

O/518/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3372766
IN THE NAME OF COMPAGNIE GERVAIS DANONE
IN RESPECT OF THE TRADE MARK**

YoPRO

IN CLASSES 29 & 30

AND

**OPPOSITION THERETO UNDER NO. 418008
BY YO FOODS LIMITED**

AND

**CONSOLIDATED PROCEEDINGS IN RESPECT OF UK TRADE MARK
REGISTRATION NO. 3042418
IN THE NAME OF YO FOODS LIMITED FOR THE TRADE MARK**

YoPro

IN CLASSES 5 & 29

AND

**THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 502688
IN THE NAME OF COMPAGNIE GERVAIS DANONE**

Background and pleadings

1. Compagnie Gervais Danone (“Danone”) applied to register the trade mark no. 3372766 for the mark ‘YoPRO’ in the UK on 5 February 2019. It was accepted and published in the Trade Marks Journal on 19 July 2019. The application currently stands in respect of the goods as below, following the removal of class 32 on 2 June 2020:

Class 29: Milk, milk products and their substitutes; milk powder; gelled, flavoured and whipped milk; milk-based desserts; yoghurts; yogurt drinks; cottage cheese; beverages composed mainly of milk or milk products; milky beverages mainly made of milk; milky beverages comprising fruit; fermented plain or flavoured milky products; milk substitutes of plant origin; substitutes for milk products made from plants or nuts; fruit or vegetable drinks composed mainly of milk products; fruit soups.

Class 30: Cocoa, chocolate, cocoa-based beverages, chocolate-based beverages, coffee-based beverages, tea-based beverages; custard; chocolate mousses, dessert mousses (confectionery), confectionery, sugar confectionery, sugar, puffed rice, preparations made from cereals; breakfast cereals, biscuits (sweet or savoury); cakes; pastry; waffles; cereal-based desserts (confectionery); rice cakes; semolina cakes; rice pudding, rice-based snacks (confectionery), cereal-based snacks (confectionery); edible ices, edible ices primarily consisting of yogurt, ice creams, sherbets (edible ices), frozen yoghurts (edible ices), edible ices based on frozen flavoured water; fruit coulis (sauces); vegetable beverages except substitutes for milk products, included in this class.

2. Yo Foods Limited (“Yo Foods”) oppose the trade mark on the basis of section 5(1) and section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK trade mark no. 3042418 for the mark ‘YoPro’, with the

registration date of 13 June 2014. The following goods are relied upon in this opposition:

Class 29: milk and milk products; yogurt, yogurt-based beverages and yogurt-based snacks; yogurt containing nutritional supplements.

3. Yo Foods submit that the marks are identical and that the respective goods are identical or similar. Yo Foods states particularly that the Danone's mark is to be used for identical goods, namely 'yogurt'.
4. Danone filed a counterstatement denying that the goods are similar and requesting proof of the same, other than in respect of yogurt. Danone submitted the opposition has been unjustifiably extended to include all of the its goods and that the opposition lacked clarity and was inconsistent with the Tribunal Practice Notice ("TPN") 1/2018. Further, Danone referenced the cancellation action filed against the registration comprising the sole basis of the opposition, and stated that should the cancellation action succeed, the opposition should be dismissed.
5. As referenced in Danone's counterstatement above, cancellation action in the form of a revocation application under no. 502688 was filed by Danone against registration no. 3042418 for the trade mark 'YoPro', in the name of Yo Foods. The revocation application was filed on 25 June 2019 under section 46(1)(a) of the Act. Danone argues that the registration has not been put to genuine use within the five years following the completion of its registration process on 13 June 2014. Danone submits the registration should be revoked in respect of all goods for which it is registered as of 14 June 2019. The mark is registered in respect of the following goods:

Class 5: Dietetic preparations and substances; food, dietary and nutritional supplements including whey and soya proteins; nutritional additives; protein foods, drinks and supplements; vitamins or mineral substances; food, dietary and nutritional products; food and drinks supplemented with protein for fitness, personal care or general use.

Class 29: Dairy products including those from milk or milk powder; whey products and whey powder; lactose products; egg or egg products including those from egg powder; milk and milk products; yogurt, yogurt-based beverages and yogurt-based snacks; yogurt containing nutritional supplements; cheese, soft cheese and cheese products; fruit; jellies, jams and compotes; prepared meals and snack food; soya-based substitute dairy products and products containing or prepared from soya protein.

6. Yo Foods filed a counterstatement in the revocation action stating that the mark had been used in the UK in respect of yogurt, but also ticked the box on its form TM8N filed indicating that the defence was in respect of all goods registered. The counterstatement states that Yo Foods entered into a manufacturing agreement which included a licence to use the mark, as well as a separate licence agreement with a distributor in 2015. Yo Foods goes on to explain there was a pause in production of its product in 2016 whilst its manufacturer modernised and expanded its “production capabilities”, consisting of large-scale development over a three-year period. It is stated that in 2019 it was agreed with the manufacturer that production of the product would recommence. Yo Foods submits that Danone was aware of its use within the relevant period as the product had been in the public domain since 2015, and Danone launched a confusingly similar product outside of the UK in 2017.

7. On the 23 September 2020, the Tribunal wrote to the parties informing them of the consolidation of the revocation action no. 502688 and the opposition no. 418008. A deadline was set for both parties to file evidence in relation to the opposition on 23 November 2020. Neither party filed evidence by this date in respect of the opposition only, but both parties filed evidence in these consolidated proceedings in relation to the application for revocation. This will be summarised to the extent that it is considered necessary.

8. Only Yo Foods filed written submissions which will not be summarised but will be referred to where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. By the close of the evidence rounds, both parties had legal representation in these proceedings. By the time it filed evidence in reply, Yo Foods was represented by Dolleymores. Danone is represented by Potter Clarkson LLP.
10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Preliminary issues

11. The first matter I wish to address before proceeding is the interplay between the opposition action filed by Yo Foods and revocation action filed by Danone within these consolidated proceedings. Danone has stated that if the revocation application succeeds, that the opposition should be dismissed. In its written submissions, Yo Food has provided me with submissions on the opposition based on what it believes to be a fair specification following the outcome of the revocation action. However, despite both party's apparent assumption that I should consider the opposition solely on the basis of the rights remaining following the revocation action, it is my view I must consider the opposition with the relevant date, that being the date the opposed application was filed, in mind. If, within the opposition proceedings, there is a valid earlier mark at the relevant date, the opposition must be considered on the basis of this earlier mark even where the earlier mark is revoked from a later date. This position that was set out by Professor Ruth Annand as the

Appointed Person in the appeal in consolidated proceedings between Mr Nasratul Ameen and Taxassist Direct Limited.¹

12. The revocation application requests that the earlier registration owned by Yo Foods (upon which the opposition has been based) be revoked as of 14 June 2019. The trade mark application by Danone (which is the subject of the opposition) was filed on 5 February 2019. This means that if the revocation application were to succeed in its entirety, the earlier registration will nonetheless have been extant on the register and will have been a valid earlier mark as defined under section 6 of the Act at the date the application for registration was filed.
13. I find the position that a party should be able to rely on rights that existed at the relevant time, even where those rights are revoked from a later date, to be further supported by the findings of the Court of Justice of the European Union (CJEU) in *Cooper International Spirits and Others* (C-622/18), in which it was found that rights in infringement actions may be asserted even after the date on which the rights have been revoked, and even if they have not been used within the grace period of five years for use.
14. Whilst I therefore find the timings and the circumstances of these consolidated proceedings to be unusual, I find that contrary to the submissions of Danone in its counterstatement and the assumption that seems to have been made by Yo Foods, the outcome of the revocation action will have no material impact on the consolidated opposition proceedings in this instance.
15. The second point I wish to address and the outset of these proceedings was raised in the counterstatement filed by Danone within the opposition and concerns the TM7 document filed by Yo Foods. Danone argues that the TM7 lacked the clarity required in TPN 1/2018. It states that as Yo Foods uses the terminology “is used for identical goods and services (yogurt)” that the opposition is only directed towards yogurt. Danone states the identity or

¹ BL O-491-12

similarity between the remaining goods and services is not addressed. Danone has stated that the lack of clarity within the opposition means it is prevented from providing an accurate defence, as Yo Food's claim cannot be precisely identified. I have set out TPN 1/2018 referred to below:

TPN 1/2018

Examination of pleadings based on earlier marks

1. The purpose of pleadings is to set out the party's legal case with sufficient clarity so that the other side can make an informed decision about whether to defend their trade mark, and in which respects. The pleadings filed in trade mark oppositions and invalidation proceedings do not always meet this standard.

2. The registrar has a duty to ensure that the system is fair to both parties and that, so far as is reasonably practical, those without legal representation and/or of limited means, are given equal access to justice.

3. From 1 January 2019, where the pleadings in trade mark opposition/invalidation proceedings under s.5(1) -s.5(3) of the Act are not sufficiently clear, the registrar's casework examiners may require further information, particularly if:

(i) The number of earlier marks exceeds 6, and/or

(ii) It is not obvious why the goods/services covered by an earlier mark are claimed to be identical or similar to the opposed goods/services.

16. I have considered the claims made by Danone, and whether there is an issue with the pleadings filed by Yo Foods. Firstly, I note that that the grounds relied upon by Yo Foods have been clearly set out as section 5(1) and section 5(2)(a). By ticking the box stating that it believes all goods are identical or

similar under the two grounds Yo Foods has indicated that the opposition has been filed against all of Danone's goods. Further, I note that Yo Foods has limited the goods it relies upon under both grounds to only some of those it has registered in class 29, listing the exact goods in the relevant box and helping to define its case. I note that Yo Foods has identified that it believes that the mark will be used in respect of identical goods (yogurt) within the box supplied for giving further detail, but this does not mean that the grounds and position identified in the remainder of the form no longer applies or is no longer clear, not least because it will be the goods as registered and not those in use or for which the parties plan to use the mark that will be the relevant consideration.

17. Whilst I agree it would have been possible for more detail to be provided in the TM7 document filed by Yo Foods, in this case, I note the opposition relies upon various food and drink items and is filed against food and drink items, some of which are evidently identical. Whilst I am not suggesting this will necessarily result in a finding of identity or similarity in respect of all of the goods, it is clear that when the pleadings were assessed by the case worker as referred to in the TPN 1/2018, they did not believe this required further detail for the case to have sufficient clarity. I agree with this position, and I find that the opposition could have proceeded on the basis of section 5(1) and 5(2)(a) even without the additional comment on the identical use on yogurt by Yo Foods.

18. I therefore find the TM7 document was sufficient for an adequate defence to be filed by Danone in this instance. Further, it appears Danone provided its defence in this respect, stating that it denies and requires Yo Foods to prove that there exists any similarity between the contested goods other than 'yogurt'. In summary, whilst I have considered TPN 1/2018 as referenced by Danone, I find in this instance that both the pleadings and the defence filed are sufficient for me to proceed with my decision in this instance.

Evidence

19. The initial evidence filed by Yo Foods comprises a witness statement in the name of Thomas Mathew, along with exhibits TM1-TM7. Within the witness statement, Mr Mathew is described as the director of Yo Foods Limited since 2014, as well as the director of Dunsters Farm Limited ('DF') since 2015.

20. In the witness statement, Mr Mathew explains that Yo Foods approached a third party, namely Littletown Dairy ('LD'), to manufacture its yogurt and start on product development in March 2014, and a manufacturing agreement between Yo Foods and LD was entered into on 19 May 2015, a copy of which is provided at Exhibit TM3. At Exhibit TM2, images are provided showing the mark on products in the form below:



21. Mr Mathew explains that in April/May 2015, Yo Foods took part in the Virgin Campaign 'Pitch to Rich' which put the mark in the public domain. He explains that Yo Foods were ultimately unsuccessful at securing funding in the campaign, and as a result it licenced the mark to DF on 16 June 2015, who then used LD to manufacture the products. In his witness statement, Mr Mathew explains DF "then sold the yogurt to its customers based in Lancashire, Greater Manchester, Yorkshire, Merseyside and North Wales. DF sell direct to the public and to a variety of food service customers including

coffee shops, restaurants, schools, hospitals, wholesalers and other catering establishments”.²

22. In his witness statement, Mr Mathew explains that DF placed orders with LD “usually” twice a week between July 2015 and March 2016,³ and turnover figures for this period are provided as below:

July 2015	£2,105.24	
August 2015	£1,638.88	
September 2015	£3,336.70	
October 2015	£2,448.06	
November 2015	£2,939.88	
December 2015	£1,873.43	
January 2016	£2,737.48	
February 2016	£2,424.88	
March 2016	£2,251.67	
Total July 2015 – March 2016		£21,756.23

23. Exhibit TM5 shows a purchase order between DF and LD describing products including those such as “Dunsters YoPro Strawberry Yogurt 150g”. TM6 provides DF’s sales records for every transaction that took place in the period outlined above, and TM7 provides a copy of a customer invoice from within this period listing the goods “Assorted Dunsters YoPro Yogurt 150gm”. The customer details are redacted other than a reference to ‘Bury’ in the address.

24. Danone filed evidence by way of a witness statement in the name of Sarah Talland. Ms Talland is described in the witness statement as a Chartered Trade Mark Attorney and Partner at Potter Clarkson LLP. The witness statement introduces 4 exhibits, namely ST1 to ST4, which focus on the details of the yogurt market. The exhibits provide third party articles and websites describing the most used yogurt brands in the UK, detailing yogurt sales in the UK, the value of the yogurt and sour milk market in the UK, and a brochure detailing the yogurt market is also provided. As an example, the exhibits state that in 2018 the ‘GB’ market for dairy yogurt sales was at 1.47 billion,⁴ and that the top yogurt brand reportedly had over 5.8 million users in

² See paragraph 3

³ See paragraph 3

⁴ See Exhibit ST2

Great Britain, with the 10th most popular brand holding over 1.6 million users and the 20th most popular having over 718 thousand users in 2018.⁵ The evidence shows the value of the “yogurt and sour milk products” market in the UK exceeded 3 billion USD in 2014, 2015 and 2016, and was close to 3 billion USD in 2017.⁶

25. By the time Yo Foods requested to file evidence in reply, it had acquired professional representation. Yo Foods requested to file the evidence in reply both to clarify its initial statements, as well as to reply to Danone’s evidence. The evidence in reply was filed in the form of a second witness statement in the name of Thomas Mathew, along with exhibits TM11 to TM17. There appears to be no Exhibit TM8, TM9 or TM10 filed in evidence.

26. In his second witness statement, Mr Mathew addresses the ‘size of the market’ evidence filed by Danone and explains that Yo Foods operates on a business to business basis. He expresses that it is difficult for small businesses to sell goods to supermarkets when they start out, and that they should not be required to reach the same level of sales as a multinational corporation in order for use to be found to be genuine.

27. In addition, Mr Mathew explains in more detail the steps that have been taken towards resuming the production of its goods, and its expectations for the same. Within the witness statement, Mr Mathew states:

“We are restarting full scale production and our distribution partner has doubled in size, so it is realistic that we expect double the sales volume to take place moving forward. We also have now developed a network of national wholesaler contacts, which we would leverage to quickly scale the brand within wholesale channels.”⁷

⁵ See Exhibit ST1

⁶ See Exhibit ST3

⁷ See paragraph 2

28. At Exhibit TM11, Mr Mathew provides the renewed license with DF dated 30 May 2019. The licence again provides DF with permission to use the 'YoPro' mark in the UK in connection with the manufacture, promotion, distribution and sale of yogurt for a five-year term.

29. Exhibit TM12 provides still images taken from the video previously submitted under Exhibit TM1 showing images of a person appearing to eat the product and displaying the mark as below:



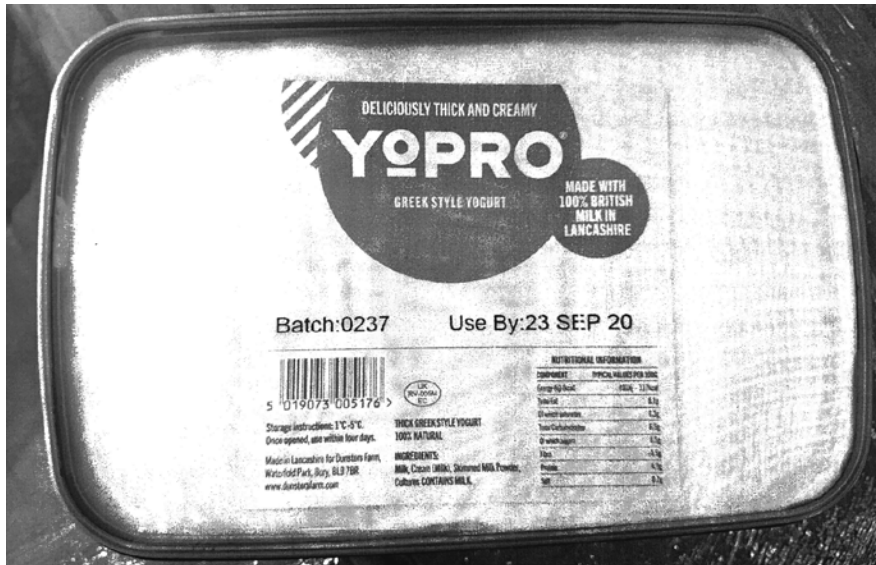
30. Exhibit TM13 is described by Mr Mathew as an image of the product taken from when it was manufactured in 2015, and the mark displayed is as shown above on a pot of what appears to be strawberry yogurt. A purchase order for the payment of £10,000 (exc. VAT) to a third party for the design and development of the brand is dated 16 April 2014 and shown at Exhibit TM14.

31. Exhibit TM16 shows calendar appointments accepted on 30 May 2019 and scheduled for 17 July 2019 named "Littletown visit". The email exchange between DF and LD arranging the appointment is also provided. Below the appointment, the following information is provided:

"Factory tour to see extension and new equipment.

Discuss own-label opportunities re YoPro in light of recent investment"

32. Exhibit TM17 shows a tub of yogurt as below:



33. In the witness statement, Mr Mathew confirms the above is an image of their branded bulk catering size product, which they have produced due to the lower commitment to packaging costs. Mr Mathew also explains that the first time they became aware of the challenge from Danone was on the 8 July 2019, when they were notified the TM26N had been filed. Mr Mathew explains that despite being “certain about the security of [their] trade mark, the challenge from Danone was intimidating and delayed [them] “pressing go” on ordering millions of units of packaging and setting a start date for the main SKUs”.⁸

34. Finally Mr Mathew has referenced the impact that Covid-19 has had on their market over the past 12 months, stating that further mass production was not sensible due to the shutdown of their customer base.

35. I have outlined the evidence to the extent I find necessary to do so. Whilst I have not outlined every element of the evidence provided in detail, this has been considered in full.

⁸ See paragraph 11

Decision

Section 46(1)(a)

Legislation

36. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

- (a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)
- (d)

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that

paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

37. Section 100 is also relevant, which 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.”

The principles of genuine use

38. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

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

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].”

39. The relevant period within which use of the mark has been challenged is the five year period falling directly after the registration of the mark, namely 14 June 2014 to 13 June 2019. Further, as per section 46(3), if use has commenced after the relevant period but prior to the filing or notification of the intention to file the cancellation action, this may also be considered.

Form of the mark

40. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered marks, it is necessary to review the instances where the proprietor has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use 'of the mark' for the purpose of the assessment. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

41. Where the mark YoPro is used as a trade mark on its own in word format within the opponent's evidence, it is clear this will be acceptable use of the marks as registered. This mark appears on invoices and purchase order documents in the description of the goods, although the documents themselves are headed with the Dunsters Farm logo. The mark is used on the products themselves and on promotional material in the stylised form as below:



42. As the earlier mark is registered as a word mark, it may be used in a variety of fonts and colours, and in upper or lower case. I note that the font used appears to be a fairly standard typeface, although I find the underlining of the 'O' may fall outside of what I consider to be notional and fair use of the word mark. However, the mark YoPro is clearly in use in the variant used, and the phrase THE PROTEIN YOGURT is clearly descriptive of the products. It is my

view that the addition of the descriptive phrase “THE PROTEIN YOGURT” and the addition of a line under the ‘O’ do not prevent the element YOPRO from being viewed independently to indicate the origin of the goods. I therefore find this mark to be an acceptable variant of the mark as registered in line with Colloseum.

Use of the mark

43. The first thing that is clear from the evidence provided and from the submission received on behalf of Yo Foods is that there is nothing to suggest there has been use of the mark in respect of any goods other than yogurt. It is submitted on behalf of Yo Foods that the use in respect of yogurt means it is entitled to keep its protection for broader categories of goods, but I will deal with that claim separately should it become necessary to do so. For the purpose of assessing the use made within the relevant period and any reasons for non-use, as well as any plans to resume use of the mark, it is clear I am considering that use in respect of yogurt only.
44. The evidence I have been provided with sets out fairly clearly the extent of the use made of the mark. I find that during the period of July 2015 – March 2016 there were orders and business to business sales of yogurt under the mark, or under an acceptable variant of the mark as registered. Whilst I note that the sales were made by DF during this period, the license agreement provided shows these were made with the consent of Yo Foods. It is therefore apparent that the manufacture and sale of the goods by DF under license from Yo Foods will be use of the mark with its consent. On this basis I accept there was use of the mark between the period of 2 July 2015 up until 29 March 2016, as evidenced by the combination of the sales breakdown at Exhibit TM6, the images of the packaging used as shown in, inter alia, Exhibit TM2, and as supported by the turnover figures and information provided in the witness statement of Mr Mathew.
45. After March 2016 it is explained that the reason for stopping production of the product was that the factory used to produce the products undertook a three

year renovation, which appeared to be completed only in July 2019, shortly after the end of the relevant period.⁹ There is a license agreement signed by Yo Foods and DF renewing the permission for DF to use the ‘YoPro mark’ dated by both parties on 30 May 2019, within the relevant period, but there is no evidence that the mark was used by DF after this was signed, either during or after the relevant period. In this case the license agreement was signed the day before DF arranged a factory visit to view the new facilities which would apparently enable the resumption of the production of the product. The appointment was arranged during the relevant time period on 31 May 2019, but the visit itself was scheduled for 17 July 2019, falling outside of the relevant period. It seems likely that there were no plans to resume the production of the goods until at least after this visit, and it appears there had been no further use by the time the evidence was filed.

Genuine use within the relevant period

46. Whilst Yo Foods has stated in its pleadings that there are reasons for a pause in its production of the goods within the relevant timeframe, it has not pleaded that there are proper reasons for non-use as such, in respect of the whole of the relevant timeframe. Whilst I will therefore take into account for the reasons given for the pause in production, I will do so in the context of my consideration as to whether genuine use has been shown within the relevant period. As the evidence establishes no use of the mark in relation to any of the goods outside of yogurt, it follows there will be no genuine use in respect of the same. However, the evidence establishes there was use of the mark for yogurt for a period within the relevant timeframe, and so I will consider if I find this use to be genuine. I note firstly that the use itself spanned only 9 months of the relevant timeframe, following which there was a period of over three years where there appears to have been no use of the mark. Within the 9 month timeframe the use itself was consistent. I note the turnover during this time is modest, but I also note that the value of the items is relatively low,

⁹ See Exhibit TM16 in which it is referenced by Littleton Dairy that a visit in July 2019 would be preferable as everything will be “in place”.

meaning more goods will need to be sold to achieve the sales figures than if these goods retailed at a higher value. This is supported by the evidence provided at Exhibit TM6 which displays a number of monthly transactions, which varied from month to month but is often in excess of 200 transactions per month. In his second witness statement, Mr Mathew confirms there were 3,200 instances of sales to commercial catering customers. I also consider the geographical extent of the use, and I note this was limited to a relatively confined area in the North of the UK, with the goods sold to customers within Lancashire, Greater Manchester, Yorkshire, Merseyside and North Wales. There is little evidence attesting to the promotion and advertising of the mark throughout the relevant timeframe, although I note the initial spend on its brand creation is provided to the sum of £10,000.

47. Danone has provided me with evidence of the size of the yogurt market in the UK in its various exhibits, and I repeat what the evidence shows here, that in 2018 the 'GB' market for dairy yogurt sales was at 1.47 billion,¹⁰ and that the top yogurt brand reportedly had over 5.8 million users in Great Britain, with the 10th most popular brand holding over 1.6 million users and the 20th most popular having over 718 thousand users in 2018. The evidence shows that the value of the "yogurt and sour milk products" market in the UK exceeded 3 billion USD in 2014, 2015 and 2016, and was close to 3 billion in 2017. It is clear from the evidence filed by Danone that the size of the UK yogurt market is very large, and relative to this market, the sales made with the consent of Yo Foods within the relevant timeframe are clearly only a very tiny portion of the market as a whole.

48. I find it appropriate to address the comments Mr Mathew made in his second witness statement at this stage. Mr Mathew stated in response to Danone's evidence on the size of the market and the top yogurt brands, that small businesses, and businesses just starting out, cannot be expected to reach the same level of sales as multinational companies, and this should not be required for genuine use. Further, he states the difficulties of selling directly to

¹⁰ See Exhibit ST2

supermarkets when starting up, and that the sales under the mark are business to business, and so it is part of a different market. I agree with Mr Mathew that the smaller businesses are not required to reach the same level of sales as that of a multinational business, and it is clearly established in the case law that there is no de minimis rule when it comes to considering genuine use. However, it is also established in the case law that the size and characteristics of the market concerned are relevant factors to consider, and that I must also consider whether the use made of a mark is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services in question. Whilst I therefore may have taken judicial notice that the UK yogurt market would be fairly large, the evidence provided by Danone on this is nonetheless relevant to my consideration of the use as a whole and provides additional context. However, as noted, the size of the market is only one factor I must consider, and I am not looking to establish that Yo Foods are a major player or top brand in this market in order to find genuine use.

49. Having established that a modest number of consistent sales of goods took place for a period of nine months in the North of England and Wales under the mark between July 2015 and March 2016, I consider also the reasons given use stopping completely between April 2016 – June 2019. It is stated that the reason for this is that the manufacturer was revamping its facilities. I note that without the ability to manufacture the goods, these products could not then be sold under the mark. However, I do not believe that the chosen manufacturer LD would be the only factory with the facilities and ability to produce the products under the mark for sale. I do not think that any business with a genuine interest in continuing the trade of their products during that time would have simply accepted that a three year break in the production and sale of the goods under the mark as the only viable option, or a viable option at all. Whilst they may have accepted the pause in production with the current manufacturer was necessary, and perhaps endured a break in production for a few months whilst an alternative was found, it makes no economic sense to seek no alternative for a period of three years during the relevant period (and I note this extends further outside the relevant period). Whilst it appears in the

manufacturing agreement provided at Exhibit TM2 that LD agreed to exclusively manufacture for Yo Foods, it does not appear that this exclusivity went both ways, with the subsequent licence agreement between Yo Foods and DF giving the latter permission to manufacture goods under the mark reinforcing this. I do not believe that Yo Foods were contractually tied into halting production for three years (something which I find would be very unlikely in most circumstances) and there has been no plausible explanation given as to why alternative arrangements were not put in place to continue to the manufacture and sale of goods under the mark in the meantime. I do not see this as a justifiable reason for the non-use of the mark during this time, rather, I simply find there is no use of the mark for this stretch of the relevant period.

50. I note there is evidence relating to the renewed activity in respect of the mark towards the end of the relevant period. I note the appointment scheduled with DF to visit the manufacturing facilities, and I acknowledge there is a note in the calendar appointments provided mentioning the discussion of YoPro and “own label opportunities” whatever these may be. I also note that the trade mark license agreement with DF was renewed on 30 May 2019 before the revocation action was filed (although after Danone’s own trade mark application for the same mark was filed). However, neither of these actions show that any use of the mark resumed or that real plans were in place for a timely resumption of this use. Whilst I accept that both the action filed against the mark and the subsequent global pandemic due to Covid-19 may have deterred further use of the mark in the second half of 2019 and in 2020, this does not account for the considerable lack of use of the mark during the relevant timeframe I have to consider, between 14 June 2014 to 13 June 2019, and from the evidence provided I cannot infer that there would have been use made of the mark during this time after the relevant period had these events not taken place.

51. Considering the evidence as a whole, I do not believe the use made of Yo Foods mark was token use, that being purely for the purpose of maintaining its rights in the mark. It seems to me that whilst the mark was being used, it

was commercial use. However, I also consider that not every proven case of commercial use may be automatically deemed as genuine use for the purpose of this assessment. The use shown is confined to a relatively small number of sales within a few months at the beginning of the relevant period, within only a relatively modest part of the relevant territory. This use was followed by an apparently unresisted and unexplained three year break in any further use of the mark, and with no promotional or marketing activity shown in respect of the same. Whilst I note Yo Food's appeal to be considered in a different league to multinational corporations, and for me to take account of the struggles that come with starting up a business and selling directly to supermarkets, I do not find this helps their case in this instance. It does not appear to me that Yo Foods have been making consistent attempts to create or maintain a market for goods under the mark within the relevant period but have been held back by the challenges that may face a smaller business. It appears instead that Yo Foods, via its distributor DF, dabbled briefly with the idea of selling yogurt under the mark, testing the market, only to give up on this very shortly after starting, and making very little if any attempt to resume the use during the relevant period. In the absence of further evidence, I therefore find the use made of the mark within the relevant period would be viewed as trivial and not "warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question."

Resumption of the use under section 46(3)

52. As I found the evidence insufficient to establish genuine use of the mark during the relevant timeframe, I will consider if I find that the use of the mark has been resumed after the end of the relevant period on 14th June 2019 but before the filing of the application for revocation under the provisions of section 46(3).

53. The revocation action against the Yo Food's registration was filed on 25 June 2019. In his second witness statement, Mr Mathew states that Yo Food received no "pre-warning" of the TM26 form that arrived with them on 9 July

2019. I may therefore consider the recommencement of the use of the mark up until the date on which the application for revocation was filed on 25 June 2019. I find this adds little to Yo Foods position in this instance, with no additional evidence to consider for this short time period. For the avoidance of doubt, I do not find that the re-signing of a distribution agreement and a scheduled factory visit (both in May 2019) make any difference to my findings on this basis. I do not therefore find that use has been resumed under section 46(3) of the Act.

The opposition

54. As I have mentioned in the preliminary issues section of this decision above, the outcome of the revocation action will have no material impact on the opposition, as the earlier mark was extant on the register on 5 February 2019, the date on which the opposition was filed.

Section 5A

55. Section 5A of the Act is as follows:

“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.”

Section 5(1)

56. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

57. The trade marks for consideration are as filed and registered, as below:

Earlier mark	Contested mark
YoPro	YoPRO

58. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

59. I note firstly there is no denial of the identity of the marks within Danone's TM8 and counterstatement. However, for the avoidance of any doubt, I will nonetheless consider the identity of the marks at this stage. Although the marks use a slightly different combination of upper case and lower case lettering, both are filed as word marks and as such may be used in either case within the fair and notional use of the marks, and so it is my view that this does not detract from the identity of the marks themselves. However, I note in this instance that the combination of cases used strays slightly from the normal rules applied to English text. I therefore note for completeness that even if it were to be found that the different combination of the upper and lower case lettering in each mark means there will be a difference between the protection held and the protection sought in the above marks, I find the differences caused by the change in case in the letters 'RO' are insignificant, and that they would go unnoticed by an average consumer. As such, the marks are identical as per the definition set out by the CJEU above.

60. As set out in the preliminary issues, I find that Yo Foods has filed its opposition on both grounds against all of the goods as filed. Where the goods covered by the earlier mark are clearly replicated in the later mark, there will

be identity between the goods. In addition, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 fur 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”.

61. The following goods included in the specification of the contested mark are evidently identical to those relied upon in the earlier mark:

Earlier mark (as relied upon)	Contested mark
Class 29: milk and milk products; yogurt, yogurt based beverages and yogurt based snacks; yogurt containing nutritional supplements	Class 29: Milk, milk products [...]; cottage cheese; milk powder; gelled, flavoured and whipped milk; milk-based desserts; yoghurts; yogurt drinks; milky beverages mainly made of milk; fermented plain or flavoured milky products

62. The opposition under section 5(1) will therefore succeed to the extent that I have found identity between the goods as above.

Section 5(2)(a)

63. The representative for Yo Foods has filed written submissions, addressing its claim under section 5(2)(b). I note again at this stage that the opposition is based on section 5(1) and 5(2)(a), and there is no additional claim under section 5(2)(b). Whilst I have therefore considered the submissions made to

the extent that they will apply to the 5(2)(a) ground, I will consider the opposition on the basis of the grounds as filed.

64. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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 principles

65. The following principles are gleaned from the decisions of the Court of Justice of the European Union (CJEU) 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.

The principles

(f) 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;

(f) 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

66. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

67. 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.

68. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

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

Case T-325/06, the GC stated that goods may be considered “complementary” where:

“...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”.

70. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. 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.”

71. It is my view that whilst goods which are similar to other goods are not necessarily identical, goods which are identical, are also similar. However, as the wording of this ground is as such that I am looking for the similarity between goods, I will remove from my assessment those which I have already found to be identical under the 5(1) ground.

72. With these factors in mind, the goods for comparison are below:

Earlier mark (as relied upon)	Contested mark
<p>Class 29: milk and milk products; yogurt, yogurt based beverages and yogurt based snacks; yogurt containing nutritional supplements</p>	<p>Class 29: Milk [and] milk products [...] substitutes; beverages composed mainly of milk or milk products; milky beverages comprising fruit; milk substitutes of plant origin; substitutes for milk products made from plants or nuts; fruit or vegetable drinks composed mainly of milk products; fruit soups.</p>
	<p>Class 30: Cocoa, chocolate, cocoa-based beverages, chocolate-based beverages, coffee-based beverages, tea-based beverages; custard; chocolate mousses, dessert mousses (confectionery), confectionery, sugar confectionery, sugar, puffed rice, preparations made from cereals; breakfast cereals, biscuits (sweet or savoury); cakes; pastry; waffles; cereal-based desserts (confectionery); rice cakes; semolina cakes; rice pudding, rice-based snacks (confectionery), cereal-based snacks (confectionery); edible ices, edible ices primarily consisting of yogurt, ice creams, sherbets (edible ices), frozen yoghurts (edible ices), edible ices based on frozen flavoured water; fruit coulis (sauces); vegetable beverages except substitutes for milk products, included in this class.</p>

Contested goods: *Class 29: Milk [and] milk products [...] substitutes; milk substitutes of plant origin; substitutes for milk products made from plants or nuts;*

73. The opposition relies upon the goods *milk and milk products*. The above goods are all milk substitutes. As the above goods are substitutes for milk, they will serve broadly the same intended purpose and method of use as the *milk* relied upon, for drinking and adding to food and beverages. Both products will comprise of a white liquid of a similar consistency and will likely be sold at least in the same section of supermarkets. The intended consumer, those being members of the general public generally will be shared, although I note milk substitutes may also be aimed more specifically at those with dairy intolerances and vegan tendencies, which will not be shared. There may be a level of competition between the goods with members of the general public due to the shared purpose, with the applied for goods directly substituting the earlier goods, but clearly this will not be the case for those consumers buying milk substitutes with the specific intention of avoiding milk. Overall, I find the goods similar to a high degree.

beverages composed mainly of milk or milk products; milky beverages comprising fruit; fruit or vegetable drinks composed mainly of milk products;

74. The earlier registration covers *milk products*. As all of the above goods are derived mainly from milk, there is an argument that these are incorporated within this term. However, I note that the above goods are not based solely on milk or milk products, and I find that something comprised mainly of a particular item may not itself be considered to be that item. However, I find the goods to be of a highly similar nature to milk and milk products, and that they will likely share trade channels. Milk products will be sold in the same aisle of supermarkets as the goods above, and as milk products will include milk beverages, there will be a level of competition where the consumer is looking

to purchase a beverage of this nature. In addition, the trade channels between milk beverages and the above goods will likely be shared. Overall, I find these goods to be similar to the earlier goods milk products to high degree. I also find this reasoning to apply in respect of the earlier goods *yogurt based beverages*, which despite the slightly thicker consistency, I also find on the basis of the shared similarities to also be similar to these goods to a high degree.

Contested goods: *Class 29: fruit soups.*

75. The earlier mark covers yogurt and yogurt based snacks, which will include sweet goods that may be eaten as a snack or dessert, as is also the case with the opponent's goods *fruit soups*. However, the nature of the goods will differ with one being mashed or liquified fruit and one being a dairy based. It is possible the goods may both in the same refrigerated area of shops but it is unlikely they will be next to each other. There may be some level of competition between the goods with them both being chosen as a dessert or snack food. Overall, I find the goods to be similar to a low degree.

Contested goods: *Class 30: edible ices, edible ices primarily consisting of yogurt, frozen yoghurts (edible ices),*

76. The above goods are all made from the yogurt, or in the case of 'edible ices', they cover goods including frozen yogurt. On this basis, the nature of the goods is shared to a degree, although the frozen nature of the above goods means the consistency and presentation of the goods above will differ from the opponent's yogurt. The intended purpose of the goods will be shared, namely for consumption as a snack or dessert. It is likely the trade channels will be shared, and that there will also be a level of competition between the goods, with the consumer choosing between them due to the shared intended purpose. However, the goods will be sold in different sections of supermarkets, with yogurts being located with the chilled dairy goods, and the goods above located in the frozen section. Overall, the above goods are similar to yogurt to at least a medium degree.

Contested goods: Class 30: custard; chocolate mousses, dessert mousses (confectionery), confectionery, rice pudding

77. The above goods all comprise of dessert items that will often be found within the chilled aisle of a supermarket, near if not directly alongside the goods such as yogurt as covered by the earlier mark. They will all either be, or in the case of 'confectionery', will include goods of a similar nature and consistency to *yogurt* and *yogurt-based snacks* covered by the earlier mark. All of the goods above may be presented in a similar way including in a tub and like yogurt they are often dairy based. There will be a level of competition between the goods due to the shared intended purpose for eating as a dessert after a meal. I also find it likely there will be shared trade channels, with entities offering both yogurts, mousses and other desserts as above. Overall, I find the above goods to be similar to the opponent's earlier yogurts to a high degree.

Contested goods: Class 30: ice creams

78. The above goods share a purpose with Yo Food's food items such as *yogurt* and *milk products* in class 29, namely that they may all be for consumption as snacks or desserts. However, the goods will be placed in different areas in supermarkets, with the earlier goods placed in the chilled aisle and the contested goods in the frozen aisle. There will be a shared nature to an extent in that the ice creams will be generally made from milk, however, the fact that the contested goods are frozen means there will also be differences in the same. The users will be shared, but this will be at no more than a very general level, those users being members of the general public. However, it is possible there will be a cross over in trade channels, and I note dairies may sell both milk products such as cream as well as ice creams. Overall, I find the goods to be similar to at least a medium degree.

Contested goods: Class 30: sherbets (edible ices), edible ices based on frozen flavoured water;

79. Again, the above goods share a purpose to a degree with Yo Food's food items such as *yogurt*, *yogurt based snacks* in class 29, namely that they are for consumption as snacks. However, the goods differ in nature and will again be placed in different areas in supermarkets. The users will be shared, but this will be at no more than a very general level, those users being members of the general public. It is possible there will be a cross over in trade channels. Again, there may be a level of competition between these goods with the consumer choosing between them for consumption as a snack or dessert, but overall, I find the goods to be similar to only a low degree.

Contested goods: Class 30: cocoa-based beverages, chocolate-based beverages, coffee-based beverages, tea-based beverages; vegetable beverages except substitutes for milk products, included in this class

80. The above goods are all beverages. The earlier registration covers *yogurt-based beverages*, which will also serve at least one of the same purposes as the goods above, for consuming to quench thirst or for the flavour. There may also be a level of competition between them, with consumers choosing between a yogurt drink, or another type of chilled beverage as covered by the categories above to enjoy with their lunch, such as an iced tea or coffee, or a chilled chocolate or vegetable drink. These may all be located near each other on the chilled aisle of the supermarket. However, over all the nature of the goods will be different, and they are unlikely to be provided by the same entities as the yogurt based goods. Overall, I find these goods similar to at least a low degree.

Contested goods: Class 30: chocolate, sugar confectionery, biscuits (sweet or savoury); cakes; waffles; cereal-based desserts (confectionery); rice-based snacks (confectionery), cereal-based snacks (confectionery); rice cakes; semolina cakes; puffed rice, preparations made from cereals; fruit coulis (sauces);

81. The above goods are all sweet snacks, desserts or dessert sauces, or they include the same within the terms used. The earlier mark covers the goods *yogurt* and *yogurt-based snacks*. The intended purpose of these goods may be similar to those above to a degree, for consuming as a snack, a dessert, or as an accompaniment to the same. The goods may share trade channels, but they are unlikely to be placed next to each other on the shelves in supermarkets. They will be aimed at the same consumer, but this will be at the general level of the general public, and generally the nature of the above goods will differ to those covered by the earlier mark. There may be a level of competition between the goods where the consumer is looking to purchase a snack or dessert or dessert accompaniment and chooses between them. Overall, I find the goods to be similar to the earlier goods covered to at least a low degree.

Contested goods: *Class 30: breakfast cereals;*

82. Whilst the nature of the goods will differ to the earlier goods *yogurt* and they will be placed in different areas of supermarkets, I note both are popular breakfast items, and as such there may be a level of competition between them, as well as a shared intended purpose of consuming at breakfast time. The intended consumer will be shared but only on the basis that the goods will be aimed at the general public. Overall, I find the goods to be similar to a low degree.

Contested goods: *Cocoa; sugar; pastry*

83. Whilst the goods above may be used in combination with other ingredients covered by the earlier mark, I do not find this renders them similar. I note pastry may also be kept in the chilled aisle of a supermarket as is also the case with some of the earlier goods, but it is unlikely they will be placed directly next to the products covered by the earlier mark. I find the goods to differ in nature and intended purpose, and I do not find they will be in competition or complementary. Overall, I find the above goods to be dissimilar to those covered by the earlier mark.

Comparison of marks

84. I have considered the identity of the marks under my analysis of section 5(1), and I found them to be identical for the reasons set out previously.

Average consumer and the purchasing act

85. 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.

86. 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.”

87. Before deciding on the likelihood of confusion, I must first identify the relevant consumer of the goods.

88. The goods applied for include general items of food and drink. These may be aimed at the general public, but also at professionals responsible for stocking retail stores and hospitality establishments. The items will be relatively low

cost and will be purchased frequently by the general public, who will pay a relatively low level of attention in respect of the same. Whilst the professional consumer will likely pay a higher level of attention due to the increased responsibility of the role, as well as the likelihood that large volumes of the items may be purchased at one time, I do not find this will be high, but rather it will sit at an above average level.

89. Where the goods are purchased by the general public, I find these will primarily be bought on visual inspection being on display in retail stores or in hospitality venues. I also find professionals will primarily purchase the goods on visual inspection. However, I note there will be instances in which these items are recommended via word of mouth or ordered verbally, and so I cannot discount the aural comparison of the marks.

Distinctive character of the earlier trade mark

90. 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).”

91. The earlier mark comprises the single word YoPro. It appears to be a made-up single word, however, it consists of two elements ‘Yo’ and ‘Pro’. Whilst I therefore recognise that the two letters Yo are the first two letters of yogurt, and that ‘Pro’ often has a laudatory nature, I remind myself that I must not artificially dissect the mark and attribute a level of distinctiveness to its dissected elements only. In the context of the goods, I find the inherent distinctive character of the mark as a whole to be at a medium level.

92. I note that Yo Foods has filed evidence of use of the earlier mark within the consolidated revocation proceedings. However, the use shown was very limited and I do not find it will have enhanced the distinctive character of the earlier mark in this instance.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

93. Prior to reaching a decision under Section 5(2)(a), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 69 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I keep in mind that the level of attention paid by the average consumer and the level of distinctive character held in the earlier mark will have an impact on the likelihood of confusion, and that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa.

94. I consider at this point that there are two types of confusion that I may find.

The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.¹¹

95. In respect of section 5(2)(a), I have found the goods will range from dissimilar to highly similar. I found the degree of attention paid by the average consumer will vary from low to above average depending on the consumer. I found the inherent distinctiveness of the earlier mark to be medium, and that this was not increased through use. I found the goods will be purchased primarily visually, but that I cannot discount aural considerations, although I note in both instances these are identical.

96. Where I have found the goods to be dissimilar, there can be no likelihood of confusion, and so the opposition fails in respect of the following goods:

Class 30: Cocoa; Sugar; pastry.

97. In respect of the remaining goods, I consider all of the factors outlined above. Particularly, I keep in mind the identity of the marks, the relatively low degree of attention paid to the goods as filed by the general public and bearing in mind the interdependency principle, it is my view that even where there is a low degree of similarity shared between the goods, there will be a likelihood of direct confusion between the earlier mark and contested mark. The opposition therefore succeeds for all of the remaining goods under section 5(2)(a).

¹¹ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

Final Remarks

98. The application no. 3372766 in the name of Danone will be refused for all goods other than those below:

Class 30: Cocoa; Sugar; pastry.

99. The registration no. 3042418 in the name of Yo Foods will be revoked for all goods registered as of 14 June 2019.

COSTS

100. Both parties have achieved success in these proceedings in relatively equal measures. In the circumstances I order that both parties bear their own costs in these proceedings.

Dated this 8th day of July 2021

**Rosie Le Breton
For the Registrar**