

O-919-22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION UK00003682093 BY PIPING HOT LIMITED
TO REGISTER:**

S E A

BY P I P I N G H O T

AS A TRADE MARK IN CLASSES 3, 9, 18, 24, 25, 27, 28 AND 44

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 429495
BY PRIPD, LLC**

Background & Pleadings

1. On 16 August 2021, Piping Hot Limited (“the applicant”) applied to register the above trade mark in the United Kingdom in respect of the following goods and services:

Class 3: Cosmetics; lotions for cosmetic purposes; cleansing milk for toilet purposes; cosmetic preparations for baths; soap; toothpaste; antiperspirants [toiletries]; shampoos; hair conditioners; hair dyes; hair colorants; cotton swabs for cosmetic purposes; cotton sticks for cosmetic purposes; beauty masks; essential oils; ethereal oils; air fragrancing preparations; perfumes; lipsticks; mascara; cleaning preparations.

Class 9: Eyewear; pedometers; scales; wearable activity trackers; diving suits; covers for smartphones; cell phone straps; headphones; battery chargers.

Class 18: Bags; rucksacks; backpacks; pocket wallets; trunks [luggage]; shopping bags; bags for campers; pouch baby carriers; umbrellas; hiking sticks; trekking sticks; mountaineering sticks; alpenstocks.

Class 24: Fabric; wall hangings of textile; tapestry [wall hangings], of textile; towels of textile; cloths for removing make-up; household linen; sleeping bags; felt; silk [cloth]; bed blankets.

Class 25: Clothing; pyjamas; pajamas; underwear; underclothing; bathing suits; swimsuits; gloves [clothing]; scarves; scarfs; hosiery; footwear; hats; girdles; sleep masks; layettes [clothing].

Class 27: Yoga mats; carpets; rugs; gymnastic mats; gymnasium mats; mats; wallpaper; wall hangings, not of textile; non-slip mats; carpet underlay.

Class 28: Balls for games; waist trimmer exercise belts; yoga swings; knee guards [sports articles]; surfboards; sailboards; inflatable games for swimming pools; swimming jackets.

Class 44: Health spa services; health care; physiotherapy; physical therapy; beauty salon services; massage; solarium services; visagists' services; aromatherapy services; dietary and nutritional advice; dietary and nutritional advice.

The application was published for opposition purposes on 24 September 2021.

2. On 21 December 2021, PRIPD, LLC (“the opponent”) opposed the application, in part, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The scope of the opposition is limited to the applicant’s goods and services in classes 3, 24 and 44. The opponent relies upon the following trade mark and all goods for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3244835

PIPING ROCK

Filing date: 19 July 2017

Registration date: 13 October 2017

Class 3: Aromatic oils; bar soap; essential oils; facial oils; hair oils; massage oils; non-medicated lip care preparations; non-medicated skin care preparations; cosmetics; shampoo.

Class 5: Vitamins and vitamin preparations; vitamin supplements; mineral supplements; nutritional supplements; dietary supplements; food supplements; herbal supplements; dietary beverages supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary supplement beverage for therapeutic purposes; dietary supplemental drinks in the nature of vitamin and mineral beverages; nutritional and dietary supplements formed and packaged as bars; nutritional supplement energy bars; nutritional supplement shakes; vitamin supplement in tablet form for use in making an effervescent beverage when added to water; epsom salts; vitamins for pets.

3. The opponent contends that, due to the similarity between the parties’ trade marks and the similarity between the respective goods and services, and taking into account the effects of imperfect recollection, there exists a likelihood of confusion including a likelihood of association.

4. The applicant makes some concessions with regards to the similarity between the parties' goods, though denies that the majority are similar. Nonetheless, it further denies that the respective marks are visually, phonetically or conceptually similar and that a likelihood of confusion exists on the part of the relevant consumer.

5. The applicant is represented by Sonder & Clay and the opponent by IP Lab Limited. Only the opponent filed evidence during the evidential rounds. Neither party requested a hearing, though the applicant elected to file submissions in lieu. Whilst I do not propose to summarise those submissions here, I will keep them in mind throughout and intend to refer to them only where necessary.

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why my decision will continue to make reference to the trade mark case law of EU courts.

Decision

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

8. Section 5A reads:

“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.”

9. The mark relied upon by the opponent clearly qualifies as an earlier trade mark under the provisions set out in section 6 of the Act. In accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the filing date of the applicant’s mark, it is not subject to the proof of use requirements. Consequently, the opponent can rely upon its mark and all goods for which it is registered without providing evidence of use.

The opponent’s evidence

10. The opponent’s evidence comprises a witness statement from Mr David Anthony Evans, Director of IP Lab, dated 20 May 2022, and supporting Exhibits 1 and 2.

11. Mr Evans explains that the opponent is a U.S. based company with a ‘three-generational history’ in the provision of vitamins, supplements and natural products. He submits that the opponent has gone to great lengths to protect its PIPING ROCK mark across the world, enclosing at Exhibit 1 a list of the countries in which it has registered or applied for PIPING ROCK as a trade mark.

12. Mr Evans submits that the opponent has made extensive use of PIPING ROCK in the UK and that sales of its class 3 goods from 2017 to date amounted to \$904,574.42(USD) and its class 5 goods \$6,816,355.55 (though his statement does not make clear whether these sales concern the UK specifically). He further claims that, prior to the filing of the contested application, there were no other UK marks in classes 3 or 5 containing the word ‘PIPING’. In light of that, and the use made of the earlier mark in the UK over the last five years, it is a well known mark which enjoys a reputation.

13. At Exhibit 2, Mr Evans attaches an English translation of a decision issued by the Columbian Superintendence of Industry and Commerce, in which the same marks were considered. Mr Evans acknowledges that the decision is not binding and explains that the parties have had a number of similar disputes in other jurisdictions.

14. That concludes my summary of the opponent's evidence, insofar as I consider it necessary.

Section 5(2)(b) - Case law

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

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 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 the earlier mark to mind, 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 and services

16. The following goods in class 3 are present in both parties' specifications and are, self-evidently, identical:

Cosmetics; shampoos/shampoo; essential oils

17. The General Court (“GC”) set out a further provision as to when goods can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05. It stated:

“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 für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. Applying that principle, I consider the applicant’s *soap* identical to the opponent’s *bar soap* and the applicant’s *lotions for cosmetic purposes; cosmetic preparations for baths; beauty masks; lipsticks* and *mascara* identical to the opponent’s *cosmetics*.

19. When approaching a comparison of the remaining goods and services, I keep in mind factors including their nature, intended purpose, method of use and whether they are in competition or complementary¹.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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;

¹ *Canon*, Case C-39/97

(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.

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

22. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so².

Class 3

Hair conditioners; hair colorants; hair dyes

23. I consider the above goods against the opponent’s *hair oils and shampoo*. All of the goods could be described as hair care products intended to clean or enhance the quality or appearance of the user’s hair in some way. The respective goods therefore share a common purpose, or at least a highly similar purpose, and they will likely be purchased by the same users. Whilst each ‘type’ of product will naturally possess its own physical properties and distinct ingredients, there may be some element of similarity in the goods’ physical nature, and certainly in the way they are applied. The goods will likely reach the market via the same trade channels and be positioned in proximity on the shelves of the relevant retail establishment. The goods could be used

² *Separode Trade Mark* decision, BL O-399-10 (AP)

alongside one another, though they are not necessarily indispensable and could, in some circumstances, occupy competitive roles (admittedly, less so in the case of the applicant's colorants or dyes). In my experience, it would not necessarily be unusual for a single entity to provide a range of haircare products including those set out, respectively, above. I find a high degree of similarity.

Cotton swabs for cosmetic purposes; cotton sticks for cosmetic purposes

24. Whilst the above goods specify 'for cosmetic purposes', the goods are not what I would describe as 'cosmetics', more so accessories for cosmetics. I understand 'cosmetics', as a term, to refer to substances applied to the face or body intended to improve quality or appearance. The goods will likely be used alongside one another to fulfil the same purpose, though the cosmetics are typically applied directly to the skin and the above goods are likely used to facilitate the application. The users are likely to be shared and the goods are likely move through the same channels of trade. Whilst some degree of compatibility is likely to be considered, the physical nature of the goods is likely to be distinct. The goods are not competitive for one another, though there could be an element of complementarity; the goods may be provided by a single origin and, though not strictly indispensable, will likely be used in close conjunction. I find the similarity of at least a medium degree.

Antiperspirants (toiletries); perfumes

25. The above goods are used as a means of artificial enhancement, similarly to the opponent's *cosmetics*, yet the enhancement is to a person's smell, rather than its appearance. That is the extent of the similarity in the goods' respective uses, though the users are likely to be shared. The trade channels are likely to be highly similar, if not the same, and the goods are sold in similar retail environments, with some degree of proximity. The physical nature of the goods is unlikely to be similar to any meaningful degree and the ingredients are likely to differ on account of the goods' differing uses. The goods are not competitive; the consumer will require one or the other. In terms of complementarity, the goods are not indispensable for one another, though may be used alongside one another as part of the user's daily regime, for example, and in

some circumstances it may be foreseeable for a single entity to offer both of the respective goods. On balance, I find the similarity to be of a medium degree.

Ethereal oils

26. I compare the above goods to the opponent's *essential oils*. The respective goods may be used for a shared or similar purpose and I would expect them to be selected by the same consumer. I would further expect there to be a high similarity between the goods' physical nature. The trade channels are likely to be shared and, whilst I accept that each oil will likely carry its own properties or alleged benefits, there could be an element of competitiveness. The goods may not be indispensable for one another (to my knowledge) but the consumer would likely expect a single entity to offer both. I find a fairly high degree of similarity.

Air fragrancing preparations

27. The opponent relies upon *aromatic oils*. Whilst aromatic oils may be used to create a particular ambience, to my knowledge they are also used to fragrance an environment with a particular scent. There is therefore an element of similarity in the goods' use. It also seems likely that the respective users will be the same. The goods will likely reach the market via the same trade channels and I would expect to find them positioned closely alongside one another in the relevant retail environment. Given the potential for a similar use between the goods, they could occupy competitive roles. I also find the goods complementary; aromatic oils could be used as a component of the applicant's broader 'air fragrancing preparations' and additionally the consumer may expect to be able to purchase both of the respective goods from a single provider. I find a high degree of similarity.

Toothpaste

28. I consider the above against the opponent's *cosmetics*. Whilst I acknowledge that some toothpastes, in my experience at least, claim to have 'cosmetic' properties, insofar as they not only clean but improve the appearance of the user's teeth, the uses remain distinct. The core purpose of the applicant's toothpaste is to clean teeth. The

users will likely be shared but only to the extent that both are purchased by the general public. Any degree of similarity between the physical nature of the respective goods seems limited. That said, the trade channels are likely to be similar and the goods are traditionally sold in similar establishments, in relative but not immediate proximity. That being said, the goods are not competitive and are traditionally provided by distinct entities; it would likely be deemed highly unusual for a provider of cosmetics to also provide toothpaste. The goods are not indispensable for one another. On balance, I find a very low degree of similarity.

Cleaning preparations; (Cleansing milk for toilet purposes)

29. I note the applicant has deemed all of the applied for goods in class 3 similar to those relied upon with the exception of *cleaning preparations* on the basis that “cleaning preparations serve and (sic) entirely different purpose and are not typically stocked alongside the other class 3 goods in retail outlets and do not move through the same trade channels. It is not typical for undertakings selling beauty preparations, such as cosmetics, to also produce and sell cleaning products, such as washing up liquid or cleaning sprays. Consequently, the goods ‘cleaning preparations’ should be deemed dissimilar to the goods of the Opponent.” I agree with much of the reasoning applied by the applicant and, in my view, the analysis extends to the applied for *cleansing milk for toilet purposes*, which I understand to be a cleanser intended for use in or on a toilet. I will proceed initially on that basis but will go on to consider the alternative, in case that assumption is incorrect.

30. The use of the respective goods is different; both the aforementioned goods and the opponent’s *cosmetics* are intended to clean or cleanse, but for entirely different purposes; one for personal use and the other for household use. The users are likely to be the same, insofar as both will be purchased by the general public. Given the different purposes, I would expect very little similarity in the physical nature of the goods and the trade channels are unlikely to be shared. The goods may both be available in a large multi-purpose retail environment such as a supermarket but they are not sold alongside one another, not typically even in the same area of a store. There is no competition between the goods and no element of complementarity; they

are not indispensable nor are they typically offered by the same entity. On balance, I find no similarity.

Cleansing milk for toilet purposes

31. If I am wrong in concluding that the above goods are intended to be used in or on a toilet on account of the qualification “for toilet purposes”, I will make a brief assessment on the basis that the term instead refers to a ‘cleansing milk’, applying its traditional meaning. Were the term to refer to a ‘cleansing milk’, generally intended for use on the skin of the consumer to remove dirt or impurities, I find the term encompassed by the opponent’s *cosmetics* and consider the goods identical under *Meric*.

Class 24

Cloths for removing make-up

32. To my mind, the opponent’s *cosmetics* will incorporate goods including make-up, which the applicant’s goods (above) are intended to remove, so whilst the uses are not the same, and are almost contradictory, there is a relationship between the two and both may be used to fulfil different roles as part of a wider beauty regime. The users of the goods are likely to be the same; it follows that those purchasing make-up will likely also seek to purchase goods intended to remove make-up. The goods will not be physically similar, though would likely reach the market via the same channels and be sold in the same area of the same retail establishment. The goods have different purposes and are not competitive, though the goods may be produced by a single origin and used alongside one another. I find the similarity at least of a medium degree.

Wall hangings of textile; tapestry [wall hangings], of textile; fabric; felt; silk [cloth]; towels of textile; household linen; sleeping bags; bed blankets

33. I can see no similarity in the use of the aforementioned goods and those relied upon by the opponent. Broadly speaking, the users may be the same, but only to the

extent that each is purchased by the general public. The trade channels are likely to be distinct and the goods are unlikely to be sold in any proximity, though I accept that there are occasions whereby the goods may be for sale in the same establishment; a large supermarket, for example, may sell both *towels of textile* and *cosmetics*. The goods are not competitive in any respect, nor can I identify a complementary element. Weighing all considerations, I find the goods dissimilar.

Class 44

Dietary and nutritional advice

34. The opponent relies on a number of goods in class 5, including a selection of dietary and nutritional supplements. The applicant's services are adopted to provide the consumer with information and guidance on how to maximise their nutritional health and advice on their individual diet. The goods will be purchased to supplement the consumer's diet and fulfil a nutritional benefit or deficiency, so there is some similarity in the use of the goods and services. The users are likely to be the same, it seems fair to conclude that those seeking out nutritional advice would also seek to purchase goods to supplement or aide their nutrition. The trade channels may differ, and the respective natures are distinct. The goods and services are not competitive, though they share a complementary relationship insofar as there is an element of indispensability, albeit limited, and the consumer may expect the same entity to provide both; offering the user dietary advice or guidance and providing the recommended supplements to correlate with that advice. Notwithstanding the differences identified, I find the similarity fairly high.

Health spa services; beauty salon services; massage; aromatherapy services

35. I understand a health spa to refer to an establishment which offers customers a variety of treatments such as facials, massages and beauty treatments. It may also provide facilities such as saunas or pools. The opponent relies upon goods including *aromatic oils*, *massage oils* and *cosmetics* at large. The goods and services will, at times, be accessed for a similar purpose, to enhance one's appearance or improve the quality of a particular physical aspect. That said, I accept that some of the

applicant's services will be accessed to target a specific health problem or concern; massage services could be used to address an injury, for example. The goods and services will likely be accessed by the same users, for the most part at least. The trade channels are unlikely to be shared and there is limited opportunity for competitiveness between the goods and services, though the consumer may, for example, choose between visiting a salon for a beauty treatment or purchasing the goods to self-administer the same or a similar treatment. The goods relied upon may be utilised in the provision of the aforementioned services, respectively, so there is an element of complementarity and, in my experience, an entity offering the services outlined above may simultaneously offer the goods required to perform such services, either for use in the relevant establishment or for the customer to purchase and take home. I find the similarity to be of at least a medium degree.

Physiotherapy; physical therapy; health care

36. The above services directly concern the health of the consumer, rather than any aesthetic or artificial elements. Some of the opponent's class 5 goods are utilised for health purposes, broadly speaking, so there may be an opportunity for coincidence in the goods and services' use, though the opponent's goods primarily concern nutrition. The users will likely be shared, generally, though I accept that users of services such as physiotherapy and physical therapy likely represent a smaller consumer group, specifically those with a physical condition or injury. The trade channels are unlikely to be shared and I do not consider there to be any similarity between the nature of the respective goods and services. Whilst I have found that the respective goods and services may each be accessed by a user for the purpose of optimising its health, broadly at least, I do not consider there to be a competitive relationship between them; the consumer will require one or the other. I also do not find the goods and services complementary; they are not indispensable nor are they likely to be provided by a single origin. Though 'health care' is a fairly broad term and could entail the prescription of, or referral to, particular supplements, the consumer would not necessarily expect the health care provider to provide the goods themselves. I find the above services dissimilar to the goods relied upon by the opponent.

Solarium services; visagists' services

37. I understand solarium services to refer to establishments such as tanning salons and visagists' services to describe the services provided by a make-up artist. I consider these services against the opponent's cosmetics in class 3, which as a term is likely to encapsulate goods including tanning lotions and make-up. The goods and services will generally be selected for much the same purpose; to provide the user with an artificial tan or an application of make-up. The users are likely to be shared, though I keep in mind that make-up artists may be sought primarily by those celebrating a special occasion or attending an important event, for example. Whilst the nature of the goods and services is distinct, it would not necessarily be unusual for goods such as those relied upon in class 3 to be utilised to support the provision of the applicant's services. There may be some distinction in the trade channels via which the respective goods and services reach the market though there could be an element of competitiveness. Insofar as complementarity is concerned, whilst the goods and services may traditionally be provided by distinct entities, it would not necessarily be unusual for an entity providing such services to branch out into the provision of its own goods, or equally an entity successfully providing the respective goods may turn its hand to the applicable service in which it can make further use of those goods. There could be a degree of indispensability. Weighing all considerations, I find the similarity to be of a medium degree.

38. For those services where I have failed to find any similarity, the opposition fails at this juncture. If there is no similarity, there is no likelihood of confusion to be considered³.

The average consumer and the nature of the purchasing act

39. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA; *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

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.”

40. The average consumer of the goods and services at issue is likely to be a member of the general public. The goods are typically self-selected from a traditional retail establishment such as a supermarket or pharmacy, or an online equivalent. The services are likely identified via traditional signage or online promotional channels. The goods are purchased fairly frequently and are generally inexpensive, though admittedly the costs are variable. The services are likely engaged on a less frequent basis at a higher (but not significantly higher) cost. For both goods and services, the average consumer will typically be alive to factors such as ingredients used and compatibility. The marks’ visual impression is likely to play the greater role in the selection process, though I do not overlook the relevance of its aural impression, given that recommendations could be sought from retail assistants or peers, for example. Weighing all factors, I find it likely that the average consumer will apply a medium degree of attention to the selection of the goods and services.

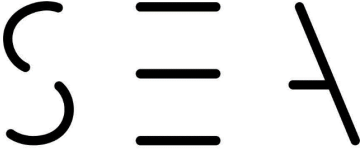
Comparison of trade marks

41. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...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.”

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

43. The trade marks to be compared are displayed in the table below:

Opponent's mark	Applicant's mark
<p>PIPING ROCK</p>	 <p>BY P I P I N G H O T</p>

44. The opponent's mark comprises two words of six and four letters, respectively. The overall impression lies in the mark as a whole, with neither word appearing more dominant than the other. That said, 'PIPING' will likely be seen as a descriptor of the mark's subsequent word; ROCK (though I will say more on that later).

45. In the applicant's mark, what will likely be perceived as the word 'SEA' (presented in upper case) is positioned above three smaller words of two, six and three letters; BY PIPING HOT. Certain aspects or lines have been removed from the word 'SEA'; there is a small middle section missing from the S and the middle letter, E, has no adjoining line on the left so appears as three identically sized horizontal lines arranged vertically, and the left-hand side of the A is omitted. I am confident, however, that it

with nonetheless be identified as the word SEA. On account of its size and the adopted presentation, I find SEA the most dominant element of the applicant's mark. 'BY PIPING HOT' will likely be seen as a nod towards the mark's origin.

46. Visually, the marks share an identical word in PIPING. The earlier mark comprises only one additional word and there are three in the applicant's mark. The applicant's mark makes a different visual impression on account of the variation in the words' sizing and positioning, and the creative adaption to the letters in SEA. Notwithstanding the identical element, keeping in mind what I have said regarding the marks' overall impressions, I find the visual similarity fairly low.

47. Aurally, the opponent's mark will be articulated in three syllables; PY-PING-ROCK. The applicant's mark, in its entirety, will be articulated in five syllables; SEE-BY-PY-PING-HOT. The marks share an identical pair of syllables, in the same sequence (PY-PING), albeit in different positions within the respective marks, and I acknowledge the similarity in the syllables which respectively follow 'PIPING', with 'ROCK' and 'HOT' sharing a similar percussive sound. In the applicant's submissions, it suggests that, given "its dominance", it is likely that many consumers will pronounce only the 'SEA' element of the later mark. In that scenario, I agree with the applicant that the marks are "phonetically dissimilar". However, this is not necessarily a reflection of how the marks will be articulated by the average consumer and I have no evidence to suggest that the mark will be condensed in any way, aurally speaking. I find the marks' aural similarity to be between a low and medium degree.

48. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer⁴. Whilst the words of which the earlier mark is comprised, specifically PIPING and ROCK, are ordinary dictionary words with definitions which will be well-known to the average consumer, to my knowledge, PIPING ROCK, as a term, is not one which carries a concept capable of immediate grasp. The concept of a rock will reside with the average consumer, and likely be recalled, but I am not sure what effect the mark's preceding word, PIPING, will have on that concept. Rather, it will likely be seen as an invented term with no specific concept. In the applicant's mark,

⁴ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

SEA will be understood by the average consumer as meaning a large body of water. The term 'PIPING HOT' will be conceptually understood as a term used to describe something which is exceptionally hot. I keep in mind what I have said regarding the mark's overall impression and, given that 'PIPING HOT' is preceded by the word 'BY', the term will likely be seen as an indicator of origin, rather than part of the mark's identity. Notwithstanding an identical word element in 'PIPING', I find the marks conceptually dissimilar.

Distinctive character of the earlier trade mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

50. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

51. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence showing the use made of the earlier mark, I have only its inherent distinctiveness to consider. As I have already concluded, the opponent's mark comprises two ordinary dictionary words, though their combination is, in my experience, rather unusual. The combination of the words creates a term which is unlikely to hold any meaning for the average consumer or make any conceptual impact. The mark therefore, to my knowledge, carries no descriptive or allusive connotations when considered against the goods for which it is registered. I find the inherent distinctiveness to be fairly high.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity

that exists between the trade marks and goods down to the responsible undertakings being the same or related.

54. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, 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.””

55. With regards the significance of the marks’ conceptual positions, 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.”

56. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established

(see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

57. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

58. I will begin by considering a likelihood of direct confusion. As the case law explains, this involves the average consumer simply mistaking one trade mark for the other. I approach the assessment initially on the basis of identical goods. I have found the marks’ visual impact to play the greatest role in the purchasing process and found the visual similarity between the marks fairly low. The opponent’s mark comprises two words, whereas the applicant’s mark comprises a total of four words, the largest of which (SEA) is presented in a distorted manner at the mark’s forefront. Even when considered in respect of identical goods, it seems highly unlikely, in my view, that the average consumer would erroneously believe the marks to be the same. The overall impression each mark makes is sufficiently distinct to allow the consumer to differentiate between the two. Having made that finding in regard of identical goods, it seems to follow that any such confusion is even less likely when considered in respect of goods or services which are similar to a lesser degree. I dismiss a likelihood of direct confusion.

59. I turn my attention now to indirect confusion. I keep in mind from the outset that a finding of indirect confusion is not to be considered a consolation prize for failing to find direct confusion; instead it requires a proper basis⁵. The marks’ common element is essentially the word ‘PIPING’. In the opponent’s mark, it precedes the word ‘ROCK’ to create an unusual and unquantified term. In the applicant’s mark, by contrast, it precedes ‘HOT’ to create a term which is likely to be familiar to, and convey a clear conceptual message to, the average consumer. Additionally, the term follows the word ‘BY’ which is consequently likely to be considered a nod toward the mark’s originating entity and, in terms of the mark’s overall impression, the term occupies a subservient

⁵ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

position. The overall impression of the applied-for mark is dominated by what will be viewed as the word 'SEA', which is notably the largest element and its letters have been distorted. The average consumer, having considered both marks and correctly identified that they are not the same, would be left with entirely different impressions and conceptual connotations on meeting the respective marks. I have not found the marks greatly similar, visually or aurally, and in this instance any similarities that exist in that regard I do not consider sufficient to counteract the mark's dissimilar conceptual positions. At most, the average consumer may, on account of the shared use of PIPING, call one mark to mind when confronted with the other but, even so, this would not be sufficient to support a finding of indirect confusion⁶. Even if the average consumer were to identify or recognise the common 'PIPING' element, for the reasons I have already considered, it would likely attribute the existence as such to mere coincidence, rather than a signal that the marks originate from a shared or economically related undertaking. I do not consider there to be a likelihood of indirect confusion in respect of any of the opposed goods and services.

Conclusion

60. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

61. The applicant has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. In accordance with that TPN, I award costs as follows:

Considering the statement of grounds
and preparing a counterstatement: £200

Considering the other side's evidence and
preparing written submissions: £400

⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Total:

£600

62. I order PRIPD, LLC to pay Piping Hot Limited the sum of £600. 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 21st day of October 2022

**Laura Stephens
For the Registrar**