

O/0139/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS

3698329 AND 3698369

BY

INTERNATIONAL FOODSTUFFS CO. LLC

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 30



And



AND CONSOLIDATED OPPOSITIONS THERETO UNDER NUMBERS

431144 AND 431145

BY

NOMAD FOODS EUROPE LIMITED

## Background and Pleadings

1. On 21 September 2021, International Foodstuffs Co. LLC (“the Applicant”), applied to register in the UK the trade marks numbered 3698329 (“329”) and 3698369 (“369”) as set out on the front cover page for goods in class 30, namely *Ice Creams*. Both marks were accepted and published in the Trade Marks Journal on 26 November 2021. The registrations were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union and therefore they have each retained their EU filing dates of 10 August 2020, which for the purposes of this decision will be taken as the relevant date.

2. On 18 February 2022 Nomad Foods Europe Limited, (“the Opponent”) filed opposition proceedings to the applications, relying on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. In both sets of proceedings, under both grounds of opposition the Opponent relies upon the following trade marks:

(i) UKTM no. 905740238 (“first earlier mark”)

IGLO

Filed: 7 March 2007

Registered: 25 February 2008

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; puddings; rice-based snack food; sandwiches; spring rolls.

(ii) UKTM no. 909314261 (“second earlier mark”)

IGLO

Filed: 13 August 2010

Registered: 19 October 2012

Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs, milk and milk products; Edible oils and fats; frozen prepared meals; instant meals and snack products; chilled foods consisting predominately of fish; chilled meals made from fish; cooked meals consisting principally of fish; fish cakes; frozen fish cakes; fish fillets; frozen fish fillets; fish fingers; frozen fish fingers; fish products; fish products being fresh; fish products being frozen; fish products being preserved; fish with chips; frozen cooked fish; frozen fish; frozen prepared meals consisting principally of fish; pre-cooked dishes incorporating [predominantly] fish; processed fish; scampi; frozen scampi; steaks of fish; frozen steaks of fish; shelled prawns; chicken; chicken pieces; chicken products; cooked chicken; frozen chicken; deep frozen chicken; dehydrated chicken; fried chicken; frozen fried chicken; prepared meals containing [principally] chicken; pieces of chicken for use as a filling in sandwiches; chicken nuggets; frozen prepared meals consisting principally of chicken; chicken kiev; frozen chicken kiev; garden peas; green split-peas; marrowfat peas; peas, preserved; peas, processed; frozen peas; soya beans; preserved soya beans; frozen soya beans; vegetarian frozen foods; frozen prepared meals consisting principally of vegetables; frozen vegetables; frozen vegetables packed in single portions; sweetcorn [cooked]; sweetcorn [preserved]; sweetcorn [frozen]; burgers; frozen burgers; meat burgers; frozen meat burgers; meat products being in the form of burgers; vegetable burgers; frozen vegetable burgers; steaks of meat; frozen steaks of meat; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals consisting wholly or substantially wholly of fish; frozen ready cooked meals consisting wholly or substantially wholly of fish; ready cooked meals consisting wholly or substantially wholly of game; frozen ready cooked meals consisting wholly or substantially wholly of game; ready cooked meals consisting wholly or substantially wholly of meat; frozen ready cooked meals consisting wholly or substantially wholly of meat; ready cooked meals consisting wholly or substantially wholly of poultry; frozen ready cooked meals consisting wholly or substantially wholly of poultry; ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready cooked meals consisting wholly or substantially wholly of vegetables; potato snack products in the form of fried

pieces; frozen potato snack products in the form of fried pieces; potato snack products in the form of pieces capable of being fried; shepherd's pie; frozen shepherd's pie; dairy desserts; cream desserts; fruit desserts; soya desserts; dairy puddings; desserts made wholly or principally of dairy products; dairy products; cream (whipped-); cream (dairy products); flavoured dairy desserts in the form of mousse layered onto flavoured sauce; flavoured dairy desserts in the form of vanilla flavoured mousse with strawberry flavoured sauce; flavoured dairy desserts in the form of chocolate flavoured mousse with caramel flavoured sauce and dark chocolate curls; desserts made from milk; desserts made from milk and gelatine; desserts made from milk products; desserts made from yoghurt; desserts made wholly or principally of milk products; instant desserts having a milk base; milk based desserts [milk predominating]; milk desserts; yoghurt desserts; fruit puree; egg based foodstuffs; frozen dairy desserts; frozen desserts made wholly or principally of dairy products; milk containing ice cream; artificial milk based desserts; cream preparations containing milk and fruits; dairy products containing milk; desserts in the form of puddings with a milk base; desserts made principally of milk; edible jellies made from milk and vegetable products; food made principally from milk; food preparations consisting wholly or substantially wholly of milk; food preparations containing anhydrous milk fats; food preparations containing soya and milk protein; food preparations having a base of milk; food products consisting principally of skimmed milk solids; foods made from milk products; foods prepared from milk; half-fat milk products; milk based desserts (milk predominating); milk cream; milk jellies; milk products for food; milk protein; milk protein products; preparations made from milk; preparations with a milk base for use as desserts; prepared desserts (milk based); prepared desserts made from milk products with fruit or herbs or pastry additives; prepared desserts made from milk with fruit additives; prepared desserts made from milk with herbs or pastry additives; prepared desserts made from milk with pastry additives; products based on milk; products made wholly or principally of milk; ready prepared desserts consisting of milk with gelatine as a binding agent; ready prepared desserts consisting of milk with starch as a binding agent; artificial milk based desserts; cream preparations containing milk and fruits; cream products; creams containing dairy products; dairy products being half cream and half milk; double

cream; edible cream; imitation cream, milk cream; frozen ready meals; frozen dairy desserts; frozen desserts made wholly or principally of dairy products.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice; sauces for frozen fish; sauces for chicken; frozen pastry stuffed with meat and vegetables; frozen pastry stuffed with vegetables; frozen prepared rice with seasonings and vegetables; bread rolls containing burgers; chilled ready meals; individual ready meals; ready cooked meals; pies containing fish; frozen pies containing fish; pies containing game; frozen pies containing game; pies containing meat; frozen pies containing meat; pies containing poultry; frozen pies containing poultry; pies containing vegetables; frozen pies containing vegetables; waffles; frozen waffles; deep frozen pasta; ready cooked meals consisting wholly or substantially wholly of pasta; frozen ready cooked meals consisting wholly or substantially wholly of pasta; dessert preparations in the nature of mousse, all being preserved by a quick-freezing process; frozen desserts; frozen fruit desserts; frozen mousse desserts; frozen mousse; frozen mousse confections; mousse (sweet); mousse confections; vanilla flavoured mousse; vanilla flavoured mousse with strawberry flavoured sauce; chocolate flavoured mousse; chocolate flavoured mousse with caramel flavoured sauce and dark chocolate curls; dessert puddings; puddings [desserts]; puddings for use as desserts; preparations for making desserts; prepared desserts [chocolate based]; prepared desserts [confectionery]; caramel; caramel sauce; strawberry sauce; chocolate sauce; sauces for ice cream; chocolate; chocolate based produces; chocolate chips; chocolate curls; chocolate flavoured confectionery; foods with a chocolate base; ice cream; ice cream desserts; ready-to-eat puddings; desserts having a reduced calorie content; desserts; ice desserts; non-dairy frozen dessert products; prepared desserts (chocolate based); prepared deserts (confectionery); confectionery; confectionery (non-medicated); confectionery bars; confectionery containing jam; confectionery containing jelly; confectionery in frozen form; confectionery items (non-medicated); confectionery items coated with chocolate; confectionery products (non-medicated); dairy confectionery; frozen

confectionery; frozen confectionery containing ice cream; frozen confections; ice confectionery; ice confections; ice cream confectionery; ice cream confections; non-medicated confectionery; non-medicated confectionery containing milk; non-medicated confectionery for use as part of a calorie controlled diet; non-medicated confectionery products; preparations for making confectionery products; prepared desserts (confectionery); frozen dairy confections; strawberry flavoured sauce; caramel flavoured sauce; foodstuffs flavoured with caramel [caramel predominating]; frozen confections in the form of cylindrical rolls consisting of ice cream covered with sponge cake; frozen confections in the form of cylindrical rolls consisting of ice cream covered with jam and sponge cake; dairy ice cream; frozen confectionery containing ice cream; frozen confectionery containing ice cream and jam; fruit ice cream; ice cream bars; ice cream cones; ice cream confectionery; ice cream confections; ice cream gateaux; ice cream products; ice cream sandwiches; ice cream with fruit; ice cream with pastry; ice creams; ice creams containing chocolate; ice creams flavoured with chocolate; imitation ice cream; non-dairy ice cream; soya based ice cream products; substances for binding ice cream; cakes; frozen cakes; sponge cakes; sponge puddings; puddings (desserts); sponge puddings; prepared desserts (pastries); puddings (desserts); bakery confectionery being chilled; bakery confectionery being frozen; confectionery (non-medicated); confectionery bars; frozen confectionery; frozen confectionery containing ice cream; frozen confections; ice confectionery; ice confectionery in the form of lollipops; ice confections; ice cream confectionery; ice cream confections; ingredients for confectionery; mixtures for making frozen confections; mixtures for making ice cream confections; non-medicated confectionery; non-medicated confectionery containing milk; non-medicated confectionery for use as part of a calorie controlled diet; non-medicated confectionery in jelly form; non-medicated confectionery products; preparations for making confectionery products; preparations for making ice cream confectionery; prepared desserts (confectionery); frozen confectionery containing jam; desserts; chilled desserts; desserts having a reduced calorie content; dessert puddings; flavoured desserts; vanilla flavoured desserts; strawberry flavoured desserts; chocolate flavoured desserts; caramel flavoured desserts.

4. Under section 5(2)(b) the Opponent claims that as a result of the visual, aural and conceptual similarities between the respective marks there would be a likelihood of confusion on the part of the public, including the likelihood of association. It is claimed that the contested goods are identical and/or similar to the goods of the earlier registrations. Furthermore it is claimed that its marks enjoy an enhanced degree of distinctive character. Under section 5(3) the Opponent contends that as a result of the continuous and extensive use made of its earlier marks it has acquired a substantial reputation in the EU amongst consumers. Use of the contested marks will therefore, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade marks as relied upon. This, it is contended, will lead to damage being suffered especially if the goods/services of the Applicant are of an inferior quality.

5. The Applicant filed a defence and counterstatement, in essence, denying each ground of opposition, putting the Opponent to strict proof of its claims, including proof of use of its earlier marks for all the goods as relied upon. Specifically, the Applicant denies similarity between the marks, identity/similarity between the respective goods, that consumers would be confused or that the Opponent enjoys a significant reputation in the UK.

6. In these proceedings the Opponent is represented by Haseltine Lake Kempner LLP and the Applicant is represented by Fox Williams LLP. Only the Opponent filed evidence during the evidence rounds. The Applicant filed submissions in reply. Neither party requested to be heard on the matter, but both parties filed submissions in lieu of a hearing. This decision is therefore taken following a careful perusal of all the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Evidence**

8. The Opponent's evidence consists of the witness statement of Rosanna Darcy dated 20 July 2022 accompanied by thirteen exhibits marked Exhibit 1-13.

9. Ms Darcy is a Legal Advisor at the Opponent company which is part of the Nomad Foods Group of companies, a position she has held for over 5 years. The information contained within her statement comes from her own personal knowledge and the Opponent's company records or its related companies.

10. The purpose of her statement is to provide evidence of use, to show the reputation the Opponent holds in its marks and that the marks IGLO have acquired an enhanced degree of distinctive character. The earlier marks stand registered for a wide range of foodstuff in classes 29 and 30 said to fall under the overarching categories of Poultry, Fish, Desserts/Puddings, Vegetables and Snacks and Meals.<sup>1</sup>

11. Ms Darcy states that the Opponent sells products under the IGLO brand in several EU member states including Austria, Belgium, Germany, Hungary, the Netherlands and Portugal. Its brand is synonymous with frozen food and is one of the leading frozen food brands in Europe.<sup>2</sup>

#### Websites

12. It is said that the IGLO brand is marketed online through the Nomad Foods homepage [www.nomadfoods.com](http://www.nomadfoods.com) and through the separate country specific websites in those countries as outlined in the preceding paragraph. In support of this statement a series of screenshots are produced using the Wayback machine archive tool taken from the country specific IGLO websites showing various packaging of foodstuff. The marks are displayed as follows:



13. The screenshots display a range of prepared foodstuff and ready meals, consisting of frozen vegetables, fish and fish fingers, chicken nuggets, 'dumplings'<sup>3</sup> both sweet and savoury, fruit and custard filled pastries, frozen pastry, vegetables in various sauces combined with cream and a range of cheeses, pizzas, pasta dishes, burgers

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<sup>1</sup> Paragraph 6

<sup>2</sup> Paragraph 19

<sup>3</sup> Described as an Austrian pastry made from light yeast dough, filled with jam or fruit compote.



– beef, chicken and vegetarian, prepared chicken and beef meals and portions in various sauces and vegetable based prepared meals. These images show no more than the availability of the Opponent’s product range on its website at various dates. It does not appear to show that consumers are able to purchase goods from these websites, given that no prices are displayed or a facility to place orders.

### Sales and market share

14. Ms Darcy produces sales figures broken down by category said to be for each country during the relevant period as reproduced below.<sup>4</sup> Only figures for the Netherlands and Germany are produced. It is said that the IGLO marks are applied to all IGLO brand products sold in each of the categories so that all sales figures can be attributed to the IGLO marks.

Country: **Netherlands**

	Sales data relating to specific categories of products (€)				
	Poultry	Fish	Desserts/ Puddings	Vegetables	(Snacks and Meals)
2016	-	24,057,909	-	10,116,921	11,271,386
2017	-	24,244,692	-	10,647,197	14,002,342
2018	-	25,030,743	-	11,054,779	16,889,247
2019	-	26,492,703	-	13,075,185	17,886,844
2020	-	29,244,979	-	14,728,295	16,466,699
2021 to 31 July	-	13,369,853	-	6,831,754	7,320,186

Country:  
Germany

	Sales data relating to specific categories of products (€) in thousands				
	Poultry	Fish	Desserts/Puddings	Vegetables	Snacks and meals
<b>2016</b>	6,417	139,452	-	81,737	5,723
<b>2017</b>	7,277	165,952	-	88,712	7,544
<b>2018</b>	7,242	173,633	-	91,007	10,232
<b>2019</b>	7,648	183,850	62	100,514	12,562
<b>2020</b>	8,283	227,400	13	114,736	19,316
<b>2021 to 31 July</b>	4,110	130,400	0	64,901	12,721

<sup>4</sup> Exhibit 3

15. It is said that the Opponent’s IGLO brand holds significant market shares, particularly in frozen fish across the EU. Market share figures for 2019 in the “Frozen Fish And Seafood” sector are produced for various territories in the EU, including the UK as follows:<sup>5</sup>

- P9 2019 Nielsen/IRI data showing the Opponent’s market value and market share in the Frozen Fish & Seafood sector. Data for Austria, Belgium, Germany, the Netherlands and Portugal show market share and value under the IGLO brand.

Period Ending: P09 2019	Market Value Sales €		Nomad Value Sales €		IGLO Value Share	
	Size	% Δ vs YA	Size	% Δ vs YA	Share %	Share Δ p
	Latest 52wks	52wks	Latest 52wks	52wks	52wks	52wks
Austria	135,426,822	-1.0%	59,463,645	5.8%	43.9%	2.8pp
Belgium	210,007,981	-1.6%	27,904,091	1.1%	13.3%	0.3pp
France	772,875,841	-3.0%	185,843,579	1.9%	24.0%	1.2pp
Germany	1,281,449,858	2.1%	276,167,809	5.2%	21.6%	0.6pp
Ireland	26,226,605	-5.3%	8,126,017	-9.0%	31.0%	-1.2pp
Italy	1,026,915,828	1.2%	321,653,226	1.4%	31.3%	0.1pp
Netherlands	156,515,538	-2.8%	41,639,808	8.4%	26.6%	2.7pp
Norway	164,775,809	-0.8%	67,440,579	-6.3%	40.9%	-2.4pp
Portugal	294,794,272	5.0%	22,074,572	-11.0%	7.5%	-1.3pp
Spain	1,112,209,032	5.1%	8,270,789	-10.4%	0.7%	-0.1pp
Sweden	274,527,282	5.0%	64,397,101	7.0%	23.5%	0.5pp
UK	780,411,477	-0.5%	184,023,134	-0.3%	23.6%	0.0pp
<b>Category Footprint</b>	<b>6,236,136,345</b>	<b>1.3%</b>	<b>1,267,004,350</b>	<b>1.8%</b>	<b>20.3%</b>	<b>0.1pp</b>

16. I am unclear as to why some figures are displayed as a negative or highlighted in red. No information or explanation is given to interpret the figures and the difference between market value sales and Nomad value sales, but if I am to take the % figures in the right hand column of each section as an indication of the Opponent’s market share then they range between -5.3% and 5.1% throughout the various territories. The sales figures only relate to fish and seafood.

17. Exhibit 10 consist of details of the Opponent’s market share in EU countries in which it offers products under the IGLO brand. It is said that the Opponent’s “Category Footprint” i.e. the sectors in which it sells products, has the following market shares in

<sup>5</sup> Exhibit 4

key territories 32.3% in Austria, 15.8% in Belgium, 16.9% in Germany 24% in the Netherlands and 14.4% in Portugal.

18. According to Europanel, the Opponent is said to have the following Household Penetration rates in its key territories in 2020.<sup>6</sup>

key territories in 2020: 77.1% in Austria, 63.3% in Germany, and 55.3% in the Netherlands. "Household Penetration" means the number of households who have purchased a category in a market.

### Revenue

19. The Opponent's annual revenue figures (which are considerable, in excess of €1,500 million) are produced between 2014 and 2019.<sup>7</sup> To support the figures extracts from the Opponent's annual reports are produced.<sup>8</sup> Its net sale figures under the IGLO brand in 2019 and up to 31 July 2020 were €546.9m and € 376.4m respectively.

### Invoices

20. Various invoices from the relevant period are produced showing the final invoice amount and the country where the goods have been sold but only those relating to Germany, Belgium and the Netherlands.<sup>9</sup> The description of the range of products are in line with those displayed on its website and referred to earlier. The mark in written form and/or the device logo appears on each invoice.

### Advertising and Promotion

21. Print outs of YouTube videos of TV advertisements for IGLO branded goods in Germany, Austria and other Territories during the relevant period are produced.<sup>10</sup> The print outs consist of stills for a selection of adverts said to feature a variety of foodstuff to include poultry, fish, 'snacks and meals' and vegetables.

22. The printouts show a number of YouTube videos mainly advertising fish fingers but the commentary accompanying the stills are not in English. The videos have generated a range of views between 360 views for the YouTube video published on 30 May 2016 to 1.4+ million for the advert relating to the Dutch market on 4 September

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<sup>6</sup> Paragraph 22

<sup>7</sup> Paragraph 29

<sup>8</sup> Exhibit 13

<sup>9</sup> Exhibit 5

<sup>10</sup> Exhibit 6

2018. The figurative iglo mark is visible on each capture as well as packaging of foodstuff displaying the mark. Not all category of goods advertised can be identified from the screenshots. However, the foodstuffs that are clearly visible and easily identifiable relate to fishfingers (predominantly), but also include veggie burgers, peas, green beans, spinach and pasta.

23. The Opponent is said to spend a significant amount on advertising and promoting the IGLO brand. In Germany the Opponent spent the following amounts between 2015 and 2018.

Year	Amount spent by Iglo Germany on advertising and promotion
2015	€16.3m
2016	€15.9m
2017	€16.5m
2018	€16.4m

24. It is said that the IGLO mark enjoys high brand awareness in the EU. In support of this statement Ms Darcy produces “Ipsos data for Q4 2017 which shows that in Austria and Germany the IGLO brand has the highest spontaneous/unsupported brand awareness among frozen food brands”.<sup>11</sup>

25. The Opponent is said to manage a number of social media accounts across the EU to include Instagram accounts in Germany and Portugal and Facebook accounts in Germany and Belgium. It is said to have the following number of followers:

Platform	Total number of followers across each platform
Facebook – Iglo Germany	152,598
Facebook – Iglo Belgium	11,373
Instagram – Iglo Germany	15,400
Instagram – Iglo Portugal	10,700

26. Screenshots of a selection of posts of its social media accounts are produced at exhibit 12. They do not show a particularly active social media presence. For example the post in its German Facebook account dated 28 April 2020 generated 144 likes, 28

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<sup>11</sup> Exhibit 9

comments and 59 shares. A similar picture emerges for the other social media accounts.

### Press Releases

27. A selection of press releases for fish and vegetable products released in Germany and Austria are produced.<sup>12</sup> No details are provided as to where these press releases were published or how many consumers read them. The press releases refer to frozen fish, red cabbage, spinach and fresh herbs.

28. It is also said that the Opponent enjoys extensive press coverage across the EU, and examples of articles published in various EU states are produced.<sup>13</sup> Articles are produced taken from the following publications:

- [www.designtagebuch.de](http://www.designtagebuch.de) dated 7 October 2014 discussing its rebranding and new logo design;
- [www.tagesspiegel.de](http://www.tagesspiegel.de) dated 20.04.2015 discussing the sale of Iglo for 2.6 billion euros in which it is referred to as the “fish sticks group” and frozen food specialist;
- [www.rends.levif.be](http://www.rends.levif.be) dated 13.05.15, discussing the new CEO appointment. The article includes following information that the igloo brand is known for its cod sticks and had an annual turnover in 2014 for the manufacture of frozen foods amounting to €1.47 billion;
- [www.rundschau.de](http://www.rundschau.de) dated 17 January 2020 discussing the managing director of Iglo Germany;
- Rtlnieuws dated 23 January 2016 discussing the search for the new face of their brand ‘Dutch Captain Iglo’ and [www.haz.de](http://www.haz.de) dated 14 August 2018 and [www.capital.de](http://www.capital.de) dated 26 October 2018 discussing the hiring of an Italian actor to play the part and the return of the Kapt’n to increase sales of its fish fingers in the German market;
- [www.oblis.be](http://www.oblis.be) dated 2 May 2017, yield close to 3% for the new Nomad Foods bond (Iglo, Findus, Lutosa);
- [www.espalhafactos.com](http://www.espalhafactos.com) dated 07.07.2018 and [www.distribuicao hoje.com](http://www.distribuicao hoje.com) dated 9 July 2018 promoting the new veggie/grain bowls in Portugal;

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<sup>12</sup> Exhibit 7

<sup>13</sup> Exhibit 11

- [www.meiosepublicidade.pt](http://www.meiosepublicidade.pt) dated 20 January 2020 discussing the launch of its new pizza range in Portugal.

29. It is said that the Opponent has been nominated or won a number of awards awarded by independent bodies as set out below. These awards are said to demonstrate its industry-wide recognition in its goods:

- In 2016 IGLO was selected from more than 200 FMCG brands as the winner of the GfK Shopper Marketing Award - an annual award presented by an independent body

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to a brand that has distinguished itself positively in the field of shopper marketing in the FMCG industry.

- My company's IGLO Röstgemüse Oriental Markt-Mix product was awarded product of the month by Austrian trade magazine Produkt in July 2017. The same magazine awarded IGLO Potato Duo product of the month in October 2018.
- In September 2018, in a brand survey by Austrian trade magazine Regal, IGLO scored number one brand in both the fish and sweet meals categories.
- IGLO was awarded "Top Brand of the Year Category Fish" by German trade magazine Die Lebensmittel Zeitung in 2018.
- The IGLO brand was also awarded Brand of the year #3 2018 and Price Performance Award #3 2018 by well-known German Business magazine Handelsblatt. These awards are based on evaluation of data provided by YouGov.
- IGLO won an award for "long-standing product quality" each year in the years 2016–2019 awarded by DLG – the German Agricultural Society.

30. As an example of its extensive use and reputation in the EU, Ms Darcy produces a copy of a decision issued by the EUIPO in earlier opposition proceedings, where it was held that the EUTM version of the first earlier mark had a reputation.<sup>14</sup>

31. Ms Darcy states that the Opponent was held to have a reputation at least in Germany and Austria for frozen fish and frozen prepared meals. The court based this conclusion on the evidence filed that related to sales figures, marketing expenditure,

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<sup>14</sup> Exhibit 8

brand awareness, surveys and market share, which it said pointed to a high degree of recognition being enjoyed amongst the relevant public.

32. The determination in the decision before me is different. I am not privy, nor have I assessed what evidence was placed before the EUIPO and whether the dates under consideration overlap with those that are before me for consideration. Just because one court found reputation does not mean that I am bound to follow the same outcome. I am not in a position to determine as to whether the identical considerations were in play. In any event the marks under consideration are different and I must assess the matter from the perspective of the UK consumer. The decision therefore is irrelevant to my assessment and will not be taken into account.

33. This concludes my summary of the evidence. Whilst both parties filed submissions, I do not propose to summarise them but suffice to say I have read them in full and will refer to the salient points where appropriate later in my decision.

### **Proof of Use**

34. Given their filing dates, the Opponent's trade marks qualify as earlier trade marks pursuant to section 6 of the Act. The Opponent claims that it has used its trade marks in relation to all the goods of its registrations as relied upon. This statement was made because the earlier marks completed their registration procedures more than five years before the date on which the applications were filed. Consequently, each of the Opponent's trade marks are subject to the proof of use provisions under section 6A of the Act.

35. I will begin by assessing whether and to what extent the evidence supports the Opponent's claim that it has made genuine use of its marks in relation to the goods relied upon. The relevant statutory provisions are set out in section 6A of the Act, which states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) 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)-(5A) [Repealed]

(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.”

36. Given that the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:



7.— (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.”

37. Section 100 of the Act is also relevant. It states that:

“100. 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.”

### **Status of the earlier marks**

38. The Opponent relies on two earlier marks which became comparable marks as at the end of the implementation period, namely 31 December 2021 (“IP Completion Day”). Where all or part of the relevant five-year period for genuine use under section 6A, falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period, up until 31 December 2021, will be taken into account in determining whether there has been genuine use of the comparable trade marks. Given the priority date claimed by the Applicant, the entirety of the use relates to use in the EU.

## Relevant Periods

39. The relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period usually ending with the date of application of each of the applied for marks.<sup>15</sup> However the Applicant's mark was registered pursuant to Article 59 of the Withdrawal Agreement which entitled it to retain its original EU filing date. Consequently, the applicable relevant five year period runs from this date as opposed to the date in which it was registered in the UK, namely 11 August 2015 to 10 August 2020.<sup>16</sup>

40. What constitutes genuine use has been the subject of a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

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

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

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

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<sup>15</sup> Section 6A of the Act

<sup>16</sup> The Opponent refers to dates which are a day earlier but which will make little difference in the assessment

(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].”

41. The comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant for determining genuine use of an EUTM. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

....

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

42. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main

proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

43. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

44. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where the market for the goods/services is not limited to that area of the Union.

45. Whether the use shown is sufficient for this purpose, will depend on whether there has been real commercial exploitation of both trade marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant jurisdiction during the relevant five-year period. In making the required assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;

- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

46. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not genuine use.<sup>17</sup>

47. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C.(as he then was), as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is 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. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to

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<sup>17</sup> *Naazneen Investments Ltd v OHIM*, Case T-250/13; C-252/15 P



the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

48. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

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.”

49. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

50. And furthermore:

“Any tribunal assessing this evidence would be bound to conclude, especially given the nature of the proprietor in question, the alleged importance of the mark and the fact that the proprietor was represented by legal advisors of repute that a diligent and careful search had been made for relevant documents proving use and this was the best that could be found.”

### **Form of the Mark**

51. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration

may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

52. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the

distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

53. Although the above decision related to revocation proceedings the principles have equal application in relation to the proof of use assessment to be undertaken.

54. Where the Opponent has used the earlier marks in the form in which they are registered, namely in word only format, then clearly this will be use upon which the Opponent may rely. The Opponent’s evidence, however, also includes the following variations of the marks in use, displayed on packaging, its website and promotional material:



55. The Applicant argues that the way in which the Opponent has used its marks differ considerably to its registration and therefore it should not be entitled to rely on the variations as set out above. As stated in *Colosseum*, where an additional element is incorporated into a mark, and that additional element does not alter the distinctive character of the mark, this is an acceptable variation. Furthermore, a word only mark may be used in any font or casing without altering the distinctive character of the mark.

56. In the first example, the red device is no more than a background shape upon which the words iglo are presented and has little impact to the registered word itself as it will merely be seen as a background. It does not detract from the word itself and the distinctiveness of the word would be unaffected by the device, which in my view would not impair the mark’s ability to indicate trade origin. In the second example where the logo is used in conjunction with an image of a captain again I do not consider that this detracts from the word. Following the position held by Professor Johnson, it is usually the word element which will be more distinctive where a mark contains words and a figurative element. I find that use of the mark in these forms qualifies as acceptable use and may be relied upon by the Opponent.

## Sufficient use

57. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. In this case, the responsibility is on the Opponent to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to accomplish. 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.<sup>18</sup>

58. The Opponent has clearly used its mark for various foodstuff. However, its range of products as relied upon is extensive. Ms Darcy produces global revenue figures for the company as a whole which run into over €1,500 million but a substantial portion of these figures include revenue from other brands which the Opponent manages. Only net sale figures specifically relating to the IGLO brand are produced, of approx €547m and €376m for 2019 and 2020. These figures, however, are not broken down further either by category of goods or country.

59. The evidence clearly shows that it uses its mark for frozen and prepared foodstuff and ready meals in Germany and the Netherlands. The specific sales figures produced relating to these countries are broken down under the broad category headings as identified by Ms Darcy. The table demonstrates significant sales for Fish, Vegetables, Poultry and '(snacks and) Meals'. I am unclear as to what goods would come under the category snacks, however, as described by Ms Darcy, there does not appear to be any evidence of goods that could be described as coming within this term. Under the heading Desserts no entries are listed for the Netherlands and for Germany, only €75,000 of sales is recorded in total during the years 2019 and 2020.

60. Breaking down the categories further, the screenshots, YouTube stills and invoices clearly support the sales figures that demonstrate the Opponent's use for frozen fish; in particular, fish fingers and prepared fish in sauces; a range of frozen vegetables; prepared meals to include chicken nuggets, pizzas, pasta dishes, burgers (beef, chicken and vegetarian); prepared chicken and beef meals including these meats as portions in various sauces and vegetable based prepared meals. Whilst the

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<sup>18</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC Case T-415/09

Opponent's websites do not show the products being offered for sale or the number of customers accessing the website, the invoices clearly show goods being distributed, and repeated orders which indicate that sales are taking place.

61. The Opponent's advertising spend is significant for Germany running into millions of euros with a number of campaigns being run, in particular, the Captain Iglo video for fish/fishfingers generating over a million views on YouTube. However, its Facebook and Instagram accounts do not show significant activity. Its German Facebook account is shown to have over 150,000 followers, but its social media presence in other countries is very low. The number of followers the Opponent has on its Facebook and Instagram accounts in Portugal and Belgium, for example, are minimal and do not demonstrate an active presence in these countries. The press releases and articles do not show that they were published in mainstream magazines or websites and appear to have been placed in industry focussed publications. Furthermore no circulation figures are given or viewing figures of the number of consumers who read or accessed these websites.

62. I am unable to clearly interpret the market share table produced at exhibit 4 other than it appears to show a significant market share for frozen fish which is supported by the remaining evidence within Ms Darcy's statement. No evidence is produced however for seafood generally and therefore I can only reasonably take the evidence of market share to relate to frozen fish.

63. The evidence is not without its faults and lacks the specificity one would expect to have been filed. For example I am not told the number of units sold for each category of goods, nor specifically the revenue figures other than in general terms across all products. However, the Opponent has clearly been using its mark for a number of years across Europe, particularly in Germany and the Netherlands. I am satisfied, looking at the evidence as a whole, that it has used its mark for frozen foods, vegetables and ready meals.

### **Fair specification**

64. I must now consider whether and to what extent the evidence shows use for the earlier marks to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

65. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed



independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

66. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs. Although these are foodstuff products and not pharmaceuticals, the principles remain the same regarding subcategories. I shall go through the category of goods following the approach identified by Ms Darcy as falling into five groups namely Poultry, Fish, Desserts/Puddings, Vegetables and Snacks and Meals.

67. I do not consider that the Opponent has shown genuine use in relation to the broad term Desserts/Puddings. Some use has been shown for sweet dumplings, pastry including fruit and custard based pastries, but this is mainly by way of photographs on its own generic and country specific website and in some invoices. No revenue or market share figures are produced specifically for goods in this category other than €75,000 of sales over a two year period relating to Germany. Over a five year period I consider this figure to be insufficient to be regarded as genuine use.

68. I am unclear what is meant and covered by the term Snacks included within Ms Darcy’s evidence and the Opponent’s specification. This term is generally used to describe small portions of prepacked or processed foodstuff, eaten between meals. I cannot see anything in the Opponent’s evidence that could be taken to be included within this term. Even if the Opponent’s dumplings for example could be regarded as snacks, insufficient evidence has been produced to amount to genuine use for these goods in any event.

69. Taking the categories Meat, Poultry, Meals and Fish, I am satisfied based on the evidence filed that the Opponent has proved genuine use in relation to frozen fish and fish fingers, pasta, pizza, prepared meals (including those containing chicken and beef) and vegetables. Given the range of products under these categories for which it has used its marks I am satisfied that it can retain the following broad terms for the purposes of this opposition as set out below:

Class 29: Meat, fish, poultry;<sup>19</sup> frozen prepared meals; chilled foods consisting predominately of fish; chilled meals made from fish; cooked meals consisting principally of fish; fish cakes; frozen fish cakes; fish fillets; frozen fish fillets; fish fingers; frozen fish fingers; fish products; fish products being fresh; fish products being frozen; fish products being preserved; fish with chips; frozen cooked fish; frozen fish; frozen prepared meals consisting principally of fish; pre-cooked dishes incorporating [predominantly] fish; processed fish; frozen scampi; steaks of fish; frozen steaks of fish; chicken; chicken pieces; chicken products; cooked chicken; frozen chicken; deep frozen chicken; fried chicken; frozen fried chicken; prepared meals containing [principally] chicken; chicken nuggets; frozen prepared meals consisting principally of chicken; garden peas; frozen peas; vegetarian frozen foods; frozen prepared meals consisting principally of vegetables; frozen vegetables; frozen vegetables packed in single portions; burgers; frozen burgers; meat burgers; frozen meat burgers; meat products being in the form of burgers; vegetable burgers; frozen vegetable burgers; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals consisting wholly or substantially wholly of fish; frozen ready cooked meals consisting wholly or substantially wholly of fish; ready cooked meals consisting wholly or substantially wholly of meat; frozen ready cooked meals consisting wholly or substantially wholly of meat; ready cooked meals consisting wholly or substantially wholly of poultry; frozen ready cooked meals consisting wholly or substantially wholly of poultry; ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready cooked meals consisting wholly or substantially wholly of vegetables; frozen ready meals;

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<sup>19</sup> These goods appear in both earlier marks' specifications.

Class 30: deep frozen pasta; ready cooked meals consisting wholly or substantially wholly of pasta; frozen ready cooked meals consisting wholly or substantially wholly of pasta.

70. No or insufficient evidence has been provided at all for the remaining goods under its registrations and the Opponent is unable to rely on these goods for the purposes of its opposition. It is unable to rely upon core ingredients that constitute or are used in the prepared meals that it sells.

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

71. Section 5(2)(b) of the Act states as follows:

“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.”

72. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 the goods**

73. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

74. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

“... 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.”

75. In light of my findings regarding the proof of use the comparison shall be undertaken between those goods I found the Opponent was able to retain for the purpose of this opposition as set out in paragraph 69 and the Applicant's *ice creams*.

76. To establish a likelihood of confusion between the marks it is essential for there to be at the very least some identity or similarity between the goods or services. This was highlighted in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that (my emphasis):

“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.”

77. The case of *2nine Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-363/08 stated as follows in relation to the similarity of class 25 goods to certain goods in classes 9,14 and 26:

“40. It must, moreover, be pointed out that the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (*PiraÑAM diseño original Juan Bolaños*, paragraph 30 above, paragraph 44; see also, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).”

78. Other than both parties' goods being frozen foodstuff and directed at the general public, consumers will not consider that these goods are similar. Even if they happen to be sold in the frozen section of retail premises they are unlikely to be in the same cabinets; ice creams would be displayed in separate units to savoury foodstuff. The goods may well be sold together in supermarkets and will thus on a very general level overlap in trade channels, but this is insufficient in accordance with the caselaw. The goods are manufactured from different ingredients, via different processes. The goods differ in nature and purpose, they do they compete with one another. There is no complementarity between them, where one could be used or was indispensable to the other, so that consumers would think that the same or linked undertakings were responsible. The goods are dissimilar. No consumer would determine that there would be any identity or similarity in the goods other than the fact that they are consumables. The fact that they are all foods found in the frozen compartments of supermarkets is not enough for similarity.

79. I conclude therefore that the respective parties' goods are not identical or similar. Under s5(2)(b) for there to be a likelihood of confusion between the marks there has to be a finding of similarity between the goods or services.

80. Based on my conclusions, the opposition under section 5(2)(b) of the Act fails. I shall now move on to consider the ground of opposition under section 5(3).

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

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

“A trade mark which-

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

(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.”

82. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

83. The relevant case law can be found in the following judgements of CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case

C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

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

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

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



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

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

84. The conditions of section 5(3) are cumulative. The Opponent must show similarity between the respective marks; that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public and 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 marks being brought to mind by the later mark. Assuming that the first three conditions have been met, section 5(3) requires that one or more of the types of damage claimed by the Opponent will be suffered. It is unnecessary for the purposes of section 5(3) for the goods to 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 them. For the purposes of section 5(3) the relevant date for the assessment is 10 August 2020.

### **Reputation**

85. I shall deal with the question of whether the Opponent has established a reputation first. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

86. The marks upon which the Opponent relies for the purposes of its claim under section 5(3) are comparable marks based on pre-existing EUTMs. The use in the EU prior to IP Completion Day is therefore relevant to the assessment of the existence of a reputation in accordance with Schedule 2A of the Act.

87. I have summarised the Opponent's evidence in relation to use. It is clear that the Opponent has used its mark throughout the EU and although Ms Darcy states that its use extends to Austria, Belgium, Germany, Hungary, the Netherlands and Portugal the evidence for these countries bar Germany and the Netherlands is very limited. Ms Darcy provides global revenue figures which are not broken down by country or category of goods, but she has provided sales figures and significant advertising spend for Germany and the Netherlands which show significant sales for frozen fish, prepared meals and vegetables.

88. In *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, it was held that a reputation in a single member state may be sufficient to constitute the required reputation in “a substantial part of the territory of the Community”. On this basis it is not fatal to the Opponent that it has not demonstrated a reputation in every

member state or throughout the whole of the EU, evidence of a reputation in both Germany and the Netherlands is sufficient. Based on my assessment of the evidence, I have no hesitation in finding that the Opponent has a significant reputation in the EU (by virtue of the use in Germany and the Netherlands) for those goods as outlined in paragraph 69.

89. However, the Opponent has not provided any evidence of any use or an establishment of a reputation in its marks in the UK. There is no evidence at all to show sales or any awareness of the brand by the UK public.

### **Link**

90. Having considered that IGLO enjoys a reputation in the EU, I would ordinarily go on to consider whether or not the average consumer will make a link between the earlier marks and the contested marks taking account of the factors in *Intel*.<sup>20</sup> Whilst its reputation is considered a qualifying reputation under section 5(3), I note that it will still be more difficult for a mark which holds a reputation in a country outside the UK to show a link will be made between the marks. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.

It is apparent from the court’s judgment that “a commercially significant part of the [relevant] public” is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. This is confirmed by versions of the

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<sup>20</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* C-252/07

judgment in other languages. The French version says that a “commercially non-negligible” part of the relevant public in the Member State must be aware of the earlier CTM (now: EUTM) and make a link with the later national trade mark.

It follows that where there is no awareness of the EU trade mark in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary ‘link’ between the EU mark and the later national mark. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the [EU] reputation and/or the distinctive character of the EU trade mark.”

91. The evidence provided by the Opponent does not show that the relevant public in the UK have an awareness of its mark/s. Absent a reputation in the UK, notwithstanding its reputation in Germany and the Netherlands, I see no reason to conclude that a link would be made in the minds of a significant part of the relevant UK public. On this basis I find it unnecessary to go through the *Intel* factors since without a link being able to be established none of the types of damage or injury could arise.

92. The opposition under section 5(3) fails.

### **Conclusion**

93. The opposition fails under both grounds of opposition, subject to appeal the applications may proceed to registration.

### **Costs**

94. The Applicant has been successful and therefore is entitled to a contribution towards its costs. Any award of costs is governed by the published scale as set out in Tribunal Practice Notice 2 of 2016. I note that the application was for two marks resulting in two separate oppositions. However, the proceedings were consolidated early in the process without necessitating any duplication in the arguments put forward. I have taken these matters into account when assessing costs and make the following award:

Considering the notices of opposition and preparing a defence and counterstatement to each:	£400
Considering the Opponent's evidence and preparing submissions in reply:	£600
Drafting submissions in lieu of hearing and considering the Opponent's submissions:	£400
<b>Total</b>	<b>£1,400</b>

95. I order Nomad Foods Europe Limited to pay International Foodstuffs Co. LLC the sum of £1,400 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 8<sup>th</sup> day of February 2023

Leisa Davies

For the Registrar