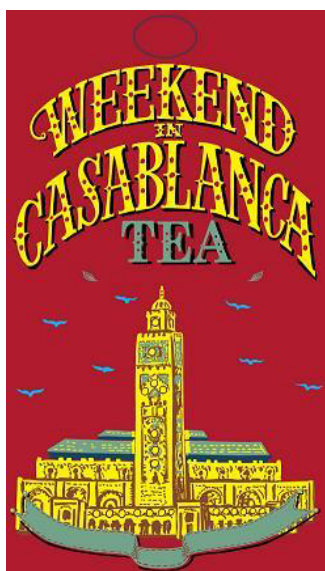


**O-604-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3028566**

**BY TWG TEA COMPANY PTE LTD TO REGISTER THE FOLLOWING SERIES OF  
TWO TRADE MARKS**



**AND**



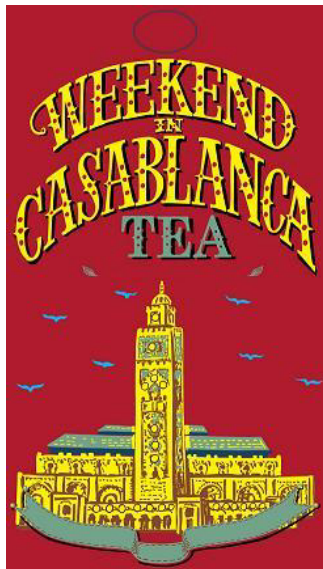
**IN CLASS 30**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 401756**

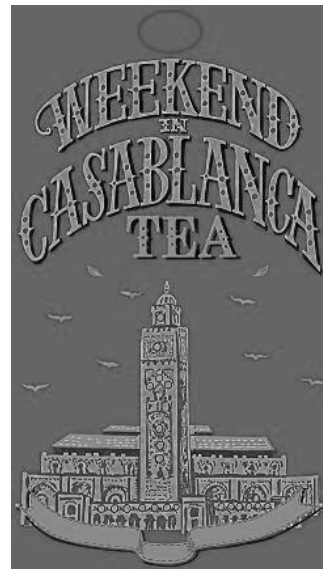
**BY MARIAGE FRÈRES, SOCIÉTÉ ANONYME**

## Background and pleadings

1) TWG Tea Company PTE Ltd (hereafter “TWG”) applied to register the mark no. 3028566 in the UK on 30 October 2013 in respect of the following series of two marks:



and



2) It was accepted and published in the Trade Marks Journal on 22 November 2013 in respect of the following goods:

**Class 30:** *Coffee, coffee-based beverages; tea, black tea [English tea], flavorings of tea, tea-based beverages, fruit flavoured tea (other than medicinal), fruit tea (other than for medical purposes), beverages with tea base, Rooibos tea, herbal tea (other than for medicinal use), Chai tea, green tea, Japanese green tea, Oolong tea (Chinese tea), aromatic teas (other than for medicinal use), beverages made of tea, iced tea, tea bags (other than for medicinal use), tea extracts, tea essence; tea for infusions (other than for medicinal use), spices; sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies, aromatic preparations for pastries; food dressings (sauces), sauces (condiments); frozen yoghurt [confectionery ices], marzipan, quiches, puddings, bread, bread rolls.*

3) Mariage Frères, Société Anonyme (hereafter “MF”) oppose the mark on the basis of section 3(6), section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Following the earlier comments by the Appointed Person in an appeal against my decision in the earlier SAKURA! SAKURA! case between the parties, MF has subsequently taken the decision to restrict its opposition to the grounds based upon section 5(2). MF claims that the TWG’s mark is similar to its “Casablanca” mark and that its goods are identical or similar to the following of MF’s goods:

**Class 21:** *Teapots; tea services, tea balls, strainers, tea measures, infusers, tea filters, tea cosy of metal; tea canisters, caddies and urns.*

**Class 30:** *Tea, blended teas and herbal teas (bulk or tea bag); tea based beverages.*

4) TWG filed a counterstatement denying the claims made by MF.

5) Both sides filed evidence in these proceedings. This will be summarised to the extent that I consider appropriate/necessary. This case forms one of a number of cases between the parties that were heard consecutively over two dates in October 2016 where MF was represented by Thomas St Quintin of counsel, instructed by Potter Clarkson LLP and TWG represented by Mr Ian Bartlett for Beck Greener. The hearing in respect of this case took place on 13 October 2016.

### **MF’s evidence**

6) This takes the form of two witness statements, the first by Kittichat Sangmanee, President and CEO of MF. The second is by Sanjay Kapur, Registered UK Trade Mark Attorney and Partner in Potter Clarkson LLP.

7) Mr Sangmanee provides evidence that MF has been using “Casablanca” as a mark applied to teas since 1984 (at Exhibits KS1 – KS3). The first part of this evidence is in the form of a French language “Guide du The” published by MF in 1984. This publication carries a reference to “Casablanca” tea. There is also a French language booklet called “L’Art Du The” published in 1994 that contains a

reference to “Casablanca” tea, and a selection of annual tariffs listing MF’s tea prices for that year.

8) Evidence of MF’s use of its “Casablanca” mark is provided at Exhibit KS9 and consist of mentions of MF’s “Casablanca” tea in an online forum dated 26 June 2003, an article dated 6 November 2003 on the website chocolateandzucchini.com extorting the values of MF’s tea including “Casablanca” tea and others from 2006, 2007, 2009, 2010 and 2012.

9) Mr Sangmansee states that MF’s “Casablanca” tea is served and sold in the Claridges Hotel in London, Le Manoir aux Quat’Saisons in Oxfordshire, Selfridges department store and the Harvey Nicholls department store. Mr Sangmansee states that these are just examples of where the tea is sold in the UK and at Exhibit KS10, he provides copies of eight invoices addressed to seven UK customers between 2006 and 2013. These amount to the sales of seventy two 3.5 ounce tins, sixty 100 gram boxes, forty eight “30 bourses” and one “200 bourses”.

10) In his witness statement, Mr Kapur provided submissions regarding the likelihood of confusion that I will keep in mind, but not detail here.

### **TWG’s evidence**

11) This takes the form of a witness statement by Taha Bouqdib, a director, President and Chief Executive Officer of TWG. He states that TWG is a subsidiary of The Wellness Group Pte Limited, a company he joined in June 2007. A market analysis commissioned in the context of legal proceedings in France, and referred to by Mr Bouqdib, mentions that TWG “...operates an outlet at Harrods in London.”

12) Mr Bouqdib states that TWG’s WEEKEND IN CASABLANCA is one of its range of teas that include a number of WEEKEND IN ... marks. He states that TWG use of the mark dates back to “at least 2009” in respect of its loose leaf tea and 2010 in respect of its packaged tea and has been used continuously since.

13) Mr Bouqdib states that TWG began selling its tea in *Harrods* in London in 2009 and he provides exhibits to support this.

### **MF's evidence in reply**

14) This consists of two further witness statements, one by Mr Sangmanee and one by Mr Kapur. Mr Sangmanee and Mr Kapur provide a number of criticisms of Mr Bouqdib's evidence that I will not detail here, but I will keep them in mind, as relevant.

### **DECISION**

15) Sections 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”.

16) TWG's application is in respect of a series of two marks. The difference between the two in that one is colour (and features red and yellow in particular). It could be argued that colour will add an additional difference between the marks. Therefore, for reasons of procedural economy, I will consider the case based on a comparison between MF's mark and TWG's colour mark. If MF's opposition is successful against the colour mark, it will also be successful against the same mark in black and white.

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

17) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

18) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

19) MF's earlier mark includes goods in Class 21 and Class 30. It is my view that MF's case is not as strong when relying on its Class 21 goods as when relying upon its Class 30 goods. At the hearing, Mr St Quintin took the same approach and provided submissions based only upon MF Class 30 goods. With this in mind, the respective goods are:

| MF's goods  | TWG's goods   |
|---|---|
| <p><i>Tea, blended teas and herbal teas (bulk or tea bag); tea based beverages.</i></p> | <p><i>Coffee, coffee-based beverages; tea, black tea [English tea], flavorings of tea, tea-based beverages, fruit flavoured tea (other than medicinal), fruit tea (other than for medical purposes), beverages with tea base, Rooibos tea, herbal tea (other than for medicinal use), Chai tea, green tea, Japanese green tea, Oolong tea (Chinese tea), aromatic teas (other than for medicinal use), beverages made of tea, iced tea, tea bags (other than for medicinal use), tea extracts, tea essence; tea for infusions (other than for medicinal use), spices; sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies, aromatic preparations for pastries; food dressings (sauces), sauces (condiments); frozen yoghurt [confectionery ices], marzipan, quiches, puddings, bread, bread rolls.</i></p> |

20) TWG's *tea, black tea [English tea], flavorings of tea, tea-based beverages, fruit flavoured tea (other than medicinal), fruit tea (other than for medical purposes), beverages with tea base, Rooibos tea, herbal tea (other than for medicinal use), Chai tea, green tea, Japanese green tea, Oolong tea (Chinese tea), aromatic teas (other than for medicinal use), beverages made of tea, iced tea, tea bags (other than for medicinal use), tea extracts, tea essence; tea for infusions (other than for medicinal use)* are all included in, or covered by the terms listed in MF's specification and are self-evidently identical.

21) In respect of TWG's *coffee, coffee-based beverages*, Mr St Quintin submitted that they share identical uses and physical nature, both being hot, caffeinated beverages. He also submitted that there is substantial overlap of the respective users with many tea drinkers also being coffee drinkers and vice-versa. They appear on the same or closely adjacent shelves in shops and, therefore, share the same

trade channels. Mr St Quintin concluded by submitting that the respective goods are very highly similar. Mr Bartlett conceded that these goods are “pretty close” to the tea based beverages contained in MF’s specification. I agree with Mr St Quintin and I find that the respective goods are very highly similar.

22) At the hearing, Mr Bartlett submitted that TWG’s mark should survive at least for the following goods:

*spices; sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies, aromatic preparations for pastries; food dressings (sauces), sauces (condiments); frozen yoghurt [confectionery ices], marzipan, quiches, puddings, bread, bread rolls.*

23) I agree with Mr Bartlett’s conclusions. All the goods listed in paragraph 20, above are foodstuffs and consequently different in nature, intended purpose and method of use to MF’s goods that are beverages. The respective goods are not in competition, nor are they complimentary in the sense that “there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking” (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06). I conclude that the goods listed in paragraph 20, above, are not similar to MF’s goods.

### **Comparison of marks**

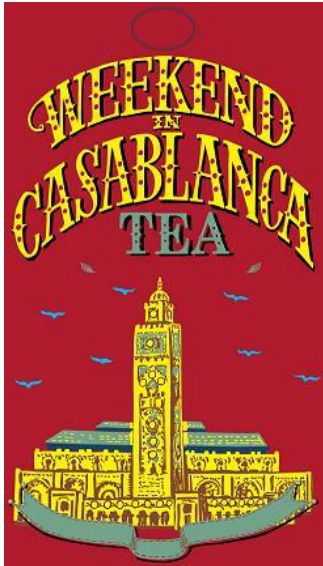
24) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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



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

25) 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.

26) The respective marks are shown below:

| Earlier mark | Contested marks  |
|--------------|--|
| Casablanca   |  |

27) MF, earlier mark consists of the single word “Casablanca” and is therefore its dominant and distinctive element.

28) TWG’s mark consists of numerous elements, namely the words WEEKEND IN CASABLANCA TEA, the device of what appears to be an Arabic-style building

featuring a tower, possibly a mosque, what appear to be small devices of birds in flight and a “sash” or banner type device at the bottom and slightly overlapping in front of the building. The mark also features various colours, namely, a red background, yellow script and building, green building roof, sash and the script of the word TEA and the flying birds in blue. Mr St Quintin submitted that the CASABLANCA element is the dominant, distinctive element of the mark because it “qualifies the ‘WEEKEND IN...’”. I do not agree. By virtue of being the prominent element within the mark, the words WEEKEND IN CASABLANCA, as a whole, is the dominant element. The word TEA will be perceived as descriptive and therefore does not contribute to the distinctive character of the mark. The devices of birds are so small when considered within the context of the mark as a whole, so as to go unnoticed and are negligible. However, if they are noticed, they are subservient to the other elements of the mark. The building depicted fills most of the bottom half of the mark and is also a distinctive element of the mark.

29) In respect of the degree of visual similarity between the marks, Mr Bartlett submitted that TWG’s mark consists of an ornate label with the device of a building being a strong feature of the mark. I agree that the device of the building is a strong visual feature within the mark, but still visually subservient to the words WEEKEND IN CASABLANCA. Within this text element, the word CASABLANCA features prominently when viewing the mark as a whole. Taking this into account, whilst TWG’s mark is a reasonably visually complex label device, the common occurrence of the word CASABLANCA and its prominence at the centre of TWG’s mark still leads to a level of similarity somewhere between low and medium.

30) Aurally, TWG’s mark is likely to be referred to as WEEKEND IN CASABLANCA. The TEA element is unlikely to be referred to and it is not normal for device elements to have aural characteristics. Taking all of this into account, where comparing TWG’s mark to MF’s mark, whilst there are three additional syllables at the beginning of TWG’s mark, the last four syllables are identical. Mr Bartlett submitted that the average consumer would be immediately struck by the WEEKEND IN... part of the phrase and contended that, as a result, there is no aural similarity. Whilst the WEEKEND IN... element has an impact upon the aural characteristics of TWG’s mark, I do not agree that it results in no aural similarity. The fact that the last, four syllable word in TWG’s

mark is identical to the four syllables in MF's mark results in a medium level of aural similarity.

31) Conceptually, Mr Bartlett submitted that the respective marks are wholly different and offered the view that one would be seen as a city name and the other a holiday or period of time. There is some force to this submission, but the analysis is not as "cut and dry" as Mr Bartlett would wish me to adopt. The words WEEKEND IN CASABLANCA do dominate TWG's mark. However, as Mr St Quintin submitted, the average consumer is likely to assume that the device of an Arabic-styled building is representative of the type of building to be found in Casablanca, or possibly to even believe that it is a depiction of a specific building in that city. Either way, it strengthens the concept of the place CASABLANCA within the mark as a whole. When this is combined with the prominence of the word CASABLANCA within the mark, although it is part of the phrase WEEKEND IN CASABLANCA, the concept of the city itself is present in the mark. Taking all of this into account, I conclude that there is a medium level of conceptual similarity.

32) There is one further issue that I need to comment upon. Mr St Quintin referred to the findings of my fellow hearing officer, Al Skilton, in TWG's failed opposition to MF's CASABLANCA mark (BL O-005-16). In that case, TWG was relying on the unregistered word mark WEEKEND IN CASABLANCA. Ms Skilton found that the respective marks share a medium level of similarity. I note that in the current case, TWG's mark is not a word mark but, rather, a label mark with other elements present. This results in the need for me to undergo an analysis that is different from that that Ms Skilton had to undertake. For that reason alone, I am not bound to follow my colleague's findings. That said, my findings do not depart from hers to any great degree, and where they do, it is because of the presence of additional elements in TWG's mark.

### **Average consumer and the purchasing act**

33) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

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

35) As Mr St Quintin submitted, the goods of both parties can be described as ordinary grocery products that are normally self-selected from a shop shelf of the online equivalent. The purchasing process is, therefore, normally visual, but I do not ignore that on occasions aural considerations may play a part. These products are bought regularly by ordinary members of the public and are normally inexpensive. Mr Bartlett submitted that there is a stronger level of attention involved in the purchasing process for teas than for the other goods. I do not agree. The fact that both sides currently market their products as high-end luxury goods does not disturb my finding based upon a notional consideration of the goods listed in the respective applications. Under notional considerations, the level of attention paid in respect of the purchase of teas is no different than for many other grocery goods and does not involve an enhanced level of attention.

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

36) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV, Case C-342/97* the CJEU stated that:

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

37) Mr Bartlett submitted that if MF’s mark is distinctive at all, it is only at the lowest level. In making this submission, he referred to the Registry’s Work Manual, Chapter 3 (Examination Guide), 2, ii on page 134, where it states that:

“The names of places which are likely to be the source of natural produce are unlikely to be registrable as trade marks for such goods even if the place identified by the mark has no specific reputation”

and Registry’s Work Manual, Chapter 3 (Examination Guide), 2, iii (under the heading of “Local Services”, on page 134:

“For example, “Marrakech” may be seen as simply a fancy and exotic name for motor cars (but may be a plausible indication of the geographical source of other goods, such as carpets, and therefore not registrable for those goods).”

38) In the absence of a challenge to MF's mark, I am required to take registration of its mark as prima facie evidence that it has the minimum level of distinctive character for registration (see *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 – 44). Mr Bartlett submitted that Morocco has a reputation for tea. There is no evidence supporting this submission and, even if it is correct, it is not a fact so notorious that I can take judicial notice. It is my view that what I can take judicial notice of is that North Africa, more generally, being predominantly Muslim, has a tea-drinking culture. I am not aware of Morocco, or more particularly, Casablanca, having a reputation for producing tea and certainly, there is no evidence before me that this is so. Consequently, I dismiss Mr Bartlett's submission that I should treat the mark "Casablanca" in the manner set out in the Work Manual extracts reproduced above. Casablanca is not likely to be perceived as the source of tea. Rather it is merely evocative of the type of tea consumed in North Africa or, if the average consumer is aware that Casablanca is in Morocco, of tea consumed in that country. Mr Bouqdib states in his evidence that Morocco is synonymous with mint tea. This lends further support to my finding. Therefore, I reject the first part of Mr Bartlett's submission that the mark is not distinctive at all.

39) Having concluded that the mark is evocative of the type of tea consumed in North Africa, or possibly more specifically Morocco, its level of inherent distinctive character is not the highest. However, I find that the second limb of Mr Bartlett's submission, namely, that its distinctiveness is only at the lowest level is pitching it a little too low. The evocative nature of the mark results in a moderate degree i.e. somewhere between low and medium.

40) TWG's evidence illustrates some very modest use in the UK from a single outlet (in *Harrods*). The confidential turnover disclosed in the evidence (see paragraph 19) demonstrates this. Such low use is wholly incapable of demonstrating that the mark benefits from any enhanced level of distinctive character.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

41) The following principles are gleaned from the decisions of the CJEU 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:

(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.

42) Mr Bartlett submitted that the coincidence of a common element with a low level of similarity must lead to the conclusion that there is no likelihood of confusion.

Firstly, I have found that the level of distinctive character is not as low as Mr Bartlett contends. Secondly, such an approach has been criticised by the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, where is stated:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier



mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

43) Mr Bartlett also submitted that TWG use a family of WEEKEND IN... marks and that WEEKEND IN CASABLANCA is just one of this family. He argued that because of the existence of this family of marks, the average consumer will associate TWG’s mark with this family and not with Casablanca. He submitted that use within the family of marks constitutes paradigm use. I dismiss this argument. Whilst this may be how TWG currently market its WEEKEND IN CASABLANCA brand, this may change in the future, or it may sell the mark to another business who may decide to market it differently. The CJEU confirmed that marketing considerations are not relevant when considering the likelihood of confusion (see *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59).

44) I do not agree with Mr St Quintin’s submission that because MF’s mark is word only (and therefore entitled to protection in a range of scripts) it should be considered as identical to script in TWG’s mark. The script used in TWG’s mark is not a normal script and, further, it has other presentational characteristics such as the word “IN” being represented in a much smaller font than the words WEEKEND and CASABLANCA, and the curved presentation of the words. These are characteristics that go beyond what is covered by a word only mark. Consequently, I dismiss Mr St Quintin’s submission.

45) However, I do agree with a number of other submissions made by Mr St Quintin. He submitted that the nature of the purchasing act, being not particularly well considered, will result in the effect of imperfect recollection being heightened and that, in oral use, Casablanca will lodge in mind. I agree with this and, when considering this together with:

- the identity or high similarity of many of the respective goods;
- MF's earlier mark being of a moderate level of distinctive character, and;
- visual similarity somewhere between low and medium and a medium level of aural and conceptual similarity,

I find that there is a likelihood of indirect confusion where the average consumer will not confuse one mark for the other, but will believe that identical or highly similar goods provided under the respective marks originate from the same or linked undertaking.

46) In conclusion, MF's opposition succeeds in respect of the following of TWG's goods:

*Coffee, coffee-based beverages; tea, black tea [English tea], flavorings of tea, tea-based beverages, fruit flavoured tea (other than medicinal), fruit tea (other than for medical purposes), beverages with tea base, Rooibos tea, herbal tea (other than for medicinal use), Chai tea, green tea, Japanese green tea, Oolong tea (Chinese tea), aromatic teas (other than for medicinal use), beverages made of tea, iced tea, tea bags (other than for medicinal use), tea extracts, tea essence; tea for infusions (other than for medicinal use)*

47) The opposition fails in respect of the remaining goods, namely:

*spices; sugar, chocolates, chocolate bars, pralines, edible ices, ice cream, sorbets (ices), ice desserts, confectionery, cakes, pastry, macaroons (pastry), pastries, biscuits, cookies, aromatic preparations for pastries; food dressings (sauces), sauces (condiments); frozen yoghurt [confectionery ices], marzipan, quiches, puddings, bread, bread rolls.*

## **COSTS**

48) Both sides have achieved a measure of success. Consequently, I take the view that in respect of the substantive issues the outcome is reasonably evenly balanced and that each party should bear its own costs.

49) Mr Bartlett submitted that whilst TWG is content for any costs award to be made on-scale, it should receive an award of costs in its favour in respect of his attendance at the CMC insofar as it resulted from MF's challenge to its request for a confidentiality order relating to its turnover figures in the UK. Mr St Quintin submitted that because the CMC discussed other issues, the costs of the CMC arose anyway and not as the result of the challenge to the confidentiality request. The CMC also covered issues in other related cases, including a defence filed by MF's relying upon bad faith (where I directed that it be disregarded) and also a discussion on the consolidation groupings of the numerous proceedings (that was instigated by myself). Therefore, two of the issues went against MF and a third was an issue raised by me and not an issue between the parties. As such, I concur with Mr Bartlett that TWG is entitled to a contribution towards its costs. However, I have made the award in respect of my decision in TWG's sister proceedings against MF's mark PARIS BREAKFAST TEA. To do so again here would be a duplication of the award.

**Dated this 20th day of December 2016**

**pp. Mark Bryant**  
**For the Registrar,**