

O/0452/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003709356

BY JATINDER SINGH

TO REGISTER THE TRADE MARK:



**MAMA'S
TASTE**

IN CLASSES 29, 30 AND 31

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430322 BY

DRUSTVO ZA PRERABOTKA NA OVOSJE I ZELENCUK TRGOPRODUKT DOO
UVOZ-IZVOZ STRUMICA

BACKGROUND AND PLEADINGS

1. On 13 October 2021, Jatinder Singh (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 19 November 2021 and registration is sought for the following goods:

Class 29 Meat and meat products; Beans; Dried beans.

Class 30 Food flavourings; Food seasonings; Food dressings [sauces]; Starch for food; Flour for food; Foods (Farinaceous -); Cereal breakfast foods; Processed grains; Maize flour; Wheat flour; Potato flour; Rice flour; Flour.

Class 31 Raw grain; Unprocessed grain; Grains [cereals].

2. On 19 January 2022, the application was opposed by Drustvo za prerabotka na ovojse i zelencuk TRGOPRODUKT DOO uvoz-izvoz Strumica (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon trade mark no. 915850415 for the mark **MAMA’S**, which was filed on 20 September 2016 and registered on 24 January 2017.¹ The opponent relies upon all goods for which the mark is registered, namely:

Class 9 Electronic publications [downloadable], namely downloadable publications relating to food recipes.

Class 29 Homemade ajvar [preserved peppers]; roasted peppers; preserved fruits; fruit jams and purees; gherkins; baked beans; preserved vegetables.

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Class 30 Chutneys; fruit sauces included in this class; peppers [seasonings]; tomato sauce; ketchup.

3. Under section 5(2)(b), the opponent claims that the marks are similar and that the goods are identical or similar, resulting in a likelihood of confusion.

4. Under section 5(3), the opponent claims that it has a reputation for all of the goods listed above and that use of the applicant's mark would, without due cause, take advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. The applicant is represented by HGF Limited and the opponent is represented by Taylor Wessing LLP.

7. The applicant filed a witness statement with his Form TM8. Both parties filed evidence in chief. The opponent also filed evidence in reply. Neither party requested a hearing, and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The applicant filed a witness statement with his Form TM8 dated 31 March 2022. The majority of that document contains submissions rather than evidence; it is, essentially, the applicant's counterstatement. However, it was accompanied by 3 exhibits (JS1-JS3).

9. The opponent filed evidence in chief in the form of the witness statement of France Delord dated 20 September 2022, which is accompanied by 3 exhibits (FD1-FD3). Ms Delord is a Partner at the opponent's representative.

10. The applicant filed evidence in chief in the form of the witness statement of Lauren Richardson (undated), which is accompanied by 6 exhibits (LR1-LR6). Ms Richardson is a Trade Mark Attorney at the applicant's representative.

11. The opponent filed evidence in reply in the form of the witness statement of Julia King dated 20 January 2023, which is accompanied by 1 exhibit (JK1). Ms King is a Chartered Trade Mark Attorney acting on behalf of the opponent.

12. The applicant filed undated written submissions in lieu on 21 February 2023.

RELEVANCE OF EU LAW

13. 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Preliminary Issue

14. Ms King's witness statement serves to introduce correspondence which confirms that the opponent is opposing three other trade marks in the EU, all of which contain the word MAMA'S. No explanation is provided by the opponent as to what relevance these other proceedings have. I agree with the applicant that they are of no apparent relevance and I give no further consideration to them.

Section 5(2)(b)

15. Section 5(2)(b) of the Act reads 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.”

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act.

18. 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 goods

19. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 9</u> Electronic publications [downloadable], namely downloadable publications relating to food recipes.</p> <p><u>Class 29</u> Homemade ajvar [preserved peppers]; roasted peppers; preserved fruits; fruit jams and purees; gherkins; baked beans; preserved vegetables.</p> <p><u>Class 30</u> Chutneys; fruit sauces included in this class; peppers [seasonings]; tomato sauce; ketchup.</p>	<p><u>Class 29</u> Meat and meat products; Beans; Dried beans.</p> <p><u>Class 30</u> Food flavourings; Food seasonings; Food dressings [sauces]; Starch for food; Flour for food; Foods (Farinaceous -); Cereal breakfast foods; Processed grains; Maize flour; Wheat flour; Potato flour; Rice flour; Flour.</p> <p><u>Class 31</u> Raw grain; Unprocessed grain; Grains [cereals].</p>

20. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

24. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

Class 29

Meat and meat products

25. The opponent's specification does not include any meat products. The mere fact that both specifications include food products and would all be used by the general public does not, in my view, give rise to similarity. The applicant's goods differ in nature, method of use, purpose and trade channels with the opponent's goods. They are neither in competition nor complementary. Consequently, I consider them to be dissimilar.

Beans

26. This term in the applicant's specification is broad enough to cover beans in any form. Consequently, I consider it to be identical on the principle outlined in *Meric* to "baked beans" in the opponent's specification.

Dried beans

27. This term will overlap in nature to a degree with "baked beans" in the opponent's specification as both are types of beans. However, they will differ in that one has been dried in order to preserve it and the other has been canned and cooked in sauce. The purpose of the goods will clearly overlap. The method of use will differ, as the opponent's goods can just be heated prior to eating, but are essentially already cooked, whereas the applicant's goods will need rehydrating and cooking before they can be consumed. The user of the goods will clearly overlap. I have no evidence before me that there will be any overlap in trade channels other than at a general level (such as in supermarkets). However, the aisles in which the goods are likely to be sold will differ as the opponent's goods will be sold in aisles of canned goods and the applicant's goods will be sold in an aisle for packet goods. The goods are not complementary and I do not consider there to be any meaningful competition. The goods are similar to a medium degree.

Class 30

Food flavourings; food seasonings

28. These goods are identical on the principle outlined in *Meric* to “peppers [seasonings]” in the opponent’s specification.

Food dressings [sauces]

29. The opponent submits that these goods are identical to “tomato sauce” and “ketchup” in the opponent’s specification. I agree. They are plainly identical on the principle outlined in *Meric*.

Starch for food; Flour for food; Foods (Farinaceous -); Cereal breakfast foods; Processed grains; Maize flour; Wheat flour; Potato flour; Rice flour; Flour

30. The opponent has provided no explanation for how these goods are similar to its own specification and I can see no meaningful point of overlap in nature, method of use, purpose or trade channels. There is no competition or complementarity. The fact that the users overlap and they are all, broadly speaking, food products, is not sufficient for a finding of similarity. I consider the goods to be dissimilar.

Class 31

Raw grain; Unprocessed grain; Grains [cereals]

31. Again, the opponent has provided no explanation for how these goods are similar to its own specification and I can see no meaningful overlap in nature, method of use, purpose or trade channels. There is no competition or complementarity. The applicant’s goods are likely to be used by those involved in agriculture, rather than members of the general public. However, even if there is an overlap in user, this is not sufficient on its own for a finding of similarity. I consider the goods to be dissimilar.

32. In order for there to be a likelihood of confusion, there must be some similarity of goods. Consequently, the opposition must fail in relation to those goods that I have found to be dissimilar. I will, therefore, consider the global assessment in respect of the following goods only:

Class 9 Beans; dried beans.

Class 30 Food flavourings; food seasonings; food dressings [sauces].

The average consumer and the nature of the purchasing act

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

34. The average consumer for the goods that I have found to be similar will be a member of the general public. The applicant submits that an average degree of attention will be paid during the purchasing process and the opponent submits that the degree of attention will be “below average to average”. In my view, the cost of the goods is likely to be low and they will be reasonably frequent purchases. However, the average consumer will take factors such as flavour preferences, nutritional content and dietary requirements into account. Consequently, I consider that a medium (or average) degree of attention will be paid during the purchasing process.

35. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalents. Consequently, visual considerations are likely to dominate the purchasing process. However, given that advice may be sought from retail assistants, I do not discount that there may be an aural component to the purchase.


Comparison of trade marks

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

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

37. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

38. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
MAMA'S	 <p data-bbox="882 517 1321 663">MAMA'S TASTE</p>

39. The opponent's trade mark consists of the word MAMA'S. There are no other elements to contribute to the overall impression, which lies in the word itself. The applicant's mark consists of the words MAMA'S TASTE presented (one on top of the other) in large black font (as noted by the opponent, the word MAMA'S appears slightly bigger and, therefore, more prominently). Above those words is a colourful palm tree, badge device containing the words MAMA'S TASTE TASTE OF AFRICA. The words MAMA'S TASTE play the greater role in the overall impression due to the size of those words, with the badge device (and the text it contains) playing a slightly lesser role.

40. Visually, the marks overlap in that they contain the word MAMA'S. However, they differ in the additional word TASTE in the applicant's mark and the palm tree, badge device, both of which are absent from the opponent's mark. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

41. Aurally, the word MAMA'S will be pronounced identically in both marks. The word TASTE in the applicant's mark will act as a point of aural difference. I consider it unlikely that the words in the device will be articulated (because of the repetitive element and the fact that they are likely to be viewed as describing the origin/style of the goods). Consequently, I consider the marks to be aurally similar to between a medium and high degree. However, if the additional word elements in the device are pronounced then they will be aurally similar to a medium degree.

42. Conceptually, both marks share the concept of referring to something that belongs to mother (by virtue of the affectionate/shortened term “MAMA”). In the opponent’s mark, what it is that belongs to “MAMA” is ambiguous, but it is likely to be seen as referring to the product it appears on (such as, MAMA’s beans). The applicant’s mark refers to MAMA’S TASTE, indicating that it refers to a mother’s preference for a particular flavour/product. The palm tree device in the applicant’s mark will also convey a conceptual message in itself, which is absent from the opponent’s mark. The words ‘TASTE OF AFRICA’ in the applicant’s mark will be a further point of conceptual difference, although I do not consider it to be a distinctive one. Taking all of this into account, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

45. The earlier mark consists of the word MAMA’S. It is allusive of something that is home-cooked or a home-inspired recipe. I consider it to be distinctive to between a low and medium degree.

46. For the purposes of considering enhanced distinctiveness, the relevant market is the UK. As the applicant submits, parts of the opponent’s evidence are dated after the relevant date and, therefore, does not assist them. However, I note the following from the opponent’s evidence:

- a) The opponent’s MAMA’S goods were first introduced in the UK market in 2012, working with Fortnum & Mason, MAGAZA food.
- b) Since 2012, the opponent has made a profit of €516,270.47 and turnover of over €1million in the UK in relation to its MAMA’S goods.
- c) By 2016, the opponent’s MAMA’S goods were being sold in Fortnum & Mason.² In particular, the goods sold were condiments and preserves.
- d) The opponent has provided ‘financial information’ which lists invoices addressed to UK customers (including dates and amounts), but no information is provided about what proportion of these relate to MAMA’S goods (or, indeed, what food products).³

² Exhibit FD1

³ Exhibit FD3

47. The turnover and profit figures are not broken down by goods to enable me to identify the scale of the use shown in relation to the goods relied upon. Further, it is not clear what proportion of these figures relate to the period prior to the relevant date. As noted above, there are clearly issues with the invoice information provided by the opponent. I note that the opponent's goods have been sold by well-known retailers such as Fortnum & Mason. The goods were sold in the UK for 9 years prior to the relevant date. However, I have no information about market share information, no advertising or promotional expenditure or information about activities undertaken. Taking the evidence as a whole into account, I am not satisfied that the opponent has established that the distinctive character of the earlier mark has been enhanced through use.

Likelihood of confusion

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

49. I have found as follows:

- a) I have found the goods to be identical or similar to a medium degree.

- b) The average consumer is a member of the general public who will pay a medium (or average) degree of attention during the purchasing process.
- c) The marks are visually similar to between a low and medium degree, aurally similar to a medium or between medium and high degree (depending on how they are pronounced) and conceptually similar to a medium degree.
- d) The earlier mark is inherently distinctive to between a low and medium degree.

50. Taking all of the above factors into account, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other, even when used on identical goods. This is particularly the case bearing in mind the visual differences between the marks and the fact that the purchasing process will be predominantly visual. Consequently, I do not consider there to be a likelihood of direct confusion.

51. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

52. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

53. Bearing in mind the earlier mark is only distinctive to between a low and medium degree, I do not consider the common element to be so strikingly distinctive that the average consumer would consider only one undertaking to be using it. The addition of the word TASTE (which changes the conceptual meaning), plus the device, are not, in my view, non-distinctive additions. I do not consider the addition of a second word, which changes the conceptual meaning of the mark, to be consistent with a brand extension. The opponent has provided no explanation as to how indirect confusion

would occur, outside of the three examples identified in the above case law, nor am I able to identify any. Consequently, I do not consider there to be a likelihood of indirect confusion.

54. The opposition based upon section 5(2)(b) is dismissed.

Section 5(3)

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

“5(3) A trade mark which -

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

56. Section 5(3A) of the Act states:

“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.”

57. 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

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

58. I can deal with this ground relatively swiftly. For the reasons identified above, I am not satisfied that the opponent has demonstrated the requisite reputation. There is insufficient evidence to establish a reputation in the UK or the EU. Consequently, the opposition based upon this ground fails at the first hurdle.

59. The opposition based upon section 5(3) is dismissed.

CONCLUSION

60. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

61. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,350**, calculated as follows:

Filing a counterstatement and considering the Notice of opposition	£300
Filing evidence and considering the opponent's evidence	£700
Written submissions in lieu	£350
Total	£1,350

62. I therefore order Društvo za prerabotka na ovojse i zelencuk TRGOPRODUKT DOO uvoz-izvoz Strumica to pay Jatinder Singh the sum of £1,350. This sum should

be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of May 2023

S WILSON

For the Registrar