

O/697/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003486661

BY THE BUBBLESHAKE BAR LIMITED

TO REGISTER:



AS A TRADE MARK IN CLASSES 29, 30 AND 43

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 421253 BY

SHAKEN UDDER LIMITED

## BACKGROUND AND PLEADINGS

1. On 4 May 2020, THE BUBBLESHAKE BAR LIMITED (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 29: Milkshakes; Milk drinks; Flavoured milk; Milk products; Milk based beverages.

Class 30: Confectionery; Chocolate; Chocolate bars; Confections; Milk chocolate; Milk chocolate bars; Chocolate beverages containing milk; Ice milk [ice cream]; Ice cream; Bases for making milk shakes [flavourings]; Biscuits; Cookies; Bread and pastries.

Class 43: Milkshake bar services; sandwich bar services; café services; services for the provision of food and drink; advice and information relating to the above.

2. The applicant’s mark was published for opposition purposes on 22 May 2020 and, on 24 August 2020, it was opposed by Mr Andrew Thomas Howie. The marks relied upon in the notice of opposition were subsequently assigned to Shaken Udder Limited (“the opponent”).
3. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The goods and services relied upon by the opponent under its section 5(2)(b) grounds are set out in the **Annex** to this decision. In respect of the section 5(3) ground, the opponent relies on the goods that have been underlined in the Annex.
4. In respect of the section 5(2)(b) and 5(3) grounds, the opponent relies on the following trade marks:



EUTM: 013798988<sup>1</sup>

Filing date 5 March 2015; registration date 17 June 2015

Colours claimed: Cream; White; Black; Pink

Relying on all goods.

("the opponent's first mark");

SHAKEN UDDER

EUTM: 017576133

Filing date 11 December 2017; registration date 19 April 2018

Relying on all goods and services

("the opponent's second mark");



EUTM: 017911714

Filing date 1 June 2018; registration date 11 October 2018

Relying on all goods

("the opponent's third mark");

SHAKEN OTHER

EUTM: 018258013

Filing date 19 June 2020; registration date 5 November 2020

Relying on all goods

("the opponent's fourth mark");

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<sup>1</sup> Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain relevant rights in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application



UK registration no. 3155885

Filing date 21 March 2016; registration date 19 August 2016

Relying on all goods

("the opponent's fifth mark")

SHAKEN OTHER

UK registration no. 3453368

Filing date 20 December 2019; registration date 8 August 2020

Relying on all goods

("the opponent's sixth mark")

5. Under its section 5(2)(b) ground the opponent claims that in view of the high level of similarity of the applicant's mark and the opponent's marks and the identity/similarity of the goods and services, there is a likelihood of confusion which includes a likelihood of association. Further, under its section 5(3) ground the opponent claims that it has established an extensive reputation of its marks in the UK and beyond and that use of the applicant's mark would unfairly trade off, or ride on the coat-tails of the opponent's significant reputation or tarnish the opponent's reputation and reduce the distinctiveness of the opponent's marks.
6. In respect of its opposition under section 5(4)(a), the opponent alleges that it has been using the following sign:



("the opponent's first right")

throughout the UK since at least 2016; and the following signs:

SHAKEN UDDER

("the opponent's second right"); and

SHAKEN

("the opponent's third right)

throughout the UK since at least 2004

7. In respect of all three rights, the opponent claims that it has accrued goodwill for the following goods:

Class 29: Dairy products, milk and milk products; flavoured milk beverages; milk beverages; milk drinks; beverages made from milk; milk beverages with high milk content; milk beverages containing fruits; beverages having a milk base; milk based drinks; beverages consisting principally of milk; flavoured milk drinks; milk drinks containing fruits; dairy-based beverages; drinks made from dairy products; milk shakes and flavoured milk drinks; food products consisting of or including milk as the predominant ingredient.

Class 30: Beverages with a chocolate, cocoa or coffee base and containing milk; chocolate beverages containing milk; chocolate-based beverages with milk; coffee, coffee extracts, coffee-based preparations and beverages; coffee based drinks; coffee beverages; iced coffee; artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee; cocoa-based preparations and beverages; chocolate-based preparations and beverages; drinking chocolate; cocoa and cocoa based drinks.

8. The opponent claims that it, or its predecessor in title, has acquired significant goodwill and reputation in the rights and, as a result of the highly similar marks and identical or related goods, use of the applicant's mark constitutes passing off.

Further, use of the applicant's marks would result in misrepresentation that would result in lost sales for the opponent.

9. The applicant filed a counterstatement denying the claims made.
10. The opponent is represented by Dummett Copp LLP. The applicant is represented by RevoMark. While the opponent filed evidence in chief, the applicant did not. During the evidence rounds, the opponent filed written submissions. No hearing was requested and neither party filed written submissions in lieu of the hearing. This decision is taken following a careful perusal of the papers.
11. Although the UK has left the EU, 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 Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

12. The opponent filed evidence in chief in the form of the witness statement of Mr Andrew Howie dated 10 March 2021. Mr Howie is the founder and current director of the opponent. Mr Howie's statement is accompanied by 12 exhibits.
13. I do not propose to summarise the evidence and submissions here. However, I have taken them into consideration in reaching my decision and will refer to them below, where necessary.

## **MY APPROACH**

14. I consider it appropriate to approach this decision by first considering whether there is any likelihood of confusion between the opponent's second mark and the applicant's mark. I shall adopt this approach for two reasons, the first being that the opponent's second mark has a wider specification than the opponent's remaining marks and the second being that the opponent's second mark is a word

only mark. In the event that there is likelihood of confusion between these marks, I do not consider that assessing the remaining marks would improve upon the opponent's position. However, in the event that there is no likelihood of confusion, I will proceed to assess the remaining marks in turn.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

15. Section 5(2) of the Act reads as follows:

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

(a) [...]

(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 or association with the earlier trade mark.”

16. Section 5A of the Act states as follows:

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

17. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

18. Given its filing date, the opponent’s second mark qualifies as an earlier trade marks under the above provisions. As the opponent’s second mark had not completed its registration process more than 5 years before the date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services for which the mark is registered.

19. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.

## Comparison of goods and services

20. The applicant's goods and services are listed at **paragraph one** above. The goods and services of the opponent's second mark are listed in the **Annex** to this decision. To simplify matters, this comparison will refer to the opponent's second mark's specification as the opponent's specification.

21. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 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”.

22. 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 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.

23. The General Court (GC) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 fur 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”.

24. I have submissions from the opponent regarding the similarity of the goods and services. While I do not intend to reproduce the submissions in full here, I have taken them into account in making my following assessment.

#### Class 29 goods

25. “Milkshakes” and “milk products” in the applicant’s specification have direct counterparts in the opponent’s specification. These goods are, therefore, identical.

26. “Milk drinks”, “flavoured milk” and “milk based beverages” in the applicant’s specification all fall within the broader category of “milk shakes and flavoured milk drinks” in the opponent’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.

#### Class 30 goods

27. “Biscuits” and “chocolate beverages containing milk” in the applicant’s specification have direct counterparts in the opponent’s specification. These goods are identical.

28. Although expressed slightly differently, I am of the view that “ice milk [ice cream]” and “ice cream” in the applicant’s specification are identical to “ice creams” in the opponent’s specification.
29. The applicant’s specification contains the terms “confections”. It is my understanding that confections describe goods that are also commonly referred to as ‘confectionary’. As a result, I consider that “confections” in the applicant’s specification is identical to “confectionary” in the opponent’s specification.
30. “Dairy confectionery” in the opponent’s specification falls within the broader category of “confectionery” in the applicant’s mark, meaning that these goods are identical under the principle outlined in *Meric*.
31. In my view, chocolate is a type of confectionery. As a result, I consider that “chocolate”, “chocolate bars”, “milk chocolate” and “milk chocolate bars” in the applicant’s specification fall within the broader category “dairy confectionery” in the opponent’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.
32. “Cookies” in the applicant’s specification are a sub-category of biscuit and will, therefore, fall into the broader category of “biscuits” in the opponent’s specification. These goods are identical under the principle outlined in *Meric*.
33. “Bases for making milk shakes [flavourings]” in the applicant’s specification can include powders for making milk shake. As milkshakes are beverages, I am of the view that these goods fall within the category of “powdered preparations containing flavourings for use in making beverages” in the opponent’s specification. These goods are, therefore, identical under the principle outlined in *Meric*. In the event that I am wrong in my finding of identity, they are similar to a high degree on the basis that there is an overlap in user, method of use, purpose and trade channels.
34. “Pastries” in the applicant’s specification may cover both savoury or sweet breads and pastries. In my view, these goods are similar to “tarts” in the opponent’s specification. This is on the basis that there is an overlap in user, being a member

of the general public. Alternatively, these goods have a competitive relationship as a user looking for a snack or dessert may choose a pastry over a tart and vice versa. Further, the goods overlap in method of use and purpose in that they will both be consumed by the user. As for nature, there is some overlap as tarts commonly consist of a pastry base. Overall, I consider these goods similar to a high degree.

35. “Bread” in the applicant’s specification shares a level of similarity with “preparations made from cereals” in the opponent’s specification. It is my view that the opponent’s term can include goods such as bread dough and mixes for making bread. I make this finding on the basis that bread is commonly made from cereals such as wheat and rye. While these goods differ in nature and method of use in that one will be the final product of bread whereas the other will be a mix or pre-cooked dough, I am of the view that they overlap in user on the basis that both goods will be bought by members of the general public. Alternatively, they share a competitive relationship in that a user may choose to buy bread or a mix or pre-cooked dough to make fresh bread at home. Even though the specific purposes of the goods differ, the end purpose overlaps in that both goods will be consumed by the user. Further, I consider that there is an overlap in trade channels in that an undertaking that makes bread as a final product is also likely to provide pre-mixed preparations for the user to bake at home. Overall, I consider these goods to be similar to a medium degree.

#### Class 43 services

36. “Services for the provision of food and drink” in the applicant’s specification describes the same service as “provision of food and drink” in the opponent’s second mark’s specification. These services are identical.

37. “Milkshake bar services”, “sandwich bar services” and “café services” in the applicant’s specification are all types of services for the provision of food and/or drinks. As a result, they all fall within the broader category of “provision of food and drink” in the opponent’s second mark’s specification. These services are, therefore, identical under the principle outlined in *Meric*.

38. The applicant's class 43 services contain "advice and information relating to the above" at the end of its list of services. In my view, this is a service that provides the user with advice and information regarding the food being served by the applicant's services. For example, this can cover the provision of advice/information regarding allergens or nutritional information. In my view, these services will be aimed at the same users as the services themselves. They may also be offered through the same trade channels in that a café may also provide advice and information about its own services and food offerings via its website or at its physical premises. Given that I have found identity between the applicant's food and drink provision services and the opponent's food and drink provision services, I consider there to be an overlap in user and trade channels between the class 43 services in the opponent's second mark and the applicant's advice and information services. Further, while the nature and purpose of the services may be different, they share a complementary relationship. This is on the basis that, in my view, food and drink services are important and indispensable to the service of providing advice regarding those services and an average consumer is likely to believe that an undertaking responsible for one is responsible for the other, and vice versa.<sup>2</sup> Overall, I consider these services to be similar to a medium degree.

### **The average consumer and the nature of the purchasing act**

39. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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

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<sup>2</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

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.”

40. In my view, the average consumer of the goods and services at issue will be a member of the general public.

41. These goods are generally sold through a range of retail shops, including supermarkets and their online equivalents. Some of the goods may also be sold in cafes and restaurants. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as cafes and restaurants, the goods are likely to be displayed on menus. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

42. The goods at issue are low in value and will be reasonably frequent purchases. When selecting the goods, the average consumer is likely to consider such things as dietary requirements, flavour and/or nutritional information. For the majority of the goods, the average consumer is likely to pay a medium degree of attention during the selection process. However, I recognise that some of the goods will be very casual purchases (such as confectionery or other types of snacks selected at a checkout). For those goods I find that the average consumer is likely to pay a lower degree of attention.

43. As for the parties’ various food and drink services, these are likely to be selected following inspection of the premises’ frontage, the website of the service provider or advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural

component to the purchase of the services, given that word-of-mouth recommendations may also play a part.

44. I am of the view that the cost of these services can range significantly in price (from Michelin-starred restaurants to fast food outlets) and frequency of use. However, even where the costs are fairly low and purchases relatively frequent, such as in the case of the applicant's café services, a number of factors will still be taken into consideration such as type of food or drink offered, dietary requirements and hygiene rating. I therefore consider that a medium degree of attention will be paid during the selection process. I am of the view that the same findings will apply to the advice and information services in the applicant's specification.

### **Comparison of the marks**

45. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

46. 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.”

47. 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.

48. The respective trade marks are shown below:

<p>The opponent's second mark</p>	<p>SHAKEN UDDER (the opponent's second mark)</p>
<p>The applicant's mark</p>	

49. I have detailed submissions from the opponent in respect of the comparison of the marks. However, I do not intend to reproduce these here but have taken them into account in making my following comparison.

Overall Impression

*The applicant's mark*

50. The applicant's mark consists of both word and device elements. The first word element sits at the centre of the mark and is 'SHAKENBAR' in a large blue and white typeface. Despite being presented as one word, I consider that the average consumer will identify the words 'SHAKEN' and 'BAR' within it. Below this are the words 'THE FAMOUS MILKSHAKE INSPIRED CHOCOLATE BAR' displayed within a black rectangle. I consider that these words will have little trade mark significance given their purpose as a descriptive strapline and are, therefore, likely to play a lesser role in the overall impression of the mark. The first device element is a stylised black and white cow that sits at the beginning of the mark. The second device element is placed at the end of the mark and is the same stylised cow within a circle, surrounded by the words 'SHAKEN COW MILK BAR COMPANY'. Given

its size and placement in the mark, 'SHAKENBAR' will play the greater role in the overall impression of the mark. The device elements are distinctive but play lesser roles in the overall impression of the mark.

#### *The opponent's second mark*

51. The opponent's second mark is the words 'SHAKEN UDDER'. There are no other elements that contribute to the overall impression of the mark which lies in the words themselves, neither of which dominates the other.

#### Visual Comparison

52. The only point of similarity between the marks is the word 'SHAKEN'. All other elements differ. While the differences play lesser roles in the applicant's mark, they still constitute points of visual difference between the marks. I note that the opponent's second mark is a word only mark registered in black and white, meaning that it can be used in any standard typeface or in any colour. Taking all of this into account, I consider that these marks are similar to between a low and medium degree.

#### Aural Comparison

53. The opponent's second mark consists of four syllables that will be pronounced 'SHAY-KUN-UH-DUH'. As for the applicant's mark I consider that the only element that will be pronounced is the word 'SHAKENBAR' which consists of three syllables that will be pronounced 'SHAY-KUN-BAR'. While the beginning of the marks, being where the average consumer tends to focus,<sup>3</sup> are identical, the ends are completely different. Overall, I consider these marks to be aurally similar to a medium degree.

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<sup>3</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

## Conceptual Comparison

54. I am of the view that the opponent's second mark is an unusual formulation of words that is likely to be conceptualised as an udder that has been shaken. However, given that an udder is the milk producing gland of a cow, I do acknowledge the possibility that it may also be understood as being a reference to milkshakes (being milk that is shaken).
55. Turning to the applicant's mark, I have set out above that despite being presented as one word, the average consumer will identify the words 'SHAKEN' and 'BAR' within the word 'SHAKENBAR'. In isolation, this will be understood as being a 'BAR' that is 'SHAKEN'. However, when taken in the context of the mark as a whole, particularly the words 'THE FAMOUS MILKSHAKE INSPIRED CHOCOLATE BAR', it will, in my view, be understood as referring to milkshake inspired chocolate bars. I make this finding despite the lesser roles played by the strapline.
56. While the concepts of both parties' marks are dominated by their reference to something that has been 'shaken', there are points of conceptual differences between them, particularly their references to an 'UDDER' and a 'BAR'. Overall, I consider the marks to be conceptually similar to a medium degree.

### **Distinctive character of the opponent's marks**

57. 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).”

58. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

59. The opponent has submitted that the distinctiveness of its mark has been enhanced through use. However, I will begin by assessing its inherent distinctiveness first.

60. I am of the view that, on milkshake related goods, it is possible that the opponent’s second mark has allusive qualities. I make this finding on the basis that the average consumer will understand that an udder is a milk producing gland of a cow and the addition of ‘SHAKEN’ may give rise to a link to shaken milk, being milkshakes. Further, given the reference to an udder, I consider the opponent’s second mark will also have allusive qualities in relation to dairy products, generally. Having said that, I am of the view that ‘SHAKEN UDDER’ is an unusual combination of words and consider the mark’s allusiveness will be limited as a result. As for the goods

and services in the opponent's specification that do not relate to milkshakes or dairy products, the opponent's second mark has no descriptive or allusive qualities.

61. In respect of milkshakes or dairy products, I cannot ignore the allusive qualities of the mark and, therefore, find that the opponent's second mark enjoys between a low and medium degree of inherent distinctiveness in respect of milkshake and dairy related goods. On goods and services unrelated to milkshakes or dairy products, I consider the mark enjoys a higher than medium degree of inherent distinctiveness.

62. I must now consider whether the distinctiveness of the opponent's second mark has been enhanced through use. While my initial assessment of this decision focuses on the opponent's second mark only, the opponent's evidence refers to all of its marks. Given that it may be necessary for me to return to the opponent's remaining marks further on in this decision, the following assessment of the evidence will consider all of the opponent's evidence as regards to all of its marks.

63. In respect of the type of goods sold, the opponent sets out that it has sold milkshakes, dairy free shakes, yogurt and oat foodstuffs/beverages.<sup>4</sup> Evidence of the products on the opponent's website is provided.<sup>5</sup> I note that this evidence only shows milkshakes and a product called 'Ooh La Latte' that third party evidence refers to as an iced coffee.<sup>6</sup> However, it is referred to as a milkshake on the packaging and I will, therefore, consider it as such. The milkshake products on the opponent's website bear the opponent's third and fifth marks and the dairy free milkshakes bear the following mark:



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<sup>4</sup> Paragraph 12 of the Witness Statement of Mr Andrew Howie

<sup>5</sup> Exhibit AH2 of the Witness Statement of Mr Andrew Howie

<sup>6</sup> Page 53 of Exhibit AH10 of the Witness Statement of Mr Andrew Howie

64. In respect of these print outs, I note that they contain a copyright date of 2021. The 'SHAKEN OTHER' products are referred to as 'NEW' and throughout the remainder of the evidence, there is nothing to indicate its availability prior to the relevant date.

65. A print out from Tesco's online store<sup>7</sup> is provided that includes a number of products bearing the opponent's second, third and fifth marks. It also shows one 'SHAKEN OTHER' product. This printout bears the copyright date of 2021. For the same reason as set out at paragraph 64 above, it is not clear whether the 'SHAKEN OTHER' product was available as at the relevant date.

66. The opponent discusses portable bars and beverage trucks that it states are a significant part of its business. The opponent explains that these bars/trucks attend festivals across the country. The opponent has set out the festivals attended and the typical attendance figures for them in non-pandemic affected years. Of these I note that the opponent attends Glastonbury (203,000 attendees), Download (111,000 attendees), Reading (105,000 attendees), Bestival (50,000 attendees), Latitude Festival (35,000 attendees) and Camp Bestival (10,000 attendees). Print outs from Wikipedia discussing these festivals are provided.<sup>8</sup> While these print outs are undated, I accept that the attendance figures for these festivals is significant. While I appreciate the opponent's comments that these trucks are an important part of its business, it is not clear how much custom or reputation the opponent generates from attending these events.

67. The range of retail stores that stock the opponent's goods are then discussed. I note that they are sold via Tesco, Sainsburys, Asda, Co-op, Waitrose, Ocado, Marks and Spencer and Morrisons. Printouts showing the products listed on Tesco, Sainsburys, Waitrose and Asda are provided.<sup>9</sup> I note these all show the opponent's second, third and fifth marks on milkshake products but are all dated after the relevant date. However, the Waitrose website shows reviews from a number of years prior to the print outs date which is likely to fall prior to the relevant date, therefore indicating that these goods were available before 4 May 2020.

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<sup>7</sup> Page 3 of Exhibit AH3 of the Witness Statement of Mr Andrew Howie

<sup>8</sup> Exhibit AH4 of the Witness Statement of Mr Andrew Howie

<sup>9</sup> Exhibit AH5 of the Witness Statement of Mr Andrew Howie

68. I note that the opponent has failed to provide evidence of the market share held by its mark in the UK. However, the evidence provided sets out the opponent has sold a total of £29,408,280 worth of goods under its 'SHAKEN UDDER' brand in the UK between 2010 and 2020.<sup>10</sup> The total sales have been broken down on a year by year basis as follows:

<b>Year</b>	<b>Total Revenue (£)</b>
2010 – 2011	318,278
2011 – 2012	896,746
2012 – 2013	1,230,293
2013 – 2014	1,601,522
2014 – 2015	1,642,992
2015 – 2016	2,057,129
2016 – 2017	2,903,754
2017 – 2018	3,959,370
2018 – 2019	6,538,468
2019 – 2020	8,259,728

69. Further evidence of sales is provided by way of 46 sample invoices.<sup>11</sup> Of this, I note that eight invoices are after the relevant date. All invoices from prior to the relevant date bear the opponent's first and second marks. While they have been heavily redacted, the total amounts are included. So too are the names of the recipients, all of which appear to be UK based retailers or festivals. I note that these invoices show sales of various flavours of milkshakes. However, I do note that there were 16 sales of a product called 'YogOaty' together with 18 sales of the 'Ooh La Latte' product.

70. In respect of advertising expenditure, the opponent has confirmed that its total expenditure between the financial years of 2017 and 2020 is £3,436,341.<sup>12</sup> This figure has been broken down as follows:

<b>2017</b>	<b>2018</b>	<b>2019</b>	<b>2020</b>
£340,287	£561,208	£807,167	£971,258

71. In my view, these figures are significant and the increased expenditure in recent years is indicative of a serious effort of the opponent to expand its brand. A number

<sup>10</sup> Paragraph 17 of the Witness Statement of Mr Andrew Howie

<sup>11</sup> Exhibit AH6 of the Witness Statement of Mr Andrew Howie

<sup>12</sup> Paragraph 21 of the Witness Statement of Mr Andrew Howie

of advertising materials that have resulted from the above expenditure are provided with the opponent's evidence.<sup>13</sup> Of these, I note that the opponent took out/offered the following:

- a. a half-page advert for milkshakes in May 2016 in the Waitrose Food Magazine;
- b. an advert on an in-store display screen in WH Smith in July 2018 promoting its milkshake range;
- c. a 'greeting gate' promoting the opponent's milkshake range at WH Smith's airport stores in 2018;
- d. a 'shelf barker' promoting its milkshake range in WH Smith in 2019;
- e. a free milkshake promotion for readers of the Daily Mail on 8 June 2019 (which has a circulation of over 558,000 readers) during which 6,500 free milkshakes were claimed;
- f. a free milkshake promotion from June 2019 for 'My Vodafone' users (of which there are over 2 million users) during which 60,000 codes were claimed and 13,500 were redeemed;
- g. a full-page advert in 2019's easyJet magazine regarding its milkshake products;
- h. a 2019 photo showing the 'Shaken Udder Chocolush Milkshake' for sale in easyJet's in-flight food and drinks menu; and
- i. a half page advert in a magazine called 'The Grocer' in September 2019.

72. In addition, there are examples of press coverage<sup>14</sup> in the form of an article in The Sun dated 15 March 2019 regarding the success of the opponent's brand and an article in the Daily Telegraph dated 4 October 2019 regarding the opponent's business, both of which feature its milkshake products. Both of these publications are well known UK wide publications and I note that the article in The Sun states that the opponent's business was on track to make a turnover of £6 million during the year it was published.

73. A report conducted by The Mix Global Research Agency is provided that shows the public has a 12% awareness of the opponent's 'SHAKEN UDDER' brand and

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<sup>13</sup> Exhibit AH7 of the Witness Statement of Mr Andrew Howie

<sup>14</sup> *ibid*



a 3% awareness of its 'SHAKEN OTHER' brand.<sup>15</sup> This report was created upon the request of the opponent. While I acknowledge the report, it is referred to as a 'recent report' and given the date of the witness statement, being 10 March 2021, it is possible that this report was undertaken after the relevant date. Further, it is not clear what information or data the report was based on.

74. Awards obtained by the opponent are discussed, however, I note that the example provided is for a product called 'YogOaty'.<sup>16</sup> It is not clear that this product bears any of the opponent's marks. It, therefore, does not assist the opponent.

75. I have no evidence as to the size of the relevant market for the opponent's goods in the UK. Given that the opponent's evidence points to use of its mark on milkshakes and milkshake beverage trucks at festivals, I consider it appropriate to limit the relevant market to that industry only. I am of the view that the market would be significant with an annual turnover of ten of millions, if not hundreds of millions of pounds per annum. When assessing the revenue figures discussed at paragraph 68 above against the size of the relevant market, I consider that the sales figures are moderate.

76. In my view, the opponent has demonstrated an increasingly intensive level of use of some of its marks throughout the entirety of the UK. This is particularly the case given the evidence that the opponent's goods are sold in popular UK-wide supermarket chains. Further, the use is somewhat long standing and has been steadily increasing over the last 10 years. In addition, the amount invested by the opponent in promoting its marks has been fairly significant and has been further evidenced by examples of marketing across a number of large retailers, airlines and a number of large-scale nationwide promotions. The evidence shows use of the opponent's first, second, third and fifth marks throughout. As a result, I consider the evidence to be sufficient to demonstrate that the opponent has enhanced its distinctiveness through use in the UK in respect of those marks. However, as the evidence only shows no sales or promotional activity in relation to the 'SHAKEN

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<sup>15</sup> Exhibit AH11 of the Witness Statement of Mr Andrew Howie

<sup>16</sup> Exhibit AH12 of the Witness Statement of Mr Andrew Howie

OTHER' product branding, being the opponent's fourth and sixth marks, prior to the relevant date, there can be no enhanced distinctiveness for these marks.

77. While I note the opponent's use of trucks at festivals to sell its milkshake products and the significant level of attendees at these festivals, the only evidence in respect of these festivals is two invoices for the Reading Festival in 2016 and 2018 for a total of £30,093. While these invoices are noted, they do not, in my view, point to a level of enhanced distinctiveness in the opponent's class 35 or 43 services. Further, I note that the evidence points to retail of the opponent's goods being done mostly via third party retailers (as evidenced by the print outs of those retailers and the sample invoice evidence that shows sales to retailers only and not the consumer directly).

78. On the basis that the evidence points towards milkshakes only, I consider that the enhanced distinctiveness applies to milkshake related goods only. While I note the sales of 'Ooh La Latte' products and the reference to it as an 'iced coffee' by a third party, I do not consider it to be an 'iced coffee' but a coffee flavoured milkshake. This is on the basis that the opponent refers to it as a milkshake on its own website. Even if I am wrong on this point, the evidence of 18 sales of this product is not, in my view, sufficient to warrant a finding that the opponent has demonstrated an enhanced reputation for 'iced coffee'.

79. On the basis that class 29 of the Nice Agreement consists of goods deriving from animal origin, such as milk, whereas class 30 of the Nice Agreement consists of goods derived from plants, I consider it necessary to find that the opponent has enhanced the distinctiveness of its first, second, third and fifth marks for the following goods only:

*The opponent's first mark*

Class 29: Flavoured milk beverages; Flavoured milk drinks

*The opponent's second mark*

Class 29: Flavoured milk beverages; flavoured milk drinks; milk drinks containing fruits; milk shakes and flavoured milk drinks.

*The opponent's third mark*

Class 29: Flavoured milk beverages; flavoured milk drinks; milk shakes and flavoured milk drinks.

*The opponent's fifth mark*

Class 29: Milk shakes; Milk-based beverages flavored with chocolate.

80. As for the level of distinctiveness, I do not consider the evidence is sufficient to warrant a finding of high distinctive character. However, I am content to conclude that the distinctiveness of the opponent's first, second, third and fifth marks has been enhanced to a higher than medium degree for the above goods only.

**Likelihood of confusion**

81. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

82. I have found the applicant's goods and services to be either identical or similar to varying degrees to the opponent's goods and services. I have found the average consumer for the goods and services to be a member of the general public who will select the goods and services through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention when selecting a majority of the goods and the services but may, for some goods, pay a lower degree of attention. I have found that the opponent's second mark enjoys between a low and medium degree of inherent distinctive character for milkshake and dairy related products and that for goods and services unrelated to these, it enjoys a higher than medium degree of inherent distinctive character. Further, I have found that the distinctiveness of the mark has been enhanced through use to a higher than medium degree in respect of the goods listed at paragraph 79 above, only. Finally, I have found the applicant's mark is visually similar to between a low and medium degree and aurally and conceptually similar to a medium degree with the opponent's second mark.

83. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks. I make this finding even on goods or services that are identical.

84. It now falls to me to consider whether there is a likelihood of indirect confusion. Firstly, I have found that the word elements, being 'SHAKEN UDDER' and 'SHAKENBAR', play greater roles in their respective marks. Secondly, I consider that the average consumer will identify the words 'SHAKEN' and 'BAR' within the applicant's mark's 'SHAKENBAR'. In the present case, I consider that it is likely that as a result of the use of the common element 'SHAKEN', the average consumer will believe that the applicant's mark is another brand, sub-brand or

brand extension of the owner of the opponent's second mark, or vice versa.<sup>17</sup> This is on the basis that the shared element, being 'SHAKEN' is, in my view, sufficiently distinctive to lead the average consumer into believing that these marks are owned by the same or economically connected undertakings. In addition, the presence of the device containing the words 'SHAKEN COW THE MILK BAR COMPANY' in the applicant's mark points to the likelihood not only of more than one trade mark featuring the word 'SHAKEN' being in use by the same undertaking but also that the natural evolution of the brand is not restricted to a combination of 'SHAKEN' with a descriptive word. As for the differences in stylisation and presentation of the marks (such as the typeface, colour and device element used in the applicant's mark), these will be seen as indicative of an alternative mark being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I consider there to be a likelihood of indirect confusion between the marks, even on those goods and services that I have found to be similar to a medium degree. Further, I consider that this finding applies even when taking into account the low to medium degree of inherent distinctive character of the opponent's second mark on those goods and services for which the evidence does not show enhanced distinctiveness.

85. It has been my approach throughout this decision to first assess the opponent's second mark on the basis that it is a word only. Given that I have found a likelihood of confusion in respect of this mark, I do not consider it necessary to consider the remaining marks on the basis that doing so will not improve the opponent's position.

86. I will now proceed to consider the remaining grounds of the opposition.

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

87. I will adopt the same approach under the opponent's section 5(3) ground that I did for its section 5(2)(b) ground in that I will firstly focus on the opponent's second mark. If necessary, I will proceed to consider its remaining marks separately.

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<sup>17</sup> Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

88. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

90. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

91. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 4 May 2020.

## **Reputation**

92. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.



28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

93. In its notice of opposition, the opponent claimed that its mark has a reputation in respect of the goods that have been underlined in the **Annex** to this decision. The opponent's second mark is an EUTM, so the relevant territory is the European Community and the trade mark must have a reputation in a substantial part of that territory. However, I note paragraph 30 of *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, wherein the CJEU held that:

"a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community."

94. Further, I also refer to the case of *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC) wherein Mr Geoffrey Hobbs QC, as Deputy Judge in the High Court held that:

"the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community."

95. In my view, at the relevant date, the UK constituted a substantial part of the territory of the Community.

96. The test for enhanced distinctiveness that I have considered above and the test for reputation that I must now consider are unlikely to produce different results. Given that the opponent's claim for reputation relies on a narrower range of goods and

services than its claim for enhanced distinctiveness, I conclude that I find that the opponent has demonstrated a reputation in its second mark for the same reasons set out in my assessment of enhanced distinctiveness above. I consider this reputation to be moderate and reside in the same goods listed at paragraph 79 above.

## **Link**

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

The degree of similarity between the conflicting marks.

98. I have found above that the applicant's mark is visually similar to between a low and medium degree and aurally and conceptually similar to a medium degree with the opponent's second mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

99. The goods for which the opponent has demonstrated a reputation are identical to "milkshakes", "milk drinks", "flavoured milk", "milk products" and "milk based beverages" in the applicant's specification. Further, I consider the opponent's goods to be similar to "chocolate beverages containing milk" in the applicant's specification on the basis that they overlap in nature, method of use and purpose in that they are beverages that are consumed by the user for the purpose of a satisfying drink. Further, they are also similar to "bases for making milk shakes [flavourings]" in the applicant's specification on the basis that there is an overlap in purpose between the goods and while they differ in nature and method of use, there may be an indirect competitive relationship between them as a user may choose to buy a milk shake ready-made or the powder or syrup to make it themselves. Further, there is an overlap in user in that the user will be someone

looking to consume a milkshake, regardless of whether it is ready-made or not. In addition, the opponent's goods are also similar to "milkshake bar services" in the applicant's specification. This is on the basis that the goods and services are complementary in that milkshakes are important for the running of a milkshake bar and the average consumer is likely to believe that the undertaking providing one is responsible for the provision of the other. Further, there is an overlap in user in that both will be used by someone looking to consumer a milkshake.

100. As for the remaining goods and services in the applicant's specification, I consider these to be dissimilar on the basis that while there may be an overlap in user in that they will all be used by members of the general public, they all differ in nature, method of use and purpose. However, I am of the view that the relevant section of the public that uses the dissimilar goods and services will be relatively close on the basis that they relate to goods and/or services in the food and drink sector.

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

101. The opponent's second mark has a moderate reputation in the UK.

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

102. In respect of the reputed goods, I have found that the opponent's second mark enjoys between a low and medium degree of inherent distinctiveness that has been enhanced through use to a higher than medium degree.

#### Whether there is a likelihood of confusion

103. In normal circumstances, it is the case that where there is no similarity between goods and services, there would be no likelihood of confusion. However, the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of the earlier mark. For example, some marks are so

distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services on which the marks are used.

104. I am now required to determine whether, in this particular case, the average consumer would be caused to believe that the user of the applicant's mark for the dissimilar goods and services is connected to the user of the opponent's second mark. In my view, while the repute and distinctiveness of the opponent's second mark is not huge, I am of the view that the reputation is enough to result in a significant number of average consumers being confused. Firstly, I make this finding given the presence of the shared element of 'SHAKEN' that sits at the beginning of both marks. Secondly, although the opponent has no reputation for any goods or services outside of those listed at paragraph 79 above, the reputation lies it does have is in goods that are found in the same economic sector as the applicant's remaining goods and services (being the food and drink sector). In my view, the closeness of the parties' areas of trade is likely to lead the average consumer to think that there is an economic connection between the users of the marks.

105. Even if I am wrong in my finding that there would be confusion even where dissimilar goods and services are concerned, I am of the view that, when all of the above is taken into account, the relevant public would bring to mind the opponent's second mark when confronted with the applicant's mark. In my view, the moderate reputation of the opponent's second mark, the common use of the 'SHAKEN' element and the fact that the respective goods and services, even where not identical or similar, are in the same sector of trade (food and drink) will create the necessary link between the marks.

## **Damage**

106. The opponent has pleaded that use of the applicant's mark would constitute an unfair advantage for the applicant, would be detrimental to the opponent's reputation and would dilute the distinctive character and repute of the opponent's first and second marks. I will deal with each head of damage in turn below.

## Unfair advantage

107. I bear in mind that unfair advantage has no effect on the consumers of the opponent's marks' goods and services. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

108. Given the moderate reputation of the opponent's marks and the presence of the common element of 'SHAKEN', it is my view that it is quite clear that there is potential for the applicant to gain an unfair advantage by using its mark. The applicant, by using the identical prefix 'SHAKEN' to the descriptive suffix 'BAR' would achieve instant familiarity in the eyes of the average consumers, thereby securing a commercial advantage, benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's marks. Therefore, I find it likely that the applicant's mark takes unfair advantage of the opponent's marks.

109. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage.

110. The opposition based upon section 5(3) succeeds in respect of the opponent's second mark. I do not consider it appropriate to proceed to assess the reliance upon the opponent's remaining marks on the basis that it will not improve the opponent's position.

### **Section 5(4)(a)**

111. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) .....

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

112. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

113. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

114. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### Relevant Date

115. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:



‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

116. As the applicant’s mark does not have a priority date and there is no evidence that the applicant’s mark was used prior to the application date, the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of the application for registration, being 4 May 2020.

### Goodwill

117. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in a business of which the following signs were distinctive at the relevant date.



(“the opponent’s first right”)

SHAKEN UDDER

(“the opponent’s second right”); and

SHAKEN

(“the opponent’s third right”)

118. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

119. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

120. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

121. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

122. Goodwill arises as a result of trading activities. Firstly, I note that there is no evidence that the opponent has used the word ‘SHAKEN’ in solus. I do not consider that use of ‘SHAKEN UDDER’ would result in ‘SHAKEN’ on its own becoming distinctive of the business. As a result, the opponent’s reliance upon its third right must fail.

123. Based on the evidence of turnover and advertising expenditure provided, I am content to conclude that the opponent has demonstrated that it had a protectable goodwill at the relevant date. Given that the evidence refers to milkshakes only, I am prepared to accept that the opponent has a fairly strong degree of goodwill in the UK in relation to “flavoured milk beverages” and “flavoured milk drinks milk shakes and flavoured milk drinks” only. I am satisfied that the first and second signs relied upon were distinctive of that goodwill at the relevant date. While the original opponent in this matter was Mr Andrew Howie, I am satisfied that the goodwill resides in the opponent. This is on the basis that the opponent has provided evidence that any goodwill in the rights were assigned from Mr Howie to the opponent. While the assignment is not included within the evidence, Mr Howie is a director of the opponent and I consider it reasonable to conclude that such an assignment took place. Further, I note that the applicant hasn’t taken issue with this point so I will proceed on the basis that the ownership of the goodwill isn’t challenged.

### **Misrepresentation and damage**

124. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

125. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). Taking this into account together with the closeness of the parties' respective fields, in that they operate in the same food and drink sector, and the fairly strong level of goodwill in the opponent's business, I am of the view that a substantial number of members of the public are likely to be misled into purchasing the applicant's goods and services in the mistaken belief that they are the goods and services of the opponent. I make this finding in respect of all of the goods and services in the applicant's specification. This is on the same basis as set out at paragraphs 103 to 104 above.

126. Given that I have found that there is a misrepresentation in respect of all of the applicant's goods and services, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful.

## **CONCLUSION**

127. The opposition succeeds under all of the grounds relied upon. As a result, the application is refused in its entirety

## **COSTS**

128. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,300** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's counter statement:	£200
Preparing evidence:	£600
Preparing submissions in lieu of a hearing:	£300
Official Fees:	£200
<b>Total</b>	<b>£1,300</b>

129. I therefore order THE BUBBLESHAKE BAR LIMITED to pay Shaken Udder Limited the sum of £1,300. This 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 23rd day of September 2021**

**A COOPER**  
**For the Registrar**

## ANNEX

### *The opponent's first mark*

#### Class 29

Flavoured milk beverages; Milk beverages; Milk drinks; Beverages made from milk; Milk beverages with high milk content; Milk beverages containing fruits; Beverages having a milk base; Milk based drinks [milk predominating]; Beverages consisting principally of milk; Flavoured milk drinks; Milk drinks containing fruits; Flavoured milk powder for making drinks; Drinking yogurts; Yogurt; Dairy produce; Dairy puddings; Dairy desserts; Dairy-based beverages; Drinks made from dairy products; Yoghurt based drinks; Yoghurt drinks.

#### Class 30

Chocolate beverages containing milk; Chocolate beverages with milk; Chocolate-based beverages with milk; Ice, ice creams, frozen yogurts and sorbets; Ice cream; Dairy ice cream; Coffee drinks; Coffee based drinks; Coffee beverages; Dairy confectionery.

#### Class 32

Concentrates for use in the preparation of soft drinks; Soft drinks; Sports drinks.

### *The opponent's second mark*

#### Class 29

Dairy products, milk and milk products; flavoured milk beverages; milk beverages; milk drinks; beverages made from milk; milk beverages with high milk content; milk beverages containing fruits; beverages having a milk base; milk based drinks; beverages consisting principally of milk; flavoured milk drinks; milk drinks containing fruits; flavoured milk powder for making drinks; drinking yoghurts; yoghurt; dairy puddings; dairy desserts; dairy-based beverages; drinks made from dairy products; yoghurt based drinks; yoghurt drinks; fromage frais, mousses; preserved, dried and cooked fruits and vegetables; jellies; jams; yoghurt products; products consisting wholly of or principally of yoghurt; yoghurts incorporating jellies, jams, fruits, fruit

sauces, fruit purees, chocolate, nuts, cereals, cereal products or cereal preparations as a condiment, flavouring or ingredient thereof; soya milk and soya milk products; milk shakes and flavoured milk drinks; milk substitutes; powdered milk; powdered milk drinks; powdered preparations containing milk for use in making beverages; dried milk powder; deserts made of milk and cream; cream; spreads; cheese; food products consisting of or including milk as the predominant ingredient; whitening agents for coffee and for tea.

### Class 30

Cereals; preparations made from cereals; confectionary; sweets; cakes; biscuits; flavourings other than essential oils; beverages with a chocolate, cocoa or coffee base and containing milk; chocolate beverages containing milk; chocolate-based beverages with milk; coffee, coffee extracts, coffee-based preparations and beverages; coffee based drinks; coffee beverages; iced coffee; artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee; tea, tea extracts, preparations and beverages made with tea; iced tea; powder for making beverages; powdered preparations containing flavourings for use in making beverages; malt- based preparations for human consumption; cocoa, powdered preparations containing cocoa for use in making beverages; cocoa-based preparations and beverages; cocoa powder; chocolate-based preparations and beverages; chocolate syrups; chocolate syrups for the preparation of chocolate based beverages; drinking chocolate; ice creams, dairy ice cream, ice desserts, sorbets, frozen yogurts, edible ices, water ices, powders and binding agents (included in this class) for making edible ices and/or water ices and/or sorbets and/or ice confectioneries and/or iced cakes and/or ice- creams and/or ice desserts and/or frozen yogurts; puddings and desserts (included in this class); pancakes and tarts; honey; treacle; golden syrup; jelly; dairy confectionery; flavourings other than non-essential oil; cheesecake; sauces; fruit sauces; condiments; cocoa and cocoa based drinks.

### Class 32

Non-alcoholic drinks and preparations for making non-alcoholic drinks; fruit drinks and fruit juices; vegetable drinks and vegetable juices; mineral water; flavoured water; aerated beverages; syrups and other preparations for making beverages; isotonic



sports beverages; non-alcoholic sports drinks; concentrates for use in the preparation of soft drinks; soft drinks; sports drinks.

### Class 35

Retail and wholesale services relating to dairy products, milk and milk products, flavoured milk beverages, milk beverages, milk drinks, beverages made from milk, milk beverages with high milk content, milk beverages containing fruits, beverages having a milk base, milk based drinks, beverages consisting principally of milk, flavoured milk drinks, milk drinks containing fruits, flavoured milk powder for making drinks, drinking yoghurts, yoghurt and dairy puddings; Retail and wholesale services relating to dairy desserts, dairy-based beverages, drinks made from dairy products, yoghurt based drinks, yoghurt drinks, fromage frais, mousses, preserved, dried and cooked fruits and vegetables, jellies, jams, yoghurt products, yoghurt drinks, products consisting wholly of or principally wholly of yoghurt, yoghurts incorporating jellies, jams, fruits, fruit sauces, fruit purees, chocolate, nuts, cereals and cereal products or cereal preparations as a condiment; Retail and wholesale services relating to flavouring or ingredient thereof, soya milk and soya milk products, milk shakes and flavoured milk drinks, milk substitutes, powdered milk, powdered milk drinks, powdered preparations containing milk for use in making beverages, flavoured milk powder for making drinks, dried milk powder, deserts made of milk and cream, cream, spreads, cheese and food products consisting of or including milk as the predominant ingredient; Retail and wholesale services relating to whitening agents for coffee and for tea, cereals, preparations made from cereals, confectionary, sweets, cakes, biscuits, flavourings other than essential oils, beverages with a chocolate, cocoa or coffee base and containing milk, chocolate beverages containing milk, chocolate-based beverages with milk, coffee, coffee extracts, coffee-based preparations and beverages, coffee based drinks and coffee beverages; Retail and wholesale services relating to iced coffee, artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee, tea, tea extracts, preparations and beverages made with tea, iced tea, powder for making beverages, powdered preparations containing flavourings for use in making beverages and malt- based preparations for human consumption; Retail and wholesale services relating to cocoa, powdered preparations containing cocoa for use in making beverages, cocoa-based preparations and beverages, cocoa powder, chocolate-based preparations and

beverages, drinking chocolate, ice creams, dairy ice cream, ice desserts, sorbets and frozen yogurts; Retail and wholesale services relating to edible ices, water ices and powders and binding agents (included in this class) for making edible ices and/or water ices and/or sorbets and/or ice confectioneries and/or iced cakes and/or ice- creams and/or ice desserts and/or frozen yogurts; Retail and wholesale services relating to puddings and desserts (included in this class), pancakes and tarts, honey, treacle, golden syrup, jelly, dairy confectionery, flavourings other than non-essential oil, cheesecake, sauces, fruit sauces, condiments, cocoa and cocoa based drinks and non-alcoholic drinks and preparations for making non-alcoholic drinks, fruit drinks and fruit juices; Retail and wholesale services relating to vegetable drinks and vegetable juices, mineral water, flavoured water, aerated beverages, syrups and other preparations for making beverages, isotonic sports beverages, non-alcoholic sports drinks, concentrates for use in the preparation of soft drinks, soft drinks and sports drinks.

#### Class 43

Provision of food and drink; restaurants; cafes; coffee houses; snack bars; catering services; mobile catering services; outside catering; providing of food and drink via a mobile truck.

*The opponent's third mark*

#### Class 29

Dairy products, milk and milk products; flavoured milk beverages; milk beverages; milk drinks; beverages made from milk; milk beverages with high milk content; milk beverages containing fruits; beverages having a milk base; milk based drinks; beverages consisting principally of milk; flavoured milk drinks; milk drinks containing fruits; flavoured milk powder for making drinks; drinking yoghurts; yoghurt; dairy puddings; dairy desserts; dairy-based beverages; drinks made from dairy products; yoghurt based drinks; yoghurt drinks; fromage frais, mousses; preserved, dried and cooked fruits and vegetables; jellies; jams; yoghurt products; products consisting wholly of or principally of yoghurt; yoghurts incorporating jellies, jams, fruits, fruit sauces, fruit purees, chocolate, nuts, cereals, cereal products or cereal preparations as a condiment, flavouring or ingredient thereof; soya milk and soya milk products;

milk shakes and flavoured milk drinks; milk substitutes; powdered milk; powdered milk drinks; powdered preparations containing milk for use in making beverages; dried milk powder; deserts made of milk and cream; cream; spreads; cheese; food products consisting of or including milk as the predominant ingredient; whitening agents for coffee and for tea.

### Class 30

Cereals; preparations made from cereals; confectionary; sweets; cakes; biscuits; flavourings other than essential oils; beverages with a chocolate, cocoa or coffee base and containing milk; chocolate beverages containing milk; chocolate-based beverages with milk; coffee, coffee extracts, coffee-based preparations and beverages; coffee based drinks; coffee beverages; iced coffee; artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee; tea, tea extracts, preparations and beverages made with tea; iced tea; powder for making beverages; powdered preparations containing flavourings for use in making beverages; malt- based preparations for human consumption; cocoa, powdered preparations containing cocoa for use in making beverages; cocoa-based preparations and beverages; cocoa powder; chocolate-based preparations and beverages; chocolate syrups; chocolate syrups for the preparation of chocolate based beverages; drinking chocolate; ice creams, dairy ice cream, ice desserts, sorbets, frozen yogurts, edible ices, water ices, powders and binding agents (included in this class) for making edible ices and/or water ices and/or sorbets and/or ice confectioneries and/or iced cakes and/or ice- creams and/or ice desserts and/or frozen yogurts; puddings and desserts (included in this class); pancakes and tarts; honey; treacle; golden syrup; jelly; dairy confectionery; flavourings other than non-essential oil; cheesecake; sauces; fruit sauces; condiments; cocoa and cocoa based drinks.

### Class 32

Non-alcoholic drinks and preparations for making non-alcoholic drinks; fruit drinks and fruit juices; vegetable drinks and vegetable juices; mineral water; flavoured water; aerated beverages; syrups and other preparations for making beverages; isotonic sports beverages; non-alcoholic sports drinks; concentrates for use in the preparation of soft drinks; soft drinks; sports drinks.

*The opponent's fourth mark*

Class 29

Dairy products, milk and milk products; flavoured milk beverages; milk beverages; milk drinks; beverages made from milk; milk beverages with high milk content; milk beverages containing fruits; beverages having a milk base; milk based drinks; beverages consisting principally of milk; flavoured milk drinks; milk drinks containing fruits; flavoured milk powder for making drinks; drinking yoghurts; yoghurt; dairy puddings; dairy desserts; dairy-based beverages; drinks made from dairy products; yoghurt based drinks; yoghurt drinks; fromage frais, mousses; preserved, dried and cooked fruits and vegetables; jellies; jams; yoghurt products; yoghurts incorporating jellies, jams, fruits, fruit sauces, fruit purees, chocolate, nuts, cereals, cereal products or cereal preparations as a condiment, flavouring or ingredient thereof; soya milk and soya milk products; beverages made with soya milk [milk substitute]; beverages made with rice milk [milk substitute]; beverages made with oat milk [milk substitute]; milk shakes and flavoured milk drinks; milk substitutes; dairy substitutes; beverages made with milk substitutes; flavoured beverages made with milk substitutes; powdered milk; powdered milk drinks; powdered preparations containing milk for use in making beverages; dried milk powder; deserts made of milk and cream; cream; spreads; cheese; food products consisting of or including milk as the predominant ingredient; whitening agents for coffee and for tea.

Class 30

Cereals; preparations made from cereals; confectionary; sweets; cakes; biscuits; flavourings other than essential oils; beverages with a chocolate, cocoa or coffee base and containing milk; chocolate beverages containing milk; beverages with a chocolate, cocoa or coffee base and containing milk substitutes; chocolate beverages containing milk substitutes; chocolate-based beverages with milk; coffee, coffee extracts, coffee-based preparations and beverages; coffee based drinks; coffee based drinks containing milk substitutes; coffee beverages; iced coffee; artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee; tea, tea extracts, preparations and beverages made with tea; iced tea; malt-based preparations for human consumption; cocoa, powdered preparations containing cocoa for use in making beverages; cocoa-based preparations and beverages; cocoa

powder; chocolate-based preparations and beverages; chocolate syrups; chocolate syrups for the preparation of chocolate based beverages; drinking chocolate; ice creams, dairy ice cream, ice desserts, sorbets, frozen yogurts, edible ices, water ices, powders and binding agents (included in this class) for making edible ices and/or water ices and/or sorbets and/or ice confectioneries and/or iced cakes and/or ice- creams and/or ice desserts and/or frozen yogurts; puddings and desserts (included in this class); pancakes and tarts; honey; treacle; golden syrup; jelly; dairy confectionery; flavourings other than non-essential oil; cheesecake; sauces; fruit sauces; condiments; cocoa and cocoa based drinks.

### Class 32

Non-alcoholic drinks and preparations for making non-alcoholic drinks; fruit drinks and fruit juices; vegetable drinks and vegetable juices; mineral water; flavoured water; aerated beverages; syrups and other preparations for making beverages; isotonic sports beverages; non-alcoholic sports drinks; concentrates for use in the preparation of soft drinks; soft drinks; sports drinks; nut and soy based beverages; soya-based beverages, other than milk substitutes; rice-based beverages, other than milk substitutes; oat-based beverages, other than milk substitutes; powder for making beverages; powdered preparations containing flavourings for use in making beverages.

*The opponent's fifth mark*

### Class 29

Milk beverages; Milk products; Milk beverages, milk predominating; Milk based beverages [milk predominating];Milk based drinks [milk predominating];Milk drinks; Milk shakes; Milk-based beverages flavored with chocolate; Milk-based beverages containing coffee; Milk-based beverages containing fruit juice; Milk and milk products.

*The opponent's sixth mark*

### Class 29

Dairy products, milk and milk products; flavoured milk beverages; milk beverages; milk drinks; beverages made from milk; milk beverages with high milk content; milk

beverages containing fruits; beverages having a milk base; milk based drinks; beverages consisting principally of milk; flavoured milk drinks; milk drinks containing fruits; flavoured milk powder for making drinks; drinking yoghurts; yoghurt; dairy puddings; dairy desserts; dairy-based beverages; drinks made from dairy products; yoghurt based drinks; yoghurt drinks; fromage frais, mousses; preserved, dried and cooked fruits and vegetables; jellies; jams; yoghurt products; yoghurts incorporating jellies, jams, fruits, fruit sauces, fruit purees, chocolate, nuts, cereals, cereal products or cereal preparations as a condiment, flavouring or ingredient thereof; soya milk and soya milk products; beverages made with soya milk [milk substitute]; beverages made with rice milk [milk substitute]; beverages made with oat milk [milk substitute]; milk shakes and flavoured milk drinks; milk substitutes; dairy substitutes; beverages made with milk substitutes; flavoured beverages made with milk substitutes; powdered milk; powdered milk drinks; powdered preparations containing milk for use in making beverages; dried milk powder; deserts made of milk and cream; cream; spreads; cheese; food products consisting of or including milk as the predominant ingredient; whitening agents for coffee and for tea.

### Class 30

Cereals; preparations made from cereals; confectionary; sweets; cakes; biscuits; flavourings other than essential oils; beverages with a chocolate, cocoa or coffee base and containing milk; chocolate beverages containing milk; beverages with a chocolate, cocoa or coffee base and containing milk substitutes; chocolate beverages containing milk substitutes; chocolate-based beverages with milk; coffee, coffee extracts, coffee-based preparations and beverages; coffee based drinks; coffee based drinks containing milk substitutes; coffee beverages; iced coffee; artificial coffee, artificial coffee extracts, preparations and beverages made with artificial coffee; tea, tea extracts, preparations and beverages made with tea; iced tea; powder for making beverages; powdered preparations containing flavourings for use in making beverages; malt- based preparations for human consumption; cocoa, powdered preparations containing cocoa for use in making beverages; cocoa-based preparations and beverages; cocoa powder; chocolate-based preparations and beverages; chocolate syrups; chocolate syrups for the preparation of chocolate based beverages; drinking chocolate; ice creams, dairy ice cream, ice desserts, sorbets, frozen yogurts, edible ices, water ices, powders and binding agents (included in this

class) for making edible ices and/or water ices and/or sorbets and/or ice confectioneries and/or iced cakes and/or ice-creams and/or ice desserts and/or frozen yogurts; puddings and desserts (included in this class); pancakes and tarts; honey; treacle; golden syrup; jelly; dairy confectionery; flavourings other than non-essential oil; cheesecake; sauces; fruit sauces; condiments; cocoa and cocoa based drinks.

### Class 32

Non-alcoholic drinks and preparations for making non-alcoholic drinks; fruit drinks and fruit juices; vegetable drinks and vegetable juices; mineral water; flavoured water; aerated beverages; syrups and other preparations for making beverages; isotonic sports beverages; non-alcoholic sports drinks; concentrates for use in the preparation of soft drinks; soft drinks; sports drinks; nut and soy based beverages; soya-based beverages, other than milk substitutes; rice-based beverages, other than milk substitutes; oat-based beverages, other than milk substitutes.