

O/890/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3602611
IN THE NAME OF
ACEITUNAS Y ENCURTIDOS ARTESANOS DE NAVARRA S.A
TO REGISTER AS A TRADE MARK**



IN CLASS 29

AND

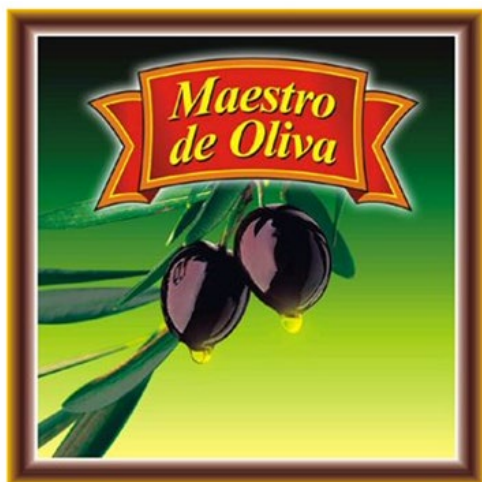
**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 425130
BY OLIVE LINE INTERNATIONAL, S.L.**

BACKGROUND AND PLEADINGS

1. On 01 March 2021, Aceitunas y Encurtidos Artesanos de Navarra S.A (“the applicant”) applied to register trade mark number UK3602611 for the mark shown on the cover page of this decision in the United Kingdom.
2. The application was accepted and published for opposition purposes on 23 April 2021, in respect of the following goods:

Class 29: *Olives, preserved; Olives, [prepared]; Processed olives; Pickles.*

3. The application is opposed by Olive Line International, S.L. (“the opponent”). The opposition was filed on 24 June 2021 and is based upon Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the following three marks under both grounds:



International Registration No.: WO0000000938133

International Registration date: 21 March 2007

UK Date of Designation: 21 March 2007

Date protection conferred in the UK: 09 March 2016

Protected for goods in Class 29

Relying on some goods only, namely:

Olive oils for foods.¹

(“**Mark 1**”); and



UK trade mark registration number 800938133

Filing date: 21 March 2007

Registration date: 20 August 2014

Registered in Classes 29, 30

Relying on some Class 29 goods only, namely:

Class 29: *Preserved olives*²

(“**Mark 2**”); and

MAESTRO DE OLIVA

International Registration No.: WO0000000712672

International Registration date: 03 May 1999

UK Date of Designation: 25 June 2002

Date protection conferred in the UK: 03 January 2003

Protected for goods in Class 29

¹ In the original filing of the opposition, the opponent stated that it was relying on all goods covered by the earlier registrations and use was also claimed in relation to all such goods covered by them. In its written submissions dated 23 December 2021, the opponent confirmed that it was limiting the basis of the opposition to the goods shown above for its Mark 1 and Mark 2 (Mark 3 remains the same). The full specification of goods for which Mark 1 and Mark 2 are registered is shown under Annex A at the end of this decision.

² See Footnote 1.

Relying on all goods, namely:

Olives and edible olive oils.

(“**Mark 3**”)

4. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM or International Trade Mark designating the EU. As a result, the opponent’s Mark 2, which is based on the EU designation of its Mark 1, was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

The 5(2)(b) ground

5. The opponent submits that the contested mark is similar to the opponent’s earlier marks and that the application covers goods in Class 29 which are identical or highly similar to the goods registered in Class 29 of the three earlier marks, in view of which there exists a strong likelihood of confusion and likelihood of association on the part of the relevant public throughout the UK.

The 5(3) ground

6. The opponent claims that it has produced, processed and exported the goods covered by its registrations for over 30 years, and as a result of the use of those marks, they have become intrinsically linked with the opponent by a significant part of the relevant public. It submits that when a consumer is confronted with the applicant’s mark, a link with the opponent’s registrations will be made erroneously in the mind of the average consumer. As such, it submits that there will be a change in the consumer’s economic behaviour, making it more likely that the consumer will purchase the applicant’s products and as such, the use and registration of the applicant’s mark will take unfair advantage of the reputation of the opponent’s registrations, which will be detrimental to the distinctive character and repute of the marks by dilution and by tarnishment.

7. The opponent asks that the contested mark be refused in respect of all goods, and that an award of costs be made in the opponent's favour.

8. The applicant filed a counterstatement denying each of the grounds of the opposition. Under section 5(2)(b), it denies that a likelihood of confusion exists between the applied-for mark and any of the earlier registrations. It further denies that any of the goods covered by the opponent's Mark 1 are identical or similar to any of the goods of the application, although it does not deny that the contested goods are either identical or similar to certain goods covered by the opponent's Mark 2 and Mark 3.

9. In relation to the section 5(3) grounds, the applicant denies that any of the earlier registrations have a reputation, or that there are any similarities between the applied-for mark and the marks protected by the earlier registrations, to the extent that even if a reputation were to exist, the relevant public would not establish any link between the applicant and the opponent, or that the use and registration of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character and repute that the opponent claims to exist in the earlier registrations.

10. The applicant requests that the opposition be rejected in its entirety and that an award of costs be made in favour of the applicant.

11. Both parties filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. Both parties filed evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

12. In these proceedings, the opponent is represented by Bryers LLP and the applicant is represented by Forresters IP LLP.

Preliminary Issues

13. I note that the opponent has indicated on its form TM7 under Q2 STATEMENT OF USE that the registration or protection process for each of its earlier marks "was

completed 5 years or more before the application date (or priority date, if applicable)” of the UK application it wishes to oppose. On its form TM8, the applicant has indicated under Q7 Request for “proof of use” that it wants the opponent to provide proof of use for each of the earlier marks.

14. The opponent’s Mark 1, being International Registration No. WO0000000938133, was protected in the UK on 09 March 2016. The filing date of the contested mark is 01 March 2021. Consequently, the earlier mark had been protected for less than 5 years prior to the contested application. Therefore, the requirement to provide proof of use for this mark does not arise.

15. In relation to the evidence provided in support of the genuine use made of the earlier marks, I will consider this in relation to the opponent’s earlier Mark 2 and Mark 3 only.

16. As mentioned in Footnote 1 of this decision, the goods relied upon by the opponent were limited to those goods outlined under paragraph 2 of this decision, confirmed in the opponent’s correspondence of 23 December 2021. The Tribunal duly rejected the format of the opponent’s proof of use evidence which was provided as an annex to the written submissions³. The opponent refiled the evidence in the correct format on 19 January 2022.

17. In its submissions in lieu⁴, the applicant submits that the request to limit the basis of the opposition had been removed in the refiled evidence, and that the applicant is therefore proceeding on the basis that the opposition has not been limited in any way. However, to my mind, the request to limit the goods was never queried by the Tribunal, and further, while the opponent did not explicitly restate that the goods were to be limited in the refiled submissions, under the comparison of goods table under paragraph 43 of those refiled submissions, the opponent clearly shows the goods upon which it relies as being *Olive oils for foods* (Mark 1); *Preserved olives* (Mark 2); and

³ See the official letter dated 16 January 2022.

⁴ See paragraphs 7-10 of the submissions dated 29 July 2022.

Olives and edible olive oils (Mark 3). It is therefore on these goods only that I base my decision.

18. In the applicant's submissions in lieu, it submits that it is unclear whether the opponent continues to rely upon the section 5(3) grounds.⁵ While the opponent has made no mention of the 5(3) grounds in its submissions dated 23 December 2021, in the submissions in lieu dated 1 August 2022, the opponent submits that the earlier marks have a reputation in the UK.⁶ I therefore consider this to show a clear intention by the opponent to pursue the claim under section 5(3). Further, no formal request to withdraw the pleaded ground has been submitted. Accordingly, I will consider the opponent's claims under section 5(3), as appropriate.

EVIDENCE

Opponent's Evidence

19. The opponent's evidence consists of two witness statements.

20. The first witness statement is by Nadezda Dolskaya, who is the sole administrator of Olive Line International S.L. The witness statement is dated 19 January 2022, to which there are attached three exhibits, labelled **EXHIBIT OL1** to **EXHIBIT OL3**. The opponent states that the evidence "clearly demonstrates the marks in question have been in genuine use in the UK over the past 5 years in respect of all goods on which the opposition is based."

21. The second witness statement is by Óscar García Cortés, who is the legal representative of Olive Line International S.L. The witness statement is dated 3 June 2022, to which there are attached three exhibits, labelled **EXHIBIT ND1** to **EXHIBIT ND3**. The main purpose of the evidence is in reply to the evidence filed by the applicant in relation to frequency of Spanish speakers and language learners in the UK.

⁵ See paragraphs 8 and 76 of the submissions dated 29 July 2022.

⁶ See paragraphs 43-44.

Applicant's Evidence

22. The applicant's evidence consists of a witness statement dated 4 April 2022 by Matthew Shaw of Forresters IP LLP, who is the representative of the applicant. Attached are six exhibits, labelled **Exhibit MNS1** to **Exhibit MNS6**. Mr Shaw states that the purpose of the witness statement is "to provide information from publicly available and independent sources that is pertinent to the Opposition."

23. I note that Exhibit MNS1 comprises an original copy of an appeal decision, which is written in Spanish, as issued by the Spanish Patent and Trade Mark Office, and a translation into English of the same. The appeal was in relation to the applicant's opposed (figurative) mark "MAESTROS ACEITUNEROS DESDE 1960" in Class 29 by the same opponent as in these proceedings, who relied on the marks "MAESTRO DE OLIVA" (word mark) and "MAESTRO DE OLIVA" (figurative mark), both for goods in class 29. At appeal, the contested decision finding no likelihood of confusion between the marks was upheld. Whilst I note the impact of this decision, I am not bound by the findings of other jurisdictions, and as such, I draw my own conclusions based on the evidence before me.

24. I have read and considered all of the evidence of both parties and I will refer to the relevant parts at the appropriate points in the course of the decision.

DECISION

25. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

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

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

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

...”

27. Each of the three trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

28. As outlined earlier in this decision under Preliminary Issues, as Mark 1 had been protected less than 5 years before the application date of the contested mark, it is not subject to the provisions on use contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of it.

29. The opponent’s Mark 2 and Mark 3 each completed the registration/protection process more than five years before the application date of the contested mark, and, as a result, each mark is subject to the provisions on use under Section 6A of the Act. The applicant has required the opponent to provide proof of use of the marks for all the goods on which each relies, as listed under paragraph 3 of this decision.

Proof of Use

30. Proceedings were started on 24 June 2021, and at that time, the relevant statutory provisions under Section 6A of the Act were as follows⁷:

(1) This section applies where –

⁷ See Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

31. As the earlier Mark 2 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

32. Section 100 of the Act states that:

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

33. The relevant period during which genuine use must be shown is the five years ending with the filing date of the contested application, which was 01 March 2021. The relevant period is 02 March 2016 to 01 March 2021. As the opponent’s Mark 2 is a comparable mark, as per paragraph 7 of Part 1, Schedule 2A of the Act, the territory in which use must be shown is the United Kingdom which includes the European Union. As the opponent’s Mark 3 is an International registration designating the UK, the territory in which use must be shown is the United Kingdom.

34. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV*

[EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the

distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis*

rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Use of the mark

35. In the first witness statement, the opponent states that exhibit OL1 is a copy of the current brochure which is available in digital form on its website. Ms Dolskaya states that “the brochure demonstrates use of the trade marks on which the opposition is based in respect of all of the goods, namely olives, preserved olives, olive oils for food and edible olive oils.” The opponent confirms that product brochures made available from April 2016 to February 2021 were in a substantially similar form and all brochures available between these dates clearly showed the goods on which the opposition is based bearing the marks.

36. In her witness statement, Ms Dolskaya clarifies that Exhibit OL2 consists of a selection of sample invoices, packing lists, order & shipping documents dating from between April 2016 and February 2021 and which demonstrate sales of the goods on which the opposition relies under the respective earlier marks. It adds that the code “MO” used on the invoices refers to the mark MAESTRO DE OLIVA.

37. Ms Dolskaya states that Exhibit OL3 comprises screenshots showing the goods bearing the marks on which the opposition relies which are offered for sale from the “myfooden” website. I note that both this exhibit, and Exhibit OL1, show use of the marks in relation to a variety of olive and olive oil products, being the goods for which genuine use of the marks must be proven

38. Where there is no use of the mark in respect of the goods as registered, it follows there has been no genuine use of the mark. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he was then) as the Appointed Person stated that:

“ 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

39. The evidence filed by way of the exhibits demonstrates some commercial use of the mark in relation to olives and olive oils. I must consider whether, or the extent to which, the evidence shows genuine use of the earlier marks at issue in relation to those goods on which the opponent relies under Section 5(2)(b).

Form of the mark

40. The opponent has provided evidence to support that the earlier marks have been put to genuine use by way of Exhibits OL1 – OL3. The marks at issue are registered as a figurative mark (Mark 2), and as a plain word mark “MAESTRO DE OLIVA” (Mark 3).

41. The evidence shows limited use of the word only Mark 3 MAESTRO DE OLIVA by way of the text descriptions of the goods being offered for sale in Exhibit OL3. The majority of the evidence shows use in relation to a figurative mark by way of the various product labels as shown in both Exhibit OL1 and Exhibit OL3.

42. Section 46(2) of the Act states that:

“... use of a trade mark includes use in a form (“the variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it is registered...”

43. I note that use of the mark with, or as part of, another mark would be acceptable providing it is indicative of the origin of the goods, as the Court of Justice of the

European Union (“CJEU”) stated in *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, paragraphs 32 – 35.

44. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

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

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

45. Mark 2 as registered comprises the words “MAESTRO DE OLIVA” written in a yellow font, set in the centre of a red banner or ribbon which is outlined in yellow, which is positioned above an illustration of two black olives attached to a branch with leaves, the whole of which sits within a brown border, infilled in a green ombré background:



46. The mark appears on the front of the brochure of Exhibit OL1 and on the various product labels contained therein, in several different forms, examples of which are shown below. However, for reasons that will become apparent, I will consider the variant forms collectively:



47. The distinctive character of the registered marks rests in the words "MAESTRO DE OLIVA" (Mark 3), and in the same stylised words positioned within the banner element for Mark 2.

48. In the majority of the variant forms there is an additional element which is not present in Mark 2 of what appears to be a coat of arms, positioned above the red and yellow banner in which sits the stylised words "MAESTRO DE OLIVA". Further variations include the colour of the olives and the overall background colour and

border. To my mind, these would be perceived by the average consumer as decorative elements which would not detract from the trade mark message itself. In my view, the relevant consumer is more likely to identify and recall the words “MAESTRO DE OLIVA” within the banner in the second mark, and which is present in all the variants, as being indicative of brand origin. Even where the average consumer notices the additional elements such as the coat of arms, and the change in background, I consider that use of the mark in the stylised forms shown above does not alter the distinctive character of the mark as registered and as such they are all acceptable variants.

Genuine use

49. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK, which includes the European Union for the comparable Mark 2, during the relevant five-year period. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

50. In its submissions in lieu, the applicant submits that the opponent has failed to show sufficient use for the goods covered by the earlier registrations, and that no evidence relating to financial turnover from sales of its goods or any evidence to demonstrate promotional investment or advertising exposure of the earlier registrations in the UK has been provided. It submits that the opponent has failed to validate the earlier rights relied upon, and that the opposition should be refused in its entirety.

51. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows

use by itself. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. I bear in mind that use of the mark need not always be quantitatively significant for it to be deemed genuine.⁸

52. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am entitled “to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”: (see *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22).

53. The evidence by way of Exhibit OL1, being extracts from what is described as the current brochure, is undated, although I accept Ms Dolskaya’s claims that product brochures made available from April 2016 to February 2021 were in a substantially similar form. While I consider that the exhibit indicates marketing of a range of olive and olive oil products under the MAESTRO DE OLIVA trade marks, it does not, however, evidence where, how or to whom the brochures were circulated, nor does the exhibit show how potential consumers would be able to purchase any of the advertised goods, which in turn would lead to actual sales emanating from the product advertisements. I note that at paragraph 3 of the witness statement a link is given to the current brochure in digital form on the website, which can be accessed via a Spanish domain address.

54. Exhibit OL3 shows examples of the goods bearing the marks being offered for sale from the “myfooden” website. The exhibit does not show whether the goods at issue were offered for sale during the relevant period, nor the target audience, and I note the link to the site given at paragraph 5 of the first witness statement is a “.com” domain. Neither is there anything to substantiate the number of visitors to the website or the amount of sales which resulted directly from visitors to the website.

⁸ *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

55. There are 7 individual invoices and corresponding packing/shipping documents provided under Exhibit OL2. The earliest is dated 20/04/2016 and the latest is dated 16/02/2021, with an example provided for each year in between. As such they all span the relevant period and all show the final destination for the orders as London (UK). On all but one invoice, the customer details are redacted and it is therefore not possible to say if the orders were made by a single consumer or multiple clients. However, I note that use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark⁹.

56. As submitted by the opponent in its submissions in lieu¹⁰, the invoices show the number of units ordered to be in large quantities, with many of the overall units being ordered per invoice showing as several thousand, although the price per unit of the goods and the total value of the orders have been redacted. The marks at issue are not shown on any of the invoices in any form, which are headed under the company name Olive Line International, S.L. although I note that Ms Dolskaya states at paragraph 4 of the witness statement that the code MO used on the invoices refers to the mark MAESTRO DE OLIVA, and the brandname is also shown as Maestro de Oliva on the packing slips.

57. Although there is no *de minimis* rule, proven commercial use of the mark may not automatically be deemed to constitute genuine use. I have no figures outlining marketing spend, I have no evidence relating to the size of the corresponding food market or the percentage market share enjoyed by the opponent, and I have no figures to determine the turnover of the goods provided under the marks in the relevant territory during the relevant period. However, the invoices indicate that there has been some commercial use of the mark MAESTRO DE OLIVA on olives and olive oils within the relevant period and within the relevant territory.

⁹ *La Mer* at [24].

¹⁰ See paragraph 9 of written submissions dated 1 August 2022.

58. The evidence provided in relation to genuine use of the marks is limited. However, having considered the evidence as a whole, it is my view that given the large quantities of goods ordered as shown on the invoices, which are consistent throughout the full five year period, the opponent has done enough to demonstrate commercial exploitation of the earlier marks. I consider the evidence provided to be sufficient to allow me to find that there has been genuine use of the goods under the marks on which the opponent relies within the relevant period and within the relevant territory.

59. Consequently, the opponent's earlier Mark 2 and Mark 3 may be relied upon for all goods on which the opposition is based.

Section 5(2)(b)

60. Section 5(2)(b) reads as follows:

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

...

(a) 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”.

61. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

62. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

63. I am therefore mindful of the fact that the appearance of respective goods in the same class is not sufficient in itself to find similarity between those goods.

64. The goods to be compared are:

Opponent's goods	Applicant's goods
<p data-bbox="220 255 517 286"><u>All being in Class 29</u></p> <p data-bbox="220 309 323 340">Mark 1</p> <p data-bbox="220 362 472 394"><i>Olive oils for foods.</i></p> <p data-bbox="220 465 323 497">Mark 2</p> <p data-bbox="220 519 448 551"><i>Preserved olives.</i></p> <p data-bbox="220 622 323 654">Mark 3</p> <p data-bbox="220 676 572 707"><i>Olives and edible olive oils</i></p>	<p data-bbox="834 309 963 340"><u>Class 29</u></p> <p data-bbox="834 362 1326 394"><i>Olives, preserved; Olives, [prepared];</i></p> <p data-bbox="834 416 1177 448"><i>Processed olives; Pickles.</i></p>

65. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 für 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”.¹¹

66. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated 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”.¹²

¹¹ Paragraph 29

¹² Paragraph 23

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

68. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.¹³

69. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”¹⁴

70. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

¹³ Paragraph 82

¹⁴ Paragraph 5

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."¹⁵

71. In its written submissions, the opponent submits that the distribution channels and points of sale overlap as the competing goods are both sold in grocery stores and supermarkets, and that as the goods are all foodstuffs they are of the same nature, purpose and method of use, and are likely to be purchased by the same consumers.

72. In its written submissions in lieu, the applicant contends that while the respective goods both fall within the broad category of foodstuffs, the applicant's goods are fruits which are primarily eaten as a snack or used as an ingredient cooking, while the opponent's oils are used in frying food or as a salad dressing, rendering the respective goods different in nature, intended purpose, and method of use.

"Olives, preserved; Olives, [prepared]; Processed olives"

73. The applicant's good listed above are self-evidently identical to the opponent's *"Preserved olives"* (Mark 2) and *"olives..."* (Mark 3).

74. The contested *"Olives, preserved; Olives, [prepared]; Processed olives"* and the opponent's *"Olive oils for foods"* (Mark 1) and *"... edible olive oils"* (Mark 3) are all foodstuffs, with the juice of the olive extracted to produce olive oil. As such there is a superficial overlap in use. However, the mere fact that a particular good is used as

¹⁵ Paragraph 12

a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar¹⁶, the nature of the finished article in each case being quite distinct. I cannot agree with the opponent that the respective methods of use are the same, although I agree that there may be an overlap in end users who use olive oil in cooking and food preparation and those consumers who enjoy eating olives on their own or within prepared dishes. There will also be an overlap in trade channels, although the goods are unlikely to be positioned on the same shelves, or even the same aisles in outlets such as supermarkets. As olive oil is derived from olives, there may be said to be a complementary relationship between the two, however, this would come from the 'raw' goods prior to the preparation and processing stages of the preserved olives as a product in their own right. This in itself is not therefore sufficient to find similarity between the goods. As outlined in *Boston Scientific*, I do not consider that the average consumer would automatically expect "*Olive oils for foods*" to be provided by the same undertaking as for the applicant's "*Olives, preserved; Olives, [prepared]; Processed olives*". I therefore find the competing goods to be dissimilar. If I am wrong in this, then I consider the goods to be similar to a very low degree.

"Pickles"

75. The contested "*Pickles*" would be commonly understood by the average consumer of the goods to be vegetables or fruit, either whole or cut into pieces, and which have been preserved in vinegar or salt water. The purpose of such goods is usually as a relish, being an accompaniment to other products such as meat or cheese. I consider the nature of pickles to be different to the opponent's "*Olive oils for foods*" (Mark 1) and "... *edible olive oils*" (Mark 3) which are liquid in nature and are usually used in the cooking or dressing of other foods. I do not consider them to be either complementary to, or in competition with, one another. Neither do I consider that the average consumer would immediately expect the same or economically linked undertakings to provide both "*Pickles*" and "*Olive oils for foods*". I therefore consider the competing goods dissimilar.

¹⁶ *Les Éditions Albert René v OHIM*, Case T-336/03 at [61].

76. The nature of the opponent's "*Preserved olives*" (Mark 2) and "*Olives...*" (Mark 3) are similar in nature to the contested "*Pickles*" in that both olives and some types of pickles, such as pickled onions, pickled gherkins, etc., are preserved fruit or vegetables which may be eaten alone as a snack, although other pickles, for example, piccalilli, or those in the form of a chutney, tend to be served as an accompaniment to other products such as meat or cheese. However, as per *YouView*, I do not consider that the natural or core meaning of "*pickles*" would include olives. There is likely to be an overlap in users, and the goods may be in competition with each other. Although the competing goods will share channels of trade, and in the case of olives which are packed in jars or pouches, they will be situated in close proximity in retail outlets, I do not consider that the average consumer would automatically expect both sets of goods to originate from the same undertaking. Overall, I find the competing goods to be similar to a low degree.

77. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, 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."

78. I have found that the applicant's goods are dissimilar to all of the goods under the opponent's Mark 1, with a contingency that if I am wrong in this finding, then they are similar to a very low degree. As Mark 1 and Mark 2 are identical, I will proceed with the decision based on the remaining Mark 2 and Mark 3 only.

The average consumer and the nature of the purchasing act

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

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.¹⁷

80. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

81. In its written submissions dated 19 January 2022, the opponent submits that the average consumer of the goods at issue is the general public, who will pay a low degree of attention to the goods due to their low value, while in its submissions in lieu dated 1 August 2022, the opponent submits that due to the cost, households on a low income may be excluded from potentially purchasing olive oil, and that no more than an average degree of attention will be paid by the majority of the relevant public. The applicant submits that the average consumer, being a member of the general public, will pay an average degree of attention during the purchasing process.

82. I agree that the average consumer for the competing goods will be the general public, and the goods are likely to be self-selected from a supermarket or grocery store, with the purchasing act being a predominantly visual one, although I do not discount oral recommendations. The goods may also be purchased by restaurateurs and food aficionados. The cost of the goods will be relatively low, and may be purchased relatively frequently, although they are unlikely to be bought on a daily basis. For the olives, considerations such as whether they are pitted or stoned, black

¹⁷ Paragraph 60

or green, stuffed or unstuffed, 'fresh' from a delicatessen style counter, or in a jar or pouch off the shelf, will play a part. For the oils, (should I be wrong in my earlier assessment of dissimilarity with the applicant's olives), considerations will include the type of oil/suitability for the intended purpose, i.e. light olive oil for cooking, virgin or extra virgin oil for marinades and dressings, etc. For both olives and olive oils, the country of origin will also be important to some consumers. Overall, I consider that the relevant public will pay a medium degree of attention to the selection process.

Comparison of marks

83. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁸

84. 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.

85. The respective trade marks are shown below:

¹⁸ Paragraph 34

Opponent's trade marks	Applicant's trade mark
<p data-bbox="204 253 308 286"><u>Mark 2</u></p>  <p data-bbox="204 725 308 759"><u>Mark 3</u></p> <p data-bbox="276 781 703 824">MAESTRO DE OLIVA</p>	

86. The opponent submits that the prefix of the respective marks is identical, MAESTRO v MAESTROS, and that the overall visual and aural impression of a mark is usually dominated by its beginning because it is read from left to right. It submits that the word MAESTRO/MAESTROS would be recognised by the English speaking public as meaning an expert, teacher or master, rendering the prefix of the competing marks conceptually identical. It further submits that the words “OLIVA” and “ACEITUNEROS” are both Spanish for “olives” and will be understood by the relevant public as referring to the fact that the goods applied for consist of olives and/or olive products, and that the overall conceptual impression created by the competing marks is therefore identical.

87. The applicant submits that its mark is visually dissimilar to both the earlier marks, with the contested mark being visually dominated by its “large and distinctive graphical imagery”, which has no similarity to the earlier marks. It accepts that there is a degree of aural similarity between the words “MAESTRO” and “MAESTROS”, however it contends that the remaining words in the individual marks have no aural similarity whatsoever. The applicant submits that none of the marks in question has any relevant meaning in the English language, and that the average consumer will

instead view the respective marks as being words in an unidentified foreign language.¹⁹

Overall impression

88. The opponent's Mark 2 consists of a number of elements. The words "Maestro de Oliva", written in a standard yellow font, are set in the centre of a red banner or ribbon, outlined in a yellow border. The banner containing the word element is positioned above an illustration of two black olives, each with what appears to be a droplet of juice (olive oil) emanating from the fruit, with the olives themselves attached to a branch of dark green leaves, the whole of which is situated on a green ombré background. These elements are all encased within a brown square frame. Although it could be said that the pictorial background element is slightly larger than the words within the banner in the overall impression, the average consumer's attention is likely to be drawn to the verbal elements: the pictorial element in the context of the goods for which I found there to be similarity earlier in this decision reinforces the message that the product contains or is made from olives and is therefore secondary to the words in the overall impression.

89. The opponent's Mark 3 comprises three words, "MAESTRO DE OLIVA" presented in capital letters in a standard font without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the combination of the words themselves.

90. The applicant's mark consists of an illustration of a left hand with the palm facing outwards, holding a small spherical object between the thumb and ring finger, which I have assumed to be an olive due to the goods on which the mark appears. Positioned directly below and central to the illustration is the word "MAESTROS", and positioned directly below and central to the word is another word "ACEITUNEROS". Both words are presented in capital letters in the same font and size. Below and

¹⁹ I note the evidence adduced in support of the application which includes exhibits intended to demonstrate that only a very small minority of the relevant public in the UK will be able to translate the respective marks. However, the evidence refers to data from 2011 and 2012, with the most recent article dated 26 September 2014, and therefore it does not truly reflect the current position.

central to this are the words “DESDE 1968”, in the same font, but of a much smaller size. Again I consider that the average consumer is likely to immediately notice the words “MAESTROS ACEITUNEROS”, and, although it makes a slightly lesser contribution to the overall impression of the mark, the illustration of the hand holding the olive will not go unnoticed. The remaining words “DESDE 1968” play a much lesser role due to their smaller font size, and may be overlooked by some consumers.

Visual comparison

91. The opponent’s earlier marks both comprise the three word combination “MAESTRO DE OLIVA”, with its Mark 2 containing the additional pictorial elements as previously described. The applicant’s mark comprises the three words and number combination “MAESTROS ACEITUNEROS DESDE 1968” with the additional device element as described in the preceding paragraph. The only element in common with the competing marks is the word MAESTRO/S which is positioned at the beginning of the word element in all three marks. Considering the marks as a whole, in view of the differing device elements and the brevity of the identical words in each of the opponent’s marks, I find there to be a low degree of visual similarity between the applicant’s mark and the two earlier marks.

Aural comparison

92. The figurative elements in the competing marks would not be articulated, therefore it is only the word elements of the respective marks which would be voiced. The opponent’s marks will be voiced as three separate words, broken down into six syllables “MICE-TRO-DAY-AWL-EEB-AH”. I consider that there would be some consumers who would only voice the words “MAESTROS ACEITUNEROS” in the applicant’s mark which would be pronounced as two words broken down into seven syllables “MICE-TROES-AS-ATE-OON-AIR-OHS”. In these circumstances, and notwithstanding the shared syllables which form the beginning of the respective marks, I consider the competing marks to be aurally similar to a low degree. Other consumers will voice all the words within the mark, which will be broken down into fourteen syllables - “MICE-TROES-AS-ATE-OON-AIR-OHS-DES-DAY-NINE-TEEN-

SIX-TEE-EIGHT”, and in this instance, I consider the competing marks to be aurally similar to a very low degree.

Conceptual comparison

93. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]²⁰.

94. The opponent submits that the overall conceptual impression created by the competing marks is identical, being that of an expert in relation to olives.

95. To my mind, the average UK consumer would immediately identify that the combination of words in both marks are in a language other than English. While it is derived from a foreign language, the word “maestro” has been adopted in its own right in the English language and it is defined in the Collins English Dictionary as “a distinguished music teacher, conductor, or musician” and “any man regarded as the master of an art: often used as a term of address”.²¹ The consumer would recognise that the competing marks have in common the word MAESTRO/MAESTROS, and I agree with the opponent’s submissions that a significant proportion of the average UK consumer would understand the basic meaning of the word MAESTRO as an expert, teacher or master when viewed on its own.

96. I would also expect that with regard to the earlier marks that the word “OLIVA” is sufficiently similar to the English word ‘olive’ to be understood as the fruit of the olive tree, given the goods on which the marks appear, the whole being construed as “master of (the) olive”, and this message is further reinforced by the pictorial elements present in Mark 2. However, in relation to the applicant’s mark, while I accept that there will be a proportion of consumers in the UK who will understand enough Spanish to grasp the meaning of the combination of the words within the mark, I do not

²⁰ Paragraph 56.

²¹ Sourced from the Collins Dictionary online on 11 October 2022.

consider this group of consumers to be significant in number. The word “ACEITUNEROS” does not immediately spring to mind as being similar to any English word that would allow the non-Spanish speaker to elicit any relevant meaning. To those consumers who neither understand the meaning of the word, nor identify the object as an olive in the hand in the applicant’s mark, there is no concept to be considered beyond the word MAESTRO/MAESTROS as referring to a master(s). In this case, I consider the competing marks to be conceptually similar to a low degree.

97. To those consumers who perceive the pictorial element in the applicant’s mark as a hand holding an olive, the concept of olives is shared with the opponent’s marks, although this merely reinforces the message that the goods contain olives or olive oil, resulting in what I also consider to be a low degree of conceptual similarity.

Distinctive character of the earlier marks

98. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

99. 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).”

100. Registered trade marks can possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a character of the goods and services, whereas invented words usually have a higher degree of distinctive character. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

101. The opponent has provided evidence in support of the use of the earlier marks relied upon, however, I have found that evidence to be somewhat lacking. As a result, I do not consider that the earlier marks can be said to enjoy an enhanced degree of distinctive character by virtue of the use made of them. I will therefore assess the earlier marks in regard to the degree of inherent distinctiveness which they possess.

102. I note the applicant’s submissions and supporting evidence that there are numerous other co-existing UK trade mark registrations for marks that feature the words “MAESTRO” or “MAESTROS” in class 29 which cover olives, pickles and oils. However, this has no bearing on my assessment. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. found that absence of evidence of confusion does not necessarily mean an absence of actual confusion.²² Meanwhile, in *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that

²² At [80].

regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

103. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them.²³

104. Both the earlier marks contain the identical (Spanish) words “MAESTRO DE OLIVA”. Mark 2 contains the additional pictorial elements as previously described in paragraphs 88 – 91 of this decision, which I consider to be decorative in nature and which strongly allude to the goods for which the mark is registered. While the stylisation and figurative elements cannot be ignored, in my view they do little to augment the distinctive character of the overall mark.

105. As considered earlier, the word “MAESTRO” is likely to be understood by the average consumer as describing or alluding to a master in the relevant field. I also considered that given the goods at issue and the similarity to the English word “OLIVE”, a significant proportion of consumers would correctly understand the term “MAESTRO DE OLIVA” to literally be referring to a “master of (the) olive”, and which

²³ See *Matratzen Concord AG v OHIM*, Case T-6/01.

I consider sends a laudatory message to the consumer regarding the provider of the goods.

106. Taking all of the above into consideration, I find the distinctive character of both the opponent's earlier marks to be at the lower end of the spectrum, although not of the very lowest degree.

Likelihood of confusion

107. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

108. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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).”

109. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

110. Earlier in this decision, I found that the applicant’s olives were identical to the opponent’s “*Preserved olives*” (Mark 2) and “*olives...*” (Mark 3), and that they were dissimilar to the opponent’s “*Olive oils for foods*” (Mark 1) and “*... edible olive oils*” (Mark 3), although I expressed that if I were wrong in this assessment then I considered them to be similar to a very low degree. I also found the applicant’s “*Pickles*” to be similar to a low degree to the opponent’s “*Preserved olives*” (Mark 2) and “*olives...*” (Mark 3).

111. I considered that the level of attention of the average consumer during the selection process would be medium, and that the selection of goods would be made by predominantly visual means, although I did not discount aural considerations. I found that when considering the marks as a whole, in view of the differing device elements and the brevity of the identical words in each of the opponent's marks, there was a low degree of visual similarity between the applicant's mark and the two earlier marks. I considered that to those consumers who would only voice the words "MAESTROS ACEITUNEROS" in the applicant's mark, the competing marks were aurally similar to a low degree, and where all three words and the number present in the applicant's mark were articulated, the competing marks were aurally similar to a very low degree. With respect to the level of conceptual similarity between the marks, I considered the competing marks to be conceptually similar to a low degree.

112. Finally, I found the earlier marks to be at the lower end of the spectrum of inherent distinctiveness, although not the very lowest.

113. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise. I find this even where the respective goods are held to be identical, which offsets a lesser degree of similarity between the marks.

114. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

115. Keeping in mind the global assessment of the competing factors in my decision, and in particular the low degree of visual, aural and conceptual similarity between the marks, and the low degree of distinctive character of the earlier marks, it is my view that it is unlikely that the average consumer would assume that there is a connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. are not exhaustive, however, I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

116. The opposition under section 5(2)(b) fails.

Section 5(3)

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

“A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

[...]

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.”

118. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oréal 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'Oréal 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 Page 59 of 76 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'Oréal v Bellure*).

119. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks are similar to the applicant's mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. In this case, I found the parties' goods to be either identical, or similar to a low degree, with the exception of the opponent's olive oils, which I found to be dissimilar to the applicant's goods (with the contingent that if I were wrong in this finding, then the goods were similar to a very low degree).

120. With regard to the first condition of similarity between the marks, as considered earlier in this decision, I found the earlier marks to be visually, aurally and conceptually similar to the applicant's mark to a low degree.

121. The second hurdle for the opponent to get over is the question of reputation.²⁴ Earlier in this decision, although I found the evidence relating to genuine use for the opponent's Mark 2 and Mark 3 to be limited, I considered it sufficient to show genuine use of the earlier marks. Section 5(3) requires the opponent to prove that the at least one of the earlier marks has a reputation. This is a higher bar for the opposition to get over than for genuine use. However, in view of my considerations of the evidence provided as outlined earlier in this decision, it is insufficient for me to find that the opponent enjoys a reputation which would cause the public to make a link between the marks, given the differences between them, even for identical goods.

122. I therefore consider that the opponent has not proven a reputation at the relevant date in the relevant territory, and so the opposition under 5(3) fails in respect of each of the earlier marks relied upon.

OUTCOME

123. The opposition under section 5(2)(b) and section 5(3) has failed. Subject to any successful appeal, the application by Aceitunas y Encurtidos Artesanos de Navarra S.A may proceed to registration in respect of all goods.

COSTS

124. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. Applying the guidance in that TPN, I award the Aceitunas y Encurtidos Artesanos de Navarra S.A the sum of £1,300, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement: £300

²⁴ See *General Motors Corp v Yplon SA*, Case C-375/97, at [24] –[28].

Preparing evidence and considering the other party's evidence:	£600
Preparing written submissions in lieu of a hearing:	£400
Total:	£1,300

125. I therefore order Olive Line International, S.L. to pay Aceitunas y Encurtidos Artesanos de Navarra S.A the sum of £1,300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of October 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General

ANNEX A

Mark 1 - WO0000000938133

Class 29

Olive oils for foods, mixtures containing fat for spreading mixed with olive oil, edible fats made with olive oil, butter made with olive oil, margarine made with olive oil.

Mark 2 - UK00800938133

Class 29

Preserved olives, anchovies with olive oil, herrings with olive oil, tuna with olive oil, milk beverages in which milk enriched with olive oil predominates, preparations for making bouillon made with olive oil, meat and fish preserves made with olive oil, milk products enriched with olive oil, crisps (potatoes) made with olive oil, prepared dishes made with meat and/or fish and/or vegetables made with olive oil and/or olives, gazpacho made with olive oil, preparations for making soup made with olive oil, vegetable juices for cooking made with olive oil.

Class 30

Gravy made with olive oil, pastry and confectionery made with olive oil, pancakes made with olive oil, biscuits made with olive oil, pastry made with olive oil, meat pâtés made with olive oil, ready made dishes of flour and/or rice made with olive oil, sandwiches made with olives and/or olive oil, tortillas made with olive oil, bread made with olive oil and/or olives, bread rolls made with olive oil and/or olives, spice bread made with olive oil and/or olives.