

O-363-18

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATIONS NOS. 3212935 AND 3212932
BY HEAVENZ DESSERTS LIMITED
TO REGISTER

Heivenz

Heivenz

(SERIES OF TWO)

AND

HEAVENZ

AS TRADE MARKS IN CLASSES 21, 25, 30, 35 AND 43

AND CONSOLIDATED OPPOSITIONS THERETO
(UNDER NOS. 409390 AND 409417)
BY HEAVENLY DESSERTS VENTURES LTD

Background

1. The details of the marks the subject of these proceedings are:

Application 3212932 (series of two):

Heavenz

Heavenz

Application 3212935:
HEAVENZ

2. Both applications were filed on 15 February 2017 by Heavenz Desserts Limited (“the applicant”) in respect of the following identical list of goods and services:

Class 21: Tableware, cookware and containers; ceramics for kitchen use; ceramics for household use; ceramic tableware; mugs; coffee mugs; plates; bowls; jugs; lunch-boxes; glasses, drinking vessels and barware; glassware for household use; glasses; milk shake glasses; kitchen utensils; bottle openers.

Class 25: Clothing, footwear, headgear.

Class 30: Coffee; coffee flavorings; tea; fruit flavoured tea; hot chocolate; confectionary; prepared desserts [confectionary]; puddings; puddings for use as desserts; mousse; waffles; crepes; cakes; ice creams; frozen yogurts; sorbets; syrup for food; foodstuffs made of sugar for sweetening desserts; doughnuts; sandwiches; sandwich wraps; filled sandwiches.

Class 35: The bringing together for the benefit of others of a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice

creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear enabling customers to conveniently view and purchase those goods; mail order retail services connected with a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear; online shopping retail services connected with a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear; organisation, operation, management, and supervision of promotional, incentive and loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty services for commercial, promotional and advertising purposes; franchising services; business advice relating to franchising; business management assistance in the field of franchising.

Class 43: Provision of food and drink; restaurant, bar, snack bar, cafeteria, public house, banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services; dessert shop services; pudding shop services; sandwich shop services; consultancy services relating to the aforesaid services.

3. Both applications were accepted and published in the Trade Marks Journal on 14 April 2017.

4. On 7 June 2017 Heavenly Desserts Ventures Ltd (“the opponent”) filed two notices of oppositions against the applications. Various amendments were made to those notices, which is why an issue subsequently arose between the parties as to whether the opponent could rely on the UK trade mark 3204560. Having investigated the matter, it appeared that that mark was initially relied upon (amongst others) by the opponent in the notice of opposition filed on 7 June 2017 against the application 3212932, but it got removed from the opponent’s claim (along some grounds under Section 5(1)), by way of an amended notice filed on 27 October 2017. On 29 May 2018 I wrote to the parties confirming that the opponent could no longer rely on the mark 3204560 and inviting them to submit any comments by 5 June 2018. No comments were received by the deadline.

5. The grounds of oppositions are under Section 5(2)(b) of the Trade Mark Act 1994 (“the Act”). The opponent relies on the following three marks:

- i. UK TM 3022966 (series of two) for the marks Heaven Dessert and Heaven's Desserts which was filed on 20 September 2013 and registered on 11 April 2014. The mark is registered in respect of:

Class 35: Retail services connected with the sale of dairy and non dairy ice cream cakes.

- ii. UK TM 2634891 for the mark:

Heavenly Desserts

which was filed on 10 August 2012 and registered on 21 June 2013. The mark is registered in respect of:

Class 35: Retail of Dairy and non Dairy Ice cream Cakes

- iii. UK TM 3139951 for the mark:



Heavenly Desserts

which was filed on 09 December 2015 and registered on 11 March 2016. The mark is registered in respect of:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps, milk shakes.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes, hot beverages, biscuits, sundae, ice cream, waffles.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines. soft drinks.

Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of waffles, crepes, milkshakes, ice cream, hot beverages, soft drinks, sundae, cakes, biscuits).

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services. Provision of food and drink.

6. Although, in its notice of oppositions, the opponent selected the box indicating that it wished to rely only on some of the goods and services in its earlier marks, from the comments provided on the forms, which are reproduced below, it is clear that the opponent wished, in fact, to rely on the whole specifications comprised in the earlier registrations:

My mark 3022966 is (i) identical or similar to the Applicants mark in class 35 (and in practice Applicants's mark and the Heavenly Desserts Marks are both used primarily in respect to the retail sale from shop outlets of desserts) (ii) similar to the Applicants mark in class 21, 30 and 43.

My mark 3139951 is (i) identical or similar to the Applicants mark in classes 30 and 35 and 43 (ii) similar to the Applicants mark in classes 21.

My mark 2634891 is (i) identical or similar to the Applicants mark in class 35 (ii) similar to the applicants mark in classes 21, 30 and 43.

7. Both oppositions were defended by the applicant who filed counterstatements denying the claims made. The oppositions were consolidated.

8. The applicant is professionally represented by Swindell & Pearson Ltd, whilst the opponent represents itself. Neither side filed evidence but both filed written submissions. A hearing took place before me on 11 April 2018 at which the applicant was represented by Mr Kieron Taylor and Mr Mohammed Imran appeared on behalf of the opponent.

9. At the hearing Mr Imran confirmed that the opponent wished to withdraw the oppositions against the contested goods in classes 21 and 25. He also withdrew any objections against the contested retail services (in class 35) connected with the sale of goods in classes 21 and 25.

DECISION

10. Section 5(2)(b) of the Act reads:

“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.”

Section 5(2)(b) - case-law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach to the comparison/the opponent's best case

12. Although the opponent has based its oppositions on three earlier marks, in my view, the opponent's strongest case lies in 3022966 and 3139951: if it cannot succeed in respect of these earlier registrations, it will be in no better position as regards its other mark. I proceed on that basis. Since those earlier marks had not been registered for five years or more when the applicant's marks were published for opposition, they are not subject to the proof of use provisions under section 6A of the Act.

Comparison of goods and services

13. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

14. 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 services;
- 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.

15. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where 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”.

16. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Gérard Meric v OHIM*, Case T- 133/05, the GC 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".

19. In *Oakley, Inc v OHIM*, Case T-116/06 at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

20. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

21. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

22. The competing goods and services are reproduced in the Annex to this decision.

23. I shall begin my comparison by comparing the services of the earlier mark 3022966 with the applied for specification, and then continue the comparison on the basis of the earlier mark 3139951, where it provides the better case.

Comparison on the basis of the earlier registration 3022966

Class 35

24. The parties' specifications in class 35 cover retail services connected with the sale of specific goods. Since the opponent's retail services are not limited in any way, they cover services provided through commercial outlets, as well as via the internet or via mail order. As regards the various retail services in the applications, i.e. *the bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase those goods, mail order retail services and online shopping retail services*, as they relate exactly to the same services, for convenience, I will group them together⁴ and refer collectively to them as "retail services".

25. Whilst the services under comparison share the same nature, i.e. they are all services offered by retailers, and have the same purpose of allowing consumers to conveniently satisfy different shopping needs, the degree of similarity between retail services of specific goods and retail services of other specific goods depends, to a certain extent, on the similarity between the goods to which the services relate.

⁴ Separode Trade Mark BL O-399-10

Retail services connected with (the sale of) desserts, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, cakes and ice creams.

26. The earlier mark 3022966 has a very narrow specification covering *retail services connected with the sale of dairy and non dairy ice cream cakes* (in class 35). At the hearing, Mr Taylor submitted that the words *dairy and non dairy ice cream cakes* should be construed as referring to some form of cake with layers of ice cream between layers of pastry or sponge. He stated, in his skeleton arguments:

“We accept that [*retail services connected with the sale of dairy and non dairy ice cream cakes*] may well be similar to the retail of ice cream and of cakes. However, the opponent has not set out why this is the case. We should suggest that given the low level of similarity between the marks this is the full extent of the opponent’s reach”.

27. At the hearing, Mr Taylor expanded on his submission and said that, if I were to find any likelihood of confusion with the earlier 3022966 mark (which, in his view, represents the opponent’s best prospect of success), the opponent’s specification (in class 35) would only bite in relation to the applied for retail services (in class 35) connected with the sale of *desserts, prepared desserts [confectionary], puddings, puddings for use as desserts, cakes, ice creams*. However, as he did not say how similar the competing services are, I will proceed to my own assessment.

28. In my view, as a matter of construction, the natural meaning of *desserts, prepared desserts [confectionary], puddings, puddings for use as desserts, cakes and ice creams* is broad enough to include the opponent’s *dairy and non dairy ice cream cakes*. In those circumstances, the comments in *YouView TV Ltd v Total Ltd* are relevant. To dispel any doubt on this point “ice cream cake” is defined as “a type of cake that contains or consists of a layer or layers of ice cream” and “dessert” as “the sweet course eaten at the end of a meal⁵”. Since the goods to which the opponent’s retail services relate are included within the goods to which the applicant’s retail services relate, these are identical services in accordance with the decision in *Meric*.

⁵ Oxford English Dictionary

For the sake of completeness, I should say that although the applicant's specification is wider and includes retailing of goods which are not identical to the goods retailed by the opponent, the services would still be highly similar. This is because the goods in relation to which the competing retail services are provided are closely related, i.e. they share similar uses, users, nature, purpose, e.g. a sweet treat/course, and method of use, and there is a degree of competition and complementarity in play. In addition, the retail services through which the opponent's goods are normally associated correspond with the applicant's retail services. **Retail services connected with the sale of *desserts, prepared desserts [confectionary], puddings, puddings for use as desserts, cakes and ice creams* are identical or highly similar to the opponent's services.**

29. As regards to *confectionary*, the term includes *prepared desserts* (as indicated by the words in square brackets), as well as other goods that cannot be described as desserts, such as, for example, candies, marshmallows, jellies and chocolates. I extend the findings I made in relation retail services connected with the sale of *prepared desserts [confectionary]* to *confectionary* insofar as the term covers *prepared desserts*. In relation to the applicant's retail services relating to *confectionary not including desserts*, I find that they are similar to a medium degree to the opponent's retail services. Items of *confectionary not including desserts* are normally sold through retailers of sweets and chocolates. *Ice cream cakes* are normally sold through retailers of ice creams, cakes and desserts. Although the goods to which the competing services relate are all sweet goods, the nature, purpose and method of use are not particularly similar and if there is any competition or complementarity it must be limited. Even if the goods could be sold in the same retail outlets, e.g. supermarkets, they and are unlikely to be located in close proximity. **Retail services connected with the sale of confectionary [prepared desserts] are similar to a high degree to the opponent's services. Retail services connected with the sale of *confectionary not including desserts* are similar to a medium degree to the opponent's services.**

Retail services connected with mousse, waffles, crepes, frozen yogurts, sorbets, doughnuts

30. The term *mousse* includes desserts, such as, for example, chocolate mousse. *Waffles, crepes and doughnuts* are all types of cakes. *Frozen yogurt* and *sorbets* are frozen desserts. For similar reasons to those outlined at paragraph 28, I find that **there is a high degree of similarity between retail services connected with mousse, waffles, crepes, frozen yogurts, sorbets, doughnuts and the opponent's services.**

Retail services connected with coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps, filled sandwiches.

31. These goods are different, in terms of uses, users, nature, purpose and method of use from the ice cream cakes retailed by the opponent's. The competing retail services are neither complementary nor competitive. The retail services through which these goods are normally associated do not correspond with the opponent's retail services, and even if the goods are retailed in the same outlets, i.e. supermarkets, they are unlikely to be found in close proximity. **There is a low degree of similarity between retail services connected with coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps, filled sandwiches and the opponent's services.**

Organisation, operation, management, and supervision of promotional, incentive and loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty services for commercial, promotional and advertising purposes; franchising services; business advice relating to franchising; business management assistance in the field of franchising.

32. The opponent did not raise any specific argument in relation to these services. The intended purpose of the applied for services is to organise, operate and manage sales and promotions, to advertise and promote goods and services, to provide business

advice and support in relation to franchising. The purpose of the opponent's services is to retail dairy and non-dairy ice cream cakes. The respective services are not fungible, they are not in competition. They are not indispensable or important to one another "in such a way that customers may think that the responsibility for those goods lies with the same undertaking". They are not complementary. The applied for services do not have the same channels of trade as retailing as they are supplied by agencies, media undertakings or companies that allow their products or services to be franchised. The end user of the applied for services is a business or person who wishes to set up a franchise business; the end user of the opponent's retail services is a person who wishes to purchase ice cream cakes. **There is no similarity here.**

Class 30

Confectionary⁶; prepared desserts [confectionary]; puddings; puddings for use as desserts; cakes and ice creams

33. As I mentioned earlier, these goods include the goods to which the opponent's retail services relate. The GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. This creates a complementary relationship between the applicant's goods and the opponent's retail services of such goods. **These goods are similar to low to medium degree to the opponent's retail services.**

Mousse; waffles; crepes; frozen yogurts; sorbets; doughnuts.

34. Although these goods are not identical to the goods to which the opponent's retail services relate, the retail services normally associated with these goods are closely related to the retail services covered by the opponent's mark. **The goods are similar to a low to medium degree to the opponent's retail services.**

⁶ For reason which will become apparent, I will consider confectionary as one set of goods.

Coffee; coffee flavorings; tea; fruit flavoured tea; hot chocolate; syrup for food; foodstuffs made of sugar for sweetening desserts; sandwiches; sandwich wraps; filled sandwiches

35. Here the goods are two steps removed from the opponent's retail services. **There is no similarity here.**

Class 43

Provision of food and drink; restaurant, bar, snack bar, cafeteria, public house, banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services; sandwich shop services; consultancy services relating to the aforesaid services.

36. At the hearing Mr Taylor submitted that the extent of protection granted by the opponent's retail services should be limited, given the fairly specific nature of the goods involved. I agree that, as far as desserts go, retail services relating to *dairy and non dairy ice cream cakes*, constitute a distinct service within the desserts (retail) market. The applied for services involve preparing and serving food and drink for the public; they are not places whose principal or customary function is to provide retailing services in respect of food and drink, such as, for example, supermarkets. The nature and intended purpose of the services is different. As to the possibility that there could be a direct overlap in terms of trade outlets with the opponent's retailing services, there is no evidence to support such a conclusion. Although, for example, a coffee shop providing consumers eating in with cakes, may also sell cakes to consumers who just walk in to buy and then take the goods away (so that the retailing of cakes may take place), there is no evidence before me to demonstrate that the specific goods retailed by the opponent are ordinarily within the assortment of cakes sold in the premises where the applied for services are provided. Neither is there any evidence that the retailing of ice cream cakes may naturally expand into café, restaurants and the like. **There is no similarity here.**

Dessert shop services; pudding shop services

37. In the preceding paragraph, I have concluded that the applied for *provision of food and drink; restaurant, bar, snack bar, cafeteria, public house, banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services and sandwich shop services*, do not usually engage in the retailing of *dairy and non-dairy ice cream cakes*. However, here the services are dessert and pudding shop services and shops serving desserts/puddings are also likely to be shops retailing desserts/puddings, including the opponent's ice cream cakes. Whilst dessert and pudding shop services in class 43 are in their nature, intended purpose and method of use different from the opponent's retailing services, the respective trade channels through which the competing services reached the market may coincide. **These services are similar to a medium to high degree to the opponent's services.**

Comparison on the basis of the earlier registration 3139951

38. For reasons that will become apparent later in this decision, I will proceed on the basis that the opposed goods and services are identical to the specification covered by the opponent's mark 3139951.

Average consumer

39. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 and 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 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 parties’ goods and services in classes 30 and 43 and retail services in class 35 is the general public.

41. Insofar as the goods are concerned, they are most likely to be selected from physical outlets or from a website. While visual considerations are likely to dominate the selection process, aural considerations in the form of, for example, word-of-mouth recommendations or requests to sales assistants will also play their part. All of the goods at issue are likely to be fairly frequent, low cost purchases so I would expect the average consumer to pay a slightly below normal degree of care during the selection process.

42. As the retail services in class 35 are most likely to be selected from, inter alia, websites, catalogues, advertisements and signage on the high street, visual considerations are, once again, likely to dominate the selection process. That said, as such services may also be the subject of, for example, word-of-mouth recommendations, aural considerations must not be forgotten. As to the degree of care with which such services may be selected, given the inexpensive nature of the goods in connection to which the services are provided, by taking into account that the average consumer is likely to be mindful of a range of considerations such as the breadth of brands stocked, opening/delivery times and, in relation to a physical outlet, proximity to their location, parking etc. the degree of attention being paid during the selection process will be normal.

43. The parties’ services in class 43, are, in my experience, most likely to be selected having considered signage appearing on the high street and, for example, promotional material and reviews (in hard copy and on-line); once again visual considerations will be an important part of the selection process. However, as such services may also be the subject of word-of-mouth recommendations, aural considerations will also play

their part. As the average consumer will be alive to factors such as menu choices, cost, ambience etc. when selecting such services, I would expect them to pay a normal degree of attention during that process.

Comparison of marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

45. It would be wrong, therefore, artificially to dissect the 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. The respective marks are shown below:

Heaven's Desserts. The mark is made up of the word Heaven followed by the possessive reference 's and the word Desserts presented in title case. The words Heaven's Desserts are likely to be perceived by the average consumer as a unit, hanging together. The words Desserts, albeit not directly descriptive in relation to the opponent's services, it is descriptive in relation to the goods to which the opponent's services relate, so Heaven's is more distinctive than Desserts and has more weight in the overall impressions the marks convey.

Comparison between the earlier 3022966 mark and the applied for 3212935 mark

48. The applied for 3212935 mark consists of the word HEAVENZ presented in capital letters. Therefore, the overall impression of the mark is based upon the single word HEAVENZ.

49. Visually and aurally, the marks share the first six letters, i.e. HEAVEN. They differ in that the application contains a final 'z' at the end of the word HEAVENZ. Whilst the earlier mark also contains two additional elements, i.e. the possessive form 's and the word Desserts, which have no counterpart in the application, their impact is less than that of the word Heaven. In my view, the marks are visually and aurally similar to a high degree.

50. Conceptually, the applicant submits that Heaven's Desserts is likely to evoke the concept that "the dessert(s) are potentially out of this world" whereas the applied for mark HEAVENZ has no meaning. According to the applicant the closest wording is Heavens! as an exclamation of surprise and there is no conceptual similarity between the competing marks. The opponent argues that Heavenz "is clearly a play on, and alludes to, the word heaven". I accept that the word HEAVENZ is invented and does not appear in any English dictionary and that there is no evidence HEAVENZ is a common misspelling of the word heaven. However, because the word is long, I do not consider that the visual or aural impact of the misspelling is particularly striking. As to the conceptual impression of the mark, I am not persuaded that the addition of a z at the end of the word HEAVENZ will prevent it from being readily associated with the word heaven. In my view, it is more likely than not that the average consumer will

recognise in the HEAVENZ mark the word heaven⁷. As to the opponent's argument that the application will convey the meaning of the word heavens! used as an expression of exclamation, I reject it. The correct word is heavens not heavenz and the mark does not include an exclamation mark.

51. In terms of what perception HEAVENZ and Heaven's Desserts will trigger, the word heaven is defined as 1) in some religions, the place, sometimes imagined to be in the sky, where God or the gods live and where good people are believed to go after they die, so that they can enjoy perfect happiness and 2) (informal) a situation that gives you great pleasure: *I just lay in the sun for a week and did nothing - it was heaven*. I agree with the applicant that the earlier Heaven's Desserts mark will convey the concept of desserts coming from Heaven. Notwithstanding the misspelling, the applied for mark will evoke the concept of Heaven. In this connection I note that in *EDEN*, BL-547/17, James Mellor, sitting as the Appointed Person, in considering conceptual similarity between EDEN and EDEN CHOCOLAT said:

78.3.1. I agree that whichever meaning of Eden occurs to the average consumer (the garden of God, the first home of Adam and Eve or a delightful place, a paradise) the same meaning would be called to mind.

78.3.2. Without getting too analytical, there is some conceptual difference between 'Eden' which evokes a place, even when it is considered used in relation to goods (in this instance, cocoa or a chocolate mousse) and 'Eden Chocolat' which, to my mind, signifies something from the place.

78.3.3. Overall, and particularly bearing in mind the other elements of the mark applied for which cannot be ignored, I would assess the degree of conceptual similarity as above medium but not high."

52. In my opinion, similar considerations apply here. The marks are conceptually similar to a medium degree.

⁷ *Usinor SA v OHIM*, Case T-189/05

Comparison between the earlier 3022966 mark and the applied for 3212932 mark

53. The applied for 3212932 mark consists of a series of two signs, one in shades of grey and one in shades of yellow. The word HEAVENZ in both marks is fairly stylised; the letter Z at the end of the mark is presented in a larger size and stands out; the letter a, appearing in the third position, reproduces what the applicant describes as a coffee bean motif. As the stylisation has no impact of how the applied for marks will be articulated, for the same reasons I have outlined above, I find that the marks are aurally similar to a high degree. Visually, the degree of similarity is medium. Conceptually, even considering the additional concept of a coffee bean, the marks are still similar to a medium degree.

Comparison on the basis of the earlier registration 3139951

54. Once again, I will begin by assessing the overall impression of the earlier 3139951 mark. I will then proceed to carry out a comparison between the 3139951 mark and the applied for marks.

55. The earlier 3139951 mark consists of a circular device incorporating a highly stylised letter H placed above the words Heavenly Desserts, presented in a handwritten script with the 'H' and 'D' in capital letters and the remaining letters in lower case. The opponent submits that the dominant and distinctive element of the mark is the letter H because the word Heavenly and Desserts are descriptive. In this connection, Mr Taylor states that "the average consumer is used to seeing descriptors such as 'heavenly' in connection with desserts [...]. It is common place in the dessert industry to refer to desserts as 'out of this world', 'death by chocolate' and we argue that 'heavenly' fall firmly within this framework". The applicant also submits that the element Desserts is descriptive. In my opinion, irrespective of the specific goods and services I am considering, the words Heavenly Desserts in the earlier mark will be perceived as a unit. The letter H is clearly intended to mirror the word Heavenly and the average consumer is likely to realise that it stands for Heavenly. As regards the weight to be given to these components, I find that the words Heavenly Desserts and the letter H make a roughly equal contribution to the overall visual impression the mark conveys. However, when the mark is applied to goods and/or services in relation to

which the component Desserts has a direct significance (see below), that component should be considered to carry less weight than the other components of the mark in the overall impression.

Comparison between the earlier 3139951 mark and the applied for 3212935 mark

56. Considering the plain HEAVENZ mark first, I find that the competing marks are visually similar to a low degree. Aurally, the applied for mark will be articulated as HEAVENZ and the opponent's mark is likely to be pronounced as Heavenly Desserts, in which case there is a medium degree of similarity. Were the letter H to be articulated, the degree of similarity would be low. In terms of conceptual similarity, I have already found that irrespective of the goods and services in relation to which the mark is used, the word HEAVENZ in the application will evoke the concept of heaven so that the perception of the mark is likely to be locational (albeit it is an imaginary location). As for the earlier mark, Heavenly is an adjective meaning 1. "of heaven; divine"; 2. (Informal) very pleasing; wonderful". Consequently, the adjective Heavenly will be seen as qualifying the word Desserts and the overall significance of Heavenly Desserts will be of desserts which are very pleasing/tasty. The marks are conceptually similar to a low degree. In this connection I should also mention that the conceptual impact of the words heavenly desserts is likely to be much more distinctive when the mark is applied to goods and services in connection to which the use of the word Desserts is not descriptive.

Comparison between the earlier mark 3139951 and the applied for mark 3212932

57. In terms of visual similarity of the marks, considering the degree of stylisation in both marks, I find that they are similar to a very low degree. Aurally and conceptually I reach the same conclusion I have reached above.

Distinctive character of the earlier mark

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

59. Since the opponent has filed no evidence, I have only the inherent distinctiveness of the marks to consider. In his submissions, the opponent attempted to introduce some evidence and put forward several uses of the term heaven/heavenly, particularly for desserts, to demonstrate that it is used in a descriptive manner. As this material was not introduced in the form of evidence, I will disregard it. I can, however, take into account the dictionary meaning of heavenly as a laudatory term as mentioned above, which I believe to be in common usage based on my own experience as a consumer.

60. Considering firstly the earlier Heaven's Desserts mark (3022966) I have already found that Heaven's Desserts will be understood as desserts coming from heaven. Consequently, when applied to the narrow specification for which the mark is registered, i.e. *retail services connected with the sale of dairy and non dairy ice cream cakes*, the words Heaven's Desserts are likely to be understood as metaphorically emphasising the quality of the goods retailed. In my view the mark has a low degree of distinctive character.



61. Moving on to the *HeavenlyDesserts* mark (3139951), the word Heavenly is laudatory and therefore likely to be taken as designating the quality of the 'Desserts'. I therefore find that the mark has a very low degree of distinctive character in relation to the following goods and services which consists of desserts or are very closely related to desserts, namely compotes and prepared meals (which include desserts) (in class 29); preparations made from cereals, bread, pastry and confectionery, pies, biscuits, sundae, ice creams and waffles (in class 30) and retail services connected with the sale of waffles, crepes, ice cream, sundae, cakes and biscuits. I reach the same conclusion in relation to goods which could be used with (or to make) desserts, namely jellies, jams (in class 29); cocoa, sugar, rice, tapioca, sago, flour, edible ices, honey, treacle; yeast and baking-powder (in class 30). Although the device element adds some distinctiveness to the mark, this is not relevant for the purpose of the proceedings at issue, as it is the distinctiveness of the common element that matters⁸.

62. As regards the remaining goods and services (which are neither desserts, nor goods and/or services closely related to desserts), I find that the use of the mark is fanciful, and that the mark has a normal degree of distinctive character.

Likelihood of confusion

63. 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 marks may be offset by a greater degree of similarity

⁸ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

64. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 Mr Iain Purvis Q.C. sitting as the Appointed Person noted 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.

65. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind all the relevant factors. I will assess the likelihood of confusion firstly on the basis of the earlier 3022966 mark.

Likelihood of confusion on the basis of the earlier 3022966 mark

66. Here I found that there is no similarity between the earlier mark's specification and the following goods and services in the applications:

Class 30: Coffee; coffee flavorings; tea; fruit flavoured tea; hot chocolate; syrup for food; foodstuffs made of sugar for sweetening desserts; sandwiches; sandwich wraps; filled sandwiches.

Class 35: Organisation, operation, management, and supervision of promotional, incentive and loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty services for commercial, promotional and advertising purposes; franchising services; business advice relating to franchising; business management assistance in the field of franchising.

Class 43: Provision of food and drink; restaurant, bar, snack bar, cafeteria, public house banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services; sandwich shop services; consultancy services relating to the aforesaid services.

67. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

68. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be, at least, a degree of similarity of goods and services. Having concluded that there is no similarity between these goods and services and the specification of the earlier 3022966 mark, the opposition against these goods and services fails.

69. As regards the goods and services which I found to be similar to the earlier 3022966 mark's specification, my conclusions are as follows:

70. In relation to the application for the plain mark HEAVENZ (3212935), I found that the competing marks are visually and aurally similar to a high degree and conceptually similar to a medium degree. Notwithstanding the earlier mark has a very narrow specification and only a low degree of distinctive character in relation to the services concerned, given the marks' similarities, there is likely to be direct confusion between them, particularly when one bears in mind the concept of imperfect recollection, where the services involved are identical or highly similar. **There is a likelihood of direct confusion in relation to the applied for *retail services connected with the sale of desserts, confectionary [prepared desserts], prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets and doughnuts (class 35).***

71. I extend the same finding in relation to dessert shop services and pudding shop services (class 43). Notwithstanding the different classification, it seems to me that dessert/pudding shop services are in reality indistinguishable from retail services for desserts. **There is a likelihood of direct confusion in relation to the applied for dessert shop services and pudding shop services.**

72. In relation to the remaining retail services, namely *retail services connected with the sale of coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary not including desserts, syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps and filled sandwiches*, I find that the lower degree of similarity between the competing services, will avoid both direct and indirect confusion. **There is no likelihood of confusion in relation to *retail services connected with the sale of coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary not including desserts, syrup for***

food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps and filled sandwiches.

73. In relation to the applied for goods in class 30, it is unlikely that the average consumer would mistake these goods for the opponent's retail services so there is no likelihood of direct confusion. As to the question of whether there is a likelihood of indirect confusion, in my view, the average consumer having encountered the earlier mark Heaven's Desserts in the context of retail services relating to the sale of a very narrow category of cakes, i.e. ice cream cakes, would only believe that the goods are the responsibility of the same undertaking where the applied for HEAVENZ mark is applied to identical goods, i.e. where the goods are ice cream cakes.

74. The issue of partial refusal is dealt in TPN 1/2012. That TPN includes the following:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If,

however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective.” (my emphasis)

75. In those circumstances, the text I have highlighted above seems apposite and points towards limiting the applicant’s specification in classes 30 as follows:

Class 30: none of the aforementioned goods being ice cream cakes.

76. The opposition based on the mark 3022966 succeeds in relation to:

Class 35: The bringing together for the benefit of others of a variety of goods, namely, desserts, confectionary [prepared desserts]; prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, doughnuts, enabling customers to conveniently view and purchase those goods; mail order retail services connected with a variety of goods, namely, desserts, confectionary [prepared desserts]; prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, doughnuts; online shopping retail services connected with a variety of goods, namely, desserts, confectionary [prepared desserts]; prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, doughnuts.

Class 42: dessert shop services; pudding shop services

77. And fails in relation to:

Class 30: Coffee; coffee flavorings; tea; fruit flavoured tea; hot chocolate; confectionary; prepared desserts [confectionary]; puddings; puddings for use as desserts; mousse; waffles; crepes; cakes; ice creams; frozen yogurts; sorbets; syrup for food; foodstuffs made of sugar for sweetening desserts;

doughnuts; sandwiches; sandwich wraps; filled sandwiches; none of the aforementioned goods being ice cream cakes.

Class 35: The bringing together for the benefit of others of a variety of goods, namely, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary [not including desserts], syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps, filled sandwiches, enabling customers to conveniently view and purchase those goods; mail order retail services connected with a variety of goods, namely, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary [not including desserts], syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps, filled sandwiches; online shopping retail services connected with a variety of goods, namely, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary [not including desserts], syrup for food, foodstuffs made of sugar for sweetening desserts, sandwiches, sandwich wraps, filled sandwiches; organisation, operation, management, and supervision of promotional, incentive and loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty services for commercial, promotional and advertising purposes; franchising services; business advice relating to franchising; business management assistance in the field of franchising.

Class 43: Provision of food and drink; restaurant, bar, snack bar, cafeteria, public house, banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services; sandwich shop services; consultancy services relating to the aforesaid services.

78. I extend the same conclusion to the series of marks 3212932.

79. In reaching my conclusions I have not overlooked Mr Taylor's suggestion put forward at the hearing that the opponent should be allowed to limit the specification in class 35 to retail services related to the sale of hot desserts, so that to avoid any

conflict with the opponent's retail services connected with the sale of ice cream cakes. However, even if the specification were so limited, I would still find that the competing services are similar to a high degree (which would still give rise to a likelihood of direct confusion) so I reject the proposal.

80. I now move on to consider the likelihood of confusion based on the earlier 3139951 mark in relation to the goods and services in connection to which the opposition based on the earlier 3022966 mark has failed.

81. Here, although I found that the respective goods and services are identical, the marks are visually similar to, at best, a low degree, and aurally similar to, at best, a medium degree and conceptually similar to, at best, a low degree. Although in relation to some of the goods and services the earlier mark possesses a normal degree of distinctive character, in that context, the component Desserts of the earlier mark (which has no counterpart in the applications) becomes a distinguishing element between the marks and therefore the normal distinctiveness of Heavenly Desserts makes confusion no more likely. The common element alone Heavenly, remains low in distinctiveness and, combined with the low level of similarity between the marks, it points away from a likelihood of confusion. The opposition based on the mark 3139951 fails in its entirety.

Overall outcome

82. Taking into account that the oppositions were partially withdrawn at the hearing, I find that the applications can proceed to registration in relation to the following goods and services:

Class 21: Tableware, cookware and containers; ceramics for kitchen use; ceramics for household use; ceramic tableware; mugs; coffee mugs; plates; bowls; jugs; lunch-boxes; glasses, drinking vessels and barware; glassware for household use; glasses; milk shake glasses; kitchen utensils; bottle openers.

Class 25: Clothing, footwear, headgear.

Class 35: The bringing together for the benefit of others of a variety of goods, namely, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear enabling customers to conveniently view and purchase those goods; mail order retail services connected with a variety of goods, namely, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear; online shopping retail services connected with a variety of goods, namely, tableware, cookware and containers, ceramics for kitchen use, ceramics for household use, ceramic tableware, mugs, coffee mugs, plates, bowls, jugs, lunch-boxes, glasses, drinking vessels and barware, glassware for household use, glasses, milk shake glasses, kitchen utensils, bottle openers, clothing, footwear, headgear.

83. The oppositions succeed and the applications will be refused in relation to the services listed at paragraph 76.

84. The oppositions fail and the applications can proceed to registration in relation to the goods and services as listed at paragraph 77.

COSTS

85. Although both parties have achieved a measure of success, the applicant has been far more successful than the opponent. I award costs to the applicant on the following basis (applying a percentage reduction):

Considering the statement of case and filing a counterstatement (x2):	£500
Written submissions: (x2):	£500
Total:	£1,000

86. I order Heavenly Desserts Ventures Ltd to pay Heavenz Desserts Limited the sum of £1,000 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 18th day June of 2018

Teresa Perks

For the Registrar

The Comptroller General

Annex

Applicant's contested goods and services

Class 30: Coffee; coffee flavorings; tea; fruit flavoured tea; hot chocolate; confectionary; prepared desserts [confectionary]; puddings; puddings for use as desserts; mousse; waffles; crepes; cakes; ice creams; frozen yogurts; sorbets; syrup for food; foodstuffs made of sugar for sweetening desserts; doughnuts; sandwiches; sandwich wraps; filled sandwiches.

Class 35: The bringing together for the benefit of others of a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches, enabling customers to conveniently view and purchase those goods; mail order retail services connected with a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches; online shopping retail services connected with a variety of goods, namely, desserts, coffee, coffee flavorings, tea, fruit flavoured tea, hot chocolate, milkshakes, confectionary, prepared desserts [confectionary], puddings, puddings for use as desserts, mousse, waffles, crepes, cakes, ice creams, frozen yogurts, sorbets, syrup for food, foodstuffs made of sugar for sweetening desserts, doughnuts, sandwiches, sandwich wraps, filled sandwiches; organisation, operation, management, and supervision of promotional, incentive and loyalty schemes; organisation, operation and supervision of sales and promotional incentive schemes; customer loyalty services for commercial, promotional and advertising purposes; franchising services; business advice relating to franchising; business management assistance in the field of franchising.

Class 43: Provision of food and drink; restaurant, bar, snack bar, cafeteria, public house, banqueting and catering services; takeaway food services; fast food restaurant services; preparation of food and drink; providing food and beverages; coffee shop services; milkshake shop services; dessert shop services; pudding shop services; sandwich shop services; consultancy services relating to the aforesaid services.

Opponent's goods and services

Mark 3022966

Class 35: Retail services connected with the sale of dairy and non dairy ice cream cakes.

Mark 3139951

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.milk shakes.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.hot beverages, biscuits, sundae, ice cream, waffles.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.soft drinks.

Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale

of waffles, crepes, milkshakes, ice cream, hot beverages, soft drinks, sundae, cakes, biscuits).

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services. Provision of food and drink.