants (including cargo pants), aprons, shirts (men and

³ Exhibit PG15 page 121 and pages 131-132.

women), jackets (mostly chef jackets), headgear (i.e., baseball caps, drivers' hats, chef hats and toques), denim beanies, coats (including chef coats), neck ties.

40. **Exhibit PG19** features some sample invoices issued to other clients and distributors (different from Nisbets PLC) and summarised below:

Date	Shipped to	Value
18 January 2019	Bradford	£31.66
17 April 2019	Sutton Coldfield	£908.23
12 July 2019	Farsley	£72.00
19 August 2020	London	£115.13
4 January 2021	Leeds	£103.64
1 May 2021	Whitby	£176.84
25 June 2021	Hall Road	£277.04
22 September 2022	Hounslow (Heathrow Airport)	£1,839.48
4 September 2023	Peterlee	£253.21
19 September 2023	Southhall	£2,020.89

41. Mr Gross reports that the Opponent frequently advertises in the Nisbets Plc's seasonal print catalogues. Mr gross indicates that such catalogues are widely distributed throughout the UK and within Nisbets Plc's twenty-three UK high street stores. **Exhibit PG20** features pictures of the September 2019 'Nisbets' catalogue. The evidence shows a picture of the magazine's content featuring pictures of articles of clothing (i.e., chef jackets). The Earlier Mark is visible in the page's top-left corner. The evidence also provides a list of the Nisbets' store in the UK (i.e., Bath, Birmingham, Brighton, Cardiff, Glasgow, Leicester, Belfast, Bradford, Bristol, Edinburgh, Leeds, Liverpool, four locations in London, Manchester, Newcastle-upon-Tyne, Norwich, Nottingham, Reading, Sheffield, Southampton).

42. Mr Gross says that the Opponent also advertises on specialist magazines. **Exhibit PG21** features pictures of the front pages and content of some of these magazines. More specifically the evidence contains:

- Pictures of two issues of the 'Chef' magazine dated 2012 (dated outside of the relevant period).
- Cover page and interior of 'The World of Hospitality' magazine dated 2019. The magazine contains a page with the Earlier Mark at the top and images of the Opponent's aprons and chef jackets.
- Front page and interior of the 'Hotel' magazine dated May 2023. The magazine shows the Earlier Mark along with some pictures showing some of the Opponent's goods (i.e., aprons and chef jackets).

43. This concludes the summary of the Opponent's relevant evidence.

Assessment of the sufficiency of use

44. Overall, while I acknowledge that some of the evidence falls outside the relevant period and does not demonstrate the volume of sales, the Opponent's market share, or revenue figures, I nonetheless find that it largely supports the conclusion that the Opponent established and maintained a solid market presence for its goods during the relevant period. Accordingly, the evidence features some sample invoices relating to the relevant period⁴ and it demonstrates that the Opponent's website remained consistently active from 2001 to 2024, attracting 63,939 visitors and generating a total of 82,306 sessions between 2019 and 2020. Throughout the relevant period, the Opponent used the Earlier Mark across various social media platforms, maintaining a modest but relevant following. Marketing expenditure figures provided include £6,912.48 for the period November 2018 to March 2020, and £33,349.14 for the year 2020. The Earlier Mark was promoted through

⁴ The Applicant argues that the invoices from Chef Works Europe Ltd. are invalid due to a lack of evidence showing its licence to use the Earlier Mark. However, Mr Gross's witness statement outlines the commercial relationship and confirms the company's authorisation to use the Opponent's intellectual property, which I find sufficient.

catalogues, booklets, specialised magazines, select third-party websites, and participation in networking events, with total attendance costs amounting to approximately £13,000. In reaching my conclusion, I remind myself that, to determine whether there has been genuine use, the assessment is made by looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself⁵ and that all the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark.⁶ Furthermore, the test is not whether the use has been quantitatively significant, but whether there has been real commercial exploitation of the mark intended to create and preserve an outlet for the goods which are sold under or in relation to that mark⁷. I also remind myself that the assessment of genuine use is not simply about sales figures, and I must consider them alongside other evidence of use.⁸ Therefore, in light of the above considerations, I find the evidence provided showed that the Earlier Mark had a reasonable use and exposure to the relevant public in relation to some of the goods in class 25 throughout the relevant period. Later in this decision I will detail which goods I consider there to have been genuine use for and what constitutes a fair specification.

Form of the mark

45. The evidence shows numerous instances where the word-only registered mark is represented in colour variations with the words “Chef” and “Works” represented in different colours (Figure 2 and Figure 3) and, at times, in conjunction with a stylised logo (Figure 4 and Figure 5).



Figure 2

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

⁶ *Ansul* at [38] and [39].

⁷ *Ansul* at [43].

⁸ Case T-467/20 *Industria de Diseño Textil, SA (Inditex) v EUIPO*, EU:T:2021:842.



Figure 3



Figure 4



Figure 5

46. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark *dreams* qualified as use of the registered word-only mark 'DREAMS'. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

47. As the Earlier Mark is registered as a word mark, it may be used in any form, in any colour or font type.⁹ I find that use of the Earlier Mark in its different colours amounts to use of the mark as registered because the verbal component of the Earlier Mark 'Chef Works' remains clearly visible in the mark and the level of stylisation in the variant forms does not alter the distinctive character of the mark. Consequently, it is fair and notional use of the registered mark and/or use upon which the Opponent can rely in accordance with the guidance in *Dreamersclub*.

⁹ Case T-24/17, *La Superquimica v EUIPO* [39].

48. Additionally, I note that, in most instances, the Opponent's mark (in its acceptable colour variations) has been used alongside a logo featuring a white stylised fork inscribed into a red circle (Figure 4 and Figure 5 above). The Applicant submitted that such device element is striking and it alters the Earlier Mark's distinctive character.¹⁰ I acknowledge the Applicant's submissions, but, whilst I find that use of the logo alone would not constitute an acceptable variant form of the Earlier Mark, I consider that the use of 'Chef Works' (whether in its accepted colour variants or as word only) along with the logo, does not prevent the element 'Chef Works' from being viewed independently to indicate the origin of the goods.¹¹ Therefore, I find that 'Chef Works', even when showed in combination with the stylised logo, remains an acceptable use of the Contested Mark.

Fair specification

49. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

50. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

¹⁰ Applicant's submissions in lieu dated 15 November 2024, [12].

¹¹ As per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

51. This was approved by the Supreme Court in *Skykick*,¹² with the following qualification:

“261. I would mention two other matters in this context. First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made partly in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-249 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

52. Mr Gross reports in his witness statement that the Opponent mostly operates in the field of clothing and markets workwear and apparel used for various applications (i.e., hospitality, catering industries, schools, food service, laundries, assisted living facilities, cinemas and private use). Further evidence also reports that “*Chef Works, the global leader in culinary and hospitality apparel [...] revolutionized the culinary and hospitality apparel industries with fashion-forward chef coats, aprons, shirts, pants and hats [...]. Chef Works dresses a diverse range of costumers for the culinary and hospitality industries including: International hotel chains, award-winning restaurants and bars, culinary schools, food service companies, laundries, assisted living facilities and upscale cinemas*”.¹³

¹² *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36.

¹³ Exhibit PG14, page 117.

53. Therefore, from the evidence it emerges clearly that the Opponent markets workwear especially for waitstaff and cooks (e.g., chef jackets, cargo pants, aprons) as well as headwear (e.g., baseball caps). I also note that some of the invoices list “shirts” and “ties” as types of clothing being retailed. The evidence shows (Figure 6) that the Opponent retails “shirts” and “ties” as workwear (i.e., part of uniforms for waitstaff).¹⁴

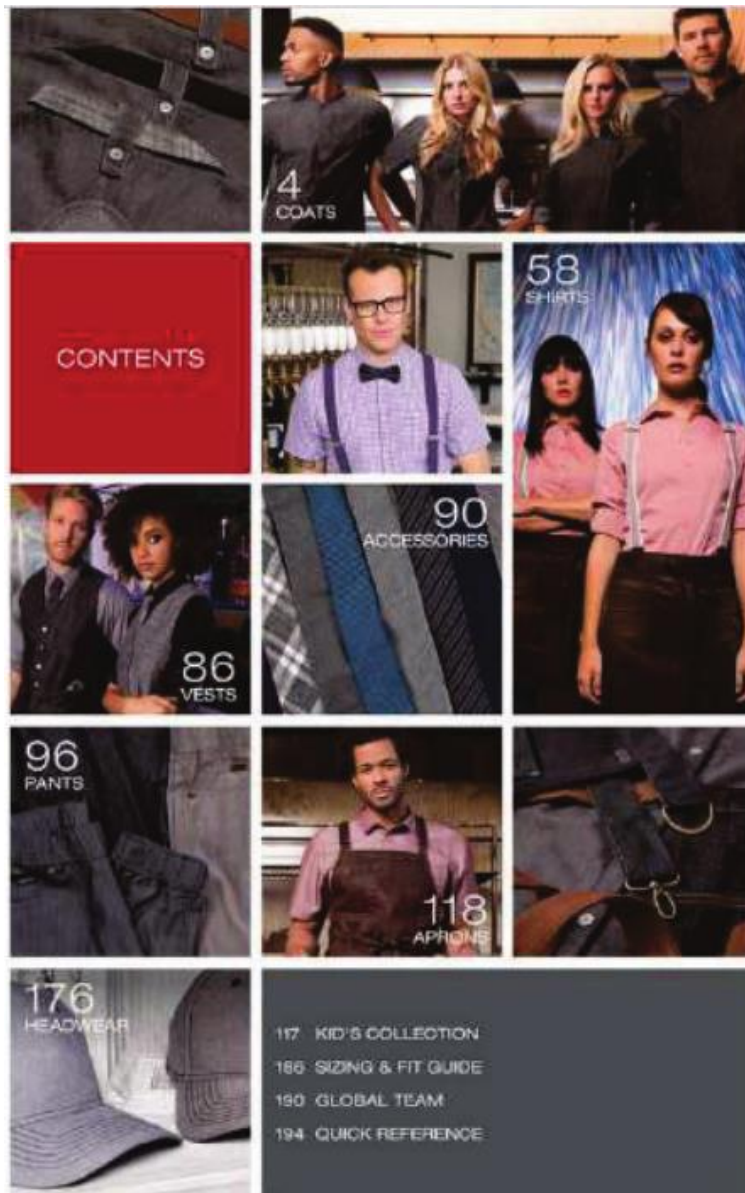


Figure 6

¹⁴ Exhibit PG4, page 37.

54. Therefore, bearing in mind the Opponent's specification, as registered, and the nature of the use shown, I find the fair specification for the Earlier Mark in class 25 to be: "*Articles of clothing, **namely** headgear; workwear*". The Opponent may rely upon the specification above for its section 5(2)(b) ground and for the section 5(3) ground, dependent upon the existence of a qualifying reputation in the case of the latter ground.

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

Case law

56. The leading authorities which guide me are from the Court of Justice of the European Union ("CJEU"): *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

57. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- a. The respective uses of the respective goods or services;
- b. The respective users of the respective goods or services;
- c. The physical nature of the goods or acts of service;

- d. The respective trade channels through which the goods or services reach the market;
- e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

59. The goods for comparison are as follows:

Opponent's goods	Applicant's goods
<u>Class 25</u>	<u>Class 9</u>
Articles of clothing, namely headgear; workwear.	Temperature sensitive testing apparatus for industrial use; Temperature indicators; Temperature sensors; Temperature switches; Temperature control apparatus [thermostats]; Temperature monitors [valves] for central heating radiators; transmitters.
	<u>Class 11</u>
	Broiling pans; Cooking stoves; Domestic cooking ovens; Electric cooking pots for industrial purposes; Electric deep fryers; Folding portable charcoal, propane and gas fired barbecues, stoves, and grills; Industrial cooking ovens; Microwave ovens for cooking; domestic multi-purpose, electric countertop food

	preparation apparatus for cooking, baking, broiling, roasting, toasting, searing, browning, barbecuing and grilling food, none of these apparatus featuring a mixing function; pressure cooking saucepans, electric; Roasting spits for cooking ovens.
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60. The Opponent contends that the similarity between the goods at hand stems from the nature of the relevant consumer and the respective goods' overlap in trade channels. Regarding the relevant consumer, the Opponent argues that although the class 25 goods generally target the general public, the Opponent's target consumer is, in fact, a professional in the catering or hospitality market field (e.g., restaurant, hotel, canteen or hospital) and that since the Contested Mark's specification features the word "industrial", it indicates that also the Applicant's goods are aimed at professional consumers. Whilst I acknowledge the Opponent's submission, I must point out that I already defined the Opponent's fair specification on the basis of the use shown for the Opponent's goods. Any other consideration on the parties' goods must be notionally and objectively based on the Opponent's goods, as identified in the fair specification, and the Applicants' goods, as applied for. Since I concluded that the Opponent's fair specification consists of "*Articles of clothing, namely headgear; workwear*" I find that the target consumer is not exclusively a professional but also the general public independently of how (or to whom) these goods are marketed by the Opponent.

61. In regard to the trade channels, the Opponent argues that consumers are accustomed to shop online for a variety of different goods and purchase different products all from third-party wholesalers in one single transaction. To this end, the Opponent provided evidence showing that wholesale or retail websites such as Nisbets, Lockhart, Alliance Online and Stephenson offer for sale on their platforms both clothing (e.g., aprons) and kitchen appliances.¹⁵ The Applicant contended that

¹⁵ Mark Smith's witness statement dated 25 September 2024 and exhibits MS1 – MS4.

the goods at hand are not retailed through the same points of sale or undertakings. To this end, the Applicant provided evidence featuring screenshots from the homepages of some businesses (i.e., Beko, Hotpoint, Whirlpool, Philips, Miele, Lavazza and Hive) that offer kitchen appliances for sale, showing that they do not sell articles of clothing or workwear.¹⁶

62. I considered both parties' evidence and submissions and I conclusively agree with the Applicant's position. While I appreciate the Opponent's evidence showing that the competing goods can share the same trade channels (i.e., undertakings retailing both clothing and kitchen appliances/apparatuses for cooking, kitchen tools or parts thereof), this fact alone is insufficient for the finding of similarity between such goods. The Opponent's evidence merely shows a few companies offering a variety of goods online (under different categories); such degree of similarity is placed at a too-high general level to base a finding of similarity exclusively on this basis.

63. Other than an overlap in trade channels at a very general level, there are no similarities between these goods, and they are neither complementary nor in competition with one another. I bear in mind the comments of Mr Iain Purvis KC, sitting as a deputy High Court judge in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)*.¹⁷ He reiterated that the overall purpose of considering similarity between goods is to identify similarities which might be relevant to the likelihood of confusion, and that the greater the level of generality at which some similarity can be found the less relevant it could be. That is the case here; any similarity is at such a general level that I do not consider it could be relevant to the likelihood of confusion. I find no similarity between these goods.

Outcome of the section 5(2)(b) opposition

64. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be

¹⁶ Daniel Anti's witness statement dated 26 July 2024.

¹⁷ [2024] EWHC 1098 (Ch).

considered. Consequently, the opposition under section 5(2)(b) has failed in its entirety.

65. I will now consider the section 5(3) ground of opposition.

Section 5(3)

66. Section 5(3) states:

“(3) A trade mark which –

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 the repute of the earlier trade mark”.

67. Section 5(3A) states:

“(3A) 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.”

68. The relevant case law in relation to section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

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

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

(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 on 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

69. For a successful claim under section 5(3), cumulative conditions must be satisfied by the Opponent: a qualifying reputation in the earlier mark; similarity between the marks; a link between the marks (the earlier mark will be brought to mind on seeing the later mark); and one (or more) of the claimed types of damage. It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks. In this case, I found the goods to be dissimilar.

Reputation

70. 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."

71. In considering the issue of a reputation, I remind myself that I have summarised the Opponent's evidence from paragraph 18 to paragraph 43.

72. In considering the present assessment, I wish to clarify that while I have found that this evidence was sufficient to prove that the Opponent has been using its mark, the test for proving reputation is significantly more onerous than that for proof of use. I say this because a finding of genuine use only requires a sufficient level of use whereas a finding of a reputation requires that the mark relied upon is known by a significant part of the relevant public in the relevant territory. As a result, it does not simply follow that I must find a reputation in the Opponent's mark because I found use.

73. The Opponent demonstrated that its website has been active for over 20 years, offering goods for sale and distributing them through physical outlets across various UK locations. This suggests long-standing and geographically widespread use of the Earlier Mark. It also provided sample invoices and evidence of investment in marketing activities, including social media advertising. However, the Opponent did not supply figures for sales volume, revenue, or market share. The invoices were redacted, showing no monetary values, and both the marketing spend and social media following are not significant enough to demonstrate intensity of the use of the mark to warrant a finding of reputation.

74. Overall, I am of the view that the level of use before me is insufficient to give rise to a finding that the Opponent enjoyed a reputation in the UK with regard to the relevant period.

75. If I am wrong, and the Opponent has established a reputation, it is too weak to bridge the gap between the goods which I found to be dissimilar, which, in turn, means that any mental link which might be created (if there is one) is too tenuous to result in any real damage.

76. The opposition under Section 5(3) fails.

Conclusion

77. The opposition is unsuccessful and, subject to any appeal, the application may proceed to registration.

Costs

78. The Applicant has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1/2023. Bearing that scale in mind, I award costs to the Applicant as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Preparing evidence and considering and commenting on the other side’s evidence	£600
Preparing submissions in lieu	£350
Total:	£1,200

79. I order Chef Works Branding Limited to pay Juan Rodriguez the sum of **£1,200**. 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 10th day of October 2025

Andrea Rossi

For the Registrar