

**O-583-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No. 3453688**

**BY ARLA FOODS AMBA**

**TO REGISTER:**

**SKYRIOUSLY**

**AS A TRADE MARK IN CLASSES 29, 30, 32 & 35**

**AND**

**OPPOSITION THERETO (UNDER No 420897)**

**BY LACTALIS McLELLAND LIMITED**

## **Background and pleadings**

1. This decision concerns a trade mark application for the following mark:

**Mark:** SKYRIOUSLY

**Filing date:** 23 December 2019

**Publication date:** 21 February 2020

**Applicant:** Arla Foods amba (“the applicant”)

### **Specification:**

Class 29: Eggs; milk and milk products; dairy products and dairy substitutes; milk substitutes, namely soy milk, oat milk, coconut milk, almond milk, hemp milk, peanut milk and rice milk, including in powder form; oat milk based beverages, almond milk based beverages, coconut milk based beverages, hemp milk based beverages, peanut milk based beverages, rice milk based beverages and rye-based beverages, all of the beforementioned as milk substitutes; milk substitute based beverages containing coffee; rye-based beverages in powder form; milk in powder form; cream in powder form; rye milk in powder form; substitutes for cream; yoghurt; sour cream and creme fraiche; yoghurt substitutes; sour cream substitutes; fermented yoghurt, including fermented plant-based yoghurt; non-fermented yoghurt, including non-fermented plant-based yoghurt; yoghurt desserts; drinks based on yoghurt; skyr; beverages mainly consisting of a mixture of yoghurt and skyr; desserts mainly consisting of a mixture of yoghurt and skyr; skyr desserts; dessert mainly consisting of yoghurt and/or skyr, also containing muesli and/or dried fruit and/or nuts; drinks made from dairy products or dairy substitutes, including milk shakes and chocolate milk shakes; preparations for making dairy based drinks; albumin milk; whey; dry whey; whey powder; whey concentrates; whey protein; whey permeates; rennet; cheese; cheese spreads; cheese powder; cheese-based snack foods; cheese substitutes; desserts made from milk products or

milk substitutes; snacks based on milk products or milk substitutes; puddings made from milk products or milk substitutes; chilled desserts made from milk products or milk substitutes; dairy-based dips; dips based on milk substitutes; oils and fats for food; butter; flavoured butter; butter substitutes; dairy spreads; dairy and vegetable spreads mainly consisting of a mixture of butter and vegetable oil; Ghee; Smetana [sour cream].

Class 30: Coffee, tea, cocoa and artificial coffee; cappuccino; chocolate-based beverages; cocoa-based beverages; coffee-based beverages; powders and preparations for making cappuccino, cocoa, chocolate, coffee and tea beverages bread, pastries and confectionery; cereal-based snack food; rice-based snack food; confectionery bars; cereal bars and energy bars; chocolate bars; granola-based snack bars; muesli bars; pastries, cakes, tarts and biscuits (cookies); flour and preparations made from cereals; mousse confections; prepared desserts [confectionery]; muesli desserts; custard; sauces; sauces [condiments]; relish [condiment]; flavourings for foodstuffs, other than essential oils for foodstuffs, except etheric essences and essential oils; preparations for stiffening whipped cream; thickening agents for cooking foodstuffs; ice cream; sherbets [ices]; ice for refreshment; binding agents for ice cream; powders for making ice cream; frozen yoghurt [confectionery ices]; frozen yogurt cakes; ice milk bars; fruit ice bars; frozen confectionery containing ice cream; frozen dairy confections; ice beverages with a chocolate base; ice beverages with a coffee base; ice beverages with a cocoa base.

Class 32: Non-alcoholic beverages; mineral and aerated waters; fruit juice beverages; vegetable drinks and juices; drinks containing fruit and/or vegetable juices, also based on concentrates and extracts smoothies; whey beverages; non-dairy milk and beverages, including soya-based, rice-based, oat-based, almond based, coconut-based, rye-based, plant-based; kvass [non-alcoholic beverage]; sports drinks; isotonic beverages; syrups and other non-alcoholic preparations for making beverages and smoothies; all aforementioned goods also enriched with proteins, vitamins and/or minerals.

Class 35: Retail and wholesale services, including via a global computer network, in relation to foodstuffs; retail and wholesale services in relation to beverages; retail and wholesale services in relation to dietetic substances, preparations and beverages, food for babies, substitutes for mother's milk; provision of advice and information related to all the aforementioned services.

2. Lactalis McLelland Limited (“the opponent”) opposes the registration of the mark on grounds under sections 5(2)(b)<sup>1</sup> & 5(3) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the opponent relies on the same two marks, namely:

- i) UK registration 2317123, which was filed on 29 November 2002 and registered on 23 May 2003. The mark is registered for “cheese; cheese products” in class 29 and consists of the following figurative mark:



- ii) UK registration 2398648, which was filed on 5 August 2005 and registered on 20 January 2006. Although the mark is registered for a wider range of goods, the opponent relies on “cheese; cheese products” in class 29; the registration is for a series of two figurative marks, as follows:



3. There are two points to note, neither of which are disputed: i) given the respective filing dates, both the opponent's marks qualify as earlier marks in accordance with section 6(1) of the Act, and ii) given that they were both registered well before the five

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<sup>1</sup> The section 5(2)(b) claim relates only to the applied for goods in class 29.

year period which ended on the date of filing of the applicant's mark, both earlier marks are subject to the proof of use provisions contained in section 6A of the Act.

4. The applicant filed a counterstatement denying the grounds of opposition. In its counterstatement, the applicant put the opponent to proof of use in relation to the cheese/cheese products on which the opponent relies.

5. Both sides filed evidence. Rather than summarise the evidence, I will simply draw from it when it is relevant to do so. Neither side requested a hearing, although I note that the applicant filed written submissions in lieu of attending a hearing. The applicant is represented by Gill Jennings & Every LLP, the opponent by Novagraaf UK.

6. Despite the UK having left the EU, this decision will still make reference to the jurisprudence of the EU Courts. This is because section 6(3)(a) of the European Union (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.

### **Proof of use**

7. I will start with the proof of use assessment, as unless the earlier marks clear this hurdle, the opposition must fail. Section 6A of the Act reads as follows:

“(1) This Section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

.....

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

8. The onus is on the opponent, as proprietor of the earlier marks, to show use. This is in accordance with section 100 of the Act, which states:

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

9. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...]The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and

frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

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

### **Form of use**

11. In its submissions, the applicant highlights that there is no real use of the marks as registered, and that the use put forward by the opponent is primarily of other forms of use, use which it does not consider constitute acceptable variants. I note that the opponent’s evidence concerning the use it has made of its marks comes from Mr Herve Bouchet, Group General Counsel of the Lactallis Group, of which the opponent is part. I also note that Mr Bouchet refers to the “SERIOUSLY” brand of cheese and

cheese products, and that the marks have been used since 2002 and 2005 respectively<sup>2</sup>. In paragraph 11 of his witness statement he goes on to state that the opponent:

“...has used slight variations of the marks to date using the renowned and dominant element “SERIOUSLY”. Exhibit HB1 shows a summary of the evolution of the marks since the respective filing dates...”

12. Notwithstanding Mr Bouchet’s reference to “slight variations”, it is important to consider carefully the forms in which the marks have been used. This enquiry is necessary to ascertain whether, during the relevant period, the marks relied upon have been used in the form in which they are registered, or have been used in an acceptable variant form as per section 6(4) of the Act. If the use during the relevant period does not fall into either of these categories, it cannot be relied upon. The relevant period in question is the five-year period 24 December 2014 to 23 December 2019.

13. In Annex HB1, a document is provided illustrating the evolution of the brand. The representations are not as clear as they could be, but the document shows the following forms of mark/packaging:

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<sup>2</sup> Given their filing dates, I assume the claim to use since 2002 relates to the SERIOUSLY STRONG mark, and use since 2005 relates to SERIOUSLY TASTY.

1996 Seriously® Strong launches



2006 New pack



2010 New brand architecture



2012 Easy open pack  
Strength descriptor added  
Larger rosette



2013 Moving SS from a perceived descriptor to a brand  
Updated rosette  
Sash descriptor



2014



2017



14. The opponent's SERIOUSLY STRONG CHEDDAR mark looks like this:



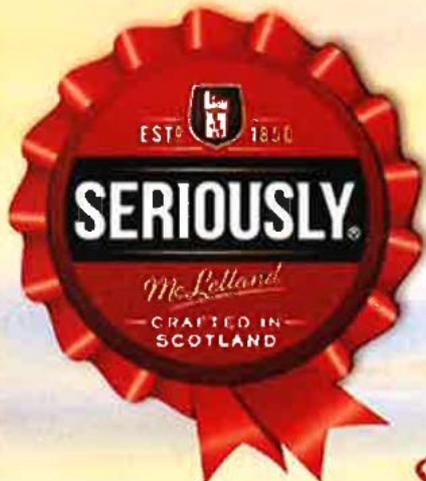
15. Whilst this mark may have been used in the form in which it is registered when first launched (or at least that is the position according to the evolution document), the mark was not used in this form during the relevant period given the way in which the brand has evolved.

16. Given that the relevant period commenced at the end of 2014, there appear to be two<sup>3</sup> forms of use to consider in terms of whether what has been used represents an acceptable variant. Given that the images in the evolution document are not the clearest, I have reproduced the images from other exhibits in Mr Bouchet's evidence<sup>4</sup>. These two forms of use, alongside the SERIOUSLY STRONG CHEDDAR mark as registered, are set out in the following table:

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<sup>3</sup> I accept that there could be some use of the 2013 version as depicted in the evolution document, however as the differences between this and the 2014 version are so small, nothing turns on this.

<sup>4</sup> An image from Facebook dated 13 February 2015 (page 148 of the evidence) and an image from the opponent's website dated 26 October 2018 at page 182 of the evidence.

Form as registered	2014-2017	2017 onwards
		

17. Cases such as *Colosseum Holdings AG v Levi Strauss & Co.*, case C-12/12, and *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61 (General Court) have provided guidance on the use of one mark with, or as part of, another mark, or of a registered mark being used in conjunction with another mark. However, I do not consider these to be germane here given that the mark as registered has not been used in its registered form as part of, or in conjunction with, another mark/matter. Thus, this is simply a question about whether the forms of use represent acceptable variants. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under Section 46(2)<sup>5</sup> of the Act as follows:

"33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period. [...]"

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark

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<sup>5</sup> Which is analogous to section 6(4) of the Act being considered here.

and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

18. Although this case was decided before the judgment of the CJEU in *Colosseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark(s) as registered.

19. In *Hyphen GmbH v EUIPO*, Case T-146/15, the General Court held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



20. The court set out the following approach to the assessment of whether the addition of additional components is likely to alter the form of the registered mark to a material extent:

"28. ...a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly

with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.”

21. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance, the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

22. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



23. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

24. In *Austria Tabak GmbH c EUIPO*, Case T-800/19, EU:T:2020:324, the General Court upheld the finding that the differences between the word mark AIR, registered in class 34, and the marks actually used were differences which altered the distinctive character of the registered trade mark. The marks used were MEMPHIS AIR BLUE, MEMPHIS AIR BLUE 100 and the figurative mark shown below:



Having noted that the evidence did not establish that the word “BLUE” was descriptive of the goods at issue, the Court said:

“33 In that regard, as stated by the Board of Appeal in paragraph 43 of the contested decision, it must be noted that both elements ‘air’ and ‘blue’ are systematically juxtaposed and, consequently, always appear together and very close to each other, forming a unit. Furthermore, in so far as the element ‘blue’ consists of four letters and the element ‘air’ consists of three letters, that added element is always clearly visible and does not have a secondary or ancillary position in the overall impression created by the combination ‘air blue’. The element ‘blue’ is therefore visually equally important as the element ‘air’.

34 Moreover, the finding that the distinctive character of the contested mark AIR, as registered, has been altered is reinforced by the fact that the combination ‘air blue’ is always subordinated to the element ‘memphis’ on the packaging of the goods, as correctly stated by the Board of Appeal in paragraph 46 of the contested decision. That addition introduces a further differentiating factor in comparison with the contested mark AIR.

35 That finding cannot be called into question by the argument that, in essence, the element ‘memphis’ is a trade mark used by the applicant to sell goods and that it corresponds solely to the addition of the ‘house mark’. Indeed, it must be stated that that element is always clearly visible in that it has a dominant position in the overall impression produced by the trade mark as used. In any event, even if it were established that that element is a ‘house mark’, that circumstance does not call into question the fact that that word alters the distinctive character of the contested mark AIR, since the relevant public no

longer perceives the element 'air' as an indication of the origin of the goods in question, in accordance with the case-law cited in paragraph 17 above.”

25. One of the reasons the applicant puts forward for its view that the marks as used not constituting acceptable variants relates to the descriptive role the words (SERIOUSLY STRONG/TASTY CHEDDAR) play in the earlier marks. I agree to an extent, in that the distinctive character of the mark as registered resides less in the inclusion of the words SERIOUSLY STRONG CHEDDAR but more in the overall get up of those words and its roundel device, together with the presence of the word McLelland and the accompanying device of a cheese press. I take this view because, notwithstanding their visual prominence within the mark, the words will likely be perceived as an indication of the strength and nature of the cheddar, it being seriously strong. As I come on to say later, I consider this phrase to be weak in inherent distinctive character. I note that in the evolution document, the change to the 2013 version of the mark is referenced as “moving SS [which I assume is a reference to SERIOUSLY STRONG] from a perceived descriptor to a brand”. That said, and for clarity, I would have taken the view that I have even without this reference in the evolution document, although it does reinforce my view of the matter.

26. In terms of the 2014 form of use, the primary differences are that: i) whilst circular in its middle, the 2014 version is in the form of a rosette rather than a roundel, ii) the get-up is different in that, whilst the words SERIOUSLY STRONG are presented in both forms in a visually prominent way on two lines in the centre of the marks, the words are broken up as registered with the background to SERIOUSLY being different to STRONG, whilst there is a single background to those words in the 2014 version, iii) the word CHEDDAR is not in the 2014 version, iv) the word McLelland is moved from top to bottom and is changed to a signature style script and v) the cheese press has been replaced by what appears to be a castle. There are other differences such as MADE IN SCOTLAND, which I do not consider to impact matters greatly.

27. In terms of whether this alters the distinctive character, I agree with the applicant that it does. Bearing in mind where the distinctiveness lies in the mark as registered, the differences are significant enough to alter the distinctive character. I am less concerned about changing McLelland from plain font to a signature script, but the

overall changes in the getup and other aspects (including the change from a cheese press to a castle) means that an alteration of the distinctiveness of the earlier mark has taken place. Given this finding, the opponent is not entitled to rely on the use of the 2014 version of the mark.

28. In relation to the 2017 version, the same applies. Indeed, the position is even starker because of the further change to just SERIOUSLY, with the dropping of the word STRONG. I consider this to represent an even greater alteration of distinctive character given the qualifying (as essentially an intensifier) role that word plays in conjunction with the word CHEDDAR, a role which is absent in the 2017 version.

29. For the sake of completeness, I confirm that I have been through the evidence in detail to ascertain whether any use more closely resembling the mark as registered has been made. I have noted the following:

- Despite the fact that the vast majority of the many exhibits in the evidence depict the forms of use in the evolution document, use which matches their relevant timeframes, Exhibit HB10 does contain some website prints (from 2018) which depict other forms of use. In his commentary, the witness states that these show use of the mark in the UK during the relevant period. The prints depict the 2017 version of the mark (as above) when reference is being made to the cheese product the opponent sells, however, some of the pictures show the following product:



However, I also note that the product is identified under the "International and regional brands" heading. There is no specific evidence beyond the website

print itself to explain the way in which these goods are marketed or sold in the UK, unlike the extremely comprehensive evidence relating to the 2014 and 2017 versions. There is, in my view, insufficient evidence to even come close to concluding that the above form of use was used in a way consistent with creating or maintaining a share of the relevant market in the UK. Such use does not, therefore, assist.

- There is also an exhibit which shows the following:



The above seems to be an earlier version of the mark, similar to the 2014 version, but I note that it includes the cheese press rather than a castle. However, I do not consider it necessary to consider this form of use because whilst on the exhibit it is stated “still in use today”, its use appears to be as a rosette on the door of a meeting room; this is internal use and not use which is consistent with creating or maintaining a share of the relevant market in the UK.

- I note that there are other forms of use on, for example, a compliments slip, but the exact form is unclear and I cannot tell if this is an example of a form of continuing use, nor the manner of its use with the public.

30. I must also keep in mind that the opponent has another earlier mark, which comprises the following two series marks:



31. Again, I can see no use at all during the relevant period (or indeed in any period) of either mark in the series. The forms of use shown under paragraph 29 do not assist

for the reasons already given. In its submissions, the applicant notes that there is a single image in the whole of the evidence<sup>6</sup> as part of a Facebook post on 24 December 2015, which shows the following:



32. However, I take the view that a single post on Facebook, one year into the relevant period, with little other use or information to contextualise its impact, and in circumstances where there is no evidence about how many people were exposed to this post, falls well short of use which is consistent with creating or maintaining a share of the relevant market in the UK.

33. That means that the only forms of use that could potentially be relied upon as acceptable variants are the forms I have already discussed. I accept that simply because the forms of use were not acceptable variants of the first mark does not mean that they should be rejected for the series of marks before me. A separate assessment must be made. The marks/forms of use are:

Form as registered	2014-2017	2017 onwards

<sup>6</sup> It is contained in Exhibit HB9

34. I accept that the decision here is a closer one than in relation to the assessment of the first earlier mark. This is because the get-up of the mark as registered at least includes the rosette form of use. That said there are still the other differences as I have described with my first assessment. There is a further difference though, on account of the main verbal element in the mark as registered being SERIOUSLY TASTY CHEDDAR (as opposed to STRONG), although I need to keep in mind my earlier comment that the distinctiveness lies less in the verbal elements and more in the get-up. Having carefully considered the matter, I still consider the differences between the marks as registered, and the forms of use, alters the distinctive character.

35. The net effect of my findings is that the opponent fails at the first hurdle in that genuine use has not been established. This results in the opposition failing and, therefore, my primary finding is that the applied for mark may be registered for all of its goods and services.

36. Irrespective of the above, I will nevertheless give my views on the substantive grounds of opposition. This is because if my findings on variant use are appealed and subsequently overturned, the appellate body would not have a first instance decision on the substantive grounds to consider which, in turn, might result in remittance and further delay for the parties. In relation to this fall-back approach, and to be clear as to what I am considering, I make the following observations:

- Contrary to my primary findings on variant use, for the purpose of my fall-back assessment, I will consider that the 2014-2017 form of use (but not the 2017 onwards form) represents an acceptable variant of both earlier marks.
- There is ample evidence to show that the acceptable variant has been genuinely used during the relevant period, even though such use is not through the whole of the period. There are numerous examples of the mark in use in relation to cheese, and the evidence given by the witness in relation to sales in the UK is significant.

- There is also some use in relation to cheese spread. I have, though, disregarded the use in relation to what appears to be a deep-fried cheese nugget product, as the only use was by way of the unacceptable variant.
- Bearing in mind the case-law on fair specifications, and notwithstanding the applicant's request that, if anything, a more restricted specification be created, I am content that the use would fairly be described as use in relation to cheese and cheese products, as claimed by the opponent.

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

37. Section 5(2)(b) of the Act states that:

“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.”

38. The following principles are gleaned from the judgments 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:

(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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

### **Comparison of marks**

39. 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.”

40. It would be wrong, therefore, artificially to 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.

41. The comparison is between:

**SKYRIOUSLY**

and



42. In terms of overall impression, the applicant's mark has just one component, the made-up word SKYRIOUSLY. That word is the only thing that contributes to its overall impression. It is worth flagging here my view that whilst the word will be seen as a whole (invented) word, most average consumers are likely to recognise that the word is based upon the word SKY mashed together with the word SERIOUSLY. A different perception might be taken by some average consumers if the mark were used in relation to yoghurt, but I will return to that point shortly.

43. The overall impression of the earlier marks is more complex. The first earlier mark has a fairly prominent verbal element SERIOUSLY STRONG CHEDDAR (albeit this verbal element is not greatly distinctive) which will be perceived a unit given it reads as a phrase, and the less prominent but distinctive word McLelland built into a less dominant representation of a cheese press. Also, as I have touched on earlier, given that the more dominant verbal element is not greatly distinctive, I consider that this results in the overall get-up of the mark playing a greater role in the overall impression than it would have done if a more distinctive verbal element dominated the mark. This results in all the components making contributions to the overall impression, with none of the components being wholly negligible. The component that I have yet to mention is the further verbal element CHEESE MERCHANTS SINCE 1869, however, given the less dominant role it plays and the clear descriptive (of the undertaking responsible for the goods) meaning of these words, this element plays only a limited role in the

overall impression. What I have said applies in equal measure to the series marks, modified for the nature of those marks to reflect that the words CHEESE MERCHANTS SINCE 1869 does not appear at all, and that part of the get-up includes the rosette. Given the findings I have made here, I do not accept that the word SERIOUSLY dominates the earlier marks.

44. Visually, there are a number of strong differences: the additional verbal elements, the graphic components, the fact that the point of commonality is SKYRIOUSLY not SERIOUSLY. The only similarity is that one of a number of words in the earlier marks is of similar length to SKYRIOUSLY, beginning with an S and ending with -RIOUSLY. Weighing the differences and similarities, I come to the view that any visual similarity is very low.

45. The same applies to the aural comparison, with the comparison being between MC-LELLAND SEE-REE-US-LY STRONG/TASTY CHEDDAR v SKY-REE-US-LY. Again, any aural similarity is very low. As I will develop further later, there is a prospect that some average consumers who encounter the mark in relation to yoghurt may perceive the applicant's mark as a mash-up of the word SERIOUSLY and the name of a type of Icelandic yoghurt called SKYR. That word is pronounced by those in the know as SKI-UR. However, the number of average consumers who a) recognise the word SKYR, and b) know how to pronounce it, will be quite low. That said, this would neither materially increase nor decrease the level of aural similarity. I accept that some average consumers might not articulate the McLelland component, however, even then I consider the degree of aural similarity to be low.

46. Conceptually, the get-up of the first earlier mark has no real concept, so its concept will be based upon the idea of seriously (in context, akin to very/extremely) strong cheddar cheese produced by a business whose founder's surname is McLelland. Similar observations apply to the series marks, although some consumers may also see the rosette as a reference to the seriously tasty cheddar being award winning. The mash-up of the earlier mark gives no real concept as a whole, but nevertheless the average consumer may conceptualise it on the basis of the normal words SKY and SERIOUSLY, although in the context of that form of use, the latter word will more probably be seen as a reference to SERIOUS (as in something to be taken seriously).

Similar observations apply for those who might recognise the use of the word SKYR in relation to yoghurt. I consider any conceptual similarity to be extremely low.

### **Comparison of goods/services**

47. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

48. In the judgment of the Court of Justice of the European Union (“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.”

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

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

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

50. Further, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

51. I set out my findings<sup>7</sup> in the table below:

**Identical**

Dairy products and whey; dry whey; whey powder; whey concentrates; whey protein; whey permeates; rennet; cheese; cheese spreads; cheese powder; cheese-based snack foods; dairy spreads

All these goods are either cheese or cheese products, or their ambit covers cheese or cheese products and so are identical on the basis set out in *Meric*. If I am wrong

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<sup>7</sup> Although only the class 29 goods are the subject of this ground of opposition, I have given my view on all the goods/services given that they are the subject of the ground under section 5(3).

on my interpretation in relation to goods such as rennet and whey, which could be said to be cheese making by-products rather than cheese products per se, I consider that there is still some similarity and I would group them with those of medium similarity I set out below.

**Highly similar**

Dairy substitutes; cheese substitutes

These goods are not cheese or cheese products, but they are substitutes for them. Thus, although not dairy based, they will likely have a very similar nature, the purpose is the same, they will be sold in close proximity and may compete.

**Medium similarity**

Milk and milk products; milk substitutes, namely soy milk, oat milk, coconut milk, almond milk, hemp milk, peanut milk and rice milk, including in powder form; oat milk based beverages, almond milk based beverages, coconut milk based beverages, hemp milk based beverages, peanut milk based beverages, rice milk based beverages and rye-based beverages, all of the beforementioned as milk substitutes; milk substitute based beverages containing coffee; rye-based beverages in powder form; milk in powder form; cream in powder form; rye milk in powder form; substitutes for cream; yoghurt; sour cream and creme fraiche; yoghurt substitutes; sour cream substitutes; fermented yoghurt, including fermented plant-based yoghurt; non-fermented yoghurt, including non-fermented plant-based yoghurt; yoghurt desserts; drinks based on yoghurt; skyr; beverages mainly consisting of a mixture of yoghurt and skyr; desserts mainly consisting of a mixture of yoghurt and skyr; skyr desserts; dessert mainly consisting of yoghurt and/or skyr, also containing muesli and/or dried fruit and/or nuts; drinks made from dairy products or dairy substitutes, including milk shakes and chocolate milk shakes; preparations for making dairy based drinks; albumin milk; desserts made from milk products or milk substitutes; snacks based on milk products or milk substitutes; puddings made from milk products or milk substitutes; chilled desserts made from milk products or milk substitutes; dairy-based dips; dips based on milk substitutes; oils and fats for food; butter; flavoured butter; butter substitutes; dairy and vegetable spreads mainly consisting of a mixture of butter and vegetable oil; Ghee; Smetana [sour cream].

These are generally speaking dairy products, albeit specific ones differing from cheese/cheese products. However, as consumable dairy products they have an overlap in nature. The purpose may be different, although they are all consumed. Dairy products are often sold in close proximity to each other, although there is no real competitive or complementary relationship.

Retail and wholesale services, including via a global computer network, in relation to foodstuffs; provision of advice and information related to all the aforementioned services.

To the extent that these services could cover the retailing of cheese/cheese products, there is in my view a medium degree of similarity based predominantly on the complementary relationship between the goods and services.

**Low similarity**

Eggs

Whilst, like cheese, eggs are basic staple products for human consumption, often sourced from farms (although the consumer rarely buys directly from farms), that is where the similarity ends.

**Very low similarity**

All of the goods in Classes 30 & 32

Whilst these are generally foods or beverages for human consumption, the points of similarity are fairly small. Therefore, whilst recognising that some may be slightly more similar to cheese/cheese products than others, I still consider that they are all only very low in similarity.

**No similarity**

Retail and wholesale services in relation to beverages; retail and wholesale services in relation to dietetic substances, preparations and beverages, food for babies, substitutes for mother's milk; provision of advice and information related to all the aforementioned services.

These retail/wholesale services have no clear relationship with cheese/cheese products.

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

52. 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. 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.”

53. The average consumer will be a member of the general public purchasing foods/beverages for consumption. Given the breadth of the specification, there will be differing degrees of care and consideration, but, at most, a medium level of care and attention will be displayed. For example, I accept that perhaps a medium degree of care will go into the purchase of a block of cheese which typically costs a few pounds and the average consumer will make some assessment of the type, strength etc of the product. However, for goods such as milk, the product may cost slightly less and the consideration that goes into its selection will also be less. In all cases for the goods at issue, the visual impact of the marks will likely have more importance in the selection process, although I will not rule out the aural impacts of the marks completely.

## Distinctive character of the earlier trade marks

54. Having compared the marks, it is necessary to determine the distinctive character of the earlier marks, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

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).”<sup>8</sup>

55. From an inherent perspective, I do not consider that either of the earlier marks are greatly distinctive. As I have already said, the verbal elements which stand out most in the marks are, in my view, weak components. Clearly, the other components of the marks and their respective get-ups help to add distinctive character, but only to the point that the marks have a medium level of inherent distinctive character. It must, though, be kept in mind that the distinctiveness of the earlier mark is only likely to

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<sup>8</sup> C-342/97, paras. 22-23

increase the likelihood of confusion to the extent that it is based in the elements of the respective marks which are in common; in this case, the word SERIOUSLY. In my view, this element is inherently weak, particularly when it is used in combination with other words (for the reasons I have already given) as it is here.

56. In terms of the use the opponent has made, the fact that the evidence depicts little use of the mark in its registered form is not fatal because the acceptable variant has been used extensively with significant levels of use being evidenced. It is logical to conclude that this variant use of the marks should be taken into account as enhancing the distinctiveness of the earlier marks. To that extent, I am prepared to say that the earlier marks (as a whole) have an enhanced level of distinctiveness.

57. I note from the opponent's submissions that it considers the word SERIOUSLY (which it considers to be the core shared element of all the marks) to be the dominant element and that as this has no specific meaning for dairy products it should be considered as highly distinctive. It also argues that the evidence it has filed demonstrates that there is a reputation in the SERIOUSLY marks amongst UK consumers. In relation to the word SERIOUSLY per se, it must be remembered that the earlier mark is not for the word SERIOUSLY per se, nor one in which the word SERIOUSLY performs an independently distinctive role. It forms part of phrase, with that phrase being, as discussed above, inherently weak. I have accepted that the use will have enhanced the distinctiveness of the mark as a whole. However, if the argument is that the use has somehow resulted in the word SERIOUSLY per se within the earlier marks standing out more and having more resonance with consumers then this is a more difficult proposition to accept. Bearing in mind that I am only considering the position in relation to use supported by the 2014 variant, and whilst accepting that some of the use (the social media use for example) of that variant mark is accompanied by marketing language which repeats the use of the word SERIOUSLY, I am not convinced that the result of this is that the word SERIOUSLY within the earlier marks has become highly distinctive of the opponent.

## Likelihood of confusion

58. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

59. Considering firstly direct confusion, and even taking into account use of the applied for marks on identical or highly similar goods to those of the opponent, and even considering that some of those goods might be subject to a lower level of care and consideration than the norm during the selection process, the differences between the marks on a visual, aural and conceptual basis are more than enough to prevent the marks from being misremembered/misrecalled as each other.

60. In terms of indirect confusion, this requires that the average consumer has identified that the marks are not the same. However, this does not mean that all of the differences between the marks will be observed by the average consumer. For example, I must countenance the possibility that the average consumer, whilst appreciating that the marks are different, still mistakes the word SKYRIOUSLY for SERIOUSLY. In my view, this is not likely. Whilst keeping in mind the tendency for the average consumer to see what they expect to see<sup>9</sup>, the way in which the word SKY and SERIOUSLY are brought together creates a clear and obvious neologism – whilst the average consumer might recognise the origin of the words used to create that word, they will not mistake it for “seriously”.

61. That then leaves indirect confusion to the extent that it might arise even though the average consumer notices most of the differences between the marks, including that one mark comprises the word SKYRIOUSLY, and that the other marks use the word SERIOUSLY (along with other words) together with other figurative elements. I still come to the conclusion that the average consumer would not assume that the goods/services (even when they are identical) come from the same or an economically linked undertaking. They will instead simply assume that an unrelated undertaking has used a fairly common English word and combined it with something else to create their own word/brand. It is far too great a leap and far too great an exercise of analysis on the part of the average consumer to come to the conclusion that the opponent wishes the Tribunal to make. The nature of the marks does not strike me as a usual type of brand extension. It is, in my view, implausible that this will be seen as a type of brand extension/variation particularly given the intensifier role the word “seriously” has in the earlier marks.

62. I should add that even if I have underestimated the role that the word SERIOUSLY plays within the earlier marks on account of the use that has been made, my view would still be the same. Put simply, it is too great a stretch for a finding of indirect confusion to be made.

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<sup>9</sup> See the Appointed Person in case BL O/227/04, *Kennedy Fried Chicken*

63. In reaching these findings, I have considered the position in relation to all the goods and services including the identical cheese/cheese products at issue. For clarity, I have also considered the use in relation to yoghurt, as it could be argued that for those average consumers that perceive the mark as a combination of the word SKYR (a type of yoghurt) and SERIOUSLY, then it might be confused on the basis that the undertaking responsible for the cheese/cheese products sold under the earlier marks have expanded into the yoghurt (specifically SKYR) market and have simply combined the name of that yoghurt with the word SERIOUSLY (which is part of their branding). For the same reasons I have given, this is simply too great a leap and the average consumer will not reach that conclusion. It is, again, implausible to think that this is a brand variation/extension. The opposition under section 5(2)(b) based on all the earlier marks is rejected.

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

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

65. The law appears to be as follows.

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

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

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

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

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

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

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

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

66. Even without fully considering the heads of damage, I am able to rule out this ground fairly briefly. This is because even if I were to accept that the earlier marks have a reputation (which on account of the significant use of the 2014 variant I would) I do not think the earlier marks would be brought to mind. This is because of the role that the word SERIOUSLY plays in those marks (as discussed earlier) and the differences between that and SKYRIOUSLY alone. Whilst accepting that the finding of a link, or bringing to mind, represents a lower hurdle than a finding of confusion, I still do not consider that it will arise.

### **Conclusion**

67. The opposition has failed and, subject to appeal, the applied-for mark may proceed to registration.

### **Costs**

68. I have determined these proceedings in favour of the applicant. It is, therefore, entitled to an award of costs. I award the sum of £1800 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing the statement of case and considering the counterstatement: £300

Filing and considering evidence<sup>10</sup>: £900

Preparing and filing written submissions: £600

69. I therefore order Lactalis McLelland Limited to pay Arla Foods amba the sum of £1800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 4<sup>th</sup> day of August 2021**

**Oliver Morris**

**For the Registrar**

**the Comptroller-General**

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<sup>10</sup> This award is made notwithstanding that the applicant's evidence was not overly helpful (I have not felt the need to comment on it, given that it relates simply to how they are using it) but the opponent's evidence was substantial and its consideration would have taken a reasonable amount of time.