

O-733-21

**TRADE MARKS ACT 1994
IN THE MATTER OF
INTERNATIONAL TRADE MARK NO. WO0000001477384
DESIGNATING THE UNITED KINGDOM**

**BY AUTOBAHN TANK & RAST GMBH
TO REGISTER**




**AS A TRADE MARK
IN CLASSES 3, 5, 10, 18, 28, 29, 30, 31, 32
& 34
AND OPPOSITION THERETO (UNDER NO. 418964)
BY
FOX'S BISCUITS LIMITED**

Background & Pleadings

1. Autobahn Tank & Rast GmbH (“the holder”) is the holder of International Registration (“IR”) no. WO0000001477384 (“the designation”) in respect of the trade mark set out on the title page. Protection in the UK was requested on 30 January 2019 in respect of classes 3, 5, 10, 18, 28, 29, 30, 31, 32 and 34. Only goods in classes 29 and 30 are under opposition in these proceedings, and the holder subsequently amended its class 30 goods on 2 August 2021. The goods as amended will be set out later in this decision.

2. The IR was published in the UK for opposition purposes on 4 October 2019. On 26 November 2019, Northern Foods Grocery Group Limited, subsequently assigned to Fox’s Biscuits Limited (“the opponent”) opposed the designation under section 5(2)(b) the Trade Marks Act 1994 (“the Act”) on the basis of its earlier UK trade marks nos. 887518 (“ the earlier word mark”) and 3338608 (“the earlier stylised mark”). It has also opposed the designation under section 5(3) of the Act on the basis of its mark no. 887518. The details of the earlier registrations are set out below. Finally, the opponent opposed the designation under section 5(4)(a) of the Act for the sign **FOX’S** for which it claims use since 1853 in the UK on *biscuits, confectionery and snack products*.

UK TM No.887518	UK TM No.3338608
<p data-bbox="204 1361 432 1429">FOX’S</p> <p data-bbox="204 1809 743 1899">Filing date: 27 November 1965 Registration date: 27 November 1965</p>	<p data-bbox="805 1355 1021 1668"></p> <p data-bbox="805 1686 1034 1720">(series of three)</p> <p data-bbox="805 1798 1345 1888">Filing date: 14 September 2018 Registration date: 21 December 2018</p>

Class 30: Biscuits (other than biscuits for animals).	Class 30: Biscuits; biscuit confectionery; bakery goods, but excluding croutons; preparations for making bakery goods; dough, batter and mixes; chocolate; chocolate confectionery; confectionery; wafers, cakes; ice creams and edible ices; sorbets; ice cream products; puddings; savoury biscuits; crackers; cereal bars and energy bars; snack bars containing a mixture of grains, nuts and dried fruit.
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3. The holder filed a counterstatement on 12 March 2020 in which it stated that the respective goods were “only partially similar or identical”, but it denied the signs were similar. The holder also put the opponent to proof of use for earlier registration no. 8875518.

4. The opponent’s registrations both have filing dates that are earlier than the designation date and, therefore they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure for UK TM No.887518 was completed more than 5 years prior to the designation date of the contested IR, it is subject to the proof of use conditions, as per section 6A of the Act. UK TM No. 3338608 is not subject to proof of use, having not been registered for five years prior to the designation date. The opponent made a statement of use in respect of all the goods it relies on.

5. Both parties have been professionally represented in these proceedings. The opponent represented by Walker Morris LLP and the holder by Redeker Sellner Dahs PartGmbH.

6. Only the opponent filed evidence and written submissions in lieu of a hearing. I make this decision based on the material before me.

Opponents evidence

7. The opponent filed evidence in the form of a witness statement by Sarah Williams dated 24 November 2020. Ms Williams is a chartered Trade Mark Attorney at Walker Morris LLP, the opponent's legal representative. The witness statement was accompanied by six exhibits. I do not intend to summarise the evidence in detail but will refer to it below as necessary.

8. Particular points to note from the witness statement are

- the FOX's mark was first used in the UK in 1853
- it has been used on snack foods including biscuits, cakes and confectionery
- Fox's products are sold in all major UK supermarkets and online retailers

9. In Exhibit SW1, the declarant has provided an extract from an internal sales database showing that the opponent's UK sales. Unfortunately the exhibit is of poor print quality and the individual figures are difficult to make out. The UK turnover appears to range from range from £84m in 2010 to £53m in 2020. In addition, the declarant provides the opponent's advertising expenditure, set out below, since 2013 but does not explicitly state if the figures relate just to the UK.

2013/2014 - £195,447

2014/2015 - £258,291

2015/2016 - £22,176

2016/2017 - £150,376

2017/2018 - £113,799

2018/2019 - £141,793

2019/2020 - £298,732

10. The declarant also provides eleven screenshot examples of the opponent's website dated between 2005 and 2019 from the Wayback Machine internet archive service. The earlier word and stylised marks are visible on the screenshots¹. In addition, Ms Williams also states that between 2014 and 2019, analytics reports show that over 500k visits to the website took place². The evidence also demonstrates use of the mark on social media channels³ namely Facebook and

¹ Exhibit SW3

² Exhibit SW2

³ Exhibit SW4

Twitter and in the trade and national press⁴. One such article titled “Rocky Road: Fox’s Biscuits” sets out the trading history of the opponent since biscuit production began in 1853. In particular I note from this article that the opponent is described as “an extensive own label producer” and has been acquired several times in takeovers in the last forty years due to the strength of its brand.

11. That concludes my summary of the evidence

Approach

12. The opponent’s UK TM no. 3338608 is not subject to proof of use and has a broader specification than the other mark on which it relies. I intend to consider the 5(2)(b) claim first using this earlier mark.

Section 5(2)(b)

13. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

14. The following principles are gleaned from the decisions of the EU courts⁵ in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

⁴ Exhibit SW6

⁵ Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

15. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*⁶, the court stated at paragraph 23 of its judgment that:

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

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁷ for assessing similarity were:

(a) The respective uses of the respective goods or services;

⁶ C-39/97

⁷ [1996] R.P.C. 281

- (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.

17. The following case law is also applicable in relation to the contested goods in these proceedings when in *Gérard Meric v Office for Harmonisation in the Internal Market*⁸, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

18. The holder stated in its counterstatement that the contested goods were “only partially similar or identical”. However the holder did not identify which of the goods it found to be either partially similar or identical so I find this to be an inexact statement. Notwithstanding this, the holder subsequently amended its class 30

⁸ Case T- 133/05

specification on 2 August 2021. So for the avoidance of doubt I undertake a full comparison of goods below.

19. The relevant goods to be compared are:

Opponent's goods	Holder's goods (class 30 amended as of 2/8/21)
	Class 29: Nut bars
Class 30: Biscuits; biscuit confectionery; bakery goods, but excluding croutons; preparations for making bakery goods; dough, batter and mixes; chocolate; chocolate confectionery; confectionery; wafers, cakes; ice creams and edible ices; sorbets; ice cream products; puddings; savoury biscuits; crackers; cereal bars and energy bars; snack bars containing a mixture of grains, nuts and dried fruit.	Class 30: Ice, ice cream, frozen yoghurt, sorbets; coffee, tea, cocoa and substitutes therefor; edible salt, condiments, spices, flavourings for beverages, other than essential oils; processed cereals and starches for foodstuffs, and goods made therefrom; sugar; popcorn; snack food products consisting of cereal products; snacks made from potato flour; snacks made from maize; snacks made from muesli; crisps made of cereals; chocolate-based ready-to-eat food bars; crepes; hamburgers being cooked and contained in a bread roll; nachos; corn crisps; pizzas; savoury pastries; chocolate bars; rice crackers; snacks consisting principally of bread; tortilla chips; edible ices; chocolate-based products; sweets (candy), candy bars and chewing gum; muesli bars and energy bars; pastries, cakes, tarts and biscuits; marzipan; tablets (confectionery); crackers; liquorice flavoured confectionery; cereals; coffee;

	tea; cocoa; artificial coffee; bread; pastries; confectionery; iced tea; iced coffee; fruit gums; mint flavoured sweets (non-medicated); sweets (candy); chocolates; chewing candy; sweet biscuits.
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20. The following goods appear in both the opponent's and holder's specifications and are self-evidently identical, namely *ice cream, sorbets, edible ices, cakes, biscuits, crackers, energy bars*.

21. The opponent's terms *chocolate confectionery* and *confectionery* at large are broad enough to encompass the following terms in the holder's class 30 specification and are therefore considered identical on the *Merici* principle: *chocolate based ready to eat food bars; chocolate bars; Chocolate based products; sweets (candy), candy bars and chewing gum; tablets (confectionery); liquorice flavoured confectionery; confectionery; fruit gums; mint flavoured sweets (non-medicated); sweets (candy); chocolates; chewing candy; popcorn*.

22. The opponent's term *bakery goods* is broad enough to encompass the following terms in the holder's class 30 specification and are therefore considered identical on the *Merici* principle: *crepes; snacks consisting principally of bread; pastries, tarts bread; pastries; savoury pastries; pizzas*.

23. The opponent's terms *cereal bars and energy bars; snack bars containing a mixture of grains, nuts and dried fruit* are encompassed by the following terms in the holder's class 30 specification and are therefore considered identical on the *Merici* principle: *muesli bars and energy bars; snacks made from muesli; snack food products consisting of cereal products; snacks made from maize*.

24. The opponent's term *biscuits* is broad enough to encompass the following term in the holder's class 30 specification and is therefore considered identical on the *Meric* principle: *sweet biscuits*.

25. The opponent's term *crackers* is broad enough to encompass the following term in the holder's class 30 specification and are therefore considered identical on the *Meric* principle: *rice crackers*.

26. The opponent's term *preparations for making bakery goods* are broad enough to encompass the following terms in the holder's class 30 specification and are therefore considered identical on the *Meric* principle: *baking preparations and yeast; spices, processed cereals and starches for foodstuffs, and goods made therefrom*.

27. I find the opponent's term *ice cream products* to be similar to the holder's *frozen yoghurt* to a high degree on the basis that both are frozen confections. Whilst their natures are slightly different, they will share the same users and will be found in the same freezer section of a retail premises. There is also a degree of competition with each other.

28. I also find the same high degree of similarity will apply to the opponent's term *savoury biscuits* which I find to be similar to the holder's terms *snacks made from potato flour; crisps made of cereals; nachos; corn crisps; tortilla chips*. This is on the basis of all these goods being savoury products by nature, sharing the same users and being found in the same area of a retail premises. The respective goods also share a degree of competition.

29. Finally I find the holder's class 29 term *nut bars* is highly similar to the opponent's class 30 term *snack bars containing a mixture of grains, nuts and dried fruit*. Both goods contain the same ingredient in *nuts*, both are snack products in bar form and will be found in the same aisle of the supermarket. There will also be an element of competition between them.

30. In terms of the holder's remaining class 30 goods, namely *Ice, sugar; marzipan; cereals; coffee, tea, cocoa and substitutes therefor; coffee; tea; cocoa; artificial*

coffee; iced tea; iced coffee; edible salt, condiments, flavourings for beverages, other than essential oils; hamburgers being cooked and contained in a bread roll, I find there is no similarity between these goods and those of the opponent. They differ in their nature, purpose and methods of use. I regard these goods as standalone items and/or raw ingredients which are not similar to finished products. In *eSure Insurance v Direct Line Insurance*⁹, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

31. As there is no similarity for the goods detailed above, then it follows that the opposition under 5(2)(b) fails for these goods.

The average consumer and the purchasing process

32. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.¹⁰ For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question¹¹.

33. The average consumer for the contested goods will be a member of the general public. The contested goods are foodstuffs which are regular and inexpensive purchases. The goods will be self-selected from a physical retail store or from images online by an average consumer paying a medium degree of attention as

⁹ [2008] ETMR 77 CA

¹⁰ *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)

¹¹ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

there is a greater emphasis from consumers checking for dietary information or allergens. The purchasing process will be predominantly visual but there may be some aural aspect to encompass, for example, word of mouth recommendations.

Mark comparisons



34. It is clear from *Sabel BV 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. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹², 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.”

35. 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.

¹² Case C-591/12P

36. The respective trade marks to be compared are shown below:

Opponent's marks	Holder's mark
	

37. The opponent's registration is a series of three stylised word marks, namely the word FOX'S. The only difference between the marks in the series is that the first mark is rendered in gold, the second in purple and the third mark in black. The stylisation consists of a font with a slight outline feature and the different sizing of the letters, i.e. the first letter F is larger in scale than the letters O and X and the final letter S is smaller than the letters which precede it. Despite the stylisation I find the overall impression resides in the word FOX'S.

38. The holder's mark comprises a word and figurative element arrangement. The word FOXX is rendered in white on a black background and there is an image of a fox's head appearing between the two letters X and what I believe is a representation of a fox's brush at the bottom of the second letter X. Although both the verbal and figurative elements have substantial visual impact, it is the verbal element, FOXX, by which the mark is likely to be referred and which carries the greater weight in the overall impression of the mark.

39. In a visual comparison, I note the respective marks are both four letters long and share the first three letters in the same order, namely F-O-X. In terms of differences, the opponent's stylised mark has an additional apostrophe and letter S in the fourth position, whereas the holder has an additional letter X. The holder also has a figurative element which is not present in the opponent's earlier stylised mark. Taking these factors into account, I find there is a medium degree of visual similarity.

40. Turning to the aural comparison, the element shared by the marks is F-O-X, which will be pronounced identically in both cases. I find that the opponent's mark will be pronounced as FOX-IS, taking into account the apostrophe and letter S element. With regard to the holder's mark and despite the presence of the two letters X, I find it will still be pronounced as FOX. Clearly the figurative element will play no part in an aural comparison. As such I find the marks to be aurally similar to a high degree.

41. In a conceptual comparison, the opponent's mark will bring to mind the possessive form of the dictionary word FOX. The holder's mark with the double letters XX may well strike an average consumer as an odd spelling but it so closely resembles the word FOX and with the figurative image of a fox's head and brush to reinforce this, it is my view that the concept brought to mind will be that of the word FOX. Taking this into account, I find the respective marks to be conceptually identical.

Distinctive character of the earlier mark

42. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion. 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).”

43. Firstly I have to consider the mark’s inherent distinctiveness. The earlier mark consists of a possessive form of the ordinary dictionary word FOX which has no meaning in relation to the goods for which it is registered. Moreover, it has some additional stylisation. As such I find that it is inherently distinctive to a medium degree.

44. Secondly, although the opponent has not claimed enhanced distinctiveness for this mark, it is apparent from the evidence provided that the stylised mark has been used significantly on the goods and in advertising. I note the *Windsurfing Chiemsee* factors set out above as to what I should consider. I find that the opponent has a significant annual turnover and advertising expenditure. The stylised mark has been used on goods sold extensively in the UK through all major supermarkets and retailers. As such I find that the distinctiveness of the stylised mark has been enhanced through use and it is distinctive to a higher than medium degree.

Likelihood of confusion

45. There is no scientific formula to apply in determining whether there is a likelihood of confusion. 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. It is necessary for me to keep in mind the distinctive character of the opponent’s mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware 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.

46. In *Kurt Geiger v A-List Corporate Limited*¹³, Mr Iain Purvis Q.C. sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

47. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

48. 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.

49. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

¹³ BL O-075-13

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

50. During the course of this decision I have found that

- Some goods are identical and similar to a high degree, though some goods were dissimilar
- The average consumer is a member of the public who pays a medium degree of attention during a predominantly visual purchasing process
- The marks are visually similar to a medium degree
- The marks are aurally similar to a high degree
- The marks are conceptually identical
- The earlier stylised registration is inherently distinctive to a medium degree

51. Clearly there are visual similarities between the marks, namely the verbal elements being four letters long and sharing the word FOX. However, these similarities are outweighed by the visual differences of stylisation, a different fourth letter and the inclusion of a figurative element in the holder’s mark which, in my view, are sufficient for the average consumer not to directly confuse the marks, i.e. to mistake one mark for the other even for identical goods.

52. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I am reminded of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a mental

process whereby it acknowledges the differences between the marks yet attributes the common element to a shared undertaking. The common element shared by the respective marks in this case is FOX. I have found that the distinctiveness of the earlier stylised mark has been enhanced through use. Moreover the opponent has made such significant use of its mark that any other 'fox' mark would naturally be associated with it in the mind of the consumer and I find there is a likelihood of indirect confusion for those goods for I have found identity and similarity.

53. The opposition under section 5(2)(b) succeeds for the following goods:

Class 29: *nut bars*

Class 30: *ice cream, frozen yoghurt, sorbets; processed cereals and starches for foodstuffs, and goods made therefrom; popcorn; spices; snack food products consisting of cereal products; snacks made from potato flour; snacks made from maize; snacks made from muesli; crisps made of cereals; chocolate-based ready-to-eat food bars; crepes; nachos; corn crisps; pizzas; savoury pastries; chocolate bars; rice crackers; snacks consisting principally of bread; tortilla chips; edible ices; chocolate-based products; sweets (candy), candy bars and chewing gum; muesli bars and energy bars; pastries, cakes, tarts and biscuits; tablets (confectionery); crackers; liquorice flavoured confectionery; bread; pastries; confectionery; fruit gums; mint flavoured sweets (non-medicated); sweets (candy); chocolates; chewing candy; sweet biscuits.*

54. The opposition under section 5(2)(b) fails for the following goods:

Class 30: *Ice, sugar; marzipan; cereals; coffee, tea, cocoa and substitutes therefor; coffee; tea; cocoa; artificial coffee; iced tea; iced coffee; edible salt, condiments, , flavourings for beverages, other than essential oils; hamburgers being cooked and contained in a bread roll.*

Section 5(3)

55. Having found a likelihood of confusion under Section 5(2)(b), I turn to consider the claim made under section 5(3). The opponent opposed the designation under Section 5(3) of the Act based on its earlier word mark, namely UK TM No. 887518

for FOX'S, and for which it claims to have a reputation for *Biscuits (other than biscuits for animals)* in class 30.

56. In particular the opponent argues in its notice of opposition that,

“The Holder's mark is so similar to the Opponent's earlier mark, that consumers would make a link or connection between the signs. The word FOXX immediately creates an association with the Opponent's earlier FOX'S mark, particularly when used in relation to identical and highly similar goods.

As a result of the Opponent's significant reputation, use of such a similar mark by the Holder without due cause will undoubtedly take advantage of and be detrimental to the distinctive character and repute of the earlier mark.

Given the high similarity of the marks, the Opponent's reputation and the image conveyed by the earlier mark is likely to be transferred to the Holder's mark. Use of such a similar mark would allow the Holder to ride on the coat-tails of the earlier mark in order to benefit from the power of attraction, the reputation and the prestige of the earlier mark, and to unfairly exploit the significant marketing investment the Opponent has made.”

Legislation

57. The relevant part of the act states:

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (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 the repute of the earlier trade mark.”

58. The relevant case law for consideration of section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07,

Intel, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

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

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court’s answer to question 1 in L’Oreal v Bellure*).

Reputation

59. I must firstly consider whether the opponent has met the test for reputation. 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."

60. Having considered the factors set out above and weighing in the opponent's evidence, I find that use of the earlier trade mark has established a significant presence in all UK supermarkets, and in other retail outlets. The evidence demonstrates a consistent annual turnover and advertising expenditure. There are a number of both trade and mainstream press articles which reference the mark and its trading history since 1853. The press articles reference the opponent's word and stylised marks in the rubric of advertising campaigns and new product launches, eg the article from British Baker re Chunky Cookies¹⁴ and the article from the Guardian on the opponent's launch of the 'Vinnie' animated character for the TV campaign. Although no market share has been indicated, the absence of such does not negate all the other factors I must take into account. Overall, from the evidence, I find the opponent has established a reputation for *biscuits* and *confectionery*. However, I do not find that the opponent has established a reputation beyond these goods.

Link

61. As noted above, the 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* underlined below are:

¹⁴ Exhibit SW6

The degree of similarity between the conflicting marks

62. For the reasons given at paragraphs 39 to 41, I find there is a medium degree of visual similarity, a high degree of aural similarity and conceptual identity.

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

63. The contested goods will be purchased by the general public paying a medium degree of attention, for the reasons given at paragraphs 32 and 33. I have already found that the goods listed at paragraph 53 are identical and similar but that the goods listed at 54 were dissimilar. Although these goods are all foodstuffs, this is at too high a level of generality to engage similarity overall. Whilst biscuits and confectionery are somewhat connected to hot beverages by dint of them both often being consumed at the same time, I do not find it a usual progression in trade to move from producing biscuits to producing beverages. Likewise, for goods such as *sugar* and *marzipan* which are used for making biscuits, but as raw ingredients would not be produced by the same manufacturers.

The strength of the earlier mark's reputation

64. The earlier mark has a strong reputation.

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

65. For the reasons given at paragraph 43, the word FOX'S is inherently distinctive to a medium degree. Given the use which has been made of this earlier mark, I find that its distinctiveness has been enhanced. As such it is distinctive to a high degree.

Whether there is a likelihood of confusion

65. The earlier registration has considerable use and reputation for biscuits and confectionery. There is also identity and similarity between the goods of the earlier registration and some of the goods of the holder, namely *chocolate-based ready-to-eat food bars; chocolate bars; chocolate-based products; sweets (candy), candy*

bars; biscuits; confectionery; mint flavoured sweets (non-medicated); sweets (candy); chocolates; sweet biscuits. Therefore, I find that the public will make a link between the marks for these goods.

66. However I do not find that the public will make such a link for the remaining goods *Ice, sugar; marzipan; cereals; coffee, tea, cocoa and substitutes therefor; coffee; tea; cocoa; artificial coffee; iced tea; iced coffee; edible salt, condiments, spices, flavourings for beverages, other than essential oils; hamburgers being cooked and contained in a bread roll.*

67. The opposition is therefore successful under section 5(3) for the goods set out at paragraph 60.

Section 5(4)(a)

68. Finally I turn to the claims made under section 5(4)(a) of the Act. The opponent opposed the designation based on its alleged earlier rights in the sign FOX'S. It claims to have used this sign on *biscuits, confectionery and snack products* since 1853 and has acquired goodwill to that end. Use of the designation would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

69. However in my previous findings under section 5(2)(b) and 5(3), I established that the opponent had demonstrated use and reputation for *biscuits and confectionery* but had failed to establish use and reputation on the other goods set out in paragraph 54. As such the case pleaded on section 5(4) will take the opponent no further forward than the case made out on the other grounds.

Conclusion

70. The opposition has partially succeeded. Subject to any appeal of this decision, the designation will be refused for the following goods:

Class 29: *nut bars*

Class 30: ice cream, frozen yoghurt, sorbets; processed cereals and starches for foodstuffs, and goods made therefrom; popcorn; spices; snack food products consisting of cereal products; snacks made from potato flour; snacks made from maize; snacks made from muesli; crisps made of cereals; chocolate-based ready-to-eat food bars; crepes; nachos; corn crisps; pizzas; savoury pastries; chocolate bars; rice crackers; snacks consisting principally of bread; tortilla chips; edible ices; chocolate-based products; sweets (candy), candy bars and chewing gum; muesli bars and energy bars; pastries, cakes, tarts and biscuits; tablets (confectionery); crackers; liquorice flavoured confectionery; bread; pastries; confectionery; fruit gums; mint flavoured sweets (non-medicated); sweets (candy); chocolates; chewing candy; sweet biscuits.

71. The designation can proceed to registration for the following goods in class 30 in addition to the remaining classes which were not involved in this opposition (save for the term *nut bars* in class 29 which is referenced above).

Class 30: Ice, sugar; marzipan; cereals; coffee, tea, cocoa and substitutes therefor; coffee; tea; cocoa; artificial coffee; iced tea; iced coffee; edible salt, condiments, flavourings for beverages, other than essential oils; hamburgers being cooked and contained in a bread roll.

Costs

72. The opponent has been partially successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows:

£200 Official fee for opposition

£400 Preparing a Notice of Opposition and considering the other side's statement

£500 Preparing evidence

£300 Preparing written submissions

£1400 Total

73. I order Autobahn Tank & Rast GmbH to pay Fox's Biscuits Limited the sum of £1400. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of October 2021

June Ralph

For the Registrar

The Comptroller-General