

**O/319/21**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION 3406243**

**BY POLISH VILLAGE BAKERY LIMITED**

**AND**

**OPPOSITION No. 418526**

**BY THE POLISH BAKERY LIMITED**

## Background and pleadings

1. This is an opposition by The Polish Bakery Limited (“the opponent”) to an application filed on 12<sup>th</sup> June 2019 (“the relevant date”) by Polish Village Bakery Limited (“the applicant”) to register the trade mark shown below.



2. The application covers *bread, confectionery* and *cakes* in class 30.

3. The opponent’s case is based on two earlier UK trade mark registrations, the details of which are shown below.

TM number	Mark	Goods/services	Filing/registration dates
2601722	Series of two marks 	Class 30: Bakery products; flour and preparations made from cereals, bread, pastry and confectionery.  Class 43: Services for providing food and drink; bakery services.	18/11/2011/ 2/03/2012
3249519	Series of two marks 	Class 30: Bakery products; bread; bread rolls; bread mixes; mixes for making bakery products; preparations for making bakery products; snack	10/08/2017/ 3/11/2017

		<p>foods consisting principally of bread; snack foods; flour; preparations made from cereals; pastry; pastries; confectionery; cakes; cake preparations; cake mixtures; cheesecakes; pastries, cakes, tarts and biscuits (cookies); custard-based fillings for cakes and pies; buns; bun mix; doughnuts; doughnut mixes; parts, fittings and accessories for all the aforesaid goods.</p> <p>Class 43: Services for providing food and drink; bakery services; consultancy services relating to baking techniques; advice, information and consultancy services relating to all of the aforesaid services.</p>	
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4. The opponent claims that:

- (i) The contested mark is similar to the earlier marks because it contains the words POLISH BAKERY, which it says is the dominant and distinctive element of the earlier marks;
- (ii) The respective goods/services are identical or highly similar;
- (iii) The earlier marks have acquired an enhanced distinctive character and a substantial reputation as a result of their extensive use prior to the relevant date;
- (iv) There is a likelihood of confusion on the part of the public, including the likelihood of association;

- (v) Use of the contested mark would, without due cause, take unfair advantage of the reputation of, and/or would be detrimental to, the reputation or distinctive character of the earlier marks;
- (vi) Registration of the contested mark would therefore be contrary to sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

5. The registration procedure for the trade marks registered under 2601722 was completed more than 5 years prior to the relevant date. Therefore, the opponent made the required statement of use of those marks.<sup>1</sup>

6. The applicant filed a counterstatement denying the grounds of opposition. I note the applicant:

- (i) Requested proof of use of the earlier trade marks registered under 2601722;
- (ii) Admitted that the respective goods in class 30 are identical;
- (iii) Claimed that the word VILLAGE is the dominant element of the contested mark, rather than the (smaller) words POLISH BAKERY;
- (iv) Claimed that POLISH BAKERY is 100% descriptive of, and non-distinctive for, Polish-style bakery products;
- (v) Relied partly on the use of different colour schemes and, in the case of the trade marks registered under 3249519, the additional words “Since 2003” and “London Wembley”, to distinguish the marks;
- (vi) Put the opponent to proof of the reputation claimed for the earlier marks.

7. Both sides seek an award of costs.

## **Representation**

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<sup>1</sup> The opponent made statements of use of both the earlier marks, even though no such statement was required for the trade marks registered under 3249519

8. The applicant is represented by Jonathan Linn Intellectual Property. The opponent is represented by Briffa, Solicitors. Neither side requested a hearing. However, I have had the benefit of written submissions from both parties. I have read these together with the evidence filed.

### **The evidence**

9. The opponent's evidence consists of a witness statement (with 28 exhibits) by Ms Agnieszka Gabriel-Damaz, who is the Managing Director and co-founder of the opponent's business. Ms Gabriel-Damaz's evidence goes to the use and promotion of the earlier trade marks since the business started in 2003.

10. The applicant's evidence consists of a witness statement by Mr Jonathan Linn (with 2 exhibits). Mr Linn's evidence goes to the lack of distinctiveness of the words 'Polish Bakery' in the UK.

### **Procedural Economy**

11. It is convenient to start by examining the opponent's case based on the black and white version of the mark registered under 3249519. I will then return to the opponent's other marks.

### **Relevance of EU law**

12. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **The section 5(2)(b) ground of opposition**

13. Section 5(2)(b) of the Act is 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”.*

#### Comparison of goods/services

14. The trade marks registered under 3249519 are not subject to the proof of use provisions in s.6A of the Act. The earlier trade mark under consideration is therefore entitled to protection in relation to all the goods/services for which it is registered. The earlier mark covers goods in class 30 that are manifestly identical to those covered by the contested application.

#### Average consumer and the selection process

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.<sup>2</sup>

16. The average consumer of the goods at issue will be a member of the general public. In its notice of opposition the opponent claimed that such a consumer's level of attention when selecting the goods would be *“no more than average”*. In its final written submissions the opponent submitted that relevant consumer *“would not pay a high level of attention”* to the marks when selecting goods that cost only £2 or less. I agree that the average consumer is unlikely to pay a particularly high level of

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<sup>2</sup> CJEU, Case C-342/97

attention when selecting the goods at issue. Nevertheless, he or she must be treated as “*reasonably observant and circumspect.*”

17. The goods appear likely to be self-selected by consumers in shops. The selection process is therefore likely to be mainly visual. However, it is possible that word-of-mouth recommendations may also come into play. It is therefore necessary to take account of the way the marks sound, albeit as a matter of secondary importance to how they look.

#### The distinctive character of the earlier mark

18. In *Lloyd Schuhfabrik Meyer & Co.* 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-0000, paragraph 49).*

*23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”*

19. I find the most dominant element of earlier mark 3249519 is the words ‘The Polish Bakery’. ‘Bakery’ describes a place where bread and cakes are made and

sold, but it also describes goods made in such a place, i.e. bakery products. I accept the applicant's submission that the words 'Polish Bakery' are inherently descriptive of Polish-style bakery products. The average UK consumer will understand 'Polish Bakery' to designate bakery products made in the Polish style and/or made by Polish people. The addition of the definite article adds emphasis to this descriptive message (especially when written in a larger and different font as in the trade mark), but it does not alter the inherently descriptive meaning of 'Polish Bakery'.

20. The ear of wheat or corn shown in trade mark 3249519 is also descriptive of (or at least non-distinctive for) goods made from wheat or corn flour.

21. The words 'Since 2003' and 'London' 'Wembley' appear to designate the date of establishment and geographical location of a business. The average consumer will not regard them as having any, or much, trade mark character.

22. The ribbon on which the words 'The Polish BakerY' appear is a traditional means of presenting branding information, but it is not distinctive *per se*.

23. I therefore conclude that the inherent distinctiveness of the black and white version of trade mark 3249519 resides in the combination of (1) the words 'The Polish Bakery', (2) The larger and different font used for 'The' and the 'Y' in bakery, (3) the ear of wheat or corn device, and (4) the ribbon on which the words and device sit. Even taking account of the combination of these elements, I find that the earlier mark is low in inherent distinctiveness.

24. The opponent claims that the earlier mark has acquired a highly distinctive character through use. Ms Gabriel-Damaz's evidence is that the opponent was the first Polish bakery brand to be established in the UK. It was originally founded to meet the needs of the Polish community for traditional sourdough bread. The goods have subsequently been sold nationwide through supermarkets including Waitrose, Sainsbury's, Tesco, Asda, Morrisons and Ocado,<sup>3</sup> as well as through independent

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<sup>3</sup> I note that an article included as the last page of exhibit AG7 records that The Polish Bakery was listed on Ocado from March 2019 (around 3 months prior to the relevant date) for its breads and buns.



stockists. Pictures of bread and cakes bearing the coloured version of the mark registered under 3249519 are in evidence, some of which pre-date the relevant date.<sup>4</sup> Examples of orders from Tesco, Waitrose and Morrisons addressed to The Polish Bakery Limited are also in evidence.<sup>5</sup> The examples of orders from Tesco pre-date the relevant date. The others do not.

25. Boris Johnson visited the opponent's London bakery in 2012 when he was Mayor of London. Pictures of the visit show use of the coloured version of the mark registered under 2601722.<sup>6</sup>

26. According to Ms Gabriel-Damaz, the opponent's turnover in the years 2014 – 2019 from sales of the opponent's "*branded products*" was between £5m and £11m per annum. Average marketing spend over the same period was about £90k per annum, although significantly more was spent in 2016 (£300k - £400k) and less in 2018 and 2019 (£20k - £60k).

27. Exhibit AG6 is claimed to be a marketing survey from 2014 showing that the opponent had 70% of the "*relevant market*" at that time. The 'survey' is simply an undated two page note from Dexter Hunt Consulting recording that 'The Polish Bakery' was the only brand of Polish bread stocked in major supermarkets at that time. As the supermarkets accounted for 70-75% of the UK grocery market the author concluded that the opponent had 70% of the UK market for Polish-style bread.

28. Examples of advertisements for goods bearing the coloured version of the mark registered under 3249519 are also in evidence.<sup>7</sup> Some of these are from national publications, such as Vogue, 'athome', Mailonline and The Sun. Others are from local publications and/or publications aimed at the Polish community in the UK, such as 'Maidstone.pl' and 'Wizz'. I note that the advertisements are dated between 2014 and 2017.

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<sup>4</sup> See exhibit AG2

<sup>5</sup> See exhibit AG4

<sup>6</sup> See exhibit AG17

<sup>7</sup> See exhibit AG7 and AG8

29. The opponent also claims to have conducted a series of television commercials on the UKTV Home Channel and UKTV Food Network which were broadcast nationwide. Pictures from YouTube are in evidence showing these commercials.<sup>8</sup> The first example includes use of the coloured version of the mark registered under 2601722. The second includes use of the coloured version of the mark registered under 3249519. Both marks were used in relation to bread. The YouTube entries are dated 15<sup>th</sup> June 2014 and 8<sup>th</sup> April 2016, respectively. Ms Gabriel-Damaz does not say when these commercials were broadcast on TV or what the viewing figures were.

30. The opponent has a website at thepolishbakery.co.uk which was visited by about 4k people per month during 2019.<sup>9</sup> It also has a small following on Facebook (12k followers in 2020) and Twitter (around 2k followers in 2020). The opponent's goods also feature on third party social media sites. The examples in evidence:<sup>10</sup>

- (i) are from 2016/17;
- (ii) show some use of the coloured version of the mark registered under 3249519 in relation to bread and cakes;
- (iii) are mainly in English and do not appear to be specifically targeted at the Polish community in the UK.

31. The opponent won a number of awards between 2014 – 2019, the most relevant being at the World Bread Awards.

32. The applicant's submissions make numerous criticisms of the opponent's evidence of use. The most serious being that (1) the opponent has failed to distinguish between use of its trade marks and its corporate name, and (2) the opponent's evidence does not establish that the goods it sold to supermarkets were marketed under the marks relied on in these proceedings.

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<sup>8</sup> See exhibit AG10

<sup>9</sup> See exhibit AG11

<sup>10</sup> See exhibit AG13

33. I see some force in the first point: Ms Gabriel-Damaz's witness statement does tend to merge use of the company name (The Polish Bakery Limited) with use of the registered marks. Nevertheless, taken as a whole, there is sufficient evidence to establish that the opponent sold a substantial volume of bread and cakes under the coloured version of trade mark 3249519 during (at least) the period 2014 – 2019, and that the mark received significant media attention. I see nothing in the applicant's second point. The evidence shows that the goods sold through supermarkets carried the colour version of trade mark 3249519 on the packaging.<sup>11</sup>

34. The opponent's goods may have a particular appeal to UK consumers with a Polish background, but they are clearly not limited to this section of the relevant public. The relevant market is therefore the UK market for bread and cakes. Whilst substantial, the opponent's mark is unlikely to hold more than a tiny fraction of this market. Similarly, whilst the amount spent promoting the mark is significant, it is unlikely to have turned the opponent's mark into anything like a household name, such as (say) Hovis.

35. In my view, the evidence shows that the mark has become known to a significant (but not high) proportion of the relevant UK public.

36. I find that the distinctive character of the earlier mark had been enhanced through use prior to the relevant date. However, I do not accept that the mark had become highly distinctive. Rather, the scale of use was sufficient to enhance the distinctiveness of the mark (as a whole) from low to a 'normal' or average level.

37. Mr Linn's evidence is that he conducted a Google search on 'polish baker' in November 2020 and found 5 active businesses in the UK (including the parties to these proceedings) with names that included 'Polish Bakery' or 'Polish Baker'. The opponent's submissions in reply pointed out that none of these businesses pre-date the establishment of the opponent's business in 2003 (two of the other three businesses were established in 2008 and 2009) and one was incorporated after the

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<sup>11</sup> See paragraphs 24, 28 and 29 above.

relevant date. Further, only two of the three third party businesses were still operating in 2020.

38. I accept the applicant's evidence does not establish that the words 'Polish Baker/Polish Bakery' were in widespread use in the UK at the relevant date. Nevertheless, an average UK consumer would immediately understand what the words 'Polish Bakery' meant. The opponent may have been the first such business in the UK, but average consumers would be alive to the possibility of other bakeries using those words in the future to inform the public that they sell Polish-style bread and cakes. Therefore, I do not accept the evidence establishes that the words 'Polish Bakery' as such had acquired a distinctive character through use prior to the relevant date.

#### Comparison of the marks

39. In *Bimbo SA v OHIM*<sup>12</sup> the CJEU stated at paragraph 34 of its judgment, 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."*

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

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

40. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

41. The registration of a mark in black and white means that it is registered in all colours or, perhaps more accurately, without regard to any particular colour.<sup>13</sup> Therefore, the colour used for the contested mark is not a relevant distinction and is of no consequence.

42. Visually, the most dominant element of the earlier mark is the words 'The Polish Bakery' in the form in which they appear in the mark. The most striking visual element of the contested mark is the word 'Village'. However, average consumers are likely to see this as part of the term 'Polish Village Bakery', albeit with visual emphasis on the word 'Village'. I accept there is a certain degree of visual similarity between the words 'The Polish Bakery' and 'Polish Village Bakery', even in the different forms in which those words appear in the marks.

43. The words 'Since 2003' in the earlier mark are small and lack trade mark character. They are negligible in impact. Therefore, they can be given little weight in the comparison. The words 'London Wembley' appear to identify the location of a business, but are clearly secondary in impact to 'The Polish Bakery' element of the earlier mark. The presence or absence of the words 'London Wembley' therefore has only minimal impact on the degree of visual similarity between the marks.

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<sup>13</sup> See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290 at paragraph 47

44. Both marks include a representation of an ear of wheat or corn toward the top of the marks. However, the representations are visually quite different. Therefore, this common feature adds only a small degree of visual similarity to the marks as wholes.

45. The ribbon device in the earlier mark looks nothing like the oval device forming the outline of the contested mark. This reduces the degree of visual similarity between the marks, but as neither device is striking or unusual, only by a small degree.

46. Overall I find the marks are visually similar to a low-to-medium degree.

47. Turning to aural similarity, the earlier mark is likely to be verbalised as 'The Polish Bakery' whereas the contested mark is likely to be verbalised as 'Polish Village Bakery'. Both marks consist of three words, but the earlier mark has six syllables - THE-POL-ISH-BAK-ER-EE - whereas the contested mark has seven - POL-ISH-VILL-AGE-BAK-ER-EE. Importantly, the contested mark includes a whole word - Village – that is absent from the earlier mark. However, the aural impact of the additional word Village is slightly reduced by the fact that it is the second (i.e. middle) word of the three-word contested mark. Overall, I find that the marks are aurally similar to a medium degree.

48. Conceptually, both marks immediately call to mind a bakery run by Polish people and/or Polish-style bakery products. The marks at issue are therefore conceptually similar to a high degree.

#### Global assessment - likelihood of confusion

49. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### *The principles*

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

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

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

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

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

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

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

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

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

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

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

50. I found the marks under consideration to be visually similar to a low-to-medium degree, aurally similar to a medium degree, and conceptually similar to a high degree. The relatively modest degree of visual similarity between the marks is important because the goods are likely to be selected primarily by eye.

51. On the other hand, the identity of the goods and the relatively modest degree of attention likely to be paid by relevant consumers when selecting the products means that a lesser degree of similarity between the marks could still be sufficient to cause confusion.

52. I found the earlier mark (as a whole) to have a normal or average degree of distinctive character. The determining factor in this assessment, in my view, is the lack of distinctiveness of the common word elements 'POLISH' 'BAKERY'. In *Kurt Geiger v A-List Corporate Limited*,<sup>14</sup> Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of distinctive character of the earlier mark is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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<sup>14</sup> BL O-075-13



*“38. The Hearing Officer cited Sabel v Puma at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.*

*39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”*

53. If I am right that POLISH BAKERY lacks inherent distinctiveness, and those words had not acquired distinctive character through use of the trade marks registered under 3249519 prior to the relevant date, then the visual and aural differences between the marks should be sufficient to avoid a likelihood of direct or indirect confusion. The high degree of conceptual similarity between the marks does not outweigh the visual and aural differences between them. This is because the conceptual similarity is a non-distinctive one. Average consumers would have no reason to believe that POLISH VILLAGE BAKERY is likely to be another trade mark used by the opponent. If an association is made between the marks, average consumers are more likely to attribute this to the fact that unrelated undertakings are selling Polish-style bakery products under different marks and using the descriptive words ‘POLISH’ ‘BAKERY’ to say so.

54. I would have come to the same conclusion even if I had found that the common words ‘POLISH’ ‘BAKERY’ were low in distinctiveness (as opposed to having none). As Arnold J. (as he then was) pointed out in *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* (“ORIGIN”):

*“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”*

55. For the reasons given above. I find that there is no likelihood of confusion between the contested mark and the black and white version of the marks registered under 3249519.

56. The colour version of the same mark is in a different colour scheme to the contested mark. That is an additional point of difference, albeit a minor one. Therefore, the colour version of the earlier mark is, if anything, less similar to the contested mark than the black and white version of the mark I have already considered. Therefore, for the same reasons given above, I find that there is no likelihood of confusion between the contested mark and the colour version of the marks registered under 3249519.

57. The earlier marks registered under 2601722 are subject to proof of use under s.6A of the Act. The relevant period is 13<sup>th</sup> June 2014 to 12<sup>th</sup> June 2019. The relevant case law is set out in *Walton International Ltd & Anor v Verweij Fashion BV*.<sup>15</sup>

58. In around 2014 the opponent appears to have switched from using the marks registered under 2601722 to using those registered under 3249519. All the marks were used in accordance with their essential function, and on a commercial scale, in relation to bread and cakes. I am satisfied that use of the colour version of the mark registered under 2601722 counts as use of the black and white version. This is because the colour and black and white versions of the mark have essentially the same distinctive character. The colour version of the mark was in use as late as October 2014.<sup>16</sup> This is within the relevant period. I therefore find that the opponent has shown genuine use of the marks registered under 2601722 in relation to bread and cakes.

59. For the reasons given above in relation to the marks registered under 3249519, I will base my comparison of the marks on the black and white version of the marks registered under 2601722.

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<sup>15</sup> [2018] EWHC 1608 (Ch)

<sup>16</sup> See exhibit AG8 for advertisement in Express Polish dated 2nd - 9th Oct 2014 using colour version of TM 2601722

60. Apart from the marks, most of the other factors in the required global assessment are the same. The other difference is the distinctiveness of the earlier mark. At the relevant date, the marks registered under 2601722 do not appear to have been used for around 4.5 years. Therefore, they will have been a little less factually distinctive than the marks the opponent used in the years leading up to the relevant date, i.e. the marks registered under 3249519.

61. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

62. The omission of the words 'Since 2003' and 'London', 'Wembley' from trade mark 3249519 does little to alter the distinctive character of the trade marks registered under 2601722. However, the device of an ear of wheat or corn in the marks covered by 2601722 is larger and more stylised than the corresponding device in the marks covered by 3249519. The device element is therefore more striking and has more visual impact. It also looks (even) less like the corresponding device in the contested mark. Therefore, the earlier mark under consideration is less visually similar to the contested mark than the marks I have already considered. It follows that there is no likelihood of direct or indirect confusion between the contested mark and the marks registered under 2601722.

63. This means that the opposition under section 5(2)(b) fails.

### **The section 5(3) ground of opposition**

64. Section 5(3) states:

“(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 the repute of the earlier trade mark.

65. I shall again begin by assessing the opponent’s case based on the black and white version of the trade marks registered under 3249519.

66. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and 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 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* 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 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*).

### Reputation

67. I am satisfied that the earlier trade mark had a qualifying reputation at the relevant date for (at least) bread and cakes.

### Link

68. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

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

69. As explained above, the marks are visually similar to a low-to-medium degree, aurally similar to a medium degree and conceptually similar to a high degree.

#### *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*

70. The goods are identical or highly similar. The relevant public is the general public.

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

71. The evidence described at paragraphs 24 to 31 above indicates that the earlier trade mark had a relatively modest reputation with a significant part of the relevant UK public.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

72. The earlier mark has a low degree of inherent distinctive character which has been enhanced through use to a normal or average degree. However, the descriptive words 'Polish Bakery' alone had not acquired a distinctive character by the relevant date. And even if they had, any secondary trade mark meaning they had acquired was not so strong as to displace the descriptive meaning of those words. Therefore, the strength of the words 'Polish Bakery' alone (if any) to identify only the opponent's goods was correspondingly limited. The words alone were, at best, low in distinctive character.

*Whether there is a likelihood of confusion*

73. There is no likelihood of confusion.

*Finding on link*

74. I find that the relevant public, composed of average consumers, would not make a mental link between the marks. If I am wrong about that, the bringing to mind of the earlier mark would simply remind consumers of another mark using the words 'Polish' 'Bakery' to designate Polish-style bakery products.

Unfair advantage

75. The possible mental link described in the previous paragraph does not constitute talking unfair advantage of the earlier trade mark. There will be no transfer of the 'image' of the earlier trade mark, to the goods covered by the contested mark. Rather, any link will merely inform the public, without causing confusion or otherwise damaging the functions of the earlier mark, that another undertaking is marketing

Polish-style bakery products. That is fair competition not taking unfair advantage of the earlier mark.

#### Detriment to the reputation of the earlier mark

76. The opponent complains that use of the contested mark would degrade or tarnish the hard earned reputation of the earlier mark. The complaint is not well explained. If it is based on speculation about the quality of the goods sold under the contested mark, it is not a proper basis for a claim of this kind.<sup>17</sup> In the absence of a likelihood of direct or indirect confusion as to the trade source of the goods marketed under the contested mark, I see no merit in this part of the opponent's s.5(3) case.

#### Detriment to the distinctive character of the earlier mark

77. The opponent complains that use of the contested mark will erode the distinctiveness of the earlier trade mark. According to the opponent, the relevant public will no longer be able to distinguish, or have greater difficulty distinguishing, the opponent's goods from those of other undertakings and this will lead to a loss of sales. In the absence of any likelihood of direct or indirect confusion as to the trade source of goods marketed under the contested mark, I see no reason why the public should have more difficulty identifying the goods marketed under the earlier trade mark from those offered under the marks of the opponent's competitors.

78. The opposition under s.5(3) based on the black and white version of trade mark 3249519 therefore fails.

79. The s.5(3) grounds based on the other marks registered under 2601722 and 3249519 is no stronger than the case based on the mark considered above. They therefore fail for the same reasons.

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<sup>17</sup> See paragraphs 46 and 47 of the decision of Ms Anna Carboni as The Appointed Person in *Unite The Union v The Unite Group Plc*, Case BL O/219/13



## **Overall outcome**

80. The opposition is rejected. The contested trade mark will be registered.

## **Costs**

81. The opposition having failed the applicant is entitled to a contribution towards its costs. I assess this as follows:

- (i) £350 for considering the notice of opposition and filing a counterstatement;
- (ii) £1100 for considering the opponent's evidence and filing submissions and evidence in response;
- (iii) £250 for filing submissions in lieu of a hearing.

82. I therefore order The Polish Bakery Limited to pay Polish Village Bakery Limited the sum of £1700. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of any appeal proceedings.

**Dated 29<sup>th</sup> day of April 2021**

**Allan James  
For the Registrar**