

O/29120

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003369923

BY THE SKINNY BAKERY LTD

TO REGISTER THE TRADE MARK:



IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 416207 BY

URBAN FRESH FOODS LTD

BACKGROUND AND PLEADINGS

1. On 25 January 2019, The Skinny Bakery Ltd (“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 1 February 2019 and registration is sought for the following goods:

Class 30 Cake bars; Cake frosting; Cake frosting [icing]; Cake Pops; Cakes; Candies [sweets]; Candy; Candy bars; Caramel; Cereal bars and energy bars; Cheesecake; Chocolate; Chocolate bars; Chocolate based products; Chocolate brownies; Confectionery; Cookie dough; Cookie mixes; Cookies; Crackers; Dessert puddings; Biscuits; Wafer biscuits; Cake mixes; Meringue.

2. On 1 May 2019, Urban Fresh Foods Ltd (“the opponent”) opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following earlier trade marks:



UK registration no. 3334002

Filing date 24 August 2018; registration date 14 December 2018

Relying on all goods for which the marks are registered, namely:

Class 29 Preserved, dried, cooked, frozen and baked fruits and/or vegetables; fruit and/or vegetable based snack foods; vegetable salad; fruit salad; jellies; jams; compotes; milk, milk products; yoghurt, snacks of yoghurt, yoghurt based drinks.

Class 30 Cereal based snack foods; wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture; snack foods

predominantly consisting of wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture also including fruit; porridge oats; porridge predominantly consisting of oats also including fruit; ice cream, frozen yoghurt; confectionery; cookies or biscuits.

("the First Earlier Registration")



UK registration no. 3333749

Filing date 23 August 2018; registration date 25 January 2019

Relying on all goods for which the marks are registered, namely:

Class 29 Preserved, dried, cooked, frozen and baked fruits and/or vegetables; fruit and/or vegetable based snack foods; vegetable salad; fruit salad; jellies; jams; compotes; milk, milk products; yoghurt, snacks of yoghurt, yoghurt based drinks.

Class 30 Cereal based snack foods; wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture; snack foods predominantly consisting of wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture also including fruit; porridge oats; porridge predominantly consisting of oats also including fruit; ice cream, frozen yoghurt; confectionery; cookies or biscuits.

("the Second Earlier Registration")

BEAR

UK registration no. 2611059

Filing date 17 February 2012; registration date 8 March 2013

Relying on some goods for which the mark is registered, namely:

Class 29 Preserved, dried, cooked and baked fruits and vegetables; fruit and vegetable based snack foods; jellies.

Class 30 Cereal based snack foods; confectionery all in the form of rolls; none of the aforesaid being cookies or biscuits.

("the Third Earlier Registration")

3. The opponent claims that there is a likelihood of confusion because the parties' respective trade marks are similar, and the goods are similar.

4. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of the Third Earlier Registration for "cereal based snack foods" and "confectionery in the form of rolls".

5. The opponent is represented by Keltie LLP and the applicant is unrepresented. Both parties filed evidence in chief and the opponent filed evidence in reply. No hearing was requested and only the applicant filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent's Evidence in Chief

6. The opponent filed evidence in the form of the witness statement of Isabelle Maes dated 26 August 2019, which is accompanied by 12 exhibits. Ms Maes is a Director of the opponent, a position she has held since December 2015. I have summarised Ms Maes' evidence only to the extent that I consider it necessary.

7. Ms Maes explains that the opponent was originally incorporated in May 2006. She states that a business called Lotus Bakeries ("Lotus") acquired 100% of the shares in the opponent company in December 2015. An official press release about the acquisition states as follows:

"BEAR, UFF's flagship brand, is loved by parents and children alike for its range of innovative and delicious pure fruit snacks. With a range that spans the fruit snacking, baby, and breakfast cereal categories, it has gained momentum through its focus on delicious natural recipes, and also through its interactive and playful approach such as the Yoyo collector cards. As a result BEAR received over 3,000 letters a week from kids. BEAR Yoyos and Paws are made

from gently baked pure fruit that is picked in season, with no added sugar, concentrates, preservatives or stabilisers. After just six years, BEAR is now the UK's No. 1 kids' fruit snacking brand with market share in excess of 30% and is available in over 18,000 stockists. In 2013, the business created BEAR Alphabites, the UK's first children's breakfast cereal with no refined sugar or salt and then recently launched its new Claws range in October 2015 incorporating two thirds fruit and one third vegetables.”¹

8. The press release also includes the following images of the opponent's products:



9. The acquisition was covered in an article in The Telegraph dated 16 December 2015 and on the website Bakeryandsnacks.com dated 18 December 2015.² Both articles refer to the acquisition of the “bear” brand.

10. An article published on the website ThisisMoney.co.uk dated 29 December 2012 is titled “Fitness fans team roars ahead with Bear fruit snacks”.³ The article confirms that for the year ending October 2011, the opponent had a turnover of £3.5million. The founder of the brand is quoted as stating:

“We have recently won new listings in Caffe Nero and Sainsbury's. Subway started trialling Bear Nibbles two months ago.

¹ Exhibit IM1

² Exhibit IM1

³ Exhibit IM2

We have just started exporting to Germany, Belgium and the Netherlands and within a year we will be launching a new product. [...]"

11. The article goes on to state that "Bear Nibbles is now stocked in all the major grocery chains including Tesco, Asda, Co-op and Waitrose."

12. Ms Maes states:

"6. BEAR is the core brand or 'house' brand of UFF in relation to its children's healthy snack division. The BEAR trade mark is used in conjunction with the 'sub-brands' YOYOS in relation to its range of healthy confectionery in the form of rolls which are vegetable and fruit based snacks, and ALPHABITES in relation to its breakfast cereal product. For the sake of clarity, I have referred to BEAR YOYOS or BEAR ALPHABITES to distinguish between the confectionery and cereal products."

13. Ms Maes has provided examples of the packaging used on BEAR products between 2009 and 2019.⁴ By way of example, the following packaging was used in 2015:



⁴ Exhibit IM3

14. Print outs from the opponent's website dated 19 December 2014, 17 January 2015, 12 August 2015, 28 January 2016, 18 July 2016, 17 December 2018 and 17 January 2019 all display the Second Registration.⁵ The printouts from 2014, 2015 and 2016 also display the following images which reference the opponent's cereal and fruit roll products:



⁵ Exhibit IM5

15. Ms Maes states that the opponent has used the trade mark BEAR in relation to confectionery fruit rolls since 2009 and in relation to cereal goods since 2013 in the UK. She goes on to state:

“10. In October 2009, we secured our first order from Waitrose which included 1.067 cases of our BEAR YOYOS confectionery fruit rolls to be distributed in around 190 stores. Due to the upgrade to our accounting software we do not have a soft copy of the invoice and it is difficult to retrieve a hard copy of this invoice. Waitrose has been stocking BEAR YOYOS fruit snacks continuously since 2009.

11. In 2013, my business created BEAR ALPHABITES, the UK’s first children’s breakfast cereal with no refined sugar or salt. We secured our first order with Waitrose in relation to BEAR ALPHABITES on 10 June 2013. For the same reasons above, we do not have a soft copy invoice and it is difficult to obtain the hard copy of this invoice. Waitrose had been stocking BEAR ALPHABITES cereal continuously since 2013.”

16. Ms Maes has provided a selection of invoices dated between May 2014 and August 2018.⁶ These invoices show sales of over 7,000 units of BEAR YOYO products and over 200 units of BEAR ALPHABITES products. The invoices are addressed to businesses located across the country including in London, Cheshire, Wiltshire, Durham and Dundee.

17. Ms Maes has also provided a selection of purchase orders dated between 10 January 2014 and 13 February 2014.⁷ Clearly, some of these are dated prior to the relevant period for establishing proof of use. However, those that are dated within the relevant period show orders for over 5,000 BEAR YOYO products to be delivered to Co-op and Morrisons.

⁶ Exhibit IM6

⁷ Exhibit IM7

18. A report provided by Ms Maes shows sales by region for BEAR ALPHABITES and BEAR YOYO products.⁸ Ms Maes explains that for the BEAR ALPHABITES products the figures displayed show the number of cereal boxes sold, whereas for BEAR YOYO products, the figures displayed show the number of packs sold (each containing two rolls). For both products, sales are recorded across various regions in England, as well as in Scotland and Wales between 20 August 2016 and 20 July 2019. For BEAR ALPHABITES, the total boxes sold throughout the UK varied from around 30,000 on 5 January 2019 to around 90,000 on 15 October 2016. For BEAR YOYOS, the total boxes sold throughout the UK varied from around 2,500,000 on 20 August 2016 to over 5,000,000 on 3 February 2018.

19. The First Registration and the words “BEAR nibbles” are used across the opponent’s social media channels.⁹ A video posted on the opponent’s YouTube channel dated 27 August 2015 is entitled “BEAR Alphabites – New Glow in the Dark Monster Magnets!”.

20. Ms Maes has provided examples of advertisements placed by the opponent, in particular, in relation to BEAR YOYOS and BEAR ALPHABITES.¹⁰ These were placed in Parentkind Magazine (2017/2018), through paid social media advertising (2018/2019) and on Tumble Tots website (2018).

21. Ms Maes states that in January 2018, the opponent’s first TV advert aired on ITV, Channel 4, 4 Music, Sky One, Comedy Central, CBS Reality, Sky Living, TLC and E4. The first broadcast was on 4 January 2018 on Sky Cinema Disney. An article published on Talkingretail.com in January 2018 stated that “Bear Nibbles has launched its first TV adverts as part of a £3m media campaign [...]”. Ms Maes states that total expenditure was around £2million in 2018 and £700,000 in 2019. Ms Maes explains:

“Reach means the % of the target audience that sees the ad one or more than 3 times and the frequency means the average number of times people saw the ad. The highest reach and frequency was in September 2018. For the January

⁸ Exhibit IM8

⁹ Exhibit IM9

¹⁰ Exhibit IM10

launch campaign, we had 82.52% reach of our target audience (adults and children) at 8.90 frequency. This gave us 68% reach of the target audience seeing it more than 3 times across the month. We aimed for 33% reach of the target audience seeing the advert at least 3 times in 2018 and 2019. We reran the advert in May 2017 and did a region airing in September 2018.”

22. Ms Maes confirms that the opponent has won the following awards: 2010 Grocer Gold Product Awards, 2011 Metro Venture Candy Award, 2011 The Grocer Gold Product Awards, 2012 Great Taste Gold Award, 2013 The Grocer SME Foods & Drink Brand of the Year Award, 2014 DBA Grand Prix Design Award, 2015 The Grocer Marketing Campaign of the Year Award, 2015 Cool Brands Award and 2018 The Grocer Top Campaign Award for Kids' Snacks.

23. Ms Maes has provided a number of articles about the awards.¹¹ In particular, I note as follows:

- a. An article dated 12 August 2011 confirms that it was the “Bear” product range that won Metro’s Venture Candy 2011 Award. The article confirms that this was voted for by Metro readers and that Bear won 54 per cent of the vote in the ‘Food and Drink’ category.
- b. An undated article lists “Bear” as the winner of the 2014 DBA Grand Prix Design Award with images showing YOYO and ALPHABITES products alongside the article. The article states: “BEAR has become the fastest growing brand in healthy snacking, delivering over 30million portions of fruit in the UK in 2012”.
- c. The results for the 2015 Cool Brands Award lists “Bear” as the winner for the ‘Food – Other Snacks’ category.

24. Ms Maes states that the annual turnover figures under the mark in relation to baked fruit snack confectionery in the form of rolls between 2014 and 2018 is approximately

¹¹ Exhibit IM12

£10,000,000 to £20,000,000 and the annual turnover figures under the mark in relation to cereal goods from 2014 to 2018 is approximately £800,000 to £1,500,000.

25. I note that the opponent's evidence was accompanied by written submissions. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

The Applicant's Evidence in Chief

26. The applicant filed evidence in the form of the witness statement of Mariella Luisa Dalton Crosthwait dated 18 November 2019. Ms Crosthwait is the Managing Director of the applicant, a position she has held since 2013. I have summarised Ms Crosthwait's evidence, only to the extent that I consider it necessary.

27. Ms Crosthwait has provided an undated printout of the opponent's website which she states demonstrate that the opponent's goods are made of 100% fruit and vegetables.¹² The website print out states "Just fruit. Just veg. Absolutely nothing else." The applicant suggests that the opponent's YOYO goods cannot properly be considered confectionery.

28. Ms Crosthwait notes that the opponent uses the word BEAR in relation to the animal, whereas the applicant used the word BARE as a determiner. In this regard, Ms Crosthwait has provided a number of print outs from the opponent's website which show the image of a BEAR (either in the form of the First Earlier Registration or presented as different devices) alongside the opponent's branding.¹³ Ms Crosthwait has also referred to the fact that these examples include text such as "cubs" and "give us a growl" which reinforces this. By contrast, Ms Crosthwait has provided a print out from the applicant's Facebook page (which is undated) which she states shows use of the word BARE as a determiner e.g. 'BARE LOVE FOR YOUR ORDER' and 'BARE TASTY'.¹⁴

¹² Exhibit 1

¹³ Exhibits 4, 5 and 6

¹⁴ Exhibit 7

29. I note that the applicant's evidence was accompanied by written submissions. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

The Opponent's Evidence in Reply

30. The opponent filed evidence in reply in the form of the witness statement of Eleni Mezulanik dated 30 January 2020, which is accompanied by 7 exhibits. Ms Mezulanik is the Chartered Trade Mark Attorney acting on behalf of the opponent in these proceedings.

31. Ms Mezulanik has provided a number of print outs about 'healthy confectionery'.¹⁵ The first is a print out from a blog about confectionery products dated 16 February 2017 titled 'Healthy Confectionery'. The article states:

“According to Euromonitor International, healthy chocolate confectionery, which includes fortified functional, organic, reduced fat and reduced sugar, will grow by 3.5% globally in retail value terms from 2016-2021. This, its research shows, will outpace regular chocolate confectionery, which is set to rise 2.3% in retail value terms.”

32. The second is dated 12 August 2019 and is taken from the website ingredientsnetwork.com. This article states:

“Growing concern about sugar has led to a slowdown in the global confectionery market, but there are pockets of faster growth, including in functional confectionery, as consumers look for more than a permissible indulgence – a sweet treat that delivers a real health benefit.”

33. The article goes on to state that boiled sweets are being used to deliver vitamins and other similar supplements within the pharmaceutical industry.

¹⁵ Exhibit ECM1

34. Ms Mezulanik has provided print outs from the Collins English Dictionary and Cambridge Dictionary which provide the following definitions for the word “snack”:¹⁶

“A snack is a simple meal that is quick to cook and to eat.”

“A snack is something such as a chocolate bar that you eat between meals.”

“If you snack, you eat snacks between meals.”

“A small quantity of food; light meal or refreshment taken between regular meals.”

“To eat a snack or snacks.”

“A small amount of food that is eaten between meals, or a very small meal.”

35. Ms Mezulanik has also provided a print out from Wikipedia which is dated January 2020 and lists “cereal” as a snack food.¹⁷

36. Ms Mezulanik has undertaken a search of the Sainsbury’s website, the results of which are dated 29 January 2020.¹⁸ The term searched for is “cereal snack” and the results show a number of cereal and cereal bar products.

37. An undated print out from a website titled Easily Confused Words has been provided which lists ‘bear or bare’ as one of the examples of commonly confused spellings.¹⁹

38. The opponent’s evidence in reply was accompanied by written submissions. Again, whilst I do not propose to summarise those submissions here, I have taken them into consideration and will refer to them below where necessary.

¹⁶ Exhibit ECM2

¹⁷ Exhibit ECM3

¹⁸ Exhibit ECM4

¹⁹ Exhibit ECM6

PRELIMINARY ISSUES

39. In its counterstatement, the applicant refers to various other marks that are already registered and which contain the word BARE or BEAR. However, I refer the applicant to the decision of the General Court (“GC”) in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, when it was stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

40. It is clear from the case law that when assessing the likelihood of confusion under section 5(2), it is necessary to consider the potential for conflict between the applied for mark and the earlier registrations in light of all the relevant circumstances. The existence of other trade marks on the Register is not relevant to the matter before me.

41. Further, the applicant has stated that this office did not notify them of the existence of the earlier registrations at the examination stage. The applicant suggests that this demonstrates agreement on the part of the office that the marks were not confusingly similar. However, the initial search undertaken by an examiner upon receipt of an application to register a trade mark is not an exhaustive search of the Register for potentially similar marks. It was made clear to the applicant in our correspondence

dated 29 January 2019 that “if you proceed, your application will be published in the online Trade Marks Journal and anyone can oppose your application should they have grounds to do so. If such action were to be successful, this would likely result in a costs award against you.” It is, therefore, clear that the search undertaken by the examiner is not indicative of the merits of this opposition.

DECISION

42. 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.”

43. Section 5A of the Act states:

“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.”

44. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. The First Earlier Registration and the Second Earlier Registration completed their registration process less than 5 years before the application date of the mark in issue. They are not, therefore, subject to proof of use pursuant section 6A of the Act and the opponent can rely upon all of the goods for which those marks are registered. However, the applicant

has requested that the opponent provide proof of use of the Third Earlier Registration, which had been registered for more than 5 years at the application date of the mark in issue.

Proof of Use

45. As noted above, the applicant has put the opponent to proof of use of the Third Earlier Registration. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

“6A(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), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

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

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

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

46. Section 100 of the Act is also relevant, which reads:

“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.”

47. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the 5-year period ending with the date of the application in issue i.e. 26 January 2014 to 25 January 2019.

48. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence

that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

49. 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, therefore, not genuine use.

Form of the Mark

50. 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 Court of Justice of the European Union (“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 *Nestle*, 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 of 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)

51. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

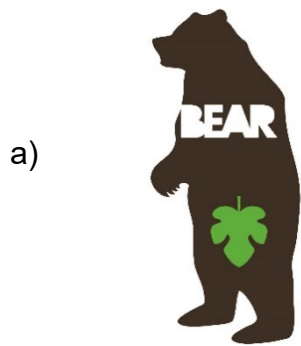
“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

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

52. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

53. Where the Third Earlier Registration has been used as registered, this will clearly be use upon which the opponent can rely (for example, in invoices and in publications). There are, of course, examples of the Third Earlier Registration being used as registered alongside words such as YOYO and ALPHABITES which are used to distinguish different products sold under the BEAR mark. As per *Colloseum*, I consider this to be acceptable use of the Third Earlier Registration.

54. There are also examples throughout the opponent’s evidence (such as on its website and on product packaging) in the form shown in the First Earlier Registration and the Second Earlier Registration i.e. in the following marks:



55. In mark a) the text is presented in white on the black background of a bear and fig leaf device. Registration of a mark in black and white covers use of that mark in any colour. I do not, therefore, consider that the use of the white font prevents this from being use of the mark as registered. Similarly, it is clear from *Colloseum* that use in conjunction with additional matter can be an acceptable use of the mark as registered. I do therefore consider that the use of the mark in question is not use of the registered mark merely because it is used as part of the bear and fig leaf device (per *Colloseum*). However, in mark a) the word BEAR itself is altered due to the fact that the letters B, A and R are 'filled in'. Whilst it may be identified by the average consumer as the word BEAR, to do so it is necessary to add back in the missing parts of the letters. Therefore, this does not show use of the word 'Bear' as such. I must, therefore, consider whether this is an acceptable variant use of the mark under s.6A(4)(a) of the Act. The distinctive character of the Third Earlier Registration lies in the word BEAR. The differences between the Third Earlier Registration and the use shown in mark a) are the presentation on the bear and fig leaf device background, the use of a white font and the 'filled in' letters. For the same reasons set out above, I do not consider that the bear and fig leaf device or the use of white in the text alter the distinctive character of the Third Earlier Registration. However, the 'filling in' of parts of the letters, with the effect that the average consumer will be required to add the missing parts of the letters back in themselves in order to identify the word BEAR does, in my view, alter the

mark's distinctive character. I do not, therefore, consider that this is an acceptable variant of the Third Earlier Registration.

56. In mark b) the text is presented in black, with a fig leaf device replacing part of the letter A. Again, as the word BEAR has itself been altered due to the 'filling in' of the B and the R, I do not consider that this is use of the Third Earlier Registration as registered. I must, therefore, consider whether this is an acceptable variant use of the mark. As noted above, the distinctive character of the Third Earlier Registration lies in the word BEAR. The difference between the Third Earlier Registration and the use shown in mark b) is the addition of the fig leaf device to the letter A and the 'filling in' of the letters B and R. As is the case for mark a) above, the effect of the 'filling in' of these letters is to require the average consumer to add the missing parts of the letters back in, in order to conclude that this variant should be read as the word BEAR. This, in my view, alters the mark's distinctive character. I do not, therefore, consider that this is an acceptable variant of the Third Earlier Registration.

Sufficient Use

57. 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.²⁰

58. The Third Earlier Registration appears in a press release dated December 2015, in which the opponent's acquisition of the brand is recorded. That press release records that BEAR is "the UK's No. 1 kids' fruit snacking brand with a market share in excess of 30%". The press release also confirms that BEAR products are available in over 18,000 stockists. This acquisition was also recorded in an article in the Telegraph in 2015 and in online publications, both of which refer to the BEAR brand. Ms Maes gives evidence that Waitrose placed its first order for BEAR products in 2009, with products being distributed to 190 stores. Ms Maes also confirms that Waitrose have been stocking the products continuously since then. The Third Earlier Registration appears on invoices dated between May 2014 and August 2018 as registered

²⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

alongside sub-brands such as YOYOS and ALPHABITES. These invoices are addressed to recipients located across the country and relate to over 7,000 units of BEAR YOYOS and over 200 units of BEAR ALPHABITES. A selection of purchase orders have been provided showing orders for over 5,000 units of BEAR YOYOS within the relevant period by Co-op and Morrisons. The Third Earlier Registration also appears as registered on the opponent's social media platforms. Ms Maes states that the annual turnover figures for BEAR YOYOS between 2014 and 2018 is approximately £10,000,000 to £20,000,000 and in relation to BEAR ALPHABITES between 2014 and 2018 is approximately £800,000 to £1,500,000.

59. I recognise that a lot of the use shown by the opponent relates to use of the marks shown at a) and b) above that I have already found not to be acceptable variant use of the Third Earlier Mark. However, the examples set out at paragraph 58 above all relate to the mark as registered (or use in combination with additional matter that I have found to be acceptable use of the mark as registered). The fact that the opponent has clearly also been using other marks (i.e. the First and Second Earlier Registrations as shown in marks a) and b)) does not mean that they have not also used the Third Earlier Registration to "maintain or create a share in the market for the goods". Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of the Third Earlier Registration during the relevant period.

Fair Specification

60. I must now consider whether, or the extent to which, the evidence shows use of the Third Earlier Registration in relation to the goods relied upon.

61. 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.”

62. 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:

“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.”

63. As noted above, the opponent relies on the following goods for which the Third Earlier Registration is registered:

Class 29 Preserved, dried, cooked and baked fruits and vegetables; fruit and vegetable based snack foods; jellies.

Class 30 Cereal based snack foods; confectionery all in the form of rolls; none of the aforesaid being cookies or biscuits.

64. This is the main focus of the applicant’s evidence. The applicant notes that the opponent’s goods are made of 100% fruit and vegetables and questions whether this can properly be considered confectionery. The applicant also questioned whether cereal per se would be considered a ‘cereal based snack food’. The opponent has filed evidence in reply to address this point. In particular, the opponent has filed an article titled “Healthy Confectionery” which states that products which are organic, reduced fat and reduced sugar represent a growing market within confectionery products. The remaining articles are all dated after the relevant date but they reinforce the fact that ‘healthier’ confectionery is a growing market and that confectionery-type products are being used to deliver vitamins and other supplements within the pharmaceutical industry. The opponent also relies on a number of dictionary definitions which note that snacks include smaller meals which are quick to eat or cook, and refers to a Wikipedia page which lists ‘cereal’ as a snack food. The opponent has also conducted a search of Sainsbury’s website for ‘cereal snack’ and found various cereal and cereal bar products returned as the result.

65. The opponent's YOYO products are, of course, made from dried and cooked fruit and vegetables. However, the opponent's products are manufactured into the form of rolls. I do not, therefore, consider that these fall within the category of "Preserved, dried, cooked and baked fruits and vegetables". To my mind, the use of the fruit and vegetable to create a secondary product (i.e. rolls) puts them outside of this category of goods. In my view, the opponent's evidence does not demonstrate any use in relation to this category of goods. I also do not consider there to be anything in the opponent's evidence to suggest that it has used its mark in relation to "jellies".

66. That leaves "fruit and vegetable based snack foods" in class 29. As set out in the opponent's evidence, a snack food would include something eaten between meals or, possibly, a very small meal. I, therefore, consider that the opponent's YOYO products would be considered fruit and vegetable based snack food. However, the category in the opponent's specification is very broad. It could incorporate any number of other products from crisps to packaged and prepared fresh fruit and vegetables. Consequently, I consider it appropriate to limit the opponent's class 29 specification to "fruit and vegetable based snack foods in the form of rolls".

67. I turn now to "cereal based snack foods" in class 30 of the opponent's specification. The opponent argues that this would include breakfast cereal products. The applicant argues that these would not be considered cereal based snack foods. In my view, the applicant's position is to be preferred. I accept the opponent's evidence (albeit undated) that breakfast cereal may be eaten as a snack food. However, it is not traditionally considered as such. As the applicant states in its written submissions:

"[...] by the definition of snack the Opponent has provided in exhibit ECM2, a small amount of any food goods in class 30 could serve as a snack food if consumed between or in place of formal meals. [...] By this definition the Opponent is using the word 'snack' as a quantifier, or small amount of something and not as a type of goods. It is far too vague to refer to breakfast cereals as a snack food in this sense for the purposes of the trade mark register."

68. In my view, the average consumer would perceive breakfast cereals to be a complete meal rather than something eaten in between meals or, indeed, as a particularly small meal that might justify it being called a snack. Further, the words “cereal based” suggest that something more has been done to the product such as incorporating it into the form of a bar or cake for snacking. I recognise that a search of ‘cereal snacks’ on the Sainsbury’s website returns both breakfast cereals and cereal bars, but I do not consider this helpful. We have no information about the algorithms used by that website in conducting the search. In my experience, where multiple words are used in a search, it is not uncommon for searches to return products applicable to both words individually. There is no evidence that the opponent sells any cereal based products other than its BEAR ALPHABITES which are a breakfast cereal product. I do not, therefore, consider that the opponent has demonstrated use of the Third Earlier Registration in relation to “cereal based snack foods”.

69. That leaves “confectionery all in the form of rolls” in class 30 of the opponent’s specification. I do not consider that the opponent’s evidence regarding the use of confectionery-type products in the pharmaceutical industry to deliver vitamins and other nutrient goods to be helpful. These goods would not, in my view, be considered confectionery per se, but would more properly fall within class 5. Confectionery will, in my view, be considered by the average consumer to be a term covering both sweets and chocolate.²¹ So the question is whether something can properly be considered a sweet if it consists of 100% fruit and vegetables? In its written submissions in lieu, the applicant states:

“the Opponent is reminded that the Oxford Dictionary defines confectionary as “sweets and chocolates considered collectively”. [...] Fruit jellies and fruit gums in class 30 may contain fruit extracts and flavourings, they may be reduced in sugar, but they are nonetheless a sugar-based product and they are not a pure fruit snack.”

70. I agree with the opponent’s evidence that there is a trend towards encouraging healthier ‘treats’, whether this be in this be in the form of reduced sugar chocolate or

²¹ <https://www.collinsdictionary.com/dictionary/english/confectionery>

sweets made from real fruit juices. I accept the applicant's position that the dictionary definition of confectionery states that it is 'sweets and chocolate'. However, whilst dictionary definitions are useful, it is the perception of the average consumer which is relevant. It is not, in my view, the ingredients alone which dictate whether the average consumer would consider a product to be confectionery, but the way in which it is perceived as a finished article. A snack that is sweet because of its natural fruit sugar content is apt to be regarded as a kind of confectionery. Taking all of this into account, I consider that the average consumer would consider the opponent's BEAR YOYO product to be an item of confectionery. It follows that the opponent has demonstrated use of the Third Earlier Registration in relation to "confectionery all in the form of rolls".

71. I, therefore, consider a fair specification for the Third Earlier Registration to be:

Class 29 Fruit and vegetable based snack foods in the form of rolls.

Class 30 Confectionery all in the form of rolls; none of the aforesaid being cookies or biscuits.

Section 5(2)(b) – case law

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 goods

73. In light of my findings above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<p>First and Second Earlier Registrations</p> <p><u>Class 29</u> Preserved, dried, cooked, frozen and baked fruits and/or vegetables; fruit and/or vegetable based snack foods; vegetable salad; fruit salad; jellies; jams; compotes; milk, milk products; yoghurt, snacks of yoghurt, yoghurt based drinks.</p> <p><u>Class 30</u> Cereal based snack foods; wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture; snack foods predominantly consisting of wholegrain, rolled oats, rice, nuts or seeds and honey or fruit extract mixture also including fruit; porridge oats; porridge predominantly consisting of oats also including fruit; ice cream, frozen yoghurt; confectionery; cookies or biscuits.</p> <p>Third Earlier Registration</p> <p><u>Class 29</u></p>	<p><u>Class 30</u> Cake bars; Cake frosting; Cake frosting [icing]; Cake Pops; Cakes; Candies [sweets]; Candy; Candy bars; Caramel; Cereal bars and energy bars; Cheesecake; Chocolate; Chocolate bars; Chocolate based products; Chocolate brownies; Confectionery; Cookie dough; Cookie mixes; Cookies; Crackers; Dessert puddings; Biscuits; Wafer biscuits; Cake mixes; Meringue.</p>

Fruit and vegetable based snack foods in the form of rolls.	
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Class 30

Confectionery all in the form of rolls; none of the aforesaid being cookies or biscuits.

74. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

75. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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.”

76. In its counterstatement the applicant states:

“The opponent’s goods are commercially different to ours. The opponent primarily sells high sugar “pure fruit” snacks [...] whereas we primarily sell sponge caked reduced in sugar (on average 14% sugar) and high in protein.

[...] Our products are marketed to fitness and weight conscious consumers. The opponent’s products are primarily targeting children. Evidence of this is found on the opponent’s social media pages where they describe their products as “delicious natural nibbles for cubs”. As such, it is clear the opponent’s reference to “cubs” is a creative play on a word alluding to children, given it refers to a bear’s young. Therefore, the target market of the parties’ products is different.”

77. The assessment that I must undertake is a notional one based upon the goods for which the marks are registered/applied-for. I am required to take into account all the ways in which the marks could be used. The way in which the marks are currently used in practice and the current target markets of the parties is not relevant to that assessment, unless it is apparent from their specifications. Consequently, I do not consider that this line of argument assists the applicant.

78. “Confectionery”, “cookies” and “biscuits” appear identically in both the applicant’s specification and the specifications of the First and Second Earlier Registrations. “Confectionery all in the form of rolls” in the specification of the Third Earlier Registration will also fall within this broader category and will be considered identical on the principle outlined in *Meric*.

79. “Candies [sweets]”, “Candy”, “Candy bars”, “Caramel”, “Chocolate” and “Chocolate bars” in the applicant’s specification will all fall within the broader category of

“confectionery” in the specifications of the First and Second Earlier Registrations. These goods can, therefore, be considered identical on the principle outlined in *Meric*. They will also overlap in use, user, method of use, trade channels and nature with “confectionery all in the form of rolls” in the specification of the Third Earlier Registration. There will be a degree of competition between them. These goods will, therefore, be highly similar.

80. “Cake bars”, “Cake Pops”, “Cakes”, “Cheesecake”, “Chocolate brownies”, “Dessert puddings” and “Meringue” in the applicant’s specification are all goods that are likely to be eaten as a dessert. These will all, therefore, overlap in use, user and method of use with “ice cream, frozen yoghurt” in the specification of the First and Second Earlier Registrations. There may be competition between these goods and there may be a degree of overlap in trade channels. Taking all of this into account, I consider the goods to be similar to at least a medium degree.

81. Energy bars are often cereal based, with additional protein or energy boosting properties. Consequently, I consider “cereal bars and energy bars” in the applicant’s specification to fall within the broader category of “cereal based snack foods” in the specifications of the First and Second Earlier Registrations. These goods can, therefore, be considered identical on the principle outlined in *Meric*. There is also competition between these goods and the “fruit and vegetable based snack foods in the form of rolls” in the specification of the Third Earlier Registration. There may be overlap method of use and user. There may also be a degree of overlap in trade channels. I consider these goods to be similar to at least a medium degree.

82. “Chocolate based products” in the applicant’s specification is a broad term that could cover a range of products including chocolate confections and chocolate cakes or desserts. Consequently, I consider that these goods will be *Meric* identical to “confectionery” in the specifications of the First and Second Earlier Registrations. There will also be a degree of overlap in use, user and method of use with “ice cream, frozen yoghurt” in the specification of the First and Second Earlier Registrations and “confectionery all in the form of rolls” in the specification of the Third Earlier Registration. There may also be a degree of competition and overlap in trade

channels. Consequently, I consider these goods to be similar to at least a medium degree.

83. "Cookie dough" in the applicant's specification is typically sold as a dessert product. Consequently, I consider it to overlap in use, user, method of use and trade channels with "ice cream, frozen yoghurt" in the specifications of the First and Second Earlier Registrations. There may also be a degree of competition between them. Consequently, I consider these goods to be similar to at least a medium degree.

84. "Cookie mixes" in the applicant's specification are products purchased to enable the user to make cookies at home without having to purchase and weigh out the dry ingredients separately. There will be overlap in user with "cookies" in the specifications of the First and Second Earlier Registrations. There may also be a degree of competition in that someone may either purchase the finished product or a mix to enable them to make the product themselves. The nature and method of use will differ. There may be a small degree of overlap in trade channels. Taking all of this into account, I consider the goods to be similar to a medium degree.

85. "Cake mixes" in the applicant's specification also enable the user to make a cake at home without the need to purchase and weigh out the dry ingredients separately. However, the opponent's specifications do not cover cakes. Cakes are typically dessert products so there may still be a degree of competition between these goods and the dessert products in the specifications of the First and Second Earlier Registrations (i.e. "ice cream, frozen yoghurt"). The users will, of course, overlap. However, the nature, method of use and trade channels will all differ. Taking all of this into account, I consider the goods to be similar to a low degree.

86. "Crackers" in the applicant's specification may be considered a snack food. This is particularly likely to be the case where crackers are coated in a particular flavouring. Crackers can also be based on cereal. Consequently, I consider these goods to fall within the broader category of "Cereal based snack foods" in the specifications of the First and Second Earlier Registrations. These goods can, therefore, be considered identical on the principle outlined in *Meric*. Even if I am wrong in this finding, then these goods will overlap in user, use, method of use, nature and trade channels with

“biscuits” in the specification of the First and Second Earlier Registrations. There may be competition between them. Consequently, I consider these goods to be highly similar.

87. “Wafer biscuits” in the applicant’s specification will fall within the broader category of “biscuits” in the specifications of the First and Second Earlier Mark. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

88. “Cake frosting” and “cake frosting [icing]” in the applicant’s specification are goods purchased to decorate a homemade cake. These goods will overlap in user with the opponent’s goods to the extent that they can all be used by members of the general public. However, this is not sufficient on its own for a finding of similarity. In the absence of any submissions to assist me, I see no further point of overlap with the opponent’s goods. Consequently, I consider the goods to be dissimilar. If I am wrong in this finding, and there is some overlap, then it will only lead to a low degree of similarity.

The average consumer and the nature of the purchasing act

89. 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 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.”

90. The average consumer for the goods will be a member of the general public. The cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. However, various factors will still be taken into account such as flavour, nutritional content and dietary requirements. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

91. The goods are likely to be purchased by self-selection from the shelves of a retail outlet such as a supermarket, or their online equivalents. The purchasing process will, therefore, be predominantly visual. However, as advice may still be sought from a retail assistant, I do not discount that there may also be an aural component to the purchase of the goods.

Comparison of trade marks

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

93. 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.

94. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p>and</p> <p>(series of 2) (the First Earlier Registration)</p>  <p>and</p>  <p>(series of 2) (the Second Earlier Registration)</p> <p>BEAR</p> <p>(the Third Earlier Registration)</p>	

The Overall Impression

95. The applicant's mark consists of the words BARE FOOD presented in a white, slightly stylised font. This text is presented on a brown background overlaid with a black outline. The words BARE FOOD play the greater role in the overall impression of the mark, with the background, colour, outline and stylisation playing a lesser role.

96. The First Earlier Registration consists of a bear device overlaid with text intended to represent the word BEAR and a fig leaf device. As noted above, elements of the letters of the word BEAR have been blocked out so that they are incomplete. The overall impression of the mark lies in the combination of these elements.

97. The Second Earlier Registration consists of text intended to represent the word BEAR. Again, as noted above, elements of the letters have been blocked out or, in the case of the letter A, replaced with a fig leaf device. The overall impression of the mark lies in the combination of these elements.

98. The Third Earlier Registration consists of the word BEAR. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself.

Visual Comparison

The First Earlier Registration and the Applicant's Mark

99. Visually, to the extent that the First Earlier Registration will be recognised as containing a stylised word element based on the word BEAR, the marks will overlap in the presence of the letter E and the elements that will be recognised as representing the letters B, A and R in the First Earlier Registration and the same letters that make up the applicant's mark (albeit in a different order). The marks differ in the presence of the word FOOD, brown background and black outline used in the applicant's mark. They also differ in the presence of the bear and fig leaf devices used in the First Earlier Registration. Further, the fonts and colour used in each mark differ. Taking all of this into account, I consider the marks to be visually similar to a low degree.

The Second Earlier Registration and the Applicant's Mark

100. Visually, to the extent that the Second Earlier Registration will be recognised as containing a stylised word element based on the word BEAR, the marks will again overlap in the presence of the letters B, E, A and R or stylised elements intended to represent these letters (presented in a different order). However, they differ in the

addition of the word FOOD, the background and outline in the applicant's mark and the fig leaf device in the Second Earlier Registration. Further, the font used in each mark differs. I consider the marks to be visually similar to a low degree.

The Third Earlier Registration and the Applicant's Mark

101. Visually, the marks overlap in that they both contain the letters B, E, A and R (albeit presented in a different order). The text in the applicant's mark is presented in a white stylised font. However, as the Third Earlier Registration is a word only mark, and use of a word only mark covers use in any standard typeface and colour, I do not consider this to be a significant difference between them. The point of visual difference, therefore, is the addition of the word FOOD in the applicant's mark and the use of a brown background and outline. I consider the marks to be visually similar to a higher than medium degree.

Aural Comparison

102. Only the text element of the earlier registrations will be pronounced. This means that they will all be pronounced identically i.e. the ordinary English pronunciation of the word BEAR. The word BARE in the applicant's mark, although spelled differently, will be pronounced identically. The only point of aural difference between the marks will, therefore, be the addition of the word FOOD in the applicant's mark which may, or may not be pronounced, given that it will be used on food products. Consequently, I consider the marks to be aurally identical, if the word FOOD is not pronounced, or aurally similar to a higher than medium degree if it is.

Conceptual Comparison

103. The word BEAR in all three earlier registrations is likely to be given its ordinary dictionary meaning i.e. a reference to a large mammal. This will further be reinforced in respect of the First Earlier Registration by the presence of the bear device. The word BARE in the applicant's mark will also be given its ordinary dictionary meaning i.e. something that is uncovered or simple. When followed by the word FOOD and used on food products, this may be seen as indicating goods that are natural or without

additives. If the different spellings of the word BEAR/BARE is noticed by the average consumer, therefore, the conceptual meanings will be dissimilar.

104. The opponent makes reference to the fact that the presence of the fig leaf device in the First and Second Earlier Registrations will be seen as alluding “to the idea of something that is naked” and that this brings these earlier registrations closer to the meaning conveyed by the applicant’s mark. I do not consider that this message will be immediately recognisable to the average consumer and I do not, therefore, consider that it contributes significantly to bring the marks closer together in their meaning.

Distinctive character of the earlier trade marks

105. 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).”

106. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

107. I will begin by assessing the inherent distinctive character of the earlier registrations. The Third Earlier Registration consists of the word BEAR. However, even for the First and Second Earlier Registrations, where parts of the letters have been blocked out, I consider that on balance, the stylised word element will still be recognised as being derived from the ordinary dictionary word BEAR. This is a word which is inherently distinctive to a medium degree for these goods. The inherent distinctiveness of the First and Second Earlier Registrations is enhanced further by the presence of the fig leaf devices, the blocking out of the letters B, A and R in the word BEAR and, in the case of the First Earlier Registration, the addition of a bear device. Taking all of this into account, I consider the First and Second Earlier Registrations to be inherently distinctive to a higher than medium degree, and the Third Earlier Registration to be inherently distinctive to a medium degree.

108. I will now consider whether the distinctiveness of the earlier registrations has been enhanced by the use made of them. The opponent's evidence demonstrates that the earlier registrations have all been in use for a number of years (since at least 2009). A press release dated December 2015 confirmed that, by that date, BEAR was the number 1 "kids' fruit snacking brand" with a market share of 30%.

109. The press release also confirms that by that date, BEAR products were being sold in over 18,000 stockists. The evidence also shows that the opponent's BEAR products have been sold in national retailers such as Caffè Nero, Sainsbury's, Subway, Tesco, Asda, Co-op, Morrisons and Waitrose. In respect of Waitrose, it is confirmed that an order was placed for BEAR products to be sold in 190 stores. There are no figures for the other national retailers, but it is reasonable to infer, given they are national retailers, that BEAR products will have been stocked in a range of their stores around the country. This is further supported by invoices provided by the

opponent which are addressed to businesses located around the country including London, Cheshire, Wiltshire, Durham and Dundee.

110. For the year ending October 2011, the opponent had a turnover of £3.5million. The opponent's evidence shows that annual turnover figures for confectionery rolls only between 2014 and 2018 is approximately £10,000,000 to £20,000,000 and annual turnover for cereal goods only between those dates was approximately £800,000 to £1,500,000. As noted above, the opponent has provided a report which shows the total sales for England, Scotland and Wales between 20 August 2016 and 20 July 2019. This shows that the total boxes of BEAR ALPHABITES sold between this period varied from around 30,000 on 5 January 2019 to around 90,000. It shows that the number of boxes of BEAR YOYOS sold in that periods varied from 2,500,000 on 20 August 2016 to 5,000,000 on 3 February 2018.

111. There is evidence of the opponent's BEAR products being referenced in articles in the Telegraph (2015) and Parentkind Magazine (2017/2018), as well as on websites such as bakerysnacks.com (2015), thisismoney.co.uk (2012) and Tumble Tots website (2018). The opponent also advertises its BEAR products through its social media channels such as Facebook and YouTube. Further, the opponent has engaged in extensive TV advertising of its BEAR products, with adverts being aired on ITV, Channel 4, 4Music, Sky One, Comedy Central, CBS Reality, Sky Living, TLC and E4 in 2018. An article dated January 2018 described this campaign as being worth £3million. The opponent confirms that total expenditure was around £2million in 2018 and £700,000 in 2019.

112. There is also evidence of the opponent having won a number of awards between 2010 and 2018. Some of these are clearly related to the business side of the operation such as marketing and design. However, some are clearly aimed at the success of the opponent's BEAR products with consumers such as the Metro's Venture Candy 2011 Award, for which the opponent's BEAR products won 54 per cent of the vote in the Food and Drink category. There is also a reference in the opponent's press release dated December 2015 which confirms that the opponent has sought to build brand awareness through initiatives involving 'collector cards' in BEAR products which led to

3,000 letters per week being received from children around the country in relation to the BEAR brand.

113. Taking all of these factors into account, I am satisfied that the opponent has demonstrated that its marks have acquired enhanced distinctive character through use. In my view, the distinctiveness of all three earlier registrations has been enhanced to a high degree by virtue of the use made of them.

Likelihood of confusion

114. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods 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 respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

115. I have found the First Earlier Registration and the Second Earlier Registration to be visually similar to the applicant's mark to a low degree. I have found the Third Earlier Registration and the applicant's mark to be visually similar to a higher than medium degree. I have found all of the marks to be aurally identical if the word FOOD in the applicant's mark is not pronounced and aurally similar to a higher than medium degree if it is. I have found all of the marks to be conceptually dissimilar for those consumers who recognise the different meanings conveyed by the spelling of the word BEAR/BARE.

116. I have found the earlier marks to be inherently distinctive to between a medium and higher than medium degree, but the distinctiveness of all three earlier registrations has been enhanced to a high degree by virtue of the use made of them. I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties goods to vary from being identical to similar to a medium degree (except for those goods that I found to be dissimilar or, if that finding is wrong, similar to only a low degree).

117. Taking all of these factors into account, I recognise that there is potential for there to be direct confusion where the marks are encountered aurally and the word FOOD in the applicant's mark is not pronounced. In these circumstances, the marks will be aurally identical and there will be nothing to assist the average consumer in distinguishing between them. However, in circumstances in which the marks are encountered visually (as will be the most common scenario given the purchasing process for the goods) or where the word FOOD is pronounced, I do not consider that there is a likelihood of direct confusion.

118. In considering whether there is a likelihood of indirect confusion, I recognise that the visual differences between the marks goes in favour of the applicant, as does the fact that a medium degree of attention will be paid during the purchasing process for the goods. However, the distinctiveness of the earlier registrations have been enhanced to a high degree by virtue of the use made of them. Indeed, in its counterstatement, the applicant states: "the opponent has acquired significant reputation in their marks to the point that consumers would actively seek their products."

119. I recognise that, of course, the dictionary meanings of BEAR and BARE are different. I also recognise that conceptual differences may counteract visual and aural similarities. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it

can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

120. However, that conceptual hook can only assist the average consumer if the spelling of the word BEAR/BARE is recalled. As noted in the applicant’s evidence, this is a common misspelling. In my view, that conceptual distinction is likely to be overlooked by a significant proportion of average consumers. I consider that when encountering the applicant’s mark, the average consumer is likely to consider it to be a different mark being used by the same or economically linked undertakings. For example, the different devices and stylisation might be seen as an alternative mark being used to identify a different sub-category of goods such as those targeted at adults, particular dietary requirements or using different ingredients. Consequently, I consider there to be a likelihood of indirect confusion where the goods are similar to at least a medium degree.

CONCLUSION

121. The opposition is partially successful and the application is refused for the following goods:

Class 30 Cake bars; Cake Pops; Cakes; Candies [sweets]; Candy; Candy bars; Caramel; Cereal bars and energy bars; Cheesecake; Chocolate; Chocolate bars; Chocolate based products; Chocolate brownies; Confectionery; Cookie dough; Cookie mixes; Cookies; Crackers; Dessert puddings; Biscuits; Wafer biscuits; Meringue.

122. The opposition is unsuccessful in relation to the following goods, for which the application can proceed to registration:

Class 30 Cake frosting; Cake frosting [icing]; Cake mixes.

COSTS

123. The opponent has enjoyed the greater degree of success 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 opponent the sum of **£1,200** as a contribution towards its costs, calculated as follows:

Preparing a Notice of opposition and Considering the applicant's counterstatement	£200
Filing evidence and submissions, considering the applicant's evidence and filing evidence in reply	£900
Official fee	£100
Total	£1,200

124. I therefore order The Skinny Bakery Ltd to pay Urban Fresh Foods Ltd the sum of £1,200. This sum should be paid within 2 months 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 26th day of May 2020

S WILSON

For the Registrar