

O-384-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3442460

BY AMANDA SIMMONS

TO REGISTER:

ButterKup

AS A TRADE MARK IN CLASS 21

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 419281 BY

RANSAT CERAMICS LIMITED

BACKGROUND & PLEADINGS

1. On 7 November 2019, Amanda Simmons (“the applicant”) applied to register **ButterKup** as a trade mark for “Utensil jars” in class 21.

2. On 9 January 2020, the application was opposed. Following a number of queries raised by the Tribunal, the Notice of opposition was amended to identify Ransat Ceramics Limited as “the opponent.” The amended opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the trade mark and goods shown below:

UK no. 2569264 for the trade mark **BUTTERCUP** which was filed on 17 January 2011 and registered on 29 April 2011:

Chinaware, porcelain, glassware, earthenware, bone china, melamine; crockery and pottery; household or kitchen utensils and containers; dinnerware; mugs and cups; tableware, ornaments; drinking vessels; plates and saucers; egg cups; napkin rings; cooking pots; containers for foodstuffs; jugs; pepper and salt mills; condiment sets; serving dishes for food; sugar bowls and gravy jugs; teapots and coffee pots; milk jugs; vases; candle sticks and holders; dinner services.

3. The applicant filed a counterstatement, subsequently amended. As this contains the only comments I have from her, they are shown below in full:

“The previous trade mark is similar in name but NOT identical. I relate below similar products in existence that share an identical name but that are in existence; Cath Kidson Buttercup Utensil Jar and Emma Bridgewater Buttercup scattered. Both these have identical names. My trade mark is on a design called ButterKup. Similar, but not identical to the opponent’s name and in no way resembling anything that they produce. I would like to see evidence of their trade mark in use. Also how is a name that is a name of a flower able to be trademarked?”

Representation

4. In these proceedings, both parties represent themselves. Only the opponent filed evidence during the evidence rounds. In an official letter dated 27 November 2020, the parties were advised that the evidence rounds had concluded and they were allowed until 11 December 2020 to request a hearing and, if no hearing was requested, until 18 December 2020 to file written submissions in lieu. Neither party elected to be heard or to file written submissions.

The procedural background

5. In a further official letter dated 27 January 2021, the Tribunal noted that the opponent's original Notice of opposition, filed on 9 January 2020, contained a witness statement and evidence which had not been dealt with by the Tribunal. In fact, it actually contained a document prepared by the Tribunal for use in proceedings headed "Statement of Use" ("SOU"), which had been completed by the opponent. The SOU was accompanied by a brochure and price list. The SOU, dated 8 January 2020, is signed by Anil Kumar and contains a statement of truth. To correct matters the Tribunal issued a preliminary view in which it invoked the provisions of rule 74 of the Trade Marks Rules 2008. This reads as follows:

"74.—(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions, as the registrar may direct."

6. The opponent was given until 10 February 2021 to file clearer copies of the evidence which accompanied its SOU. The official letter advised the applicant that upon receipt of the amended evidence, she was allowed 14 days to consider filing an amended defence and to indicate if she wished to file evidence or submissions. The parties were allowed until 10 February 2021 to request a hearing to challenge the above approach. No request for a hearing was made.

7. The opponent complied with the Tribunal's directions and in an official letter dated 8 March 2021, the applicant was reminded that she had until 22 March 2021 to consider filing an amended defence and to inform the Tribunal if she wished to file evidence or submissions. As the applicant elected not to respond to that invitation, in an official letter dated 12 April 2021, the parties were allowed until 26 April 2021 to request a hearing and until 10 May 2021 to file written submissions. Neither party requested a hearing or filed written submissions in lieu.

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

DECISION

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent’s trade mark was entered in the register and the application date of the trade mark being opposed, the earlier trade mark is subject to the proof of use provisions contained in section 6A of the Act.

11. In its Notice of opposition, the opponent states that it has used its trade mark in relation to all the goods for which it is registered and, as indicated above, in her counterstatement, the applicant asked the opponent to make good on that claim.

Proof of use

Section 6A:

12. This reads as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or

(ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

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

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

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

13. In reaching a conclusion, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five-year period is 8 November 2014 to 7 November 2019. I begin by reminding myself that section 100 of the Act reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the

mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18];
Centrotherm at [71]; Reber at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

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

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

15. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is

likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of

probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

The opponent’s evidence

17. This consists of the SOU filed with the Notice of opposition and the attached brochure and price list, together with a witness statement, dated 15 October 2020, filed during the evidence rounds. Both are from Anil Kumar, the opponent’s director, a position he has held since August 2006. In his witness statement, Mr Kumar states:

“2. My company has been using its trade mark since January 2011...Proof of usage has already been provided via a Branded catalogue with multiple products with our trade mark “Buttercup”, dated 08.01.20.

3. Evidence of the publicity my company and its trade mark have received is shown at exhibit at NEC Spring Fair every year (except 2020). Photos of our stand attached. Every year we spend between £21,000 to £25,000 on marketing at the fair and other avenues around the country/Europe...”.

18. Exhibits AK1-3 consists of photographs of the opponent’s stands. Although the photographs in exhibits AK1-2 cannot be dated, exhibit AK3 contains photographs taken at the NEC Spring Fair 2017, one of which looks like this:



19. Mr Kumar states:

“6...Please see the attached visual images of our Trade Mark 'Buttercup' on various products including Kitchen Jars, please note the 'Buttercup' is also used as a backstamp on all our products to maintain brand identity and

coverage across our ranges as this is the normal practice for product presentation in our industry sector...”

20. Exhibits AK4-6 consists of photographs of the opponent’s goods none of which appear to be dated. Exhibit AK4 looks like this:



21. In his SOU, Mr Kumar explains that the opponent’s trade mark has been used upon all the goods for which it is registered, adding that it has been used “throughout the UK” and that within the relevant period sales under the trade mark amounted to “approximately £500,000”. In support, with his SOU he provided a brochure and price list. As far as I can tell, none of the pages attached as evidence to the SOU are dated. The refiled pages contain a pricelist marked 2019 and what appears to be an undated catalogue; the prices in the refiled price list are identical to those in his SOU. Given that, for example, a 6 cup teapot costs £6.50, I infer the price lists relate to prices offered to the trade. Both the price list and catalogue have the following on their cover page:



Buttercup
FINE BONE CHINA - ENGLAND

22. Both the price list and catalogue contain references to a wide range of goods grouped under the following headings: “Accessories” (including items such as a “Butter Dish”, a “Covered Dish”, an “Eggcup”, “Salt & Pepper” pots, and small and large “Store Jar”), “Bowls”, “Cups & Saucers”, “Mugs”, “Plates”, “Serveware” (which includes items such as a “Teabag Tidy”, various “Creamers” and various “Jugs”), “Teapots” and “Tea Strainers & Infusers”. Under the heading “Find Our Products”, I note there are references to, for example, John Lewis, Selfridges, Fenwick, Harrods, Ocado, Liberty, Paperchase, Science Museum, Crabtree & Evelyn and Heathrow. Although there appears to be a number of differences in the catalogues provided (including, for example, items appearing on different pages) they are identical in most respects. I shall, as a consequence, proceed on the basis that the only date that can be identified is 2019.

23. The opponent uses its trade mark in a range of formats. For example, in the format shown in paragraph 18 (in which the word “Buttercup” is presented in title case in a slightly stylised but unremarkable font and in which the letter “r” forms the stem of what is clearly intended to be a buttercup flower). It also appears as the stylised word “Buttercup” as described earlier together with a stylised device of a head of a buttercup which appears above or to the left of the word (paragraphs 20 and 21 above respectively refer). Finally, use is also shown in the following formats: info@buttercupengland.com, www.buttercupengland.com and ButtercupEngland.

24. Having applied the relevant case law and reminded myself of the decision of the Court of Justice of the European Union (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, given its minimal stylisation, even when used with the stylised device of a head of a buttercup above or to its left hand-side, the use of the stylised word “Buttercup” is, in my view, use of the trade mark as registered.

25. Insofar as the extent of use is concerned, Mr Kumar's unchallenged evidence is that the opponent has been using its trade mark since 2011 with sales in the relevant period amounting to some £500k. In addition, the opponent has, he states, spent £21-£25k each year promoting its goods at trade shows "around the country/Europe." In support, he provides a photograph of, inter alia, the opponent's stand at the 2017 Spring Fair held at the NEC. It is my understanding that the letters NEC refers to the National Exhibition Centre in Birmingham, UK. The opponent uses the trade mark in relation to the categories of goods mentioned above, the vast majority of which appear, where appropriate, to be made from bone china.

26. The opponent's unchallenged evidence leaves a lot to be desired. For example, the sales figure provided has not been split by year nor has a split been provided in relation to the various goods to which these sales relate. In addition, many of the documents relied upon are not dated and it is not clear how much of the marketing spend relates solely to the UK. However, when viewed as a totality and when one considers: (i) the quantum of sales relied upon, (ii) the amounts spent on promoting the trade mark and the fact that evidence relating to marketing activities in the UK has been provided, and (iii) the range of outlets through which the opponent's goods are made available, it would, I think, be unrealistic for me not to conclude that within the relevant period the opponent has made genuine use of its earlier trade mark. Having reached that conclusion, I must now decide what constitutes a fair specification.

27. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand,

protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

29. It is clear from the evidence provided that the opponent has used its trade mark on a range of goods made from, where appropriate, bone china. In my view, the evidence shows use on, at least, the following goods:

Chinaware, bone china; crockery; household or kitchen utensils and containers; dinnerware; mugs and cups; tableware; drinking vessels; plates and saucers; egg cups; containers for foodstuffs; jugs; pepper and salt mills; condiment sets; serving dishes for food; sugar bowls and gravy jugs; teapots; milk jugs; dinner services.

30. Given the very limited nature of the goods for which the applicant seeks registration i.e. “utensil jars”, it is not necessary for me to consider the matter any further and it is upon the basis of the above goods I shall conduct the comparison which follows.

Case law

31. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia . 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

32. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
Class 21 - Chinaware, bone china; crockery; household or kitchen utensils and containers; dinnerware; mugs and cups; tableware; drinking vessels; plates and saucers; egg cups; containers for foodstuffs; jugs; pepper and salt mills; condiment sets; serving dishes for food; sugar bowls and gravy jugs; teapots; milk jugs; dinner services.	Class 21 – Utensil jars.

33. 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."

34. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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".

35. As the applicant's "utensil jars" would be encompassed by a number of terms in the opponent's specification including, for example, "chinaware", "bone china" and "household or kitchen utensils and containers", the competing goods are to be regarded as identical on the inclusion principle outlined in *Merici*.

The average consumer and the nature of the purchasing act

36. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. The average consumer of the goods at issue is either a member of the general public or a business user. As such goods are most likely to be obtained by self-selection from either the shelves of a bricks-and-mortar outlet or the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form of, for example, oral requests to sales assistant or word-of-mouth recommendations can be ignored. Finally, as the cost of the goods at issue can vary considerably, the degree of attention paid to their selection will also vary. I shall return to this point when I consider the likelihood of confusion.

Comparison of trade marks

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

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

Opponent's trade mark	Applicant's trade mark
BUTTERCUP	ButterKup

40. Both parties' trade marks consist of a single word consisting of nine letters. The opponent's trade mark is presented in block capital letters and the applicant's in title case with an upper case letter "K" in the seventh letter position. The only material difference between the competing trade marks is in respect of the seventh letter i.e. the letter "C" as opposed to the letter "K". Despite the presence of the upper case letter "K" in the applicant's trade mark, the overall impression both trade marks convey and their distinctiveness lie in the single words of which they are composed. In her counterstatement, the applicant admits that the competing trade marks are "similar." As the presence of the upper case letter "K" in the applicant's trade mark will not affect how it is pronounced or the concept it conveys, it is, I think, self-evident that the competing trade marks are visually similar to a high degree and aurally and conceptually identical.

Distinctive character of the earlier trade mark

41. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

Inherent distinctiveness

42. In her counterstatement, the applicant stated:

“...I relate below similar products in existence that share an identical name but that are in existence; Cath Kidson Buttercup Utensil Jar and Emma Bridgewater Buttercup scattered...My trade mark is on a design called ButterKup...Also how is a name that is a name of a flower able to be trademarked?”

43. In his witness statement, Mr Kumar replied to the above stating:

“4. In reference to Cath Kidson’s ‘Buttercup Utensil Jar’, this is a product name not a registered trade mark, in this instance the registered Trade Mark is ‘Cath Kidson’ itself where various designs are applied on numerous ‘Cath Kidson’ products which are then sold under the ‘Cath Kidson’ Brand i.e. Trade Mark.

5. In reference to Emma Bridgewater’s ‘Scattered Buttercup’ again this is a design name which is then applied on various products and not a registered Trade Mark. Again in this instance the registered Trade Mark is ‘Emma Bridgewater’ itself where various designs are applied on numerous product ranges which are then sold under the ‘Emma Bridgewater’ Brand i.e. Trade Mark.”

44. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

45. Although no evidence has been filed by either party in relation to the goods mentioned, in its response, the opponent submits that in the examples provided by the applicant the words “Cath Kidson” and “Emma Bridgewater” are the trade marks and the other words i.e. “Buttercup” and “Scattered Buttercup” are “various designs...applied on numerous product ranges.” By referring to “various designs”, the opponent is, in my view, tacitly accepting that, inter alia, the word “BUTTERCUP” could describe a design applied to numerous products (including many of those for which its trade mark is registered). If that is what the opponent intended, then I agree. As the word “BUTTERCUP” is, in my view, apt to describe goods that fall within the opponent’s specification which are decorated with images of buttercups, absent use, any inherent distinctive character the opponent’s trade mark may possess is likely to be, at best, very low.

Enhanced distinctiveness

46. That, of course, is not the end of the matter as the opponent has filed evidence of its use of its trade mark. I have summarised this evidence above. Taking into account the use the opponent has made of its trade mark since 2011 and, importantly, as the use provided shows use of the word “Buttercup” being used as a

trade mark (as opposed to being used to describe goods decorated with buttercups), I am satisfied that by the material date in these proceedings i.e. November 2019, such use is likely to have resulted in the opponent's "BUTTERCUP" trade mark acquiring a distinctive character, albeit of no more than a low degree.

Likelihood of confusion

47. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

49. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier

mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

50. Earlier in this decision, I concluded that the competing goods are to be regarded as identical and that the competing trade marks are visually similar to a high degree and aurally and conceptually identical. In reaching a conclusion, I shall approach the matter from the perspective most favourable to the applicant i.e. on the basis of an average consumer who pays a high degree of attention during the purchasing process and who is, as a consequence, less prone to the effects of imperfect recollection. However, even approached on that basis and notwithstanding the low degree of enhanced distinctive character the earlier trade mark possesses, the identity in the goods and the similarity/identity in the competing trade marks identified above is likely to result in the applicant’s trade mark being mistaken for the opponent’s trade mark i.e. there is a likelihood of direct confusion.

51. However, even if I am wrong and the evidence provided is not considered sufficient to have enhanced the distinctiveness of the opponent’s trade mark to the extent I have found, when one factors in the comments in the cases mentioned in paragraphs 44 and 49, it would result in the same conclusion.

Overall conclusion

52. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

53. As the opponent has been successful it is, in principle, entitled to an award of costs. As the opponent is unrepresented, in the official letter of 12 April 2021, the Tribunal stated:

“If you intend to make a request for an award of costs, complete and return the attached pro-forma by 10 May 2021. If it is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

54. As the opponent elected not to respond to that invitation, I order Amanda Simmons to pay to Ransat Ceramics Limited the sum of **£100** in respect of the official fee it incurred in launching its successful opposition. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th May 2021 day of May 2021

C J BOWEN

For the Registrar