

O-128-21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3419667

BY HARPREET SINGH KANG

TO REGISTER

EGGLESS CAKE SHOP

AS A TRADE MARK IN CLASSES 42 & 43

AND

OPPOSITION THERETO

UNDER NO. 418092

BY CHAZ LIMITED

Background and pleadings

1. On 7 August 2019, Harpreet Singh Kang (“the applicant”) applied to register the trade mark shown below under number 3419667:

Eggless Cake Shop

2. The application was published for opposition purposes on 23 August 2019 for the following services:

Class 42 Cake design services.

Class 43 Cake decorating

3. Chaz Limited (“the opponent”) filed a notice of opposition on 14 October 2019 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the services in the application. The opponent relies upon the below mentioned UK trade mark registrations:

Mark 1:

(series of 2)



Registration no. 3310896

Filing date: 15 May 2018

Registration date: 10 August 2018

Goods and services relied upon:

Class 30 Cakes; Cake preparations; Cake mixtures; Chocolate cake; Sponge cake; Cake batter; Cake frosting; Cake doughs; Cake mixes; Cake icing; Cake powder; Cream cakes; Iced cakes; Candy cake decorations; Chocolate covered cakes; Iced sponge cakes; Fruit cakes; Flavourings for cakes; Chocolate decorations for cakes; Candy decorations for cakes.

Class 43 Services for providing food and drink; Café services; Cafeteria services; Catering services; Coffee shop services; Restaurant services; Information, advice or consultancy services relating to the aforesaid.

Mark 2

THE EGGFREE CAKE BOX

Registration no. 2518160

Filing date: 12 June 2009

Registration date: 26 February 2010

Services relied upon:

Class 43 Operation of cafes, cafeterias, coffee shop, snack bars, catering, restaurants or other establishments or facilities engaged in providing food or drinks prepared for consumption; services for providing food or drink.

Mark 3

THE EGGFREE CAKE BOX EXPRESS

Registration no. 3116602

Filing date: 07 July 2015

Registration date: 09 October 2015

Class 30 Cakes

Class 43 Services for providing food and drink; Operation of cafes, cafeterias, coffee shop, snack bars, catering, restaurants or other establishments or facilities engaged in providing food or drinks prepared for consumption; services for providing food or drink.

4. The opponent argues that there is a likelihood of confusion, including a likelihood of association because the competing marks are similar, and the services are identical or highly similar.
5. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.

6. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of its “THE EGGFREE CAKE BOX” mark.
7. The opponent is represented by Brand Protect Limited and the applicant is represented by Serjeants LLP. Both parties filed evidence which I will refer to later in the decision only to the extent I consider necessary. No hearing was requested. Both parties filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

Proof of Use

8. The relevant statutory provisions are as follows:

“6A. Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) 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 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 of 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.

(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.”

9. 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.”

10. 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

11. 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].”

12. Pursuant to section 6A of the Act, the relevant period for assessing whether there had been genuine use of the earlier mark “THE EGGFREE CAKE BOX” (for the café/food-related services it specifies in Class 43) is the 5-year period ending with the date of application of the contested mark, i.e. 8 August 2014 to 7 August 2019. I summarise below the key points from the opponent’s evidence of use.

13. The evidence consists of two witness statements from Mr Sukh Chamdal. Mr Chamdal states that he is the Chief Executive Officer of the opponent company.

- 1) According to Mr Chamdal, the company has been franchising the business and has over 131 establishments in the UK under the name “THE EGGFREE CAKE BOX”.¹
- 2) Mr Chamdal exhibits screen grabs from the web archive “Waybackmachine” showing landing pages at www.eggfreecake.co.uk as it existed during the period 2017 – 2019.² The sign  and “Eggfree Cake Box” are seen on the webpages.
- 3) Images of a cake base, a carrier bag and a cake packaging box, all bearing either the sign  or its colour variations are provided as SC4.
- 4) Pages from the opponent’s Facebook, Twitter and Instagram accounts are in evidence. The marks “THE EGGFREE CAKE BOX”, “Eggfree Cake Box” and  appear on the social media pages. The opponent has 35,032 followers on Facebook and 7,513 followers on Instagram. The Twitter account created in 2011 has 1,515 followers. The pages filed in evidence have several images of cakes, including those customised for occasions such as graduation or birthdays.³
- 5) Various press releases from the years 2016 – 2019, covering the opponent’s business are provided as SC9. The sign  appears on most of the pages. There are also references to the sign “Eggfree Cake Box”.
- 6) According to Mr Chamdal, the opponent recorded an annual turnover figure of £4.869 million in the year 2015 that rose to 12.7 million and 17 million in 2018 and 2019, respectively.⁴

¹ First witness statement para 5.

² SC3, SC11, SC12

³ SC5 – SC7

⁴ See witness statement dated 6 March 2020 para 16.

7) Mr Chamdal states that the opponent has spent £1.27 million during 2015 – 2019 on advertising.⁵

14. That concludes my summary of the opponent’s evidence to the extent I consider necessary.

15. The mark subject to proof of use provisions is the word only mark for “THE EGGFREE CAKE BOX”. There is some evidence of use of this mark, particularly on social media and the website www.eggfreecakebox.com. There

is also evidence of the use of the signs “Eggfree Cake Box” and



. Proof of genuine use of a mark also includes proof of the use of the mark in a form that differs in elements that do not alter the distinctive character of the registered mark.

16. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person provided the following guidance to determine whether the use of a mark in a different form constitutes genuine use of the mark as registered:



“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

⁵ See witness statement dated 6 March 2020, para 18

average consumer not registering the differences at all.”

17. I will first consider the position in relation to the evidence of the use of the sign “Eggfree Cake Box”. The only difference between this sign and the registered mark is the omission of the definite article “the”. Given that “The” in a trade mark merely indicates a particular undertaking, it is unlikely that it will contribute to the distinctive character of the mark as a whole. Therefore, I do not consider that the omission of the definite article alters the distinctive character of the registered mark. Accordingly, I find that “Eggfree Cake Box” is an acceptable variant of the registered mark.

18. I turn next to the sign . The word “Eggfree” is presented in a much smaller size than the words “Cake Box”. The stylisation of the words “cake box” is minimal, and the figurative line present underneath those words is not presented in a particularly original or unusual way. As for the purple background and the orange letters, I bear in mind that the normal and fair use of a word mark allows use in variations of colour. The word “eggfree” in the figurative sign plays a similar role as in the opponent’s “THE EGGFREE CAKE BOX” word mark, i.e. to indicate that the goods sold through the establishment are free of eggs. In my view, it is the words “Cake Box” in the registered mark that is likely to fulfil the function of distinguishing the opponent’s registered services in Class 43 from those of other establishments. Therefore, I do not consider that the differences identified are likely to alter the distinctiveness of the registered mark. On that basis, I find that the sign  is an acceptable variant of the opponent’s “THE EGGFREE CAKE BOX” mark. Even if I am wrong on this finding, for reasons that will be apparent later, this will not have an impact on the opponent’s capacity to rely on its “THE EGGFREE CAKE BOX” mark.

19. Having concluded that the signs as shown used are acceptable variants of the registered mark, I must now determine whether the opponent has shown genuine use of that earlier word mark in relation to the services relied upon, namely: *operation of cafes, cafeterias, coffee shop, snack bars, catering,*

restaurants or other establishments or facilities engaged in providing food or drinks prepared for consumption; services for providing food or drink.

20. 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.⁶ Although the applicant claims that the opponent's evidence is insufficient for various reasons, I am satisfied that the opponent has reasonably clarified each of the applicant's concerns in its evidence in reply. Therefore, I do not consider it necessary to address the applicant's criticism of the opponent's evidence in any more detail than it is necessary to do so.

21. The opponent has demonstrated sales that are spread over the entire five-year period. The use appears to be stable and consistent. The turnover figures indicate sales at £4.869m in 2015, increasing considerably to £17m in 2019. Mr Chamdal confirms that the turnover figures "are directly linked to the brand THE EGGFREE CAKE BOX."⁷ Although, most of the evidence shows the use of the figurative sign, in the absence of cross-examination, I am prepared to accept that the figures provided also cover the turnover generated under THE EGGFREE CAKE BOX word mark and its variant sign the EGGFREE CAKE BOX. Mr Chamdal further submits in his second witness statement that "the turnover of the Cake Box Companies principally comprises of sales of franchises, and sales of cakes in those franchises".⁸ It also appears that, during the relevant period, the mark was widely used to identify cakes sold under the mark.⁹ I also bear in mind that the press releases, by and large, describe the opponent as a cake seller/retailer specialising in "egg-free" cakes. Evidence also indicates the use of the mark on shopfronts in various locations across the UK.

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁷⁷ See second witness statement para 11.

⁸ *Ibid*

⁹ Exhibit SC4 and witness statement dated 12 October 2020 para 6.

22. Although the opponent has claimed genuine use of the mark in relation to various services, namely, operation of cafes, cafeterias, coffee shop, snack bars, catering, restaurants or other establishments, there is nothing in the evidence to suggest that the mark was used across the full width of the specification. Considering the evidence as a whole, I am satisfied that, during the relevant period, the opponent has demonstrated the use of the registered mark sufficient to create and maintain a market for only cake shop services.¹⁰

23. The protection of the earlier mark must, therefore, be cut down to those services in relation to which the mark has been used.¹¹

24. I, therefore, consider the fair description of the opponent's services under the earlier mark "THE EGGFREE CAKE BOX" to be:

Class 43: Cake shop services

Section 5(2)(b)

25. Section 5(2)(b) of the Act is as follows:

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

(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".

Case law

¹⁰ Even if it were the case that the evidence had shown use sufficient to enable the opponent to rely on the whole of its specification, the services there specified are more general than the cake shop services on which I have framed a fair specification, so would not materially affect the opponent's case.

¹¹ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, para 65.

26. The following principles are gleaned from the judgments of the European Union ("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 C3/03, *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.

The principles:

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

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

(c) The average consumer normally perceives the 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 services

27. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

28. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

29. In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, however, Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

30. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

31. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, the General Court held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.¹²

My approach

32. The opponent relies upon three earlier marks. I have concluded that the opponent is entitled to rely only on cake shop services under its word only mark for THE EGGFREE CAKE BOX (“Mark 2”). The opponent’s other two earlier marks, i.e. Marks 1 and 3, among other services, also cover services of “provision of food and drink”. This term is broad enough to encompass cake shop services. There is, therefore, an overlap in the services covered by all three earlier marks so far as cake shop services are concerned.¹³ The applicant’s mark also covers services connected to cake. As the opponent’s

¹² case T-133/05

¹³ Although the other earlier marks cover “cakes” and “consultancy services relating to provision of food and drink, those goods and services will not put the opponent in any better position than its “cake shop” services.

Mark 2 is closest in terms of similarity to the applicant's mark, it is where I will begin my assessment.

Applicant's services	Opponent's services
Class 42 - Cake design services	Class 43 - Cake shop services
Class 43 - Cake decorating	

Cake design services

33. In comparing the services, I take account of the guidelines provided in *Avnet* to confine the interpretation of services to the core of possible meanings attributable to the term. Cake designing appears to be a skilled work where designers create cake concepts for new cake recipes or craft towering cakes for weddings, for example. The nature and purpose of the applicant's cake design services and the opponent's cake shop services may differ. However, it appears that cake design services are likely to be offered as part of cake shop services. In reaching my conclusion, I give due weight to the opponent's submissions that skilled bakers baked its themed cakes as per the customer requirements and specifications.¹⁴ I also pay particular attention to a photograph of the applicant's shopfront which the applicant describes as "100% pure vegetarian cakes".¹⁵ In the same evidence, I can also see cakes on display apparently for sale. There is in the applicant's evidence a picture of a cake box that the applicant claims to use to pack his products.¹⁶ The evidence reinforces my understanding as an average consumer that the channels of trade are likely to overlap. Cake design services are likely to be important for cake shop services and the average consumers are also likely to think that both services originate from the same undertaking. I, therefore, consider that the competing services are complementary in the sense described by the case law. The users are the same. The average consumer may buy cakes from either a cake designer working independently of cake shops or a cake shop instead. To that

¹⁴ See second witness statement para 10.

¹⁵ Exhibit HSK1.

¹⁶ Exhibit HSK2.

extent the services compete. Considering these factors, I find that competing services are similar to a high degree.

Cake decorating services

34. Cake decorating services in the application involves preparing and presenting cakes to customers in a visually attractive way. The opponent's evidence also indicates that cakes offered for sale through its establishments are decorated with icing and other decorative elements. As both services involve preparing and presenting cakes to the customers, I find that the applicant's services are included in the broad category of the opponent's services. There is nothing in the applicant's evidence to refute my understanding. The competing services are therefore identical under the *Merit* principle.

The average consumer and the nature of the purchasing act

35. It is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer.

36. 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".

37. The average consumer of the competing services is likely to be a member of the general public. The services are most likely to be selected visually after viewing signage, for example, on the high street, or visiting websites or checking catalogues. However, I do not discount an aural element to the purchase (for example on the basis of word of mouth recommendations). The degree of attention is likely to vary depending on the services, for example, designing a wedding cake is likely to attract more attention than choosing a cake shop offering a loaf of cake. These factors suggest that the average consumer is likely to pay a degree of attention that is likely to vary from low to medium.

Distinctiveness of the earlier mark

38. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

39. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

40. The opponent's earlier mark is a word only mark for “THE EGGFREE CAKE BOX”. The applicant submits that the opponent's mark does not give the

impression of a shop or premises.¹⁷ The opponent submits that its mark gives the consumer the impression that the cake is provided in a box, or that the box itself is eggfree.¹⁸

41. In assessing the distinctive character of an earlier mark, I am mindful that I must consider the mark as a whole. In doing so, I must give due weight to various descriptive, allusive and non-distinctive components in the mark. The more distinctive components in the earlier mark are the words “Cake Box”. However, I find that the word “Cake Box” used in relation to cake shop services strongly alludes to the fact that the products offered for sale are cakes. In my view, the inherent distinctive character of “THE EGGFREE CAKE BOX” mark as a whole is no more than low.

42. The opponent has claimed enhanced distinctiveness of its mark.¹⁹

43. In making an assessment of enhanced distinctiveness of a mark, 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 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 services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.²⁰

44. Enhanced distinctiveness requires recognition of the mark by the relevant public. There is evidence that for the years 2015 - 2019,²¹ the opponent has spent around £1.27 million in advertising the mark. For the same period, a turnover figure was recorded at around £48 million. There is evidence of

¹⁷ The applicant’s written submissions filed on 9 July 2020, para 8.

¹⁸ The opponent’s written submissions dated 1 December 2020, para 48.

¹⁹ Opponent’s written submissions dated 1 December 2020, para 63.

²⁰ *Windsurfing Chiemsee*, paragraph 51

²¹ First witness statement dated 6 March 2020, para. 18.

considerable media coverage, including reports from The Guardian and The Telegraph on the opponent's cake shop business. As mentioned at paragraph 21, I am prepared to accept that advertising and turnover figures also cover use of the "THE EGGFREEE CAKE BOX" word mark. Considering the evidence as a whole, I think a proportion of the relevant public is likely to associate the earlier word mark with cake shop services and its distinctiveness may be considered enhanced to a degree nearer to medium.. Even if I am wrong on this and the distinctiveness of only the figurative sign has been enhanced through use, my findings on the word mark will not have any material difference to the outcome of the decision.²² I will return to this point later in the decision.

Comparison of marks

45. 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in 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."

46. It would be wrong, therefore, artificially to 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.

²² Most of the opponent's evidence shows the use of the figurative sign.

47. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
THE EGGFREE CAKE BOX	Eggless Cake Shop

48. The opponent's mark is comprised of the words " THE EGGFREE CAKE BOX". Due to the descriptive and non-distinctive characteristics, the elements "The Eggfree" plays only a weaker role in the overall impression of the mark. It is the words "Cake Box" that plays a dominant and distinctive role in the mark.

49. The applicant's mark is a word only mark for "Eggless Cake Shop". The individual components of the mark when considered in relation to services connected with cake and provided most likely through cake shops, are descriptive. All words are likely to make a more or less equal contribution to the overall impression of the mark.

50. In a visual comparison, the marks are almost of the same length. Both marks contain the word "cake", which is non-distinctive in this context. Although "egg" in the respective marks contains different suffixes, this difference is only at the end of the words. The opponent's mark has a definite article "The". The words "box" and "shop" do create a visual difference; again the difference is only at the end of the marks. Bearing in mind the overall impression of the respective marks and weighing up various factors discussed in this paragraph, I find that the marks are visually similar to a medium degree.

51. The respective marks will be articulated entirely conventionally as 4 and 3 separate words. The article "The" in the opponent's mark does not have a counterpart in the applicant's mark. The words "eggfree" and "eggless" begins with identical but ends with a different pronunciation. Cake will be given identical pronunciation in both marks. The words shop and box are articulated differently, however, this difference is only at the end of the respective marks. Weighing up these factors, I find that the marks are similar a medium degree.

52. Regarding the conceptual comparison, Cake Shop and Cake Box in the respective marks are conceptually different; while one refers to a shop that sells cake, the other describes a storage box for cakes. There is an identical concept of eggless/egfree in the marks; however, the terms are non-distinctive in relation to services connected to cakes. Considering these factors and my assessment of descriptive components and their contribution to the overall impression of the respective marks, I find that the marks are conceptually similar to a low degree.

Likelihood of Confusion

53. The opponent submits:

"The decision by the applicant to adopt a similar colour scheme for its shop fronts and cake packaging, a similar name, for similar or identical services, and to operate in a similar location to us, suggests to me that confusion is likely."

54. I bear in mind that the applied for mark is a word only mark. The notional and fair use of the mark would entitle the applicant to use the mark in any colour and on any coloured background. Therefore, I dismiss the opponent's argument on the colour scheme.

55. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective services may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade

marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

56. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

57. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

58. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

59. I have found the respective marks to be visually and aurally similar to a medium degree and conceptually similar to a low degree. The services will be selected primarily by visual means, with a low to medium degree of attention paid by the general public. The services are either identical or similar to a high degree.
60. In my view, the difference introduced by the shop/box elements in respective marks is sufficiently prominent to avoid direct confusion. That leaves only the indirect confusion to be considered.
61. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
62. I have also concluded that the inherent distinctiveness of the earlier mark as a whole is low and that the distinctiveness has been increased by the use of the mark. However, the mark's enhanced distinctiveness does not automatically lead to an enhanced distinctiveness of the common elements. The common elements are the words "cake" and eggfree/eggless (I am mindful that both terms are often used interchangeably) which is descriptive of services connected to the sale of cakes or decoration/design of cakes. I also bear in mind that I have to assess the marks as a whole. I note that the degree of similarity between the marks arises from common elements that are descriptive of the services. An average consumer even if pays only a low degree of attention to the selection process will identify the differences between the marks. They are unlikely to think that undertakings engaged in offering services connected to eggless/eggfree cakes and who uses those terms in their trade marks to describe their services are economically connected. There is also a clear conceptual difference between "Cake Box" which is the dominant and distinctive element in the opponent's mark, and the "Cake Shop" element in the applicant's mark. Considering these factors, I find that there is no likelihood of confusion, either direct or indirect.

63. As the opponent has not succeeded in relation to the mark I have considered, it is no better off with the other two earlier marks. However, for the record, I would have found the same outcome. This is because the goods and services covered by those marks are also identical/ similar, and the stylisation in Mark 1 and the additional word “EXPRESS” in Mark 3 make those marks less close to the applied-for mark. Moreover, as the dominant and distinctive components in those marks are the words “Cake Box”, the issue of imperfect recollection considered in the preceding paragraph applies.

Conclusion

64. The opposition is unsuccessful. The application will proceed to registration.

Costs

65. The applicant has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I make an award as follows:

Considering the other side’s statement and preparing a counter statement:	£200
Filing written submissions:	£200
Considering other side’s evidence:	£600
Total:	£1000

66. I order Chaz Limited to pay Harpreet Singh Kang the sum of £1000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of March 2021

Karol Thomas

For the Registrar

The Comptroller-General