

O/1055/22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3505288
IN THE NAME OF TOP STAR MARKETING UK LTD
IN RESPECT OF THE TRADE MARK**



IN CLASSES 29 & 30

AND

**THE APPLICATION FOR INVALIDATION THEREOF UNDER NO. 504290
BY DAWN FOODS, INC.**

Background and pleadings

1. Top Star Marketing UK Ltd



Class 29: Fish products being frozen; Fish products prepared for human consumption; Frozen appetizers consisting primarily of chicken; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Crystallized ginger; Crystallized gingers; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat; Fried potatoes; Frozen appetizers consisting primarily of chicken; Frozen french fries; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen spinach; Frozen sweet corn; Frozen vegetables; Garlic paste; Garlic [preserved]; Ginger, preserved; Meat and meat products; Meat burgers; Meat products being in the form of burgers; Meatballs; Onion rings; Pre-cooked curry stew; Pre-cooked soup; Prepared dishes consisting principally of meat; Prepared meals consisting primarily of chicken; Prepared meals consisting primarily of kebab; Prepared meals consisting primarily of poultry; Prepared meals consisting primarily of vegetables; Prepared meals consisting principally of vegetables; Prepared meals containing [principally] chicken; Prepared meat dishes; Prepared vegetable dishes; Prepared vegetable products; Preserved garlic; Quick-frozen vegetable dishes; Ready cooked meals consisting primarily of chicken; Ready cooked meals consisting primarily of meat; Ready cooked

meals consisting primarily of poultry; Prepared meals consisting primarily of kebab.

Class 30: Batter for making pancakes; Biscuit rusk; Biscuits; Biscuits containing chocolate flavoured ingredients; Biscuits containing fruit; Biscuits for human consumption made from cereals; Biscuits having a chocolate coating; Biscuits having a chocolate flavoured coating; Biscuits [sweet or savoury]; Biscuits with an iced topping; Bread; Bread and buns; Bread biscuits; Bread buns; Bread crumbs; Bread doughs; Breadcrumbs; Breads; Breakfast cake; Breakfast cereals; Breakfast cereals containing a mixture of fruit and fibre; Breakfast cereals containing fibre; Brioches; Bun mix; Buns; Burgers contained in bread rolls; Butter biscuits; Cake bars; Cake batter; Cake dough; Cake doughs; Cake flour; Cake frosting; Cake frosting [icing]; Cake icing; Cake mixes; Cake mixtures; Cakes; Cheeseburgers [sandwiches]; Cheesecake; Cheesecakes; Chicken sandwiches; Chicken wraps; Chocolate biscuits; Chocolate brownies; Chocolate cake; Chocolate cakes; Chocolate coated biscuits; Chocolate confectionary; Chocolate confectionery; Chocolate confectionery products; Chocolate covered biscuits; Chocolate covered cakes; Chocolate covered wafer biscuits; Chocolate flavoured confectionery; Confectionery; Confectionery items (Non-medicated -); Confectionery (Non-medicated -); Confectionery products (Non-medicated -); Cookie dough; Cookie mixes; Cookies; Corn flour; Cornflakes; Cornflour; Cream puffs; Crisp breads; Cupcakes; Custard mixes; Custard powder; Custards; Custards [baked desserts]; Dairy confectionery; Dairy ice cream; Danish bread; Dough; Doughnuts; Dutch rusk; Flat bread; Foodstuffs made from dough; Fresh bread; Frozen confectionery; Frozen custards; Frozen pastry; Frozen pastry sheets; Frozen pastry stuffed with meat; Fruit bread; Fruit breads; Fruit cake snacks; Fruit cakes; Meal; Mixes for the preparation of bread; Multigrain bread; Multigrain-based snack foods; Naan bread; Nan bread; Pancakes; Pastries; Pastries, cakes, tarts and biscuits (cookies); Pastry; Pastry dough; Pita bread; Pita chips; Pitta bread; Pizza; Pizza bases; Pizza crust; Pizza crusts; Pizza dough; Pizza flour; Pizzas; Popped popcorn; Poppy seed pastry; Porridge; Pre-baked bread; Preparations for making bakery products; Preparations for making pizza bases; Preparations for making waffles; Puff pastry; Quesadillas;

Ready-to-bake dough products; Rolls [bread]; Rolls (Bread -); Rusks; Samosas; Sandwich wraps [bread]; Sandwiches; Sandwiches containing chicken; Savory biscuits; Savory pastries; Seasoned breading mix for deep frying; Shortbread; Shortbread biscuits; Shortbreads; Shortcake; Shortcrust pastry; Snack food products made from rice flour; Snack food products made from rusk flour; Snack foods consisting principally of confectionery; Snack foods made from corn and in the form of puffs; Snack foods made of whole wheat; Sponge cake; Sponge cakes; Spring rolls; Sweet biscuits for human consumption; Wholemeal bread; Wholemeal bread mixes; Wrap sandwiches; Wraps [sandwich].

2. Dawn Foods, Inc. (“the cancellation applicant”) applied to invalidate the trade mark on 29 October 2021 pursuant to section 47 of the Act. The invalidation is based on section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK and UK comparable¹ trade marks as set out in the table below:

Registration number & territory	Trade Mark	Filing date	Registration date	Goods and services
1353554 (UK)	DAWN	03 August 1988	24 June 1994	Class 30: Mixes, bases and concentrates for baked products; all included in Class 30.
2387377 (UK)		18 March 2005	18 August 2006	Class 30: Mixes, bases and concentrates for baked products.
903255684 (UK comparable)		04 July 2003	29 March 2005	Class 29: Fillings, icings, toppings and edible decorations for bakery products. Class 30: Preparations for making bakery products; mixes for bakery products; flour; preparations made from cereals and used as an ingredient in making baking products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings,

¹ Invalidation actions filed after the end of the transition period on or after 31 December 2020 are not able to rely on earlier EU trade marks within the proceedings but may instead rely on UK comparable marks derived from such rights. UK comparable marks hold protection from the same date as the original EU trade mark.

				<p>toppings and edible decorations for bakery products.</p> <p>Class 43: Preparation and provision of advice, reports and information; technical support services; consultancy service; provision of recipe information; all the aforesaid services relating to baking and/or bakery products.</p>
918052747 (UK comparable)	DAWN BALANCE	16 April 2019	12 September 2019	<p>Class 29: Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.</p> <p>Class 30: Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and</p>

				<p>starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.</p>
918052750 (UK comparable)	DAWN EXCEPTIONAL	16 April 2019	12 September 2019	<p>Class 29: Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.</p> <p>Class 30: Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and</p>

				starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.
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3. By virtue of their earlier filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act.

4. The cancellation applicant argues under section 5(2)(b) that the marks are similar and the goods and services are similar or identical, and that as such there is a likelihood of confusion between the marks.

5. In respect of its section 5(3) ground, the cancellation applicant argues it holds a significant reputation in its earlier marks, and that use of the contested mark would result in consumers believing that there is an economic connection between the same. The cancellation applicant also pleads that use of the mark would allow the proprietor to unfairly benefit from its reputation. Further, the cancellation applicant pleads that use of the mark by the proprietor could cause detriment to the cancellation applicant's reputation in instances where the consumer believes the goods originate from the cancellation applicant and is dissatisfied with the same. Finally, the cancellation applicant pleads that the use of the proprietor's mark would reduce the distinctiveness of its own mark and its ability to distinguish its goods from those of other undertakings.

6. The proprietor filed a counterstatement denying that the marks and the goods are sufficiently similar to give rise to a likelihood of confusion under section 5(2)(b) and putting the cancellation applicant to proof of use of its earlier registration nos. 1353554, 2387377 and 903255684. In respect of section 5(3), the proprietor put the cancellation applicant to proof of its reputation and denied that the contested mark would take unfair advantage of the cancellation applicant's marks. It also denied that the use of the mark will create the impression that the marks derive from the same economic undertaking, or that it will ride off the coattails, tarnish, or cause detriment to the reputation of the cancellation applicant's mark, or that it will reduce the distinctiveness of the same.

7. Only the cancellation applicant filed evidence in these proceedings. This will be referred to the extent that it is considered necessary.

8. Only the cancellation applicant filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

9. Both sides have had representation in these proceedings. The proprietor was represented by Edwin Coe LLP up until the end of the evidence rounds, following which it represented itself. The cancellation applicant is represented by Forresters IP 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Proof of use

11. The relevant statutory provisions are as follows:

Relevant statutory provision: Section 47:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

12. As one of the earlier marks subject to proof of use is a comparable mark, paragraph 9 of part 1 of schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

13. Section 100 of the Act states that:

“100. 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. The burden is therefore on the cancellation applicant to show it has made use of its three earlier registration nos. 1353554, 2387377 and 903255684 in respect of the relevant goods upon which they rely, in the relevant territory and within the relevant time periods. The relevant periods in this instance are as follows:

Relevant period 1	Relevant period 2
28 June 2015 - 27 June 2020	30 October 2016 - 29 October 2021


Variant use



16. There is also some use of the word mark DAWN in the evidence, shown in a range of standard fonts and colours. Earlier registration no. 1353554 is registered as the word mark DAWN, and it may therefore be used in a range of standard fonts and in upper- or lower-case lettering. Where the word mark DAWN is used in the evidence, this is clearly acceptable use of the registration no. 1353554.



17. I also note the use of the marks

I consider if these marks, in addition to mark  also constitute acceptable variants of the word only mark DAWN, with the registration no. 1353554. I consider *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, in which the Court of Justice of the European Union (“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 *Nestlé*, 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 by 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)". (emphasis added)

18. With consideration to the above, it is my view that the word mark Dawn continues to act as an indicator of origin within all four composite marks. These marks therefore constitute acceptable variants of the earlier registration no. 1353554.



Use of the mark

20. Now I have established that the marks shown in the evidence are acceptable variants of the marks as registered, I consider the use of those marks that has been shown.

21. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bunderversvereinigung 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].”

22. The cancellation applicant filed its evidence in the form of a witness statement in the name of Scott Thayer, Chief Legal Officer and Secretary for the cancellation applicant, a position he has held since 2013. The statement introduces 9 exhibits, namely Exhibit ST1 to Exhibit ST9.

23. In his statement, Mr Thayer explains his company was established in the early 1900s in the US, under the name ‘Century Bakery’. He explains it began by selling a dry donut mix that became so popular it was sold to other bakeries and it became the first industrial mix bakery company in the US.² He explains the company name was

² See paragraph 4

changed to Dawn Donut Company in 1925.³ He goes on to explain that the company expanded and was worth over 1 million USD by 1957.

24. Mr Thayer explains that the Dawn Donut Company was renamed Dawn Food Products Incorporated in 1978, and that the logo  was adopted at that time.⁴

He goes on to confirm that the current logo  was adopted in 2000.⁵ In respect of the UK presence, Mr Thayer explains the UK company Dawn Foods Limited was incorporated in 1989 and that it has been operating continuously in the UK under the name 'Dawn' since that time.

25. Mr Thayer explains that in the UK, the cancellation applicant supplies bakery products and baking ingredients to a wide range of customers in the bakery sector, in addition to semi-finished bakery products and frozen ready to sell bakery products. He explains that the semi-finished products come in the form of frozen mix/dough/batter which needs to be thawed, formed and cooked in order to produce an end product. He explains they sell 'scoop and bake' mixes, doughs and batters for cookies, muffins, brownies and cakes, in addition to preformed frozen cookies, and ready to sell frozen bakery products including pre-cooked frozen muffins, cookies, brownies and cakes, including cheese cakes that need to be thawed and served.

26. In respect of the ingredients offered by his company, Mr Thayer explains Dawn Foods Limited in the UK sells mixes, bases and concentrates for cakes, muffins, doughnuts, cookies, brownies, scones, macaroons, florentines, waffles, pancakes, shortcrust products, sponges, pound cake, choux puff pastry products, ice cream pastes and powders, fonds (cream stabilising powders), compounds (flavouring pastes), dessert mixes (including for panacotta, crème brulee, tarte citron, mousses and cream desserts), decorations, toppings, frostings, icings, fondants, glazes, fillings (including fruit fillings), flavourings, baking powder, cream powder, egg white powder, fruit pieces and Belgian couverture.

³ See paragraph 5

⁴ See paragraph 7(c)

⁵ As above

27. Exhibit ST1 provides pages from the cancellation applicant's website, including from what Mr Thayer explains is the dedicated UK version of the website at www.dawnfoods.com/UK.⁶ The pages show the mark **Dawn** and make reference to many of the goods described by Mr Thayer above, however I note the pages themselves appear to be undated other than reference to a copyright date of 2020.

Dawn



29. UK sales figures for goods sold under the 'Dawn' and 'Dawn logo' mark are provided dating back to 1993.⁷ These are as follows:

Year	UK sales figures GBP
1993	8,359,147
1994	8,384,098
1995	13,487,878
1996	15,675,182
1997	17,807,276
1998	20,117,152
1999	23,223,056

⁶ See paragraph 10

⁷ See paragraph 19

2000	17,333,817
2001	14,810,876
2002	17,237,239
2003	19,656,494
2004	22,269,900
2005	22,564,169
2006	21,482,592
2007	22,945,375
2008	27,889,385
2009	29,696,704
2010	31,585,170
2011	34,144,219
2012	35,696,178
2013	46,923,803
2014	51,933,968
2015	54,699,968
2016	56,207,872
2017	61,313,974
2018	64,429,500
2019	65,106,421
2020	48,450,504
2021	57,736,816

30. Invoices showing sales of the goods are provided at Exhibit ST4. The invoices are dated between 2016 and 2021. The majority of these invoices display acceptable variants of the DAWN word and logo marks and are mostly addressed to companies in various locations across the UK and Ireland. In addition, the description of the goods on the invoices often begins with the word DAWN. The invoices list a variety of goods sold, including many of those shown in Exhibit ST2. A helpful guide to the codes used on the invoices is provided by Mr Thayer at paragraph 20 of his witness statement as follows:

CRM PWD = cream powder
CRM FILL = cream filling
CK MIX = cake mix
CRRT CK BS = carrot cake base
CK MX SPNG = cake mix sponge
CK BS = cake base
BKG PWD = baking powder
MUF/MUFF = muffin
CKIE BS = cookie base
PSTRY MX = pastry mix
DNT = donut
CONC = concentrate

31. Whilst I do not intend to list all of the goods referenced on the invoices here, these have been considered in full, and by way of example I note they include products such as compounds, frostings, icing, muffin mixes, cookie bases, cake bases, meringues, fruit concentrates and tartlets to name a few.

32. Within his witness statement, Mr Thayer highlights that his company sells bread mix, and identifies particularly the invoice dated 11 December 2018 to a Devon based company. This invoice lists the sales of the following goods:

—
000010 8.01286.400 SAN FELIPE P5009 4 x 5 kg - Dawn
000020 0.01324.219 CR PIZZA BS MX CR 3.5KG 4CT
000030 0.02394.310 CR MUFF MIX PLAIN IMP 3.5KG 4CT
000040 0.01336.868 CR BREAD & ROLL MX WHT 3.5KG 4CT
000050 0.02394.310 CR MUFF MIX PLAIN IMP 3.5KG 4CT

33. Within his witness statement, Mr Thayer also comments on the invoices as follows:

21. The invoices identify a vast range of products as sold by my company and even if they do not cover each and every item referred to above, I can confirm that there have been sales of all such items in the UK in the five years preceding the filing date of the mark under cancellation, i.e. the five years up to 27 June 2020, as well as during the five years preceding the filing of the cancellation action.
22. The invoices do not separate out the services offered by my company to its customers as mentioned above, but I can confirm that such services have been provided to UK customers during the last five years.

34. At paragraph 27 of his statement, Mr Thayer sets out the following UK advertising spend under the “DAWN marks”:

Year	UK Advertising and Promotional Spend GBP
2000	126,104
2001	60,178
2002	120,501
2003	75,722
2004	129,159
2005	53,987
2006	94,615
2007	84,138
2008	58,294
2009	38,227
2010	71,165
2011	89,974
2012	37,397
2013	186,817
2014	291,205
2015	195,336
2016	248,408
2017	215,370
2018	253,871
2019	229,055
2020	225,602
2021	229,029



⁸ See paragraph 24

by way of the reference to the UK within the web address provided on the advertisements. These advertise goods such as cake, muffin, brownie, donut and cookie mixes, in addition to donut bases and concentrates, frozen batter, ready to use frosting and ready to serve donuts and ready to bake cookies, toppings, fillings and chocolate decorations. The advertisements shown also encourage consumers to sign up to the website for monthly insights, recipes and giveaways. Reference to signing up or visiting the website for recipes is made in advertisements dated from April 2020, July 2019, February 2019, March 2018, January 2018 and December 2015.

36. Exhibit ST7 shows the covers of magazines offering advice on baking and business, which Mr Thayer explains are published quarterly by the cancellation applicant.⁹ The level and territory of distribution of the magazines is not clear.

37. Mr Thayer explains that the cancellation applicant also sponsors various baking industry events in the UK, as well as attending relevant trade shows.¹⁰ Details of trade events and sponsorship is provided at Exhibit ST6. This exhibit explains that the cancellation applicant has sponsored the Baking Industry Awards for the last 12 years, as well as various other events across the UK dating back to 2011. An image of a large screen displaying the Dawn logo mark at the Baking Industry Awards is shown.

38. Pages from the cancellation applicant's social media accounts are provided at Exhibit ST8 and pages from UK specific accounts¹¹ are provided at Exhibit ST9. These include undated pages from a Facebook account, an Instagram account, a YouTube page and a LinkedIn page.

39. It is clear from the evidence provided that the cancellation applicant has been using its marks and acceptable variants of the same consistently within the UK throughout both relevant time periods. I also note the evidence shows some use of its comparable mark in Ireland via invoices, but generally the evidence showing use of this mark within the EU but outside of the UK is limited. In respect of the goods and services for which the earlier marks are registered, it is my view that use has been

⁹ See paragraph 28 of the witness statement of Mr Thayer

¹⁰ See paragraph 25 of the witness statement of Mr Thayer

¹¹ As confirmed at paragraph 32 of the witness statement of Mr Thayer

shown under the earlier marks in respect of the goods falling within the following categories relied upon:

Class 29: Fillings, icings, toppings and edible decorations for bakery products.

Class 30: Preparations for making bakery products; mixes for bakery products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products; Mixes, bases and concentrates for baked products.

Class 43: provision of recipe information; all the aforesaid services relating to baking and/or bakery products.

40. I note Mr Thayer's statement in his witness statement explaining that whilst the invoices do not separate out the services offered from the goods sold, that all of the services have been offered to the UK consumer within the last five years. Whilst I do not disbelieve the statement made by Mr Thayer, it is my view that this statement alone is not sufficient to support a finding that use of the mark has been made in relation to the rest of the class 43 services listed. It is also not clear from the evidence that flour per se, or preparations made from cereals and used as an ingredient in making baking products have been offered under the mark.

41. In respect of the goods and services for which I found use has been shown, I consider the consistency of this use over the relevant periods, in addition to the significant and consistent sales figures and advertising spend in respect of the same. Whilst I note the EU use evidenced is limited, I consider the UK to be a significant portion of the EU for the purpose of showing that genuine use of the mark has been made within the relevant territory of the earlier comparable mark. Whilst the reference to the provision of recipe information appears to be offered as an ancillary service to its main goods offering for which there appears to be no charge, I note reference to the provision of the same dating back to 2015 and up until 2020, and I consider that services offered free of charge may still be offered with the purpose of creating and

maintaining an outlet for those services.¹² It is my view that in respect of the goods and services for which I have found the mark (or an acceptable variant) has been used, this use constitutes use for the purpose of creating and maintaining a share of the market in the UK. I therefore find genuine use to have been made in respect of the same.

Fair Specification

42. As I have found genuine use of the marks to have been made under the categories of the goods and services outlined above, I must now consider what a fair specification would be in respect of the same, in order to determine the scope of protection under the marks within this decision. 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.”

43. 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 (at [47]):

“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].

¹² *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*, Case C-320/07 P

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."

42. I note the wording used in much of the specification relied upon above is already fairly specific. In addition, whilst I note that goods such as *preparations for making bakery products* may be capable of being broken down in to further categories, considering the range of goods offered by the cancellation applicant under the marks it is my view that the consumer would consider these slightly broader terms to

constitute a fair description of the goods offered. I therefore consider that the existing wording of the goods and services relied on and for which genuine use has been shown constitutes a fair specification in this instance. For clarity, these are set out again below with reference to the marks relied upon:

Under UK registration number 1353554

Class 30: Mixes, bases and concentrates for baked products; all included in Class 30.

Under UK registration number 2387377

Class 30: Mixes, bases and concentrates for baked products.

Under UK comparable mark number 903255684

Class 29: Fillings, icings, toppings and edible decorations for bakery products.

Class 30: Preparations for making bakery products; mixes for bakery products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products.

Class 43: provision of recipe information; all the aforesaid services relating to baking and/or bakery products.

Decision

Section 5(2)(b)

44. Section 47 of the Act is set out under the proof of use section above. This engages 5(2)(b) of the Act which reads as below:

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

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

Section 47(5)

45. As a reminder, section 47(5) of the Act is as follows:

“47. — (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only”.

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

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

47. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

48. 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.

49. 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."

50. 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 General Court ("GC") stated there is "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".

51. Where goods are included identically within a specification it is clear they should be considered identical. Additionally, where the wording differs but shares an identical meaning, the goods will be self-evidently identical. Finally, goods may be considered identical where they fall within a term covered by another application or registration. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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”.

52. With these factors in mind, the goods and services for comparison under each of the marks are set out below:

Earlier goods	Contested goods
<p>1353554 (UK) Class 30: Mixes, bases and concentrates for baked products; all included in Class 30.</p>	<p>Class 29: Fish products being frozen; Fish products prepared for human consumption; Frozen appetizers consisting primarily of chicken; Frozen meals consisting primarily of chicken;</p>
<p>2387377 (UK) Class 30: Mixes, bases and concentrates for baked products.</p>	<p>Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Crystallized ginger; Crystallized gingers; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat;</p>
<p>903255684 (UK comparable) Class 29: Fillings, icings, toppings and edible decorations for bakery products. Class 30: Preparations for making bakery products; mixes for bakery products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products. Class 43: provision of recipe information; all the aforesaid services relating to baking and/or bakery products.</p>	<p>Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Crystallized ginger; Crystallized gingers; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat;</p>
<p>918052747 (UK comparable)</p>	<p>Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Crystallized ginger; Crystallized gingers; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat;</p>

Class 29: Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.

Class 30: Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies,

Fried potatoes; Frozen appetizers consisting primarily of chicken; Frozen french fries; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen spinach; Frozen sweet corn; Frozen vegetables; Garlic paste; Garlic [preserved]; Ginger, preserved; Meat and meat products; Meat burgers; Meat products being in the form of burgers; Meatballs; Onion rings; Potato-based snack foods; Pre-cooked curry stew; Pre-cooked soup; Prepared dishes consisting principally of meat; Prepared meals consisting primarily of chicken; Prepared meals consisting primarily of kebab; Prepared meals consisting primarily of poultry; Prepared meals consisting primarily of vegetables; Prepared meals consisting principally of vegetables; Prepared meals containing [principally] chicken; Prepared meat dishes; Prepared vegetable dishes; Prepared vegetable products; Preserved garlic; Quick-frozen vegetable dishes; Ready cooked meals consisting primarily of chicken; Ready cooked meals consisting primarily of meat; Ready cooked meals consisting primarily of

<p>dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.</p>	<p>poultry; Prepared meals consisting primarily of kebab.</p> <p>Class 30: Batter for making pancakes; Biscuit rusk; Biscuits; Biscuits containing chocolate flavoured ingredients; Biscuits containing fruit; Biscuits for human consumption made from cereals; Biscuits having a chocolate coating; Biscuits having a chocolate flavoured coating; Biscuits [sweet or savoury]; Biscuits with an iced topping; Bread; Bread and buns; Bread biscuits; Bread buns; Bread crumbs; Bread doughs; Breadcrumbs; Breads; Breakfast cake; Breakfast cereals; Breakfast cereals containing a mixture of fruit and fibre; Breakfast cereals containing fibre; Brioche; Bun mix; Buns; Burgers contained in bread rolls; Butter biscuits; Cake bars; Cake batter; Cake dough; Cake doughs; Cake flour; Cake frosting; Cake frosting [icing]; Cake icing; Cake mixes; Cake mixtures; Cakes; Cheeseburgers [sandwiches]; Cheesecake; Cheesecakes; Chicken sandwiches; Chicken wraps; Chocolate biscuits; Chocolate brownies; Chocolate cake; Chocolate cakes; Chocolate coated biscuits; Chocolate confectionary; Chocolate confectionery; Chocolate confectionery products; Chocolate covered biscuits; Chocolate covered cakes; Chocolate covered wafer</p>
<p>918052750 (UK comparable)</p> <p>Class 29: Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.</p> <p>Class 30: Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake</p>	<p>918052750 (UK comparable)</p> <p>Class 29: Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.</p> <p>Class 30: Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake</p>

<p>donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.</p>	<p>biscuits; Chocolate flavoured confectionery; Confectionery; Confectionery items (Non-medicated -);Confectionery (Non-medicated -);Confectionery products (Non-medicated -);Cookie dough; Cookie mixes; Cookies; Corn flour; Cornflakes; Cornflour; Cream puffs; Crisp breads; Cupcakes; Custard mixes; Custard powder; Custards; Custards [baked desserts]; Dairy confectionery; Dairy ice cream; Danish bread; Dough; Doughnuts; Dutch rusk; Flat bread; Foodstuffs made from dough; Fresh bread; Frozen confectionery; Frozen custards; Frozen pastry; Frozen pastry sheets; Frozen pastry stuffed with meat; Fruit bread; Fruit breads; Fruit cake snacks; Fruit cakes; Meal; Mixes for the preparation of bread; Multigrain bread; Multigrain-based snack foods; Naan bread; Nan bread; Pancakes; Pastries; Pastries, cakes, tarts and biscuits (cookies); Pastry; Pastry dough; Pita bread; Pita chips; Pitta bread; Pizza; Pizza bases; Pizza crust; Pizza crusts; Pizza dough; Pizza flour; Pizzas; Popped popcorn; Poppy seed pastry; Porridge; Pre-baked bread; Preparations for making bakery products; Preparations for making pizza bases; Preparations for making waffles; Puff pastry; Quesadillas; Ready-to-bake</p>
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	dough products; Rolls [bread]; Rolls (Bread -); Rusks; Samosas; Sandwich wraps [bread]; Sandwiches; Sandwiches containing chicken; Savory biscuits; Savory pastries; Seasoned breading mix for deep frying; Shortbread; Shortbread biscuits; Shortbreads; Shortcake; Shortcrust pastry; Snack food products made from rice flour; Snack food products made from rusk flour; Snack foods consisting principally of confectionery; Snack foods made from corn and in the form of puffs; Snack foods made of whole wheat; Sponge cake; Sponge cakes; Spring rolls; Sweet biscuits for human consumption; Wholemeal bread; Wholemeal bread mixes; Wrap sandwiches; Wraps [sandwich].
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53. I consider firstly the contested goods in class 29. I note these include *crystallized ginger*; *crystallized gingers* and *ginger, preserved*. It is my view that these goods fall within *toppings and edible decorations for bakery products* in class 29 as included within the cancellation applicant's specification under its earlier mark 903255684. I therefore find these to be identical in line with the principles set out in Meric. However, if I am wrong, I find the contested goods will often be used in baking and so they will broadly share a purpose with the earlier *fillings, icings, toppings and edible decorations for bakery products* in class 29 and *bakery ingredients, fillings, icings, toppings and edible decorations for bakery products* in class 30 and are likely to share users and trade channels and are likely to be placed close to each other in shops. If the goods are not identical and are therefore not toppings and edible decorations for bakery products then I do not consider the goods to be in competition, nor will they be complementary, and the nature will differ. Overall, if these goods are not considered identical, I find them to be similar to a medium degree.

54. I now consider the rest of the contested goods in class 29 goods with the exception of *potato-based snack foods* which I will consider separately below. It is my view that the closest goods to these contested goods are *pizza dough* covered by earlier marks no. 918052747 and no. 918052750 in class 30. I note *pizza dough* will be sold partially prepared and may be fresh or frozen. Whilst *pizza dough* may therefore be sold in the same supermarket aisles as the contested frozen and prepared foodstuffs in class 29 in supermarkets, I find it is unlikely that they will be sold in the same sections of these. I note that *pizza dough* is ultimately for consumption as part of a savoury meal and therefore shares a very broad intended purpose with the ready prepared and frozen food goods in class 29, however, I note that *pizza dough* will require finishing preparation by the consumer prior to cooking, whereas the other ready prepared goods and meals will not. I consider the nature of the goods will be very different, and the goods will share users only to the extent they will all be purchased by members of the general public or professionals stocking retail stores or cafes and restaurants. Whilst I note the fact that the goods may all be for consumption as part of a meal, I do consider there to be any meaningful competition between the goods. Overall considering all of the factors I do not find any meaningful similarity between the earlier *pizza dough* and these contested goods in class 29, and I therefore find these to be dissimilar.

55. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *pretzels*. The contested mark covers the goods *pita chips; snack foods made from corn and in the form of puffs and popped popcorn* in class 30 and *potato-based snack foods* in class 29. All of these goods will be for the same purpose of snacking. They may all be savoury and salted and will also all be packaged and sold in small bags containing multiple items and will be found in the same aisle of supermarkets. There will be a level of competition between the goods due to their shared purpose and similar nature, and overall I find the goods to be similar to between a medium and high degree.

56. I now consider the rest of the contested goods in class 30. The earlier mark no. 903255684 holds protection for the goods *batter*. This will include the goods *batter for*

making pancakes and cake batter in the contested mark, and these goods are therefore identical in line with the principles set out in *Meric*.

57. The earlier marks no. 918052747 and no. 918052750 both cover *biscuits*. I find these to be either self evidently identical or identical in line with the principles set out in *Meric* to the following contested goods:

Biscuit rusk; Biscuits; Biscuits containing chocolate flavoured ingredients; Biscuits containing fruit; Biscuits for human consumption made from cereals; Biscuits having a chocolate coating; Biscuits having a chocolate flavoured coating; Biscuits [sweet or savoury]; Biscuits with an iced topping; Butter biscuits; Chocolate biscuits; Chocolate coated biscuits; Chocolate covered biscuits; Chocolate covered wafer biscuits; biscuits (cookies); Savory biscuits; Shortbread; Shortbread biscuits; Shortbreads; Shortcake; Sweet biscuits for human consumption; Snack food products made from rusk flour; Snack foods made of whole wheat; Multigrain-based snack foods; Snack food products made from rice flour.

58. I also consider the similarity of the *biscuits* and *brownies* covered by earlier marks 918052747 and no. 918052750 and the contested goods below:

Chocolate confectionary; Chocolate confectionery; Chocolate confectionery products; Chocolate flavoured confectionery; Confectionery; Confectionery items (Non-medicated -); Confectionery (Non-medicated -); Confectionery products (Non-medicated -); Snack foods consisting principally of confectionery; Dairy confectionery.

59. The goods above are all confectionery items. Although I do not consider these to be identical to the earlier *biscuits* and *brownies*, I consider that *confectionery* and *chocolate confectionery* such as outlined above may be chosen as an alternative sweet snack to a biscuit or brownie. They will all be eaten informally without utensils, and there may be some overlap in nature where the earlier biscuits are chocolate covered and considering that brownies are chocolate based, or where biscuits or brownies contain dairy confectionery such as fudge. There is a degree of competition

between the goods. Users will be shared; however, it is my view that the respective goods are unlikely to be sold on the same shelves. Overall, I find that these goods are similar to a medium degree.

60. The earlier marks no. 1353554, no. 2387377 and no. 903255684 all include mixes for baked products or mixes for bakery products. I find these goods to be identical in line with the principles set out in *Meric* to the following contested goods:

Bun mix; Cake mixes; Cake mixtures; Cookie mixes; Mixes for the preparation of bread; Wholemeal bread mixes.

61. The earlier mark no. 903255684 holds protection for *preparations for making bakery products*. I find these to be identical to the following contested goods in line with the principles set out in *Meric*:

Bread crumbs; Bread doughs; Breadcrumbs; Cake dough; Cake doughs; Cake flour; Cookie dough; Corn flour; Cornflour; Dough; Pastry dough; Pizza flour; Pizza Dough; Preparations for making bakery products; Preparations for making pizza bases; Preparations for making waffles; Ready-to-bake dough products; Meal.

62. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *donuts*. These are self-evidently identical to the contested goods *doughnuts*.

63. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *bread*s. These are identical either self evidently or in line with the principles set out in *Meric* to the following contested goods:

Bread; Bread and buns; Bread biscuits; Bread buns; Breads; Brioches; Buns; Crisp breads; Danish bread; Dutch rusk; Flat bread; Foodstuffs made from dough; Fresh bread; Fruit bread; Fruit breads; Multigrain bread; Naan bread; Nan bread; Pita bread; Pitta bread; Pre-baked bread; Rolls [bread]; Rolls (Bread -); Rusks; Sandwich wraps [bread]; Wholemeal bread.

64. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *dough cakes; pudding cakes and creme cakes*. The contested mark covers the goods *cakes*. These are identical to the earlier goods in line with the principles set out in *Meric*. In addition, the contested mark covers the following goods:

Breakfast cake; Cake bars; Cheesecake; Cheesecakes; Chocolate cake; Chocolate cakes; Chocolate covered cakes; Cupcakes; Custards [baked desserts]; Fruit cake snacks; Fruit cakes; Sponge cake; Sponge cakes.

65. The above goods are either types of cakes or are broader categories which will include various types of cakes. I find these to all have a similar nature to the earlier goods, and that they are likely to be produced by the same entities and share the same trade channels. I consider the purpose will be shared in the sense that they will all be consumed for the purpose of quelling hunger and for satisfying a craving for a sweet snack. There will also be a level of competition between the goods for this reason, with consumers deciding between which snack to choose. The goods may all be offered by the same providers and may well be found next to each other in supermarkets or in bakeries or cafes. Overall, with consideration to all of the factors, I find the goods to be similar to a high degree.

66. As mentioned above, marks no. 918052747 and no. 918052750 hold protection for the goods *cream cakes*. These will be cakes filled with cream. I consider the contested *cream puffs* to be pastry goods also filled with cream. I find that to an extent the nature is therefore shared. I also consider the intended purpose, that is for consumption as a sweet snack or treat will also be shared, and I consider there is a level of competition between them with consumers choosing from one or the other. I find they will likely be sold in the same areas of supermarkets or bakeries, and they are likely to share trade channels. I do not consider the goods to be complementary. Overall, I consider there to be a high degree of similarity between these goods.

67. In respect of the contested goods *tarts* I consider these to include both sweet and savoury varieties. In respect of sweet tarts, I consider these are goods that will again be eaten as a dessert or a sweet treat, and they therefore share an intended purpose with the earlier cream cakes. I consider that they may again share trade channels and

producers and will likely be located next to each other in supermarkets and bakeries. The nature will differ somewhat, but there will be a level of competition between the goods due to their shared intended purpose. The goods will not be complementary. Overall, I find the goods to be similar to between a medium and high degree.

68. The earlier marks no. 918052747 and no. 918052750 hold protection for *brownies*. The contested goods cover *chocolate brownies*. These are identical in line with the principles set out in *Meric*.

69. The earlier mark 903255684 includes *icings, toppings and edible decorations for bakery products* in class 30. It is my view these will include the contested class 30 goods below and are therefore identical in accordance with the principles set out in *Meric*:

Cake frosting; Cake frosting [icing] and Cake icing

70. The earlier marks no. 918052747 and no. 918052750 cover *bakery goods, frozen or fresh, namely, pastry and croissants*. It is my view these are identical to the following contested goods either self evidently or in line with the principles set out in *Meric*:

Frozen pastry; Frozen pastry sheets; Pastry; Poppy seed pastry; Puff pastry; Shortcrust pastry; Frozen pastry stuffed with meat; Pastries; Pastries; Savory pastries.

71. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *sweet dough cookies*. I find these to be identical to the goods *cookies* under the contested mark, in line with the principles set out in *Meric*.

72. The earlier marks no. 918052747 and no. 918052750 both hold protection for *pizza mixes, bases and concentrates being pizza mixes and pizza dough*. These are identical to the contested *Pizza bases; Pizza crust; Pizza crusts and Pizza dough*. The contested mark also covers *pizza and pizzas*. I find the nature of these goods will differ, with the contested goods being the finished article and the earlier goods comprising mixes bases and doughs, although there will be some similarity where

ready-formed circular pizza bases are sold ready for toppings to be added. The goods will be for the same end purpose for the consumption of pizza as a meal. There may be an element of competition between the goods on the basis that a consumer may purchase the dough to make their own pizza or a purchase a ready-made pizza, however, where the goods are both sold in supermarkets, they may not be located directly next to each other. Whilst pizza doughs, mixes and bases are essential for the creation of a pizza, I do not find it likely that the consumer would consider that the same entities usually offer both of the goods and I therefore do not find any complementarity between the same. Considering all of the factors, I find the goods to be similar to a medium degree.

73. The earlier mark no. 903255684 includes *bakery ingredients, fillings, icings, toppings and edible decorations for bakery products* in class 30. It is my view these fillings will include the contested goods *custards*. However, if I am wrong, I consider that the earlier marks no. 918052747 and no. 918052750 both hold protection for *bavarian cream*. I consider this to be of a very similar nature to the contested goods *custards*. Both are similar consistencies and share similar ingredients, and they will share the purpose of being eaten as a dessert or as an accompaniment to the same. I consider the goods are likely to be sold in the same chilled section of the supermarket, although I accept that custard may also be sold in boxes or tins elsewhere in the shop. Overall, I find these goods to be similar to a high degree.

74. The earlier marks no. 1353554 and no. 2387377 hold protection for the goods *mixes, bases and concentrates for baked products*. I consider this will include mixes and powders for making baked custard, and I therefore find these to be identical to *custard powder* and *custard mixes* in line with the principles set out in *Meric*.

75. I also consider the earlier *bavarian cream* against the contested goods *frozen confectionery, dairy ice cream, frozen custards*. Whilst the nature of the goods may differ in that the latter are frozen, I consider the purpose will be shared as they are all likely to be eaten as a dessert or an accompaniment to one. The method of use and users will be shared, and there may be a level of competition between the goods. Overall, I find the goods to be similar to a medium degree.

76. The earlier marks no. 918052747 and no. 918052750 hold protection for the goods *muffins*. I consider this will include breakfast muffins. The contested goods include *pancakes*. I consider that breakfast muffins will often be sold next to pre-made and packaged pancakes in supermarkets. Although they will both be small and round, the nature will differ to an extent, however both will share the purpose of being consumed for breakfast, and there may be a level of competition between the goods. I consider it likely that the trade channels will be shared and that they may be produced by the same entities. Overall, I consider the goods to be similar to between a medium and high degree.

77. I consider again the earlier goods *muffins* and note again these will include *breakfast muffins*. I consider these will share an intended purpose with the contested goods *breakfast cereals; breakfast cereals containing a mixture of fruit and fibre; breakfast cereals containing fibre; cornflakes* and *porridge*, in that they are all intended for consumption at breakfast time. The nature will differ, but there may be a small degree of competition between the goods due to their shared intended purpose. Users will be shared to the extent they are all aimed at the general public. Overall, I consider the goods to be similar to a low degree.

78. The earlier marks no. 1353554 and no. 2387377 hold protection for the goods *mixes, bases and concentrates for baked products*. It is my view these will include breading mix for baked products. Whilst I note this will not be identical to the contested goods *seasoned breading mix for deep frying*, it will share a very similar nature and purpose to these goods, being for coating products before frying or baking. I also note the user will be shared, as will the trade channels and the method of use. There may be a level of competition between the goods due to the shared purpose, with the consumer choosing whether to fry or bake their food items and choosing between the goods accordingly. Overall, I find the goods to be similar to a high degree.

79. The contested goods include:

Burgers contained in bread rolls; Cheeseburgers [sandwiches]; Chicken sandwiches; Chicken wraps; Quesadillas; Sandwiches; Sandwiches containing chicken; Wrap sandwiches; Wraps [sandwich].

80. These goods are savoury goods for consuming for lunch or for another meal or snack. The earlier goods under mark nos. 918052747 and 918052750 include *bagels* and *bread*s. The contested goods will include bread and so there will be an element of similarity in the nature of the goods, but this will also differ to a degree in that contested goods are pre-made lunch items containing fillings whereas the contested goods are for use in making the same. However, there may be a level of competition between the goods with the consumer choosing to buy the pre-made contested items or to make their own items using the earlier goods. The user will be shared to the extent that the goods are all aimed at the general public, and there may be a degree of overlap in trade channels. Overall, I find the above goods to be similar to the earlier goods to between a low and medium degree.

81. Finally, the contested goods include *samosas and spring rolls*. I find the nature of the goods to differ to the earlier goods. Whilst the intended purpose of the goods, namely for eating as a snack or as part of a meal may be loosely shared with the earlier *bagels* and *bread*s I find the level of competition between the goods to be far more limited than in respect of those in the paragraph above as they cannot be used to create the same end item, and I find it unrealistic to consider that the consumer would generally choose between a finished samosa or spring roll and a bagel or bread per se. I find the users will be shared only to the extent they are both purchased by the general public. The goods are unlikely to be placed next to each other in shops and trade channels are unlikely to overlap. The goods will not be complementary and overall, I do not find there to be any meaningful similarity between the goods.

82. Where I have found the goods to be dissimilar the opposition must fail under section 5(2)(b). The opposition will therefore proceed in respect of all of the goods other than those listed below:

Class 29: Fish products being frozen; Fish products prepared for human consumption; Frozen appetizers consisting primarily of chicken; Frozen meals consisting primarily

of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat; Fried potatoes; Frozen appetizers consisting primarily of chicken; Frozen french fries; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen spinach; Frozen sweet corn; Frozen vegetables; Garlic paste; Garlic [preserved]; Meat and meat products; Meat burgers; Meat products being in the form of burgers; Meatballs; Onion rings; Pre-cooked curry stew; Pre-cooked soup; Prepared dishes consisting principally of meat; Prepared meals consisting primarily of chicken; Prepared meals consisting primarily of kebab; Prepared meals consisting primarily of poultry; Prepared meals consisting primarily of vegetables; Prepared meals consisting principally of vegetables; Prepared meals containing [principally] chicken; Prepared meat dishes; Prepared vegetable dishes; Prepared vegetable products; Preserved garlic; Quick-frozen vegetable dishes; Ready cooked meals consisting primarily of chicken; Ready cooked meals consisting primarily of meat; Ready cooked meals consisting primarily of poultry; Prepared meals consisting primarily of kebab.

Class 30: *Samosas and spring rolls.*

83. I note at this stage that I have not considered individually the level of similarity between the earlier goods covered by each of the earlier marks and all of the contested goods. Should it become necessary to do so, for example, if it should become apparent the conclusions on a likelihood of confusion will differ for earlier each mark, I will return to consider the comparison of the goods with each of the earlier marks as necessary at that stage.


Comparison of marks

84. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

86. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
1. DAWN	
2. Dawn	
3. Dawn	
4. DAWN BALANCE	
5. DAWN EXCEPTIONAL	

87. The first earlier mark is the simple word mark DAWN. The overall impression resides in the mark as a whole.

88. The second and third earlier marks are essentially identical, with the second being a slightly elongated version of the third. The dominant element of these marks is the word element DAWN, both due to its size and position and the fact it is a word. The partial circle device behind the word in both marks appears to represent a sunshine. Whilst this plays a lesser role in the overall impression of the mark, it is not negligible and will not be ignored.

89. The fourth and fifth earlier marks both comprise two words, those being DAWN BALANCE and DAWN EXCEPTIONAL. The word DAWN appears to be dominant in both of these marks, being more distinctive and being at the beginning where the consumer tends to pay more attention.¹³ Whilst word EXCEPTIONAL appears to be less dominant due to its position and its laudatory nature, it is not negligible. The word BALANCE also does not appear to be overly distinctive in relation to food products for reasons I will discuss in more detail later in this decision, and it appears at the end of the mark. However, again it is not negligible and still makes a contribution to the overall impression.

90. The contested mark comprises several different elements, however, the most dominant element of the mark is the large red central word element DAWN. This is followed by the smaller and less dominant word bread, and then the sunshine device. The wheat device plays a lesser role in the overall impression of the mark, following finally by the green lines. The sunshine, wheat and green lines all appear to be fairly decorative. However, I do not consider any of the elements to be entirely negligible and I find that they still contribute to the overall impression of the mark.

Visual comparison

91. The first earlier mark DAWN is near identical to the most dominant and distinctive element of the contested mark, that being the large red DAWN element. As the earlier mark is filed as a word mark it may be used in a range of fonts and colours, including in a bold red font. This reduces the visual differences between these elements, although I note the blue outline around DAWN in the contested mark continues to act

¹³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

as a very small point of visual difference. I note the contested mark also includes several other elements including the sunshine and the wheat device as well as the word bread, and these elements do add a point of visual difference between the marks. Overall, I find them to be visually similar to a high degree.

92. The second and third earlier marks share the word DAWN with the contested mark, although the contested mark uses all upper-case lettering whilst the earlier marks use a combination of upper-case and lower-case lettering. I note that the earlier marks are filed in black and white and therefore the word DAWN may be displayed in the colour red, but I find the blue outline adds a small point of visual difference between these elements. All of the marks appear to share a sun device in a similar position over the word DAWN, although this is slightly larger and includes the ray elements in the contested mark which create a point of visual difference. The contested mark also includes the additional word BREAD and the additional decorative elements which do not have a counterpart in the earlier marks. Overall, I find the marks to be visually similar to a high degree.

93. The fourth and fifth earlier marks both begin with the word DAWN, that being the dominant element of the contested mark. They are filed as word marks and therefore may be used in a bold red font similar to that of the contested marks. However, the second word in each of the earlier marks have no counterpart in the contested mark. In addition, the contested mark includes the word BREAD as well as several decorative elements which has no counterpart in the earlier marks. Due to the visual similarity between the dominant elements in the marks, it is my view that there these earlier marks are visually similar to the contested mark to a medium degree.

Aural comparison

94. The first, second and third earlier marks will all be pronounced as the single word DAWN. The contested mark will be pronounced as the two single syllable words DAWN BREAD. It is my view that by way of the shared initial word, the marks are aurally similar to a medium degree.

95. The fourth and fifth earlier marks will each be verbalised as two words. These are DAWN BAH-LANCE and DAWN EX-SEHP-TION-AHL. The contested mark will be pronounced as the two words DAWN BREAD. Due to the aural identity of the initial word DAWN, it is my view that these marks are aurally similar to a medium degree.

Conceptual comparison

All of the earlier marks and the contested marks share the concept of dawn, that being “the time of day when light first appears in the sky, just before the sun rises.”¹⁴ The contested mark also contains the word bread, which conveys the concept of the food product, which is not particularly strong in the context of the goods. The fourth mark also conveys the concept of balance, which in my view in the context of the goods will allude to the concept of a nutritional balance rather than that of remaining steady or equally weighting an item so it will not fall. The fifth earlier mark also includes the word exceptional, which is a laudatory term expressing that something is very good. On the basis that the concept of DAWN is the most dominant concept and is shared across all of the marks, I find them all to be conceptually similar to between a medium and high degree.

Average consumer and the purchasing act

96. 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.

97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

¹⁴ <https://www.collinsdictionary.com/dictionary/english/dawn>

“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.”

98. It is my view that there will be two sets of consumers that will purchase the goods in this instance. The first will be the general public who will purchase the goods for general consumption or for the purpose of making consumable goods. The general public may purchase the goods fairly frequently and for a relatively low cost, however, they will consider factors such as nutritional content, flavour, and dietary requirements. I consider that a medium degree of attention will be paid to these purchases.

99. The second set of consumers will be those shown within the cancellation applicant’s evidence, namely professional consumers, purchasing the goods to stock retail stores or cafes, or in the case of the mixes, purchasing the goods for the purpose of preparing goods to stock the same. These consumers are likely to purchase higher quantities of the goods and the quality of the same is likely to have a direct impact on their business. I therefore consider that the professional consumer is likely to pay an above medium level of attention when making these purchases.

100. The goods are likely to be primarily purchased visually, either in physical or online retail stores, bakeries, or cafes, or where they are purchased by the professional consumers, via websites or catalogues. However, I consider that assistance from retail staff may play a part in the purchasing process, and that within cafés or bakeries the goods may be ordered verbally. I also consider that professional consumers may place orders over the phone, and as such I cannot completely discount the aural comparison.

Distinctive character of the earlier trade marks

101. 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).”

102. The earlier marks all contain the initial word DAWN, which is not directly descriptive or allusive of the goods. Whilst I acknowledge the use of DAWN may mildly allude to the idea that the goods offered or the final products may be enjoyed in the morning, I do not consider this to considerably detract from its distinctive character. This is the sole element of the first earlier mark which I find to be inherently distinctive to a medium degree. I consider the second and third earlier marks also include the sunshine device, which reinforces the concept of dawn and I find these marks to also be distinctive to a medium degree. The fourth earlier mark also includes the word balance, which in the context of the goods at least alludes to the fact that the goods

will be nutritionally balanced, and I do not find this increases the distinctive character of the mark as a whole, which remains medium. The fifth earlier mark includes the word 'exceptional' which I find to be laudatory and not to increase the distinctiveness of the mark beyond the medium level established by virtue of the element DAWN.

103. I must also consider if the distinctiveness of the earlier marks has been enhanced above its inherent level by virtue of the use made of the same. When considering whether the distinctiveness of the mark has been increased it is the perception of the UK consumer at the relevant date, that being the date the contested registration was filed that is key.

104. The cancellation applicant has filed evidence of use of its first three marks in relation to a number of its goods. Particularly, the cancellation applicant has shown considerable use of the following marks in relation to the following goods relied upon:

Mark 1

Class 30: Mixes, bases and concentrates for baked products; all included in Class 30.

Mark 2

Class 30: Mixes, bases and concentrates for baked products.

Mark 3

Class 29: Fillings, icings, toppings and edible decorations for bakery products.

Class 30: Preparations for making bakery products; mixes for bakery products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products.

105. The sales figures for the UK are shown in evidence to be between approximately 30 and 65 million GBP every year for the last 12 years. In addition, the cancellation applicant has shown a healthy advertising spend of between 150 - 300 thousand GBP every year for the last 9 years. Further considerable sales in the multimillions have also been provided dating back to 1993, and healthy advertising spend has been

shown dating back to 2004. The cancellation applicant has confirmed the current version of marks 2 & 3 have been in use since the year 2000. Evidence of advertising in publications between 2015 and the relevant date have been shown, in addition to details of sponsorship of industry events. It is my view that the cancellation applicant has evidenced that at least amongst professional consumers which appears to be its primary consumer group, the distinctiveness of the initial three earlier marks has been raised to a high degree by virtue of the consistent and longstanding use of the marks in the UK.

106. The evidence provided does not suffice to show that distinctiveness of the marks DAWN BALANCE and DAWN EXCEPTIONAL has been raised above its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

107. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 46 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 must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.¹⁵ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice

¹⁵ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

108. 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.¹⁶

109. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

Earlier mark 1 (registration no. 1353554) – DAWN

110. I found the first earlier mark to be visually similar to a high degree and conceptually similar to between a medium and high degree, and aurally similar to a medium degree to the contested mark. I found the most dominant element of the contested mark to be the word DAWN which makes up the earlier mark in its entirety. I found the contested goods that were compared with the goods of this earlier mark to be either identical or similar to a high degree. I found the earlier mark to hold a medium degree of distinctive character inherently, which has been enhanced to a high degree amongst one set of consumers, those being professionals. I found that the same set of professional consumers would pay an above medium degree of attention to the goods, whereas the general public (for whom the distinctive character of the mark has not been enhanced) would pay a medium degree of attention in respect of the same. I found the goods will primarily be purchased visually, but there will also be aural considerations. I consider that the earlier mark may be used in a bold red font, and the

¹⁶ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

consumer may easily forget or misremember the word BREAD which if not directly descriptive of the exact goods registered, will be seen to simply indicate the type of goods also offered under the DAWN mark. In addition, I consider the consumers imperfect recollection, and it is my view that the consumer may easily forget or overlook the decorative elements of the contested marks, but that the shared concept of DAWN will help this dominant element to be recalled in each. Considering all of the factors it is my view that there exists a likelihood of direct confusion between the earlier mark and the contested mark in respect of all of the goods for which I have found similarity, for at least a significant portion of both professional consumers, and the general public.

111. In respect of those consumers who may notice the differences between the marks, I consider if there exists a likelihood of indirect confusion in respect of the same. In *L.A. Sugar*, Mr Iain Purvis Q.C. (as he then was) as the Appointed Person set out three examples of when indirect confusion may occur as below:


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

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

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

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

112. I note that the examples above were intended to be illustrative and are not exhaustive. Whilst I do not consider this example to fall into one of these categories precisely, it is my view that this situation will be most similar to category b above. In this instance, I found the earlier mark DAWN to be the distinctive and dominant component of the contested mark, with BREAD appearing to be descriptive in respect of the goods. In addition, I found the additional elements to appear decorative. I also found the distinctiveness of the earlier mark to have been enhanced to a high degree in respect of the professional consumer, and to hold a medium degree of distinctiveness for the general public. I remind myself of the above medium level of attention paid by the professional consumer and the medium degree of attention paid by the general public, but it is nonetheless my view that considering all of the factors including those set out previously, in the circumstances consumers would consider the contested mark to comprise the earlier mark with the addition of a descriptive word and some decorative features, and would ultimately conclude the goods are likely to come from the same or an economically linked undertaking, with the latter being an updated or alternative stylised version of the former or vice versa, or that the later mark represents a sub brand. I therefore find there exists a likelihood of indirect confusion between the marks.

Earlier marks 2 & 3 (registration nos. 2387377 & 903255684) - 

113. I found the earlier marks 2 & 3 to be visually similar to a high degree and conceptually similar to between a medium and high degree, and to be aurally similar to a medium degree to the contested mark. I also found earlier marks 2 & 3 to be inherently distinctive to a medium degree, and that the distinctiveness of the marks has been raised to a high degree by virtue of the use made of the same amongst professional consumers. Again, I found that the same set of professional consumers would pay an above medium degree of attention to the goods, whereas the general public (for whom the distinctive character of the mark has not been enhanced) would pay a medium degree of attention in respect of the same. I found again that the goods would be primarily purchased visually, but that aural considerations cannot be completely ignored. In this instance, I found the goods covered by earlier mark 2 to be identical or similar to a high degree to the compared contested goods, and goods

covered by earlier mark 3 to range from identical at best to similar to a medium degree if I am wrong about the identity of some of the compared goods. I note that the dominant element DAWN is shared across all of the marks, both include a sunshine above the word, the word bread is smaller and descriptive and the additional elements in the contested mark are decorative. With consideration to all of the factors it is my view that the consumer may forget or fail to recall the descriptive and decorative differences between the marks and the minor stylistic changes between the dominant element and would directly mistake the contested mark for marks 2 & 3 or vice versa. I therefore consider there to be a likelihood of direct confusion in respect of both earlier marks, amongst at least a significant portion of consumers.

114. However, if the consumer were to notice the differences between the marks, I consider if there exists a likelihood of indirect confusion in this instance. Again I consider the factors set out in *L.A. Sugar* and remind myself again that they are non-exhaustive. I consider that the element BREAD in the contested mark will be considered descriptive of the type of goods offered under the DAWN mark. I also consider that the dominant and distinctive element DAWN is shared between all of the marks, and in addition to this, both marks include what appears to be a sunshine device rising up above the word. With consideration to all of the factors, it is my view in this instance that if consumers were to notice the differences between the marks, they would not consider the significant similarities to be coincidence, rather it is my view that the consumer would assume that similarities were due to the goods coming from the same economic undertakings, with the later mark being an alternative or updated version of the newer mark or vice versa, or that the later mark represents a sub brand. I therefore believe they would find there to be a likelihood of indirect confusion between the marks.

Earlier mark 4 & 5 (registration nos. 918052747 & 918052750) – DAWN BALANCE & DAWN EXCEPTIONAL

115. I found these earlier marks to both be visually and aurally similar to the contested mark to a medium degree, and conceptually similar to the contested mark to between a medium and high degree. I found them to hold a medium degree of inherent distinctive character, but I did not find the evidence to show this had been enhanced

through the use of these marks. I found the most dominant element of both of these earlier marks and of the contested mark to be DAWN. I found the general public would pay a medium degree of attention to the goods, and that the level of attention paid by the professional consumer would be above medium. I found the purchasing process would be primarily visual, but that I cannot discount the aural considerations entirely. Both earlier marks hold protection for the same goods, and I found these to range from identical to similar to a low degree to the contested goods. Considering all of the factors, it is my view that the consumer is unlikely to not notice or forget all of the differences between the marks in this instance. I therefore do not consider there to be a likelihood of direct confusion between the marks.

116. I therefore consider the likelihood of indirect confusion between these marks. I remind myself of the categories set out in *L.A. Sugar*. I also remind myself of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

117. I consider that DAWN is the most dominant and distinctive element in both the earlier marks and in the contested mark. Whilst I do not consider this situation fits exactly into category b set out in *L.A. Sugar*, I do consider there to be significant similarities. I consider particularly that the use of BREAD in the contested mark will be considered descriptive of the type of goods generally offered under the mark. In respect of earlier mark 5, I consider that the word EXCEPTIONAL included in earlier mark 5 is simply laudatory, and in respect of mark 4 I consider this to be at least allusive of a nutritional balance. Further, I do not consider that the word EXCEPTIONAL or BALANCE hangs together with the word DAWN to create a meaning that is more than a sum of their parts, and I consider that DAWN maintains an independent role within the marks. The additional elements in the contested mark are also largely decorative, and I consider that the earlier word marks may be displayed in a bold red font similar to that of the contested mark. Considering all of

these factors, it is my view that where there is at least a low level of similarity between the goods, the consumer is likely to put the shared dominant and independent element DAWN down to an economic connection between the goods and consider that DAWN EXCEPTIONAL and DAWN BALANCE represent sub brands of the earlier mark. I therefore find there exists a likelihood of indirect confusion in respect of earlier marks 4 and 5 and the contested mark.

Conclusions under 5(2)(b)

118. The opposition has succeeded under section 5(2)(b) of the Act in respect of all goods other than those below:

Class 29: Fish products being frozen; Fish products prepared for human consumption; Frozen appetizers consisting primarily of chicken; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen prepared meals consisting principally of vegetables; Frozen vegetables; Chicken breast fillets; Chicken burgers; Chicken nuggets; Chicken stock; Cooked chicken; Cooked dish consisting primarily of chicken and ginseng (samgyetang); Cooked meat; Cooked meat dishes; Cooked meats; Cooked poultry; Deep frozen chicken; Deep-frozen poultry; Fried chicken; Fried meat; Fried potatoes; Frozen appetizers consisting primarily of chicken; Frozen french fries; Frozen meals consisting primarily of chicken; Frozen meals consisting primarily of meat; Frozen meals consisting primarily of poultry; Frozen meals consisting primarily of vegetables; Frozen meat products; Frozen spinach; Frozen sweet corn; Frozen vegetables; Garlic paste; Garlic [preserved]; Meat and meat products; Meat burgers; Meat products being in the form of burgers; Meatballs; Onion rings; Pre-cooked curry stew; Pre-cooked soup; Prepared dishes consisting principally of meat; Prepared meals consisting primarily of chicken; Prepared meals consisting primarily of kebab; Prepared meals consisting primarily of poultry; Prepared meals consisting primarily of vegetables; Prepared meals consisting principally of vegetables; Prepared meals containing [principally] chicken; Prepared meat dishes; Prepared vegetable dishes; Prepared

vegetable products; Preserved garlic; Quick-frozen vegetable dishes; Ready cooked meals consisting primarily of chicken; Ready cooked meals consisting primarily of meat; Ready cooked meals consisting primarily of poultry; Prepared meals consisting primarily of kebab.

Class 30: *Samosas and spring rolls.*

Section 5(3)

119. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

120. As the earlier trade marks include comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union”.

121. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered

is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

122. An invalidation based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the cancellation applicant must

prove it holds a reputation for the earlier marks relied upon amongst a significant portion of the public. It must also be established that the marks are similar to the contested mark. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

123. The relevant date for consideration under section 5(3) of the Act is the application date of 27 June 2020.

Reputation

124. In *General Motors*, the CJEU gave the following guidance for the assessment of a trade mark's reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

125. As three of the earlier marks are comparable marks, evidence of a reputation in the EU will be considered towards the establishment of a reputation of the earlier marks, in accordance Schedule 2A of the Act. In *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member

State in question may be considered to constitute a substantial part of the territory of the Community.”

126. I note firstly that the evidence does not show a reputation is held by the cancellation applicant under marks 4 & 5, namely DAWN BALANCE and DAWN EXCEPTIONAL.

127. In respect of the remaining marks 1 – 3, I consider again the evidence as detailed in the proof of use section of this decision. I consider the sales figures for the UK are shown to be between approximately 30 and 65 million every year for the last 12 years. In addition, the cancellation applicant has shown a healthy advertising spend of between £150 - £300 thousand every year for the last 9 years. I note again that further considerable sales in the multi millions have also been provided dating back to 1993, and healthy advertising spend has been shown dating back to 2004, and the confirmation that the current logo shown in marks 2 & 3 has been in use since 2000. Once again, I consider the evidence of advertising in publications dated between 2015 and the relevant date have been shown, in addition to details of sponsorship of industry events. I note that the cancellation applicant has sponsored the Baking Industry Awards at least for the last 12 years, along with a number of other industry events over the years across the UK.

128. Whilst I am not aware of the size of the market for the goods offered under the mark in the UK or in the EU, it is my view that with consideration to the consistently high sales figures and the healthy advertising spend and sponsorship of industry events, the cancellation applicant will have built up a reasonably strong reputation under its marks at the relevant date amongst its professional consumers in respect of some of its goods relied upon in the UK. I note here that I find the UK to have been a substantial part of the EU prior to the end of the transition period and that a reputation in the UK is therefore sufficient for the purpose of satisfying the requirement that a reputation is held under both the UK marks and the UK comparable mark within the territory. It is my view that the goods for which the cancellation applicant has shown a reputation for under the earlier marks considering the goods and services relied upon are as follows:

Mark 1

Class 30: Mixes, bases and concentrates for baked products; all included in Class 30.

Mark 2

Class 30: Mixes, bases and concentrates for baked products.

And

Mark 3

Class 29: Fillings, icings, toppings and edible decorations for bakery products.

Class 30: Preparations for making bakery products; mixes for bakery products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products.

Link

129. As I have established the cancellation applicant holds a qualifying reputation, I will now consider if a link will be made between the marks. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors as set out in *Intel* which I will consider in turn below:

The degree of similarity between the conflicting marks

130. As I have set out under my decision under section 5(2)(b), I have found the earlier marks 1 – 3 to be visually similar to the contested mark to a high degree, conceptually similar to the contested mark to between a medium and high degree, and aurally similar to the contested mark to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

131. Within my comparison of the goods and services under section 5(2)(b), I have found some of those registered under the contested mark to be identical or at least similar to a medium degree to goods for which the cancellation applicant holds a reputation. However, I note there are also a number of contested goods for which a comparison with these goods has not been carried out. I consider the goods for which the cancellation applicant holds a reputation to be dissimilar to the goods in class 29 other than where previously compared and stated, however, I note the goods are all for the purpose of human consumption. I also consider that users may be shared, including both the general public and professional users who may purchase the goods for food preparation for others.

132. In respect of the goods in class 30, I consider the following contested goods to all be baked products and bakery products:

Class 30: Biscuit rusk; Biscuits; Biscuits containing chocolate flavoured ingredients; Biscuits containing fruit; Biscuits for human consumption made from cereals; Biscuits having a chocolate coating; Biscuits having a chocolate flavoured coating; Biscuits [sweet or savoury]; Biscuits with an iced topping; Bread; Bread and buns; Bread biscuits; Bread buns; Breads; Breakfast cake; Brioches; Buns; Butter biscuits; Cake bars; Cakes; Cheesecake; Cheesecakes; Chocolate biscuits; Chocolate brownies; Chocolate cake; Chocolate cakes; Chocolate coated biscuits; Chocolate covered biscuits; Chocolate covered cakes; Chocolate covered wafer biscuits; Cookies; Cream puffs; Crisp breads; Cupcakes; Custards; Custards [baked desserts]; Danish bread; Doughnuts; Dutch rusk; Flat bread; Foodstuffs made from dough; Fresh bread; Frozen pastry stuffed with meat; Fruit bread; Fruit breads; Fruit cake snacks; Fruit cakes; Multigrain bread; Multigrain-based snack foods; Naan bread; Nan bread; Pastries; Pastries, cakes, tarts and biscuits (cookies); Pita bread; Pitta bread; Pizza; Pizzas; Pre-baked bread; Rolls [bread]; Rolls (Bread -); Rusks;

Sandwich wraps [bread]; Wraps [sandwich]; Savory biscuits; Savory pastries; Shortbread; Shortbread biscuits; Shortbreads; Shortcake; Snack food products made from rice flour; Snack food products made from rusk flour; Snack foods made of whole wheat; Sponge cake; Sponge cakes; Sweet biscuits for human consumption; Wholemeal bread.

133. All of the above goods may therefore be made from mixes for baked products or mixes for bakery products as relied upon by the cancellation applicant and for which they hold a reputation. I consider that both the above goods and the mixes will be purchased with the same end goal of having a baked snack for consumption, however, the mixes will be purchased specifically so that it is easy for the consumer to bake these goods themselves, whereas the finished goods will be purchased ready to consume. The user of the goods will often be shared, and there may also be a degree of competition between the goods, as someone may either purchase the finished product or a mix to enable them to make the product themselves. This includes professionals who may purchase mixes to bake products in store or the ready made goods to sell in the same. The nature and method of use will differ, but there may be a degree of overlap in trade channels. Overall, I find the above contested goods to be similar to the goods for which the cancellation applicant holds a reputation to a medium degree. The users of these goods will again include both members of the general public purchasing the goods for the purpose of stocking bakeries and cafes, in addition to the general public.

134. For the same reasons as those above, namely that they will be purchased with the same end goal, will share users, and there will be a degree of competition as well as a degree of overlap in trade channels, I also find *pancakes* in the contested specification to be similar to *batter* to a medium degree.

135. The contested mark also covers the goods below:

Chocolate confectionery; Chocolate confectionery; Chocolate confectionery products; Chocolate flavoured confectionery; Confectionery; Confectionery items (Non-medicated -); Confectionery (Non-medicated -); Confectionery

products (Non-medicated -); Dairy confectionery; Snack foods consisting principally of confectionery.

136. I consider the similarity of these goods with the earlier edible cake decorations. It is my view that these edible cake decorations will often share a nature with the above goods, as they will often be made of chocolate, sugar, or dairy in the case of goods such as fudge or caramel. In addition, they are all ultimately for consumption, although the contested goods are intended to be consumed as party of a cake rather than alone. They may share users to the extent that they will all be purchased by the general public or professionals, but they are unlikely to be sold next to each other in stores. There may be a very limited degree of competition between the goods on the basis that the above goods may be used to decorate cakes or baked goods. However, overall I find there will be no more than a low degree of similarity between the goods.

136. The contested goods include *frozen pastry; frozen pastry sheets; pastry; pizza bases; pizza crust; pizza crusts; poppy seed pastry; puff pastry; shortcrust pastry*. These goods all share a purpose with the relied upon *mixes for baked products or mixes for bakery products* as they are all for the purpose of using as a short cut for making baked goods for consumption. There will likely be an element of competition between the goods as one might be chosen over the other due to their shared purpose. The user will also be shared, and overall I find the goods to be similar to at least a medium degree.

136. I note the goods relied upon for which the cancellation applicant holds a reputation include *fillings, icings and toppings for bakery products*. These include a range of cream fillings, and cream cheese frosting, which will all be of a similar nature to the contested *frozen confectionery, dairy ice cream and frozen custards* although they are unlikely to be served frozen. They will all be used as a sweet accompaniment for cake and desserts, although the contested goods will likely be served on the side whereas the earlier goods will become part of the baked goods, and they will not be sold next to each other in stores. The goods will share users, but overall, there is at best a low degree of similarity between the goods.

137. The remaining foods are as follows:

Burgers contained in bread rolls; Cheeseburgers [sandwiches]; Chicken sandwiches; Chicken wraps; Popped popcorn; Snack foods made from corn and in the form of puffs; Spring rolls; Samosas; Wrap sandwiches; Pita chips; Breakfast cereals; Breakfast cereals containing a mixture of fruit and fibre; Breakfast cereals containing fibre; Cornflakes; Porridge; Quesadillas; Sandwiches; Sandwiches containing chicken.

138. I find the above goods to have a different nature and method of use to the earlier goods, and whilst they are all goods ultimately for consumption, the earlier goods are for the purpose of making or decorating baked goods, whereas the above are for immediate consumption as breakfast foods, savoury meals or sweet or salty snacking foods which are not baked goods. I note that there may be an overlap in user, including in respect of the professional consumer stocking cafes and the general public. However, overall, I find the goods to be dissimilar, although not wildly disparate.

The strength of the earlier mark's reputation

139. I consider the earlier mark to hold a reasonably strong reputation for its goods amongst its professional consumers.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

140. Within my decision under section 5(2)(b) of the Act I found the earlier marks 1 – 3 to hold a medium degree of inherent distinctiveness, and I found this had been enhanced to a high degree through use amongst its professional consumers.

Whether there is a likelihood of confusion

141. I have considered the likelihood of confusion between the marks in respect of the goods ranging from identical to similar to a medium degree under section 5(2)(b). These findings apply here to all of the goods I have found to be similar, and considering all of the factors, I find this would be the case even where the level of similarity is low.

142. I remind myself at this stage that a likelihood of confusion is not necessary for a link. However, where this has been found, it is clear that there will be a link made between the marks. I also note again the high level of similarity between the marks, the high level of distinctiveness and the reasonably strong reputation held by the earlier marks, and I consider also that the goods for which a reputation has been found include mixes and preparations for baked goods including bread. It is my view that where the goods are further apart, the use of the word BREAD in the later mark will assist the consumer in making a link between the marks, with this indicating that the company responsible for the later goods also likely offers bread products under the mark. It is my view that taking all of the factors into account, the professional consumer who is familiar with the earlier mark in respect of mixes for baked goods, will make a link between this mark and the earlier marks, whether that be due to an assumption that the later mark must be connected to the earlier mark, or due to it being brought to mind by a wondering as to whether this is the case or whether they are simply similar. I therefore find there will be a link made in respect of all of the contested goods.

Damage

Unfair advantage

143. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill”.

144. The cancellation applicant pleads that the use of the contested mark will take unfair advantage of the earlier mark’s reputation on the basis that the consumer will believe there is an economic connection between the marks, and on the basis that it would unfairly trade off, or ride on the coat tails of the cancellation applicant’s reputation. In addition, it pleads that through use of the contested mark the proprietor would unfairly benefit from the power of attraction, reputation and prestige of the cancellation applicant’s earlier reputation and exploit its marketing effort.

145. There is no pleading nor evidence suggesting that the proprietor is intentionally trying to benefit from the reputation of the earlier mark by adopting the sign it has. I consider that in this instance, choosing the mark it has may have been coincidence. However, despite this, I find there to be no doubt that where the consumer believes that there is an economic connection between the marks, the proprietor will unfairly benefit from the cancellation applicant’s reputation. In addition, I consider that in this instance that even in respect of the dissimilar goods, it is my view that at least a significant portion of professional consumers will assume there must be an economic connection between the marks, and the proprietor will again unfairly benefit from that assumption. In addition, with careful consideration of all of the factors of the case, it is my view that even where professional consumers do not assume there must be an economic connection between the marks, I consider that the contested mark will appear instantly familiar and will therefore unfairly ride on the coat tails of the earlier marks’ reputation. It is my view that the proprietor would unfairly benefit from the association made in the mind of the consumer, in respect of all of the earlier goods.

146. As I have found the opposition on section 5(3) to succeed based on unfair advantage, there is no need for me to consider the additional pleaded heads of damage.

Final Remarks

147. The application for invalidation has been successful in its entirety, and subject to any successful appeal the registration will be deemed invalid.

COSTS

148. The cancellation applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the cancellation applicant the sum of £1850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
Preparing and filing the TM26(i) and considering the counterstatement	£400
Preparing and filing the evidence	£850
Preparing and filing the written submissions in lieu	£400
Total	£1850

149. I therefore order Top Star Marketing UK Ltd to pay Dawn Foods, Inc. the sum of £1850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 1st day of December 2022

**Rosie Le Breton
For the Registrar**