

**BL O/0032/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 421609**

**IN THE NAME OF CHOCOLADEFABRIKEN LINDT & SPRUNGLI AG**

**TO TRADE MARK APPLICATION No. 3495227**

**IN THE NAME OF IBRAN YASIN**

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**DECISION**

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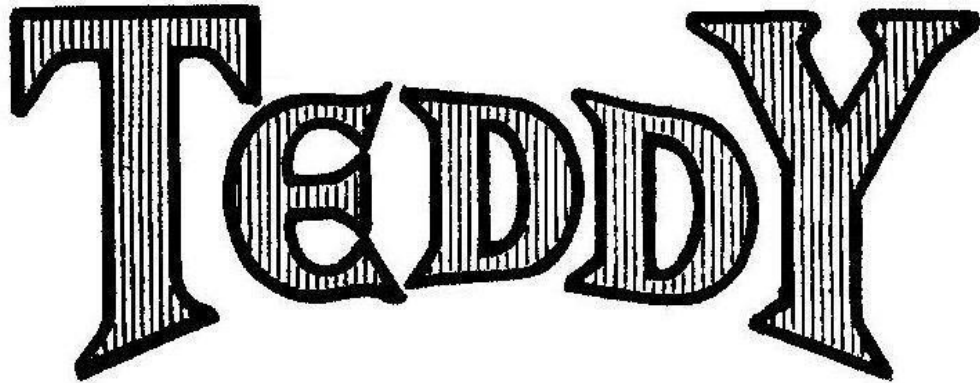
1. On 30 May 2020, Ibran Yasin (“the Applicant”) applied under number 3495227 to register the following sign as a trade mark for use in relation to “*Chocolate desserts; Cakes; Chocolate cakes; Chocolate covered cakes; Iced cakes; Iced sponge cakes*” in Class 30 and “*Retail services in relation to desserts; Wholesale services in relation to desserts*” in Class 35:



2. On 28 September 2020, Chocoladefabriken Lindt & Sprungli AG (“the Opponent”) filed a Form TM7 Notice and Statement of Grounds of Opposition objecting to the application for registration, so far as relevant for present purposes, on the basis that use of the opposed mark would conflict with the rights to which it was entitled under s.5(2)(b) of the Trade Marks Act 1994 as proprietor of the following earlier trade marks:

EU Trade Mark No. 10514578 consisting simply of the word **TEDDY** registered on 20 August 2013 with a filing date of 21 December 2011 for use in relation to “Cocoa and chocolate powder; Chocolate, filled and non-filled; Chocolate confectionery, namely small assorted chocolates (pralines); Hollow chocolate figures and solid chocolate figures” in Class 30

EU Trade Mark No. 14288047 consisting of the stylised word mark



registered on 04 September 2016 with a filing date of 23 June 2015 for use in relation to “Cocoa, chocolate, sugar confectionery, pastry and confectionery” in Class 30

3. In accordance with the provisions of s.6A of the 1994 Act, the Opponent was required to provide proof of genuine use (or proper reasons for non-use) of the word mark **TEDDY** protected by EU Trade Mark No. 10514578 during the period of 5 years beginning on 31 May 2015 and ending on 30 May 2020. It was not required to provide — and did not set out to provide — proof of genuine use (or proper reasons for non-use) of the stylised word mark protected by the more recently registered EU Trade Mark No. 14288047.
4. The evidence filed by the Opponent established that the word **TEDDY** had been used during the relevant period in relation to chocolate products packaged and presented in the manner illustrated by the images in paras [17] to [20] of the Decision under Appeal (Decision BL O/313/22 issued by Ms Teresa Perks on behalf of the Registrar of Trade Marks on 08 April 2022):





5. The Hearing Officer decided that the evidence showed use of the word **TEDDY** in the promotion and marketing of chocolate teddy bears in Class 30 in a context and manner which simply and directly exploited its natural capacity to function descriptively as a sign or indication concerning the kind or characteristics of such products: paras [16] to [24]. I agree with her overall conclusion to that effect (which I consider to be correct even if and whether or not - as the Opponent contends - she ought to have characterised the use demonstrated by the evidence as use of **TEDDY** solus rather than use of it in combination with **LINDT** as part of a single composite mark).
  
6. In accordance with the Judgment of the CJEU in Case C-689/15 W.F. Gozze Frottierweberei GmbH v Verein Bremer Baumwollbörse EU:C:2017:434 it was necessary for the evidence of use on which the Opponent relied for the purposes of s.6A

of the 1994 Act to be assessed from the perspective that: *“there is ‘genuine use’ of a trade mark ... where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services”* (para. [37]); *“ ... the fact that a mark is used in order to create or preserve an outlet for the goods or services for which it is registered and not for the sole purpose of preserving the rights conferred by the mark is not sufficient to conclude that there is a ‘genuine use’ ...”* (para. [39]); *“ ... it is equally indispensable that the mark be used in accordance with its essential function.”* (para. [40]).

7. Consistently with those principles, the Hearing Officer decided that the Opponent’s evidence failed to establish that the word **TEDDY** had been used to guarantee the identity of the origin of any goods of the kind for which its EU Trade Mark No. 10514578 was registered. I am satisfied that it was open to her, on the evidence and materials before her, to come to that conclusion.
8. The Opponent maintains that she was prevented from doing so by the requirement to proceed on the basis that the trade mark was validly registered (as to which see Case C-43/15P BSH Bosch und Siemens Hausgerate GmbH v EUIPO (KOMPRESSOR PLUS and KOMPRESSOR) EU:C:2016:837 at paras [65] to [69] and Case C-196/11 Formula One Licensing BV v OHIM EU:C:2012:314 at paras [40] to [47]).
9. I do not agree. It is implicitly recognised in the provisions of s.11(2)(b) of the 1994 Act and the corresponding provisions of Articles 14(1) and (2) of the Trade Marks Directive 2015 and Articles 14(1) and (2) of the EU Trade Mark Regulation 2017 which exclude honest descriptive use from the scope of protection conferred by registration of a trade mark, that there is no legal requirement for a validly registered trade mark to be — or be deemed — incapable of descriptive use. And it is, in any event, apparent from the Decision under appeal that the Hearing Officer’s assessment was directed not to the validity of the Opponent’s registration in Class 30, but to fulfilment of the legal obligation to determine whether there had in actual fact been ‘genuine use’ of the registered trade mark having regard to the Opponent’s evidence of use of the word **TEDDY** in connection with the marketing of chocolate teddy bear products during the relevant 5 year period.

10. With EU Trade Mark No. 10514578 eliminated from consideration for lack of proof of genuine use, the question raised by the Opponent's objection to registration under s.5(2)(b) of the Act on the basis of EU Trade Mark No. 14288047 was whether there were similarities in terms of the marks in issue and the goods and services in issue which would combine to give rise to the existence of a likelihood of confusion if the marks were to be used concurrently in the United Kingdom for goods / services of the kind for which they were respectively registered and proposed to be registered as at 30 May 2020.

11. In relation to visual similarity, the Hearing Officer considered (footnote omitted):

71. The marks coincide in the presence of the 5-letter sequence 'Teddy' in the beginning of the applicant's mark, which is identical to the only verbal element of the opponent's mark. The marks differ in the presence of the 7-letter ending '-licious' in the applicant's mark (which makes the mark look significantly longer) and in the respective get-up, namely, the individual typefaces and the complex colour combination of the applicant's mark.

72. I also note that Mr Rebling relied upon the importance of the similarity of the beginning of the marks. I was referred in this connection to a number of decisions of the GC where word marks which had identical beginnings were found to be similar, giving rise to the existence of a likelihood of confusion. Firstly, the cases to which Mr Rebling referred related to completely different marks — which means that any factual analogy is of limited assistance. Further, the principle that beginnings of marks are, generally, more focused upon cannot overshadow the impact of the whole mark and the perception that the average consumer will have of it. It is the full construction and overall impression of the verbal element 'Teddylicious' as a made-up word that the average consumer will find striking and that will be appreciated and focused upon. I therefore reject Mr Rebling's argument because it goes against the principle that the relevant public compares the signs as a whole and does not artificially dissect them. I am of the view that the marks are visually similar to a low degree.

12. In relation to aural similarity, the Hearing Officer considered that: "The aural similarity between the marks is slightly higher than the visual similarity because the impact created by the colour and the stylisation of the letters will be discounted. Looking only at the verbal elements of the marks, I find that the word '**TEDDYLICIOUS**' is aurally similar to the word '**TEDDY**' to a low to medium degree ..." (para. [74]).

13. With regard to conceptual similarity, the Hearing Officer considered (footnote omitted):

75. Conceptually, the mark ‘Teddylicious’ conveys two concepts, namely, that of a ‘Teddy’, intended as a teddy bear or soft toy bear, and that of something delicious. Mr Rebling referred me to another dictionary definition of ‘Teddy’ as “*a woman’s one-piece undergarment, incorporating a chemise top and panties*”, however, he seemed to concede that he was not particularly familiar with it; he also added that the public is likely to perceive ‘teddy’ as a toy when seeing the opponent’s mark. I have never heard the word ‘teddy’ used in connection with women’s underwear and I do not think a significant number of average consumers would have heard of it either. In addition, the Oxford English dictionary contains this:

*“teddy*

*1. Short for teddy bear n. 1. Frequently as a proper name for a teddy bear.  
[...]*

*3. Originally and chiefly North American. [perhaps transferred use of sense 1] A woman’s undergarment combining chemise and panties. Also in plural teddies.”*

76. This confirms my impression that the example of usage of the word ‘teddy’ in relation to women’s underwear relates to America not the UK. In any event, even if a significant number of average consumers would know that ‘TEDDY’ is an item of underwear (which I doubt), the meaning of ‘teddy’ as a teddy bear is much more common in the UK, and I think that the immediate image that the word would convey in the context of chocolate goods is that of a teddy bear.

77. In addition to these two concepts, the word ‘Teddylicious’ conveys a third concept, namely that of an invented word that incorporates the word ‘teddy’ and the last part of the word ‘delicious’.

78. Insofar as the opponent’s marks convey the concept of a teddy, the marks share a common concept. However, even if the concept of a teddy is relevantly recognisable within the applicant’s mark, it is merged with the ending ‘-licious’. The word ‘Teddylicious’ as a whole conveys a quite different concept from the word ‘TEDDY’ alone, namely that of a made-up word which incorporates the word ‘teddy’ and is allusive of the fact that the goods are delicious. It follows in my view that the average consumer will not understand the word ‘TEDDY’ as having independent trade mark significance when subsumed into the made-up word ‘Teddylicious’ in the applicant’s mark. I consider the marks to be conceptually similar to a low to medium degree.

14. With regard to the distinctive character of the earlier registered trade mark she considered that: “The **TEDDY** stylised mark is registered for ‘*Cocoa, chocolate, sugar confectionery, pastry and confectionery*’ which covers goods in relation to which the word **TEDDY** would be distinctive to a medium degree” (para. [87]).



15. She rejected the Opponent’s contention to the effect that in a marketplace where food products are often developed and marketed in ranges, such as with different flavours or sizes (e.g. white and dark versions of a chocolate product, mini and giant size, with and without nuts), the relevant average consumer would be likely to assume that the contested mark **TEDDYLICIOUS** (in which the element **TEDDY** is highlighted through the use of colour) was an extension of the Opponent’s **TEDDY** brand.
16. Her reasons for doing so were, in summary:
- (i) given the visual differences between the marks, consumers were not likely to mistake the contested mark for the earlier trade mark (para. [92]);
  - (ii) the word **TEDDY** does not retain an independent distinctive character in the contested mark: the ending - ‘licious’ alters the connotation of the contested mark and creates an overall commercial impression inconsistent with the shared term appearing on its own or as an independent verbal element (para. [94]);
  - (iii) the average consumer would take the Applicant’s mark for what it is, namely a new made-up word indicating different trade origin rather than as a brand extension of the earlier trade mark (para. [94]);
  - (iv) even though the ending — ‘licious’ is likely to evoke the word ‘delicious’ and would be understood as meaning that the goods are delicious, it is part of the word **TEDDYLICIOUS** which is a coined word that should not be artificially dissected (para. [96]);
  - (v) there was no evidence to support the contention that **TEDDYLICIOUS** was likely to be seen as a brand extension of the stylised word mark **TEDDY** by reason of it being common for brand owners in the food sector to add the suffix — ‘licious’ to their brands to create sub-brands (para. [96]).
17. The Opposition was rejected and for the reasons given by the Hearing Officer in a Supplementary Decision issued under reference BL O/510/22 on 14 June 2022 the



Opponent was directed to pay £437. to the Applicant in respect of his costs of the Registry proceedings.

18. On appeal under s.76 of the Act the Opponent maintains that the Hearing Officer attached too much significance to the differences and not enough significance to the similarities between the marks and the goods and services in issue. If its various arguments about under-stated and over-stated evaluations and assessments of factual matters were all to be considered afresh, the Hearing Officer's Decision under s.5(2)(b) would end up being re-taken by this Tribunal under the guise of reviewing it for "error".
19. However, the case law is clear as to the way in which this Tribunal should approach an appeal against what was, in substance, a factual determination made from a legally correct perspective. I refer in that regard to paras [2] and [3] of the Judgment of the Court of Appeal in Volpi v Volpi [2022] 4 WLR 48; [2022] EWCA Civ 464:

*Appeals on fact*

[2] The appeal is therefore an appeal on a pure question of fact. The approach of an appeal court to that kind of appeal is a well-trodden path. It is unnecessary to refer in detail to the many cases that have discussed it; but the following principles are well-settled:

- (i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.
- (ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.
- (iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.
- (iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence

(although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

(v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

(vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract.

[3] If authority for all these propositions is needed, it may be found in *Piglowska v Piglowski* [1999] 1 WLR 1360; *McGraddie v McGraddie* [2013] UKSC 58; [2013] 1 WLR 2477, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, *Henderson v Foxworth Investments Ltd* [2014] UKSC 41; [2014] 1 WLR 2600, *Glencore Services (UK) Ltd v Elliston* [2016] EWCA Civ 407, *JSC BTA Bank v Ablyazov* [2018] EWCA Civ 1176; [2019] BCC 96, *ACLBDD Holdings Ltd v Staechelin* [2019] EWCA Civ 817; [2019] 3 All ER 429 and *Perry v Raleys Solicitors* [2019] UKSC 5; [2020] AC 352.

20. This does not mean that Registry decisions are immune from challenge. Nor does it mean that they will not be carefully reviewed on appeal. It does, however, mean that a decision must stand if it is not shown to be wrong by reason of some identifiable flaw in the Hearing Officer's treatment of the question to be decided (such as a gap in logic, a lack of consistency, or a failure to take account of some material factor) which renders the disputed conclusion rationally insupportable: see, for example, *Ras Al Khaima Investment Authority v Azima* [2021] EWCA Civ 349 at paras [66] to [70]; and *In the matter of Sprintroom Ltd* [2019] EWCA Civ 932 at paras [71] to [78].
21. It is axiomatic that trade marks must be considered and compared without dismemberment or excision. The decision taker must make a realistic appraisal of the net effect of the similarities and differences between the marks and the goods and services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably well-informed and reasonably observant and circumspect, would have attached to them at the relevant point in time. It is necessary to consider, as part of that process, how the interplay between the visual, aural and conceptual aspects of the marks in issue would affect the way in which they were liable to be perceived and remembered.

22. I can see from the Decision that the Hearing Officer's assessment conformed to that approach. It does not appear to me that her conclusion can be regarded as rationally insupportable by reason of any identifiable flaw in her treatment of the question to be decided. I am satisfied that it was open to her to come to the conclusion she did on the basis of the evidence and materials before her.
23. The Opponent's Appeal is dismissed for the reasons I have given above. The Applicant did not take part in the Appeal and I have no reason to believe that he has incurred any or any appreciable costs in respect of it. I therefore dismiss the Appeal with no order for costs. The Hearing Officer's award of costs to the Applicant in respect of the proceedings in the Registry remains in place.

Geoffrey Hobbs KC

12 January 2023

Mr Jan-Caspar Rebling appeared on behalf of the Opponent.

The Applicant did not take part in the Appeal.