

O/726/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3593064
IN THE NAME OF JOHN WOODS (LISGLYN) LIMITED FOR THE TRADE MARKS



(A SERIES OF THREE MARKS)

IN CLASS 29

AND

THE OPPOSITION THERETO UNDER NUMBER 425761
BY CLC LICENCING LIMITED

Background and pleadings

1. On 9 February 2021, John Woods (Lisglyn) Limited (“the applicant”) filed an application for the series of three trade marks shown on the cover page of this decision (number 3593064), in Class 29, for:

Prepared snacks; processed fruits, fungi, vegetables, nuts and pulses; edible nuts and seeds; processed edible nuts and seeds; seed based snacks; processed flaxseed; processed chia seeds; plant based seeds; seaweed based seeds; flaxseed; chia seeds; edible pumpkin seeds; edible sunflower seeds; edible sesame seeds; sprouted seeds; seeds containing vitamins and minerals from plant sources; prepared meals and prepared snacks consisting principally of nuts or edible seeds.

2. The application was published on 23 April 2021 and opposed by CLC Licencing Limited (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier trade mark registration for its section 5(2)(b) and 5(3) grounds:

3488999



Filing date: 12 May 2020; date of entry in register: 9 October 2020

Class 29: *Preserved, frozen, dried and cooked fruits, vegetables and seeds; edible seeds; processed seeds; processed edible seeds; dry roasted seeds; dry roasted sunflower and sesame seeds in a savoury sauce; fruit- and nut-based snack bars; seed-based snack bars; snack foods consisting primarily of mixtures of dried seeds and dried fruit; chocolate coated seeds; flavoured edible seeds.*

3. Under section 5(2)(b) of the Act, the opponent claims that the parties' goods are identical or highly similar and the marks are highly similar, leading to a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent claims a reputation in its mark for the registered goods such that the relevant public will believe the parties' marks are used by the same undertaking or that there is an economic link between the users of the marks. The opponent also claims that use of the applicant's marks will erode the distinctiveness of the earlier mark, damage its repute if used in relation to goods of less quality than the opponent's goods, and give an unfair advantage to the applicant by virtue of the reputation of the earlier mark.

5. The opponent's section 5(4)(a) ground is based upon its use of two signs. The first sign is the same as its registered mark. The second sign is as follows:



6. The goods in relation to which it is claimed that the signs have been used correspond to the specification of the opponent's registered mark, set out above. The opponent states that its signs have been used throughout the UK since September 2019. The opponent claims that its goodwill in the business distinguished by its signs entitles it to prevent the use of the application under the law of passing off.

7. The applicant filed a defence and counterstatement, denying the grounds of opposition.

8. The opponent is professionally represented by Dummett Copp LLP. The applicant is represented by Murgitroyd & Company. Both parties filed evidence and written submissions during the evidence rounds. Neither party requested a hearing, but the

applicant filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Section 5(2)(b) of the Act

9. Section 5(2)(b) states:

“5. (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 of association with the earlier trade mark.”

10. Section 5A states:

“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.”¹

11. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

¹ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

12. The parties' competing goods are shown in the table below:

The opponent's goods	The applicant's goods
<i>Class 29: Preserved, frozen, dried and cooked fruits, vegetables and seeds; edible seeds; processed seeds; processed edible seeds; dry roasted seeds; dry roasted sunflower and sesame seeds in a savoury sauce; fruit- and nut-based snack bars; seed-based snack bars; snack foods consisting primarily of mixtures of dried seeds and dried fruit; chocolate coated seeds; flavoured edible seeds.</i>	<i>Class 29: Prepared snacks; processed fruits, fungi, vegetables, nuts and pulses; edible nuts and seeds; processed edible nuts and seeds; seed based snacks; processed flaxseed; processed chia seeds; plant based seeds; seaweed based seeds; flaxseed; chia seeds; edible pumpkin seeds; edible sunflower seeds; edible sesame seeds; sprouted seeds; seeds containing vitamins and minerals from plant sources; prepared meals and</i>

	<i>prepared snacks consisting principally of nuts or edible seeds.</i>
--	--

13. The applicant submits that the goods are only similar to an average degree on the basis that certain seeds have a specific purpose and are not usually consumed for snacking; such as chia, pumpkin or sesame seeds. The applicant submits that these seeds are used as a garnish in cooking and have different intended purposes and will target different end users.

14. I do not accept this submission. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa).² The opponent has cover for "preserved, frozen, dried and cooked...seeds" and "edible seeds" which encompass the applicant's *edible...seeds, processed edible...seeds, processed flaxseed; processed chia seeds; plant based seeds; seaweed based seeds; flaxseed; chia seeds; edible pumpkin seeds; edible sunflower seeds; edible sesame seeds; sprouted seeds; and seeds containing vitamins and minerals from plant sources*. These goods are identical.

15. The applicant's *seed based snacks* are identical to the opponent's *seed-based snack bars*. The applicant has cover for *prepared snacks*. This encompasses the opponent's "fruit- and nut-based snack bars; seed-based snack bars; snack foods consisting primarily of mixtures of dried seeds and dried fruit".

16. The applicant's *prepared snacks consisting principally of edible seeds* are identical to the opponent's "edible seeds", "chocolate coated seeds", "flavoured edible seeds" and "seed-based snack bars". They are also identical to the opponent's "snack foods consisting primarily of mixtures of dried seeds and dried fruit" and, if not identical because the opponent's snack foods also contain fruit, they are near-identical.

17. The applicant's *processed fruits, fungi, vegetables and pulses* are identical to the opponent's "Preserved, frozen, dried and cooked fruits, vegetables".

² *Gérard Meric v OHIM*, Case T-33/05, General Court.

18. This leaves the applicant's *processed nuts; edible nuts; processed edible nuts; and prepared meals and prepared snacks consisting principally of nuts and prepared meals consisting principally of edible seeds* which are not identical to the opponent's goods, requiring an assessment to be made as to whether the respective goods are similar and, if they are, how similar. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

19. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

20. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union (“GC”) stated that “complementary” means:

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

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

22. *Processed nuts; edible nuts; and processed edible nuts* are highly similar to the opponent's "preserved, frozen, dried and cooked...seeds" and "edible seeds". They are small edible morsels, often sold in packets side by side in supermarkets and often sold as nut and seed combinations. They may be used for snacking, sprinkling on breakfast cereal, incorporating into savouring meals, or in baking. The nature, purpose, method of use, users and channels of trade are the same or almost so. They are not complementary in the sense of the caselaw, but they are in competition as alternatives.

23. *Prepared meals consisting principally of edible seeds* are similar to between a medium and high degree to the opponent's "snack foods consisting primarily of mixtures of dried seeds and dried fruit". If not sold cheek by jowl, they are in competition, have similar natures, purposes and methods of use. There is little difference between a prepared meal and a snack; e.g. a pot of instant pasta or noodles might be considered to be a snack or a prepared meal. One might choose a prepared meal consisting principally of edible seeds, a prepared meal consisting principally of nuts or a prepared snack consisting principally of nuts instead of a snack consisting primarily of mixtures of dried seeds and dried fruit.

The average consumer and the purchasing process

24. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."³ The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

25. The average consumer for the parties' goods is a member of the general public. The various goods will be selected with an average level of care, or an above average

³ *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).

level of care if food allergies (e.g. sesame and nut) are a consideration. The goods will be bought through primarily visual means, with the goods most often being selected from supermarket shelves (or the online equivalents). There may also be an aural aspect to the purchase if the goods are bought in, for example, a delicatessen.



Comparison of marks

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

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

27. 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.

28. The marks to be compared are:

The opponent's mark	The applicant's series of marks
	

29. The opponent's mark consists of two, offset, black tear-dropped shapes, the larger one at the top. This shape has a slightly more pointed end than the smaller shape below it. The pointed ends of the shapes point in opposite directions (right and left). The word MUNCHY is super-imposed on the top shape and the word SEEDS on the lower shape. The words are both represented in white block capitals to which the eye is drawn which contributes to the words being slightly more dominant in the overall impression of the mark. I will come back to their distinctive weight later in this decision.

30. The three marks in the applicant's series vary only in respect of colour and the short lines emanating from marks two and three, which do not appear in the first mark in the series. The other details are the same in all three marks: a larger oval flanked by eight much smaller ovals to the left and right, split into two groups of four like an insect's body and legs. The larger ovals are positioned diagonally, pointed at one end towards the top right. Each large oval bears the words The Little Seed Co in white/off-white lettering. The central positioning of the words means that the eye is drawn to

them and they are slightly more dominant than the device components in the overall impression of the mark. I will come back to the distinctive weight of the words later in this decision.

31. Of the parties' respective words, only SEEDS and Seed are similar. There is some similarity in respect of both parties' marks containing pointed ovals which are slanted across the marks. That is where the visual similarities end. The small ovals on either side of the applicant's larger ovals have no counterpart in the opponent's mark, and neither do the short lines emanating from the sides of the second and third marks in the applicant's series of marks. The parties' marks are visually similar to a very low degree.

32. Only the words in the parties' marks will be articulated. Only SEEDS/Seed are similar. SEEDS is the second of the opponent's two words; Seed is the third of the applicant's four words. Bearing these respective positions in mind and that none of the other words in the parties' marks bear any similarity to one another, there is no more than a low degree of aural similarity between the parties' marks.

33. The online Oxford English Dictionary gives the following definition for 'munchy, *adj*':⁴

“colloquial (originally and chiefly U.S.).

*That may be munched; suitable for eating as a snack...Cf. MUNCHABLE *adj*.”*

For 'munch' as a noun, the definition is: "something to eat; a meal, a snack. Also: an act of munching." As a verb, transitive or intransitive, the chief meanings of 'munch' are "to eat (food) with a continuous and noticeable chewing action; to eat eagerly and audibly, or with evidence enjoyment; to make a snack of..."; and "to eat with conspicuous action of the jaws; to chew eagerly or audibly *on* something...".

⁴ As at 21 July 2022.

34. MUNCHY SEEDS forms a unitary meaning which is seeds which are good to eat, as a snack or meal: they are good for munching on. The seed-shaped devices in the opponent's mark reinforce the concept of seeds.

35. "Co" in the The Little Seed Co will be interpreted as the common abbreviation for "Company" (meaning a company or firm). 'Little' is far more likely to be seen as the adjective qualifying 'Co' than qualifying the size of the seeds sold by the company. The Little Seed Co will be perceived as a small company selling seeds. The seed-shaped devices in the applicant's mark reinforce the concept of seeds.

36. There is a degree of conceptual similarity arising from the parties' use of seed-shaped devices and from the inclusion in their wording of SEEDS/Seed. That is where the conceptual similarity ends. The main conceptual message of the opponent's mark is that the seeds are good to eat. The main conceptual message of the applicant's marks is of a small company selling seeds. The arrangement of the larger and smaller ovals may evoke a creature or insect, but this is not a central concept. Overall, there is a very low degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

37. 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.⁵ The relevant date for the assessment of distinctive character of the earlier mark is the date of application of the contested mark: 9 February 2021. I will begin by considering the inherent distinctive character of the earlier mark.

38. Most of the goods covered by the opponent's registration are seed-related. For these goods, the mark has a very low degree of inherent distinctive character because it is composed of a descriptive word, SEEDS, an adjective which describes the SEEDS as being good to eat (they are munchy) and devices which are strongly reminiscent of seeds. For goods which are not seed-based (the registration covers 'preserved, frozen, dried and cooked fruits and vegetables'), the inherent distinctive character is

⁵ *Sabel BV v Puma AG*, Case C-251/95.

low. I put it no higher than that because the mark still contains a word descriptive of eating (munchy) and shapes reminiscent of seeds, from which fruits and vegetables are grown, and which are characteristics that fruits and vegetables may contain upon preparation and/or consumption. The applicant has filed evidence from its Commercial Director, Patrick Woods, who states that it is his professional opinion that the parties' goods are very often presented in a way which includes the outline shape of seeds or nuts.⁶ Exhibit PW1 comprises prints of screenshots from websites showing packaging originating from UK retailer or manufacturers showing the trade use described by Mr Wood. These prints are dated 22 March 2022, which is after the relevant date. In any event, I have reached my conclusion that the mark is very low (or low) in inherent distinctive character simply because of the components of the mark, without the need for evidence. It is not possible to find that the mark has no distinctive character because it is registered and section 72 of the Act states:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

39. I turn now to look at the opponent's evidence about its use and whether it improves the very low (or low) level of inherent distinctive character. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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

⁶ Witness statement dated 25 March 2022 and exhibits.

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).

40. The opponent's evidence comes from Lucinda Clay, who is a founder and director of the opponent.⁷ Exhibit LC5 comprises screenshots from major high street retailers, showing the opponent's products bearing the earlier marks. These are all undated. Ms Clay states that the opponent's products have been stocked with each of the following retailers within the last five years: Tesco (1,200 stores), Sainsbury's (850 stores), Co op (30 stores), Waitrose (240 stores), Ocado, Amazon, Lakeland, Holland and Barrett and Whole Foods Market. Ms Clay state that the opponent's goods are offered via Suffolk Food Hall (Ipswich), Friday Street farm shop (Saxmundham, Suffolk), St Giles Pantry, (Norwich), Nandos, Itsu and Wagamama's.

41. Ms Clay gives the following revenue and advertising figures:

Year	Total sales revenue (£)	Marketing spend (£)
2017	2,453,003	128,388
2018	1,964,341	128,094
2019	2,023,405	119,744
2020	1,566,496	92,913
2021	833,144	58,695

42. Ms Clay states that the opponent's sales were significantly affected in 2020 and 2021 by the pandemic (only the first month of 2021 is relevant). A selection of sales invoices (wholesale) is provided at Exhibit LC6. The invoices from 2017, 2018, 2019 and one from 2020 do not show the mark: they say 'Munchy Seeds'. Other invoices show a mark in the form of the second sign relied upon under section 5(4)(a), which is different to the registered mark relied upon for sections 5(2)(b) and 5(3):

⁷ Witness statement dated 19 January 2022 and exhibits.



43. Six of the invoices showing the above sign are dated after the relevant date, the other four are dated 14 August 2020, 16 August 2020, 30 September 2020 and 15 December 2020. Exhibit LC2 comprises screenshots from the opponent's website, munchyseeds.co.uk, and from the website of ocado.co.uk, showing the earlier mark on packets of seed-related food products; however, the pages say that the images were accessed on 20 January 2022, almost a year after the relevant date. This exhibit does not assist in showing use prior to the relevant date. Exhibit LC3 includes a print of a photograph taken of a stall displaying the opponent's products. It is undated, although I note that Ms Clay states that stalls were a very significant part of the opponent's business before the Covid-19 pandemic, which began in the UK in March 2020. The packets on the stall appear to show the earlier mark. The opponent attended about forty events a year, such as the BBC Good Food show, county shows, food festivals and 'Country Living' fairs. Exhibit LC4 comprises a list of the events the opponent was due to attend in 2022, but this is after the relevant date so does not assist.

44. Exhibit LC7 comprises examples of marketing material, which Ms Clay describes as leaflets, advertisements, the opponent's 'Munchy News' newsletter, its website blog, recipes on the opponent's website, competitions, parties for new product launches and invoices in relation to marketing expenditure. There is a draft form of a flyer dated 5 September 2019 showing the earlier mark, and five invoices from design and marketing companies dated 8 September 2020, 30 September 2020, 28 February 2021, 30 June 2021 and 31 August 2021. Only the first two are dated prior to the relevant date and none show any marks. There are no versions of the September 2019 flyer other than in draft form. Another flyer showing the earlier mark is undated, but there is a 20% offer if the customer uses the code SPRINKLEOVER20. The '20'

could refer to 2020, but could also refer to 20%. The latter appears more likely as the offer expired on 31 December 2021. Another flyer appears to be a draft because it says “[Email header 2021]”. The relevant date is 9 February 2021. An undated promotional information document shows the mark with the extra seeds around it. A website screenshot showing the extra seed version of the mark was accessed on 20 January 2022, almost a year after the relevant date. A screenshot of the opponent’s Instagram page shows the extra seeds version as the opponent’s logo, but also shows a picture which includes packets bearing the registered mark. This Instagram post is dated 2 October 2020. It has with 294 ‘likes’. Ms Clay states that the opponent’s Instagram account has approximately 11,400 followers, but it is seems that this was at the date of her witness statement because Exhibit LC8 contains prints from the opponent’s Facebook, Instagram and Twitter accounts which were accessed on 19 January 2022. The Facebook and Twitter pages refer to 2022.

45. The evidence which shows the mark in the form above (i.e. the second sign relied upon under section 5(4)(a)) differs from the registered mark because it includes six small ‘scattered’ seed-shaped devices around the components which make up the registered mark. That the use of a mark has been with other matter (in this case, the extra little seeds) is not necessarily a bar to a finding of enhanced distinctive character; it depends on the facts of the case, including the nature of the use and the distinctiveness of the mark itself. In *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, the CJEU held that a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. The CJEU stated in *Specsavers v Asda* Case C-252/12, at paragraph 23, that it is necessary that “the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking.”

46. The issue is that the earlier mark is inherently of only very low distinctive character. If the mark relied upon was inherently of a reasonably high distinctive character, the addition of the (at best) weakly distinctive small seed elements would not alter the inherent or enhanced capacity of the mark to signify the goods as originating from a given undertaking. The relative distinctiveness of the earlier mark and the component(s) added to it in use are relevant factors to take into account in the assessment. The evidence of use of the mark with the small seeds surrounding it

does not assist in showing that the distinctiveness of the registered mark has been enhanced.

47. In the notice of opposition, the opponent relies upon two signs for the section 5(4)(a) ground, one of which corresponds exactly to the registered mark relied upon for sections 5(2)(3) and 5(3) of the Act. The opponent states that both of the signs have been used since September 2019. This raises a question in my mind as to what mark the pre-September 2019 evidence relates. For instance, Ms Clay states that the opponent's products have been stocked in the major high street retailers "within the last five years". That could mean that other marks have been used on the products, particularly given the section 5(4)(a) pleadings which state that use commenced in September 2019. The draft flyer in Exhibit LC7 has a date of 5 September 2019. I cannot tell whether the photograph of the stall, which is undated, showed the goods as they would have appeared prior to the relevant date. It is not stated that they looked like this; all that is stated is that stalls were an important part of the opponent's business prior to the pandemic.

48. Exhibit LC10 comprises copies of press articles. Only two pre-date the relevant date. An article, in an unidentified publication, shows the earlier mark on packets; however the article is dated after the relevant date: "June/July 2021 Vanilla" ('Vanilla' is possibly the name of the publication). Another article is from the US Sun newspaper. Although there is an image of a packet of seeds with the earlier mark upon it, apart from this being a US newspaper website (I have noted that the prices of the goods in the article are in pounds sterling), the date of publication is 2 January 2022, eleven months after the relevant date.

49. An article from a website called "FoodBev Media" is dated 9 March 2021, a month after the relevant date. Packets of the opponent's new range of seed mixes are shown, showing the mark relied upon. The article says that the products "will launch into Ocado". There is another article which refers to the products launched in March 2021 for which a listing has been secured with Ocado, from a website called Bakeryandsnacks.com, dated 16 August 2021, six months after the relevant date. I note that some of the 2020 invoices are to Ocado, prior to the relevant date, showing the extra seeds version of the mark.

50. The high point of the press evidence is an article in TopSanté dated 11 December 2019 which shows a packet of the opponent's Sweet Chilli seeds, bearing the earlier mark.

51. The other article which dates from prior to the relevant date was published in the East Anglian Daily Times, on 21 October 2018. The earlier mark is not visible, nor the extra seeds version. What appears is the following:



52. Mr Wood, for the applicant, states that he conducted an online search of the opponent's website using the internet archive, the 'Wayback Machine'. Mr Wood states that as late as 2019, the opponent was using a mark that is different to the earlier registration relied upon. He exhibits prints from the Wayback Machine from 2014, 2017 and 2019.⁸ The print for 12 February 2019 shows the following page:



53. Another print with the same date shows the following goods:

⁸ Exhibit PW2 to Mr Wood's witness statement.



Salted Caramel
(<https://web.archive.org/web/20190212003440/https://www.munchyseeds.co.uk/product/salted-caramel/>)



Choccy Ginger
(<https://web.archive.org/web/20190212003440/https://www.munchyseeds.co.uk/product/choccy-ginger/>)



Honey Seeds
(<https://web.archive.org/web/20190212003440/https://www.munchyseeds.co.uk/product/honey-seeds/>)



Omega Sprinkles
(<https://web.archive.org/web/20190212003440/https://www.munchyseeds.co.uk/product/omega-sprinkles/>)

54. Four prints dated 8 June 2016 show the following:

The Wayback Machine - <http://web.archive.org/web/20170608062758/http://www.munchyseeds.co.uk:80/>



[/web/20170608062758/https://www.munchyseeds.co.uk](http://web.archive.org/web/20170608062758/https://www.munchyseeds.co.uk)

[/about-munchy-seeds/](http://web.archive.org/web/20170608062758/https://www.munchyseeds.co.uk/about-munchy-seeds/)



[Sesame Sprinkles \(http://web.archive.org/web/20170608062758/http://www.munchyseeds.co.uk/product](http://web.archive.org/web/20170608062758/http://www.munchyseeds.co.uk/product)



[/sesame-sprinkles/](#)

[Savoury Crunch \(http://web.archive.org/web/20170608062758/http://](http://web.archive.org/web/20170608062758/http://)



55. The mark relied upon does not appear in any of the prints; nor are there any marks like it.

56. Whilst it is for the opponent to prove that the use it has made of its mark entitles it to claim an enhanced level of distinctiveness and the applicant's attempt to prove a negative would normally carry relatively less weight, in this case there are many gaps in the opponent's evidence, particularly as to what mark(s) it was using prior to September 2019 and prior to the relevant date. The paucity of cogent evidence from the opponent throws the applicant's Wayback Machine evidence into relief. Of significance is that, effectively, the applicant has made a challenge that the opponent

was not using the mark relied upon on as at 12 February 2019 and before that date. It should have been a simple matter for the opponent to refute that challenge by filing evidence in reply showing earlier evidence of use of the mark relied upon. I note that the opponent has elected not to close the gap identified by the applicant. The inference is that there is no evidence of use of the mark relied upon prior to the earliest date which the opponent's evidence shows: the article in TopSanté dated 11 December 2019 which shows a packet of the opponent's Sweet Chilli seeds, bearing the earlier mark.

57. Looking at the evidence in the round, including whether individual exhibits corroborate one another, it reveals that the mark relied upon, or the version with the seeds around it, were not used prior to September 2019; in fact the earliest use appears to be 11 December 2019. The invoices showing the extra seeds version are dated in 2020 or after 2020. This all means that the turnover figures for 2017, 2018 and the majority of 2019 are not relevant. Whilst the screenshot of the opponent's Instagram page shows a picture which includes packets bearing the registered mark, this is dated 2 October 2020, only four months before the relevant date. Although it had 294 'likes', the other Instagram evidence was accessed on 19 January 2022 and Ms Clay's statement that the account has (present tense) 11,400 followers has not been pinned down to the relevant date (or prior to the relevant date).

58. Given the shortcomings in the evidence, I find that the inherent distinctive character of the earlier mark has not been enhanced through use.

Likelihood of confusion

59. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' goods are identical or similar to between a medium and high degree, a point in the opponent's favour.

60. However, there are also points going in the applicant's favour. The marks are only similar to a very low degree visually and conceptually, and to a low degree aurally. The degree of aural similarity carries less weight in the global assessment because the purchasing process is primarily visual for the goods and services at issue.⁹

61. There are two types of confusion: direct and indirect. Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind.¹⁰ Of significance in the global assessment in this case is that the earlier mark has only a very low degree of distinctive character for most of the goods, and only a low degree in respect of the others.¹¹ This is particularly so in respect of the only elements which are similar to both marks: SEEDS/Seed and the shapes of seeds, for goods which are seed-related. These elements in both marks are of very low or no distinctive character. Caution is required before finding that there is a likelihood of confusion on the basis of a common element(s) that is descriptive and therefore low in distinctiveness; in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch), Arnold J observed:

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

62. The parties refer to the CJEU's decision in *L'Oreal v OHIM*, Case C-235/05 P, for the proposition that an earlier mark weak in distinctive character does not preclude a likelihood of confusion. That does not mean that other factors may not contribute to or counteract a likelihood of confusion. Mr Philip Harris, sitting as the Appointed Person in *Stockroom (Kent) Ltd v Purity Wellness Group Ltd*, BL O/115/22 stated:

“62. Taken alone, *L'Oreal* confirms that the mere fact a prior mark is weak/of low distinctive character does not preclude a finding of a likelihood of confusion

⁹ GC, *New Look v. OHIM*, Joined Cases T-117/03 to T-119/03 and T-171/03.

¹⁰ *Lloyd Schuhfabrik Meyer*, at [26].

¹¹ Preserved, frozen, dried and cooked fruits and vegetables.

with a later mark containing the same or a similar element of equally low distinctive character. That is uncontroversial. However, it is not the whole story, and the application of the case's principle needs to be tempered by *Whyte and Mackay* (*ibid.* [49]) and, of course, by the individual facts of each case.”¹²

63. That case concerned an earlier mark, PURITY GEL and a mark in which the dominant component was PURITY HEMP COMPANY. Mr Harris said:

“74. The Earlier Mark “Purity Gel” is unitary, describing a “gel of purity” or a gel which is pure. The key words in the Contested Mark are PURITY HEMP COMPANY, a unitary term denoting an undertaking dealing in hemp of purity or hemp which is pure, an impression emphasised to at least some consumers aware of such things by what the Hearing Officer called a “stylised hemp leaf”.

[...]

78. Furthermore, both marks contain additional features which modify their impression, and which will not go unnoticed. “Purity Gel” suggests a gel-based product. PURITY HEMP COMPANY suggests a corporate entity and the mark is highly stylised including a prominent figurate hemp leaf design. All of these features help to differentiate the marks.

[...]

80. [...] The overall differences outweigh the similarity, which is entirely due to the weak components.”

64. In the present case, the only visual and conceptual similarity between the marks arises from non-distinctive elements or elements which are very low in distinctive character. There is no distinctive similarity. The overall impressions of the marks are different, visually, aurally and conceptually. The central concept of the earlier mark is

¹² See also *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393 (Ch).

of the goods, seeds, which are good to eat. The central concept of the application is of a small company which sells seeds. These unitary meanings are entirely different and are what the average consumer will retain in their mind. The visual similarities will not cause any counteraction against the different conceptual hooks and, nevertheless, cause confusion a) because they consist of elements which are of no or a very low degree of distinctiveness; and b) because, whilst not negligible, they are not the dominant part of either mark. There is no likelihood of direct confusion between the marks; i.e. the marks will not be mistaken for one another.

65. Direct confusion is one way in which a likelihood of confusion arises; the other is where the average consumer is 'indirectly' confused. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

“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”*.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

66. I find that the marks will not be indirectly confused. As pointed out by Mr James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Limited v Ashish Sutaria*, “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”, before observing that the differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion.¹³ In the present case, the different concepts do not suggest a brand evolution, a sub-brand or co-branding. In *Duebros Limited v Heirler Cenovis GmbH*, Mr Mellor, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.¹⁴ This is all the more so when any similarity is down to elements of no or very low distinctive character. There is no likelihood of confusion, directly or indirectly.

67. I add here that even if I had found the earlier mark’s level of distinctiveness to have been enhanced, my decision would have been the same. Any enhancement would have been for the whole of the earlier mark, and not in respect of the similar elements, divorced from the whole, which have no or very low distinctive character. The marks are too different to be confused.

¹³ BL O/219/16

¹⁴ BL O/547/17

Section 5(2)(b) outcome

68. The section 5(2)(b) ground of opposition fails.

Section 5(3) of the Act

69. Section 5(3) states:

“(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 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”.

70. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

71. The relevant case law in relation to section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 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 on 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*).

72. For a successful claim under section 5(3), cumulative conditions must be satisfied by the opponent: similarity between the marks; a qualifying reputation in the earlier mark; a link between the marks (the earlier mark will be brought to mind on seeing the later marks); and one (or more) of the claimed types of damage (unfair advantage and/or detriment to distinctive character and/or detriment to the repute of the earlier mark). It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

73. The first condition of some degree of similarity between the marks is satisfied, as found earlier in this decision.

74. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

“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."

75. Earlier in this decision, I found that the earlier mark does not benefit from an enhanced degree of distinctive character because of the shortcomings in the evidence. Those shortcomings apply equally in respect of considering whether the earlier mark had a sufficient reputation for section 5(3) at the relevant date, 9 February 2021. I find that the earlier mark did not have a qualifying reputation at the relevant date.

76. Even if I were wrong about that, the ground of opposition fails. Although a finding of a likelihood of confusion is not necessary to find that there is a link between the marks, it is not irrelevant either.¹⁵ The relevant public will not make a link between the parties' marks because the differences between them are too great and the only similarities are to be found in elements of no, or very low, distinctiveness. The earlier mark will not be brought to mind by the later marks.

Section 5(3) outcome

77. The section 5(3) ground fails.

¹⁵ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, CJEU; and *Intel*.

Section 5(4)(a)

78. Section 5(4)(a) states:

“(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.”

79. 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.”

80. The three elements which the opponent must show are well known. 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)."

81. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223:

"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."

82. In a case where the contested mark is unused, it is the date when the application was made for the contested mark (in this case, 9 February 2021) which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.¹⁶ The applicant has not filed evidence that it has used its mark, which means that the relevant date is 9 February 2021. The opponent must show that it had sufficient goodwill at that date to bring the claim.

83. Ms Clay states that the opponent's goods are offered by Lawncourt Harvest Limited, of which she is a director, and that use of MUNCHY SEEDS branding and logos is under licence from the opponent:

¹⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

“Any use of the mark by LAWCOURT HARVEST LIMITED is considered effectively use by CLC Licensing Limited, with any goodwill and reputation accruing to CLC Licencing Limited.”

84. This is assertion, unsupported by evidence to show that the opponent is the owner of the goodwill generated by the licensee. However, I note that the applicant has not raised the point; its submissions have been about insufficient goodwill/trivial goodwill, not the opponent’s standing. I will go on to explain why, in any event, the section 5(4)(a) claim fails even if this issue had not arisen and the opponent was the proven owner of the goodwill claimed.



85. The opponent claims that it has used its signs since September 2019. This is a period of one year and four months prior to the relevant date. It also means that the evidence and turnover prior to the claimed date of first use of September 2019 is not relevant. The sales figures for 2020 amount to £1,566,496, with £92,913 spent on advertising. These figures can be taken into account. The figures for 2019 are only relevant in so far as they relate to the last three months of that year. There has been no identification of the sales figures for September 2019 to December 2019. The total sales figures for 2019 were £2,023,405, with £119,744 spent on advertising. Only potentially a quarter of these figures are relevant. Only the first month of the 2021 figures are relevant (the total sales for 2021 were £833,144, with £58,695 spent on advertising).

86. The goods are inexpensive. Although the period of time between the claimed date of first use and the relevant date is relatively short, the 2020 figures are sufficient to make a finding that there was goodwill in the business at the relevant date. The goodwill was not substantial, both in terms of length of time and the inherently weak distinctiveness of the signs relied upon. The next question is which sign (or whether both) was distinctive of the business.

87. As stated earlier in this decision, the opponent relies upon two signs for this ground of opposition:



88. The first sign corresponds to the earlier registered mark relied upon for the section 5(2)(b) and 5(3) grounds. Both signs are relied upon in relation to the same goods as for the earlier registered mark. The second sign might be said to be closer in similarity to the application because it contains small seeds either side of larger seeds:

The opponent's second sign	The applicant's series of marks
	 <p>The three variations of the logo are: <ul style="list-style-type: none"> Top: "The Little Seed Co" in a white, cursive font on a black, rounded seed shape, surrounded by small black seeds. Middle: "The Little Seed Co" in a white, cursive font on a black, rounded seed shape, surrounded by small black seeds and radiating lines. Bottom: "The Little Seed Co" in a white, cursive font on a red, rounded seed shape, surrounded by small red seeds and radiating lines. </p>

89. The second sign represents the better case for the opponent. Even if I were to find goodwill in relation to the first sign, it is claimed that use has taken place for the same goods as I considered for the section 5(2)(b) ground, for the same sign/mark. For the same reasons as there would be no likelihood of confusion, a substantial

number of the opponent's customers would not be deceived.¹⁷ Although the average consumer test is not strictly the same as the 'substantial number' test, in the light of the Court of Appeal's judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. In relation to the first sign, all other factors are equal.

90. In relation to the second sign, some of the 2020 invoices show the sign, and it appears on the 2 October 2020 Instagram post. Although I find that this sign was distinctive of the opponents' business at the relevant date, I remain of the view that the opponent's customers (or potential customers) will not engage in an analysis which brings them to a conclusion that the presence of non-distinctive similar elements (SEED/Seeds and the shape of seeds) signifies the opponent's goods, or that of a business connected with the opponent. The sign and the application are too different overall. As Lord Simonds stated in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39,

“[...] A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

91. The section 5(4)(a) ground fails.

Overall outcome

92. The opposition fails. The application may proceed to registration.

¹⁷ *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473.

Costs

93. The applicant has been successful and is entitled to a contribution towards its costs, based upon the published scale.¹⁸ The applicant requests costs off the scale:

“ [...] given the conditions in which its evidence was introduced into the proceedings, and the spurious nature of these proceedings.”¹⁹

94. In *Goya Foods Inc. v Asnakech Thomas (“Amaro Gayo”)*, BL O/257/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered an off-scale costs request for a withdrawn appeal. Mr Hobbs said:

“13. The long established practice in Registry proceedings is to require payment of a contribution to the costs of a successful party, with the amount of the contribution being determined by reference to published scale figures. The scale figures are treated as norms to be applied or departed from with greater or lesser willingness according to the nature and circumstances of the case. The use of scale figures in this way makes it possible for the decision taker to assess costs without investigating whether or why there are: (a) disparities between the levels of costs incurred by the parties to the proceedings in hand; or (b) disparities between the levels of costs in those proceedings and the levels of costs incurred by the parties to other proceedings of the same or similar nature. The award of costs is required to reflect the effort and expenditure to which it relates without inflation for the purpose of imposing a financial penalty by way of punishment on the paying party.”

95. The parties attended a case management conference (“CMC”), caused by the opponent’s request for an extension of time in which to file its evidence. The extension of time request was for two months and was refused by the Intellectual Property Office because the reasons given were deemed to be insufficient. Ultimately, the opponent was permitted an extra fortnight to file its evidence. However, the opponent should

¹⁸ Tribunal Practice Notice 2/2016.

¹⁹ Applicant’s written submissions in lieu of a hearing, 12 July 2022.

not view this as a 'win': if it had provided a better explanation in the first place, there would have been no need for the CMC. It put the applicant to the expense of attending the CMC, for which I have added a contributory amount. As pointed out in *Amaro Gayo*, the scale is there to take account of the varying nature and circumstances of cases. It takes account of levels of costs in proceedings of the same or a similar nature. These proceedings are not unusual. The "conditions in which [the opponent's] evidence was introduced into the proceedings" were not unusual, following an extension of sixteen days, for reasons connected to the Covid-19 pandemic. Nor were the substantive issues of a clearly spurious nature. An award off scale is not justified.

96. I award costs to the applicant, as follows:

Considering the notice of opposition and filing the counterstatement	£350
Considering the opponent's evidence and filing evidence and submissions	£1000
Written submissions in lieu of a hearing	£400
Case management conference attendance	£150
Total	£1900

97. I order CLC Licensing Limited to pay to John Woods (Lisglyn) Limited the sum of **£1900**. 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 25th day of August 2022

Judi Pike
For the Registrar