

**O-587-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3293339  
FOR THE FOLLOWING TRADE MARK:**

**FRENCH DREAM**

**IN THE NAME OF MARIAGE FRÈRES**

**IN CLASS 30**

**AND OPPOSITION THERETO UNDER NO. 412925  
BY WESTBRAE NATURAL, INC.**

## Background and pleadings

1) On 28 February 2018, Mariage Frères (“the applicant”) applied to register the trade mark FRENCH DREAM in the UK. It was accepted and published in the Trade Marks Journal on 23 March 2018. The application covers various class 30 goods but only the following have been opposed:

*Teas and tea-based beverages; cocoa; chocolate; pastry, biscuits and confectionery; edible ices; herbal infusions*

2) Westbrae Natural, Inc. (“the opponent”) partially oppose the trade mark on the basis of Section 5(2)(b)<sup>1</sup> of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier European Union (formerly Community) trade mark (“EUTM”). Pertinent details of the earlier relied registration are as follows:

**Mark:** DREAM

**EUTM no:** 14729859

**Date of Filing:** 25 October 2015

**Date of entry in register:** 2 May 2016

**Goods relied upon:** Class 30 - *Non-dairy based frozen desserts*, and Class 32 - *Non-dairy based beverage*

3) The opponent argues that the respective goods and marks are similar. The applicant filed a counterstatement denying the claims made. Only the applicant filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

4) Both parties filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A hearing via video-link took place on 8 August 2019. Both parties were represented by Counsel, with Mr Tom St Quinton appearing for the applicant, instructed by Potter Clarkson LLP and Mr Daniele Selmi, instructed by Stone King LLP, appearing for the opponent.

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<sup>1</sup> The opponent also initially relied upon section 5(3) of the Act but this was struck out following the absence of evidence of use being filed.

## **Evidence**

5) The opponent's evidence consists of a witness statement and one exhibit from Mr Sanjay Kapur who is a Partner for Potter Clarkson LLP, the opponent's representatives.

6) Mr Kapur's witness statement is very brief and simply seeks to demonstrate that the UK and EU trade mark registers consist of numerous trade mark applications and registrations covering classes 30 and 32 which contain the word DREAM. The exhibit attached to the witness statement are copies of the aforementioned trade mark register entries. I shall address the argument that the evidence is seeking to make later in this decision.

## **Section 5(2)(b)**

### *The legislation*

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### *The case-law*

8) 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 great 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.

### **Comparison of goods and services**

9) The respective goods to be compared are:

<b>Applicant's goods</b>	<b>Opponent's goods</b>
<i>Class 30: Teas and tea-based beverages; cocoa; chocolate; pastry, biscuits and confectionery; edible ices; herbal infusions</i>	<i>Class 30: Non-dairy based frozen desserts Class 32: Non-dairy based beverage</i>

10) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

11) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

12) 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;
- (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.

13) Applying the principles set out in *Meric*, the applied for *edible ices* are included, and therefore identical, to the earlier *non-dairy based frozen desserts*.

14) The opponent argues that applying the *Meric* principle, *teas and tea-based beverages; cocoa; herbal infusions* are identical to its *non-dairy based beverages*. The applicant disagrees, claiming that they are dissimilar. In support of this argument it relies upon the EUIPO Board of Appeal in Case R 1154/2015-1 *Hamadrya/hama*

where it considered “non-alcoholic beverages; beer in Class 32 with “coffee, tea, cocoa” in class 30, whereby it stated that:

*“26 .. the contested ‘non-alcoholic beverages; beer’ in Class 32 are different to any of the opponent’s goods and services which do not include any of these drink products, or services related thereto. As regards the opponent’s goods in Class 30, such as ‘coffee, tea, cocoa’, these are not similar to the contested ‘non-alcoholic beverages; beer’.*

*27 According to the class notes of Nice International Classification of Goods and Services, the drinks listed in Class 32 explicitly exclude drinks with a ‘coffee, cocoa or chocolate’ base. Hence, from the outset, the nature of the goods is different. Their purpose is also different. Non-alcoholic beverages and beers are consumed cold and primarily to quench thirst, whereas coffee, tea and cocoa are consumed hot and for their stimulating qualities or for their particular taste. Nor are they generally in competition with, or complementary to, each other. Beer or non-alcoholic beverages are not usually considered as an alternative to coffee, tea or cocoa or vice versa. Finally, the manufacturing processes and the trade channels of these goods do not coincide with each other (compare to 03/02/2015, R 26/2014-2, NATY’S, § 24; 15/04/2015, R 2598/2013-2, PREFERISCO (fig.) / I PREFERITI, § 28; 22/04/2014, R 1877/2013-2, KENTOS / KENTES, § 20; 07/08/2014, R 1880/2013-1, HEALTHPRESSO / PRESSO, § 66; 23/05/2013, R 1245/2012-4, ITALIAN BEER MORENA SPECIAL BEER (fig.) / MORENO (fig.), § 10-11).*

15) The applicant also relies upon the Boards of Appeal decision in Case R-1245/2012-4 MORENA/MORENO which found beer, mineral and aerated waters, and fruit drinks and fruit juices to be dissimilar to coffee and drinking powders containing cocoa.

16) I must say at the outset that neither of the decisions referred to are binding upon me but I do accept that it is desirable to be consistent with such matters of fact. However, I do not agree with the outcome reached by the EUIPO Boards of Appeal.

Firstly, the Boards of Appeal appear to accept that coffee, tea and cocoa in class 30 include the finished drinkable form of the goods since it refers to them as being “consumed hot”. With this in mind, I do not accept that the purpose of the respective goods differ because one is hot and the other is cold particularly since drinks such as iced latte, tea etc are available which may be sold alongside other cold beverages. In my view, the purpose of all of the goods are to be drunk to quench thirst or because the consumer simply enjoys the taste. I also disagree that the goods are not in competition and distributed through dissimilar trade channels. In view of this, I do not find the decisions referred to be of assistance when considering the respective goods.

17) For the reasons set out above I consider the applied for *teas and tea-based beverages; cocoa and herbal infusions* to have the same purpose as the earlier relied upon *non-dairy based beverages*. There is also an element of competition between the goods and they may share similar trade channels. Therefore, I find the respective goods to be similar to a medium degree.

18) I consider the applied for *confectionery; pastry; Biscuits and confectionery* in Class 30 to be similar to the opponent’s earlier relied upon *non-dairy based frozen desserts* to an above medium degree. They all they have the same purpose, i.e. to be consumed and will usually coincide in producer, relevant public and distribution channels. Furthermore they are in competition.

### **Comparison of marks**

19) 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 Court of Justice of the European Union 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.”

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

21) The respective trade marks are shown below:

<b>Applicant's mark</b>	<b>Opponent's mark</b>
FRENCH DREAM	DREAM

22) The opponent's mark consists of the ordinary dictionary word DREAM. Since this is the only element of the mark, the overall impression can only lie in this word.

23) The applicant's mark is a combination of two ordinary dictionary words. The overall impression of the mark lies in the combination of these words.

24) Visually, the applicant argues that the respective marks are visually similar to only a low degree. This is on the basis of, 1) the application beginning with the word FRENCH, which is not present in the opponent's mark, 2) the application being over twice as long (12 characters including a space as opposed to the opponent's 5 characters), 3) the word FRENCH being entirely absent and 4) the average consumer pays greater attention to the beginning rather than the end. The opponent pitches the level of similarity as being medium to high.

25) Whilst I acknowledge the applicant's arguments, in particular that more emphasis is placed on the beginning of marks, the marks are inevitably similar since they share

the word DREAM which is the sole element of the opponent's mark and the second element of the application. Therefore, I find that they are visually similar to a medium degree.

26) Aurally, both parties effectively argue the same points as raised in relation to the visual similarity and they also reach the same conclusions, i.e. the opponent states that they are aurally similar to a medium to high degree, with the applicant claiming that they are similar to a low degree. In my view, the respective marks are aurally similar to no more than a medium degree since they share the word DREAM.

27) Conceptually, the opponent argues that "Since the word FRENCH is capable of being descriptive of the nature and characteristics or the geographical origin of the Applicant's goods, it will be attributed a lower degree of trade mark significance by the average consumer, even when considering the sign as a whole." Therefore, it claims that the respective marks are conceptually similar to a medium to high degree.

28) The applicant refers to the dictionary definition of the word DREAM which is "1. A series of images occurring in the mind during sleep; 2. a cherished aspiration, as in a "a childhood dream"; 3. An unrealistic or self-deluding fantasy; or 4. A person or thing perceived as wonderful or perfect."<sup>2</sup> Putting the definitions in context of the goods, the applicant argues that the earlier mark is a laudatory term. It argues that the ordinary meaning, "evokes a very different concept: "FRENCH DREAM" will call an idyllic image of France to the mind of the average consumer. The particular imagery of France that is called to mind will vary from person to person (e.g., it may call to mind an image of a famous Parisian landmark, or a game of boules in a rural village square) but to each particular consumer the imagery will be something that they consider unmistakably French. It is a distinctly different impression to that of the Earlier Mark."<sup>3</sup>

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<sup>2</sup> Paragraph 18 of the applicant's skeleton argument which was drawn from [www.lexico.com](http://www.lexico.com) which is the new domain for the Oxford English Dictionary's free online resource, previously at [oxforddictionaries.com](http://oxforddictionaries.com)

<sup>3</sup> Paragraph 20 of the skeleton argument

29) The word DREAM has the same meaning in both marks. The word FRENCH would be attributed its normal meaning, i.e. something relating to, originating from or inspired by France. However, FRENCH DREAM as a whole has no obvious meaning. Its most likely meaning in relation to all of the goods, is that they originate from France. Therefore, the mark FRENCH DREAM may be taken to mean DREAM goods from FRANCE. Accordingly, I consider the shared use of DREAM will create an above medium degree of conceptual similarity.

### **Average consumer and the purchasing act**

30) 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

31) 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.”

32) The various goods are drinks and some foodstuffs, such as chocolate. It is not in dispute between the parties that the average consumer of the goods will be a member of the general public. It is also not in dispute that the goods will be selected following a visual self-selection process, though aural considerations are not discounted.

33) The parties do disagree, however, on the level of attention paid by the average consumer. The opponent argues that since the goods are of low value goods that are often purchased impulsively, the average consumer will only pay a low degree of care and attention when purchasing the goods. The opponent argues that an average degree of attention will be paid. It is true that some of the goods are of low-value, but equally the consumer is likely to take care to ensure, for example, that the correct blend of coffee, or type of tea, is purchased. Therefore, I find that the level of care and attention paid upon purchasing the goods is medium.

### **Distinctive character of the earlier trade mark**

34) 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).”

35) The opponent has not filed any evidence aimed at supporting any enhanced distinctive character, nor has it claimed such use. Therefore, it does not have an enhanced level of distinctive character by virtue of the use made of the mark.

36) From an inherent perspective, the earlier mark consists of the word DREAM. The mark is neither directly descriptive or allusive of the goods in question and, therefore, the opponent argues that it is distinctive to a normal to high degree. In the comparison of marks, the applicant argues that the word DREAM is a “laudatory term”<sup>4</sup> which suggests that it is arguing that the mark is of weak distinctive character. In my view, the word DREAM is an ordinary English word that is readily perceived to carry out a laudatory or aspirational message. Accordingly, I consider the earlier relied upon mark to have an inherently weak distinctive character, though that is not to say that it is devoid of any distinctive character since the mark is registered and *prima face* valid<sup>5</sup>.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

### *State of Register argument*

37) As previously stated, the opponent has filed evidence which demonstrates that there are numerous existing UK and EU trade mark registrations in classes 30 and 32 which include the word DREAM. The applicant rightfully states that this evidence is irrelevant citing *Zero Industry Srl v OHIM*, Case T-400/06 in support. In the aforementioned case, the General Court stated at paragraph 73 that:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere

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<sup>4</sup> Para. 19 of the applicant’s skeleton argument.

<sup>5</sup> See section 72 of the Act.

fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

38) In view of the above, the evidence filed by the opponent is of no assistance and I reject this line of argument.

#### *Likelihood of confusion*

39) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

41) To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

42) I have found that the respective goods either identical or similar to at least a medium degree. I also concluded that the respective marks are visually similar to a medium degree, aurally similar to no more than a medium degree and conceptually similar to an above medium degree. I have also found that the earlier mark is inherently distinctive but only to a low degree. I concluded that the goods will be purchased following a visual inspection of the goods (though I do not discount aural considerations) whereby members of the public will pay a medium degree of attention.

43) During the hearing Mr Selmi argued that the word FRENCH in the application is capable of being descriptive of the nature and characteristic of the geographical origin of the goods in question and so it would be attributed a lower degree of trade mark significance even when considering the mark as a whole. There is no evidence to support a finding that any of the goods in question would originate from France, but I do accept that the average consumer may perceive this to be the case or that they are French inspired goods. He also went on to state that the word DREAM has an independent distinctive role within the application.

44) The opponent relies on the judgement of the CJEU in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*<sup>6</sup>, and argues that as DREAM has an independent distinctive role in FRENCH DREAM it will lead the relevant public to believe that the applicant's goods and services originate from the opponent, or from an economically related company. In that case the CJEU found that:

“...Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

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<sup>6</sup> Case C-120/04

45) Mr Selmi also referred to the judgment of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), whereby Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent



distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

46) Mr Selmi argues that whilst the *Medion* approach was “softened”<sup>7</sup> by *Bimbo*, what matters is if the common element retains an independent distinctive role in the composite sign. Mr St Quinton, on behalf of the applicant, is of the view that since, 1) DREAM is low in distinctive character, 2) FRENCH is the most dominant part of the application and, 3) FRENCH DREAM when considered as a whole creates a very different impression, there is not likelihood of confusion.

47) Whilst I agree that DREAM is of low distinctive character and some of the goods in question are not identical, neither of these points exclude a finding that there is a likelihood of confusion (either direct or indirect) because that would amount to overlooking the impact that the word DREAM might have on the public and that particular part would be negligible, when that is clearly not the case.

48) I must assess the marks taking into account all of the relevant factors. With this in mind, I do not consider that the average consumer will mistake one mark for another and so there is no likelihood of direct confusion. However, I do consider the indirect likelihood of confusion position to be different. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal

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<sup>7</sup> Paragraph 38 of his skeleton argument

terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

49) I also bear in mind the guidance in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, whereby Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. However, I am of the view that whilst the average consumer will notice the differences in the marks, they will merely consider that the respective marks originate from the same, or an economically linked, undertaking.

50) In the light of my findings so far, it is clear that I do not consider the word DREAM to be “strikingly distinctive” for the goods in question and so point (a) above is not relevant. However, I do find the word FRENCH to be descriptive of the origin

or influence of the goods and so this is a non-distinctive element. When added to DREAM I consider that the average consumer will take this to originate from the same or economically linked undertakings which have brought out a FRENCH sub-brand, or brand extension. Therefore, I find that there is a likelihood of indirect confusion. I find this to be the case regardless of the degree of similarity between the goods.

## OVERALL CONCLUSION

51) The opposition has succeeded against all of the goods that it challenged. Therefore, subject to appeal, trade mark application no. 3293339 shall be refused registration for the following goods:

*Class 30: Teas and tea-based beverages; cocoa; chocolate; pastry, biscuits and confectionery; edible ices; herbal infusions.*

## COSTS

52) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. This takes into account that the opponent's evidence is brief and of no assistance. Further, the official fee has been limited to £100 since the opponent did not file evidence in support of its section 5(3) claim. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side's statement	£250
Filing written submissions	£150
Preparing for and attending a hearing	£400
<b>TOTAL</b>	<b>£900</b>

53) I therefore order Mariage Frères to pay Westbrae Natural, Inc. the sum of £900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**3 October 2019**

**MARK KING**  
**For the Registrar,**  
**The Comptroller-General**