

O/800/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3608288
IN THE NAME OF BARILLA G. E R. FRATELLI-SOCIETÁ PER AZIONI
FOR THE TRADE MARK**

BISCAFFE'

IN CLASS 30

AND

THE OPPOSITION THERETO UNDER NUMBER 426162

BY LOTUS BAKERIES, NAAMLOZE VENNOOTSCHAP

Background and pleadings

1. On 29 May 2020, Barilla G. e R. Fratelli-Società Per Azioni (“the applicant”) filed an application for the trade mark BISCAFFE’ (number 3608288) in Class 30 for *Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour and preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Pizzas and preparations for pizzas; Edible ices; Honey, treacles; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.*

2. Although the application was filed in the UK on 11 March 2021, it was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 29 May 2020. This means the relevant date and effective filing date is 29 May 2020.¹ The application was published on 14 May 2021 and opposed by Lotus Bakeries, naamloze vennootschap (“the opponent”) on 13 August 2021 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier trade mark registration for its section 5(2)(b) and 5(3) grounds, as follows:

00801442811

BISCOFF

Filing date: 6 December 2018; priority date (Benelux) 7 June 2018; registration date: 10 June 2019.

¹ It is not, as the opponent claims in its statement of grounds, a Convention Priority claim. Article 59: “1. [...] An application made pursuant to this Article shall be deemed to have the same filing date and date of priority as the corresponding application filed in the Union and, where appropriate, the seniority of a trade mark of the United Kingdom claimed under Article 39 or 40 of Regulation (EU) 2017/1001.”

Class 30: *Biscuits; cakes; confectionery; fondants (confectionery); gingerbread; (industrial) pastry; speculoos (caramelized biscuits); spreads on the basis of biscuits, speculoos (caramelized biscuits), coffee and/or chocolate; waffles; ice-cream; edible ice.*

3. Under section 5(2)(b) of the Act, the opponent claims that the parties' goods are highly similar "or complementary" and the marks are visually, aurally and conceptually similar, leading to a likelihood of confusion.

4. Under section 5(3) of the Act, the opponent claims a reputation in its mark for the registered goods such that the relevant public will believe the applicant's goods come from the opponent or that of an undertaking linked to the opponent, leading to unfair advantage. The opponent also claims that use of the applicant's mark will erode the distinctiveness of the earlier mark and damage its repute if used in relation to goods of poor quality.

5. Under section 5(4)(a) of the Act, the opponent claims that it has used the sign BISCOFF throughout the UK since March 2014 in relation to the same goods as are covered by its earlier mark. The opponent claims that its goodwill in the business distinguished by its sign entitles it to prevent the use of the application under the law of passing off.

6. The applicant filed a defence and counterstatement, denying the grounds of opposition. The applicant claims that the average consumer will break the marks into two parts, BI-SCOFF and BIS-CAFFE', recognising the verb SCOFF, and perceiving CAFFE' "to represent the loan word CAFFÈ".

7. The opponent is professionally represented by Novagraaf UK. The applicant is represented by Phillips & Leigh. Both parties filed evidence accompanied by written submissions. Neither party requested a hearing, but both filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Evidence

8. The opponent has filed evidence from two witnesses. Luke Portnow is a trade mark attorney with the firm representing the opponent. His evidence is aimed at proving that the parties' goods are similar.² Sarah Van Nevel is Legal and IP Counsel for the opponent. Her evidence is about the opponent's business and the use of its mark.³

9. The applicant's evidence is from two witnesses. James McAllister is a trade mark attorney with the firm representing the applicant. His evidence is aimed at proving how the average consumer will perceive the parties' marks.⁴ Roberto Porta is a trade mark advisor to the applicant in Italy. His evidence is aimed at proving how the average consumer will pronounce the applicant's mark.⁵

Section 5(2)(b) of the Act

10. Section 5(2)(b) states:

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

(a) ...

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

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

11. Section 5A states:

² Witness statement dated 7 March 2022.

³ Witness statement and exhibits dated 4 March 2022.

⁴ Witness statement and exhibits dated 6 May 2022.

⁵ Witness statement and exhibits dated 6 May 2022.

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”⁶

12. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.⁷

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;

⁶ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

⁷ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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

13. In its written submissions, the opponent says:

“The Applicant, in its TM8 Counterstatement, indeed did not deny that the goods are similar or at least complementary. The Applicant simply requested evidence of similarity or complementarity.”

14. The counterstatement says:

“The Opponent is put to evidence that the Opposed Goods and the Opponent’s Goods are similar or at least complementary (where identity cannot be found).”

15. There would be no need to ask for proof if the applicant accepted that the goods were similar. This is a denial of similarity where identity cannot be found. The applicant does concede in its written submissions that the following goods in its specification are identical or similar to goods within the opponent’s specification, without identifying which goods it considers to be identical, or which it considers to be similar (and how similar):

preparations made from cereals, bread, bread substitutes and other bread products; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Fruit cake snacks; Honey, treacles.

16. The parties’ goods are shown in the table below:

The opponent’s goods	The applicant’s goods
Class 30: <i>Biscuits; cakes; confectionery; fondants (confectionery); gingerbread; (industrial) pastry;</i>	Class 30: <i>Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour and preparations made from</i>

<p><i>speculoos (caramelized biscuits); spreads on the basis of biscuits, speculoos (caramelized biscuits), coffee and/or chocolate; waffles; ice-cream; edible ice.</i></p>	<p><i>cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Pizzas and preparations for pizzas; Edible ices; Honey, treacles; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.</i></p>
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17. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa).⁸ The following goods in the application are either identical on this basis or because the term is the same or almost so in both parties' specifications:

Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Fruit cake snacks; Edible ices; Ice.

18. The remaining goods are not identical, requiring an assessment to be made as to whether the respective goods are similar and, if they are, how similar. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

⁸ *G rard Meric v OHIM*, Case T-33/05, General Court

“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.”

19. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

20. *Cereal-based snack food; Snack bars containing a mixture of cereals, nuts and dried fruit*

These are sweet snacks made principally of cereals. They are similar in nature to biscuits, being composed of cereals, and may be a similar shape. The applicant’s goods and the opponent’s ‘biscuits’ are intended to be eaten as snacks. They are likely to be sold on the same shelves and are in competition with one another as alternative snacks. The applicant’s goods are highly similar to the opponent’s ‘biscuits’.

21. *Rice-based snack food; Rice cake snacks*

Despite the presence of the word ‘cake’ in *rice cake snacks*, these goods are not cakes in the conventional sense. They are more like cereal bars and biscuits. The only difference between these goods and the comparison made in the previous paragraph is that the applicant’s goods are rice-based instead of cereal-based. The nature of the goods is slightly less similar to biscuits in terms of composition, but all the other factors are present. These goods are highly similar to the opponent’s ‘biscuits’.

22. *Honey, treacles*

The applicant has included honey and treacle in the list of its goods which it concedes are identical or similar to goods within the opponent's specification. Honey and treacle are not identical to any of the opponent's terms, but they are similar to the opponent's 'spreads on the basis of biscuits, speculoos (caramelized biscuits), coffee and/or chocolate'. They are of a similar nature, contained in jars or bottles, and of a similar consistency. They are used to sweeten and to spread on e.g. toast and desserts. They share users and method of use. They are likely to be sold on the same shelves and are in competition with one another as alternatives. The applicant's goods are highly similar to the opponent's 'spreads on the basis of biscuits, speculoos (caramelized biscuits), coffee and/or chocolate'.

23. *Preparations made from cereals, bread, bread substitutes and other bread products*

The applicant has included these goods in the list of its goods which it concedes are identical or similar to goods within the opponent's specification. *Preparations made from cereals* are identical on the *Merix* principle to the opponent's 'biscuits'. *Preparations made from [...] bread, bread substitutes and other bread products* are similar to the opponent's 'cakes' to a medium degree. This is because the applicant's goods include preparations such as sweetened breads. These have a similar nature to cakes, at least in shape, and are often found in the same aisles or the bakery section of supermarkets. Sweetened bread is in competition with cakes as an alternative sweet treat or snack.

24. *Cake mixes*

These are alternatives to buying a ready-made cake, which means there is a competitive relationship with the opponent's 'cakes'. There is some similarity in nature because the composition of both will include flour and sugar, at least, although one will be in solid form and the other in powdered form. The purpose of a cake mix is to make a cake for a sweet treat. They are not generally found in exactly the same

supermarket aisle as each other, but will be nearby. There is a medium degree of similarity between the applicant's *cake mixes* and the opponent's 'cakes'.

25. *Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices.*

Mr Portnow, for the opponent, states that whilst coffee and biscuits have different purposes, it can be taken as "judicial privilege" that they are enjoyed and purchased together, often from the same manufacturer. He gives an examples of the companies Douwe Egberts and Rombouts manufacturing both coffee and biscuits in Exhibits LDP1 and LDP2. Exhibit LDP1 comprises an extract from a Belgian website, for wholesalers and was printed after the relevant date. Exhibit LDP2 comprises an undated extract from a UK website, showing coffee and wholesale prices for biscuits.

26. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union ("GC") stated that "complementary" means:

"82 ... there is a close connection between [the goods], 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...".⁹

27. I am not persuaded that the opponent's biscuits and the applicant's coffee are complementary in the sense of the caselaw. Neither is important or indispensable for the other. Two exhibits, either undated or after the relevant date (one of which is Belgian) showing that two manufacturers sell both goods does not prove that customers may think that the same manufacturer is responsible for both, leading to complementarity. I am also not prepared to find complementarity on the basis of

⁹ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

judicial notice. The alleged common manufacture of coffee and biscuits is not something of which I am aware.

28. Mr Portnow also points to the evidence of Sarah Van Nevel; in particular Exhibits SVN3, SVN4, SVN5 and SVN7 which he states provide clear evidence of how the marketplace operates. These exhibits contain details regarding the opponent's advertising for its range of goods which include biscuits, a spread and ice cream. That manufacturers make various food items does not make the food items similar to one another. The assessment must be made on the basis of the caselaw already cited in this decision.

29. Finally, Mr Portnow considers that similarity between coffee and biscuits is supported by the fact that the opponent's mark is based on the combination of the words BISCUIT and COFFEE, as set out in the Witness Statement of Sarah Van Nevel. The genesis of a party's trade mark is not relevant to an assessment of the similarity between goods.

30. I cannot see any similarity between these goods and the opponent's goods. Simply being foodstuffs is not sufficient. Nor is the possibility that some goods might be ingredients used to make other goods.¹⁰ I have considered whether *sauces (condiments)* are similar to the opponent's spreads but have concluded that the 'condiments' qualification means that the natural meaning of the term is that they are accompaniments to savoury food, such as mustards, bread sauce, cranberry sauce and mint sauce.

The average consumer and the purchasing process

31. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."¹¹ The average consumer is deemed to be reasonably well informed and reasonably

¹⁰ *El du Pont de Nemours and Company v OHIM*, Case T-288/12, GC.

¹¹ *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).

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*.

32. The average consumer for the parties' goods is a member of the general public. They are everyday foodstuffs, purchased regularly, where the main focus of attention will be use and flavour. Although some attention may be paid to allergy information, calories, fat and salt content, the goods are of relatively low cost. There will be no more than a medium average degree of attention paid during purchase and some goods, such as confectionery, may be purchased almost on a whim, with a low degree of attention. The goods will be purchased primarily visually, selected from shelves or online outlets. There may be an aural element; for example, if a confectionery purchase is being made from a street trader or kiosk.

Comparison of marks

33. The marks to be compared are:

The opponent's mark	The applicant's mark
BISCOFF	BISCAFFE'

34. *Sabel BV v. Puma AG* 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.”

35. 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.

36. The applicant submits that the opponent’s mark will be perceived as comprising two conjoined components, ‘BI’ and ‘SCOFF’ and that its own mark comprises two conjoined components, ‘BIS’ and ‘CAFFE”.

37. 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 analyse its various details. The applicant’s submissions are predicated on an artificial dissection of the marks, rather than the normal perception of marks as wholes. I will say more about the meanings of the marks later, but at this point I note that the overall impression of the opponent’s mark resides in the single component, BISCOFF. Noting the presence of the very small vertical line at the end of the mark, the overall impression of the applicant’s mark is dominated by the word element BISCAFFE.

38. The opponent’s mark is seven letters long and the applicant’s mark is eight letters long. The first, second, third, fourth, sixth and seventh letters are identical in both marks. There is also the very small vertical line at the end of the applicant’s mark. The parties’ marks are visually highly similar.

39. One of the applicant’s witnesses, Roberto Porta, has filed evidence about how the average consumer will pronounce the applicant’s mark. Mr Porta is fluent in Italian and English. He states:

“5. It is my belief that the Applicant intends for the mark BISCAFFE' to be read as and pronounced BISCAFFÈ i.e. BIS-CAFF-AY as the ' glyph at the end of the word BISCAFFE is intended to operate as an acute accent.

6. It is my belief that, in Italy, graphemes È and E' are interchangeable and signal to the reader that the E sound needs to be stressed [...].

7. It is my belief that, in Italy, it is normal for the ' glyph to be placed after the upper case E when a brand owner wishes to register a word mark that should be pronounced with an acute accent. This may be explained by the fact that you won't find an uppercase È on an Italian keyboard.

[...]

11. It is my belief that the use of the word BISCAFFÈ would amount to use of the word mark BISCAFFE' in a form differing in elements which do not alter the distinctive character of the mark applied for.”

40. Firstly, when considering the likely reaction of the average consumer to trade marks, the intentions of applicants are irrelevant. Secondly, how a mark is perceived in Italy is not relevant to the perception of the UK average consumer, although what may be relevant is the perception of UK consumers who understand Italian or have an appreciation of the more common Italian words. Thirdly, variant use of a trade mark is not in issue in this case; furthermore, the average consumer in the UK is likely to be more familiar with a É accent than the use of E', not least because of the commonly used word 'café'. I am not aware of any words which end in E'.

41. I am far from convinced that the average UK consumer will automatically approximate the E' to an É in the applicant's mark. If they do, the comparison between the parties' marks is that the opponent's mark sounds like BIS-COUGH (two syllables) and the applicant's mark BIS-CAFF-AY (three syllables). If that is the case, there is a medium degree of aural similarity between the marks. The first syllable sounds identical, there is a CK sound in the middle, and a soft F sound towards the end.

42. If the operation of the ' is unknown, the applicant's mark will either be pronounced as two syllables, BIS-CAFF, or three syllables: BIS-CAFF-EE. In the latter scenario, there will be a medium degree of similarity for the reasons already given. If only the

two syllables BIS-CAFF will be heard, there is a high degree of aural similarity, the only difference arising from the different vowels in the second syllables, O and A.

43. The applicant's other witness, James McAllister, has filed evidence aimed at proving how the average consumer will perceive the parties' marks; in particular that the average consumer will perceive the opponent's mark as containing the word SCOFF. Mr McAllister exhibits a copy of dictionary entries for 'scoff' and 'bickie'.¹² He exhibits the first page of the results of a Google search conducted on 14 October 2021 for 'scoff biscuits', which shows a 'Scoff Me' slab created by a third party. Mr McAllister states that the link is no longer available, but the item appears on a Pinterest site as being loaded with Lotus Biscoff biscuits and spread.¹³

44. Mr McAllister says that this "[...] play on words relies on the consumer being familiar with the slang verb Scoff." A play on words requires some effort. Simply because the creator of a cake using Biscoff products has contrived a play on words does not mean that average consumers, paying a low to medium degree of attention at the most to the purchase, will pick out SCOFF from BISCOFF.

45. Exhibit JM5 comprises screenshots from after the relevant date from a UK website displaying a third-party fudge slab called 'BIS SCOFF':



Slab Artisan Fudge

Bis Scoff Fudge Slab – Vegan (Ltd Edition)

[See the wholesale price](#)

Suggested retail price: £3.80

Out of stock

Shipped between 04/05/2022 and 06/05/2022

Vegan

Description

Made with caramelised biscuit spread and pieces.
(See Below for Ingredients/Allergens)

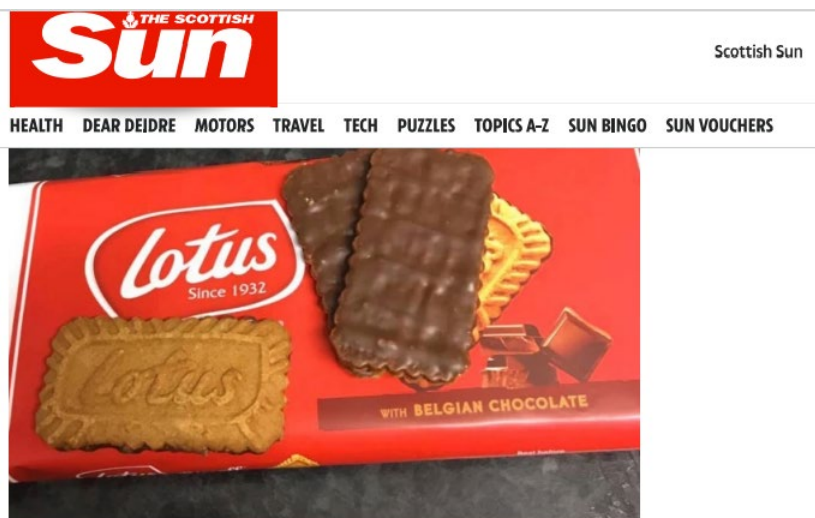
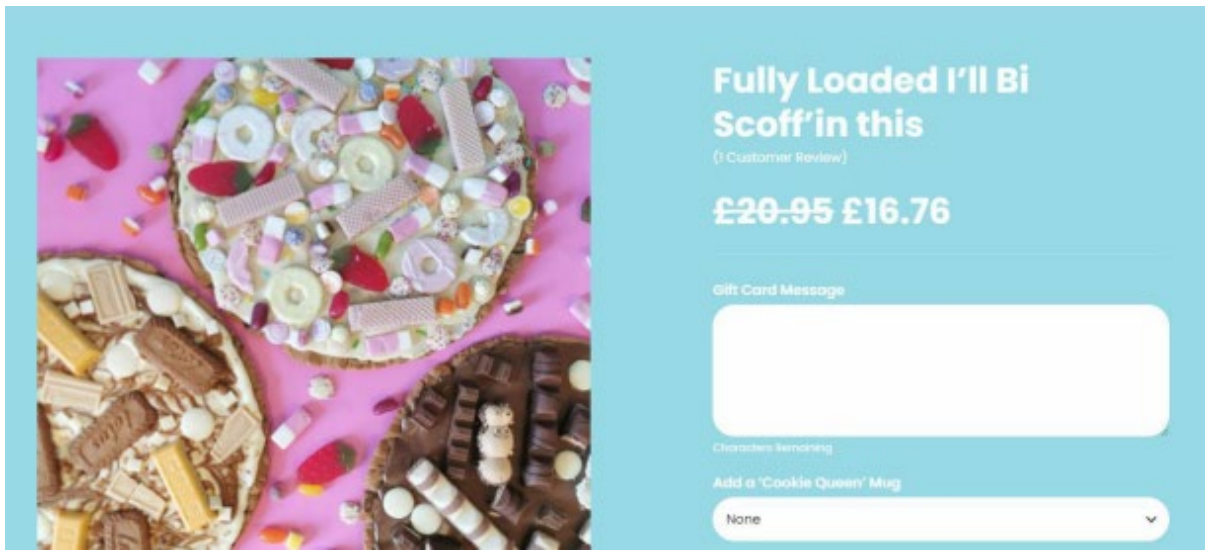
INGREDIENTS – Sugar, organic dairy free white chocolate, alte

¹² Exhibits JM1 and JM2, Collins English Dictionary, 2011 version.

¹³ Exhibits JM3 and JM4.

46. Mr McAllister states that there is an intention to emphasise the SCOFF element by capitalising it on the depiction of the caramelised biscuits on the packaging. This is also a contrived play on words by a third party. It is not indicative of the perception of average consumers during the purchasing process.

47. The remainder of Mr McAllister’s evidence continues in a similar vein, including a journalist’s play on words, a common practice in tabloid headlines; e.g.



Money > Shopping

SCOFF THE LOT Asda and Poundland are selling Lotus biscuits covered in chocolate

Levi Winchester, Senior Digital Consumer Reporter
11:20, 23 Feb 2020 Updated: 12:37, 28 Feb 2020

48. I note that the applicant’s submissions contain a reference to a section of the Registrar’s Examination Work Manual, which it has highlighted in bold:

“Non-English Words which resemble English Descriptive Words

The more closely a non-English descriptive word resembles its English equivalent, the more likely it is that its descriptive significance will be understood by the consumer. **So for example, the Italian word ‘caffè’ should be rejected as a trade mark for coffee because the average UK consumer of coffee would be likely to see that it simply means ‘coffee’.**”

49. The applicant’s mark does not consist of ‘caffè’, but it does contain these letters as the second syllable of the mark. Although the average consumer normally perceives marks as wholes, it may be the case that the construction of the mark causes the average consumer to recognise elements which suggest a concrete meaning or which resemble known words: see *Usinor SA v OHIM*, Case T-189/05, GC, paragraph 62.

50. This could apply to both parties’ marks (for the reasons given above, the applicant’s evidence about the earlier mark does not prove this point). I am not bound by the entry in the Work Manual. However, I will proceed as follows. If the applicant’s mark evokes coffee, that is a concept which is absent from the earlier mark, whether or not SCOFF is recognised in the earlier mark. If SCOFF is recognised in the earlier mark, but CAFFE is not in the later mark, that is also a concept absent from the later mark. Both of these scenarios mean the marks are not conceptually similar. If both marks are seen as invented words with no concept, they are conceptually neutral. The ‘glyph’, as the applicant refers to the small vertical line in its mark, will either make no difference if its meaning is unknown to the average UK consumer, or it will reinforce the CAFFE concept, if as the applicant submits, it will be perceived as operating like an acute accent over the E.

Distinctive character of the earlier mark

51. 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.¹⁴

¹⁴ *Sabel BV v Puma AG*, Case C-251/95.

I will begin by considering the inherent distinctive character of the earlier mark before looking at the use that the opponent has made of its mark.

52. I have found that the earlier mark is invented. Even if one took the view that it evokes SCOFF, the mark as a whole does not describe or allude to the goods or a characteristic thereof. It has a high level of inherent distinctive character.

53. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

54. Exhibit SVN1 to Ms Van Nevel’s witness statement comprises pages from the opponent’s Annual Reports from 2015 to 2020 which relate to the opponent’s business in the UK. The relevant date for the opponent to prove enhanced distinctiveness is prior to 29 May 2020, the EU filing date of the opposed application, as set out at the beginning of this decision. Ms Van Nevel draws attention to the following:

- BISCOFF products have a caramelised biscuit flavour;
- BISCOFF spread was introduced to the UK market in 2014 and in 2019 the opponent launched its BISCOFF ice cream in the UK;

- 52% of the opponent's turnover originates from sales of BISCOFF-branded products;¹⁵
- UK turnover for the opponent in 2017 was €101,321,000; in 2018 was €116,229,000; and in 2019 was €137,557,000;¹⁶
- in 2017, a TV campaign for LOTUS BISCOFF reached almost 20 million UK households, leading to a 25% increase in sales in 2018. ¹⁷ Another TV advertisement ran in June 2019 on Channel 5, Film 4, More 4 and Sky 1 and 2.

55. Exhibit SVN9 comprises an article in the Belfast Telegraph from 3 June 2014, reporting: “Crack in a jar’ Biscoff craze is spreading” and “it has become a firm favourite in the UK with sales of the sweet treat increasing by 529 per cent in Sainsbury’s over the last year – while the crunchier version has seen a 276 per cent rise.” There was an article, dated 16 October 2019, about a Biscoff-themed wedding in the UK-based online publication, tyler.com, part of the LADBible group. The first sentence of the article begins “It’s no secret that Lotus Biscoff has a pretty cult following. People are obsessed with the little caramelised treats.”¹⁸

56. Exhibit SVN5 comprises an article dated 22 February 2019 from the *Metro* newspaper, saying that the BISCOFF brand has “swept the UK”, and referring to the biscuits, spreads, ice creams, and a collaboration between the opponent and Krispy Kreme to create a BISCOFF doughnut. According to a YouGov poll, dated in 2021 but which Ms Van Nevel states used data which started in 2018, BISCOFF was ranked 93rd of the most popular confectionaries in the UK.

57. Ms Van Nevel states that BISCOFF products are available at retailers and locations such as Sainsbury, Asda, Morrisons, Tesco and the NHS. She exhibits some invoices from the opponent to these entities at Exhibit SVN13 from 2016 to 2020 which are for BISCOFF goods.

¹⁵ Exhibit SVN1, page 28.

¹⁶ Exhibit SVN2, annual reports

¹⁷ Exhibit SVN1, page 14.

¹⁸ Exhibit SVN8.

58. I find that the opponent's evidence amply demonstrates that the earlier mark strongly identifies the following goods: *Biscuits; confectionery; fondants (confectionery); speculoos (caramelized biscuits); spreads on the basis of biscuits, speculoos (caramelized biscuits); ice-cream*. The inherent distinctiveness of the mark, already high, had been elevated further through use by the relevant date for these goods. Even if I am wrong about the high inherent distinctive character, it would be at least medium and still elevated to a high level for these goods.

Likelihood of confusion

59. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, the parties' goods are either identical (*Biscuits, pastry and confectionery; Preparations made from cereals; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Fruit cake snacks; Edible ices; Ice*), highly similar (*Cereal-based snack food; Snack bars containing a mixture of cereals, nuts and dried fruit; Rice-based snack food; Rice cake snacks; Honey, treacles*), similar to a medium degree (*Preparations made from bread, bread substitutes and other bread products; Cake mixes*), or not similar (*Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices*).

60. If goods are not similar, there can be no likelihood of confusion, *per Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*¹⁹ The section 5(2)(b) ground of opposition fails in respect of:

¹⁹ "22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices.

61. Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind.²⁰ I find that there is a likelihood of direct confusion in respect of all of the other goods in the application. The marks are highly similar visually and are predominantly purchased visually, with no more than a medium, and in some cases a low, degree of attention paid to the purchase. If no concept arises from either mark, they are conceptually neutral. This means that there is no concept operating to counteract the high degree of visual (and medium or high aural) similarity.

62. I note that in *Nokia Oyj v OHIM*, Case T-460/07, where there was a pronounced conceptual difference, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

63. In *Diramode S.A. v Richard Turnham and Linda Ann Turnham*, BL O/566/19, Mr Geoffrey Hobbs KC, sitting as the Appointed Person, having quoted from the CJEU’s judgment in *Wolf Oil Corp. v. EUIPO*, Case C-437/16 P, observed;

“28. The Court thus emphasised that there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to ‘a *finding of the*

²⁰ *Lloyd Schuhfabrik Meyer*, at [26].

conceptual differences between the signs at issue’ and the second being directed to ‘*assessment of the degree of conceptual differences*’ with a view to determining whether they ‘*may lead to the neutralisation of visual and phonetic similarities*’.”

64. Even if one or both marks evokes SCOFF and/or CAFFE (coffee or café), these are unlikely to be strong evocations because of BI/BIS- at the beginning, which makes no sense and is not a separate element. There will still be a likelihood of confusion arising from imperfect recollection of visually highly similar marks, one of which has a high degree of distinctive character when no more than a medium, and in some cases a low, degree of attention is paid in what is a predominantly visual purchase.

65. If the applicant’s submission that consumers will notice the difference between the marks because its mark will evoke CAFFE, meaning coffee, is right, there is also a likelihood of indirect confusion in relation to goods in the application which could be coffee-flavoured (aside from coffee itself, which is not similar to the opponent’s goods). The opponent’s reputation in its mark indicates a strong attachment by average consumers to the caramel flavour of the goods, leading to an assumption that the applicant’s mark is a brand extension by the opponent to goods which have a coffee flavour: *Biscuits, pastry and confectionery; Preparations made from cereals; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Fruit cake snacks; Edible ices; Cereal-based snack food; Snack bars containing a mixture of cereals, nuts and dried fruit; Rice-based snack food; Rice cake snacks; Preparations made from bread, bread substitutes and other bread products; Cake mixes.*²¹

66. There is a likelihood of confusion in respect of *preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack*

²¹ For an explanation of indirect confusion, see the decision of Mr Iain Purvis KC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10.

bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles; Ice.

67. As part of its concession that some of its goods are identical or similar to those of the earlier mark, the applicant says:

“In this regard, the Applicant reserves its right to qualify these more general categories so as to exclude (similarity with) the Opponent’s goods.”

68. No suggested fallback specification has been made by the applicant. I note the content of Tribunal Practice Notice 1/2012, paragraph 3.2.2(d), in particular:

“[...] where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal.”

69. It is not clear to me how avoiding similarity would be achieved and the above extract from the TPN appears apposite. I decline to provide an opportunity for the applicant’s specification to be revised.

Section 5(2)(b) outcome

70. The section 5(2)(b) ground of opposition fails in respect of *Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices.*

71. The section 5(2)(b) ground of opposition succeeds in respect of *preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa*

based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles; Ice.

Section 5(3) of the Act

72. Section 5(3) 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

73. 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 C-383/12 P, *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 on 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*).

74. For a successful claim under section 5(3), cumulative conditions must be satisfied by the opponent: similarity between the marks; a qualifying reputation in the earlier mark; a link between the marks (the earlier mark will be brought to mind on seeing the later mark); and one (or more) of the claimed types of damage. It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

75. The first condition of similarity between the marks is satisfied, as found earlier in this decision.

76. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

“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."

77. Reputation is a knowledge threshold.²² The earlier mark has a substantial reputation in the UK for *Biscuits; confectionery; fondants (confectionery); speculoos (caramelized biscuits); spreads on the basis of biscuits, speculoos (caramelized biscuits); ice-cream*. There is insufficient evidence regarding the remainder of the specification to find a reputation for goods other than these.

78. As noted in the caselaw summary above, my assessment of whether the public will make the required mental 'link' between the earlier marks and the application must take account of all relevant factors. I bear in mind that the opponent's reputation in its mark is for a narrower range of goods than those which I considered on the basis of notional and fair use under section 5(2)(b) of the Act. Taking into account the similarities between the goods for which the opponent has a strong reputation in its highly distinctive mark and the applicant's goods, I find there will be a link in relation to the goods of the application for which I found a likelihood of confusion except for *ice*. That leaves: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes;*

²² See the judgment of HH Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at paragraph 69: "(6) Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria."

Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.

79. Although a likelihood of confusion is not necessary to find that there is a link, I find that there will be no link in respect of *tea, sugar, rice, tapioca, sago, Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.*²³ The goods are too different and the reputation of the earlier mark includes the caramel biscuit flavour for which the goods are known and for which they have become popular. Caramel is unlikely to be a feature or flavour of these goods. Without a link, there will be no damage. The section 5(3) ground of opposition fails in respect of *tea, sugar, rice, tapioca, sago, Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice.*

80. Taking into account the high level of distinctiveness and the strong reputation of the earlier mark, together with the similarities between the marks, I find that there will be a link between the parties' marks in respect of *Coffee, cocoa, coffee substitutes.* These goods could, and often do, have a caramel flavour.

81. Having found that there is a link in respect of *Coffee, cocoa, coffee substitutes; preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles,* I will assess whether any of the opponent's claims of damage are made out.

82. The opponent's TM7 notice of opposition ticked 'yes' to question 3 "Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?"

²³ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, CJEU

The opponent also said “Please see paragraphs 9 to 16 of accompanying Statement of Grounds”. It said the same in answer to the questions as to whether the opponent was claiming damage caused by unfair advantage, and detriment to the distinctive character and repute of the earlier mark.²⁴

83. Paragraphs 9 to 16 of the opponent’s Statement of Grounds claim:

“9. On the basis of Section 5(3) of the Act, the Opponent also relies on its reputation in the Earlier Mark UK00801442811 (hereinafter the “BISCOFF Mark”) for all of the Opponent’s Goods set out above (hereinafter ‘the Reputation Goods’).

10. As will be shown in evidence, through extensive use, the Opponent has acquired a valuable reputation in respect of the Reputation Goods offered under the BISCOFF Mark in the United Kingdom.

11. We submit that the use of the trade mark the subject of the Application would, without due cause, take unfair advantage of or be detrimental to the distinctive character of the BISCOFF Mark, contrary to Section 5(3) of the Act.

12. We submit that the Reputation Goods which are provided by the Opponent under the BISCOFF Mark are immediately recognisable as those of the Opponent and the potential for confusion in the marketplace could lead to detriment to the distinctive character of the Opponent’s Trade Mark. Consumers and potential consumers would be confused into believing that the Opposed Goods are the Reputation Goods of the Opponent, or that there is an association or other economic link between the Opponent and the Applicant.

13. There is a risk that use of the trade mark the subject of the Application by the Applicant would lead the Opponent’s customers or potential customers to believe that the goods of the Applicant come from the Opponent or that the goods are from an entity which is economically linked. This could lead to an

²⁴ Questions 4, 5 and 6.

unfair advantage to the Applicant, who would benefit from increased sales without the need to invest in the same amount of marketing and would therefore be riding on the coat-tails of the Opponent's reputation.

14. Additionally, this could potentially result in damage to the Opponent's business. For example, confusion as to the origin of the goods could lead to a loss of sales for the Opponent as customers may buy goods from the Applicant mistakenly believing they are buying the Opponent's Goods. In the event of any variation of quality of the goods provided by the Applicant, there will be a detriment to the Opponent's reputation and a loss of sales for the Opponent's business.

15. Use of the trade mark the subject of the Application by the Applicant will also inevitably erode the distinctive character of the Opponent's earlier rights, diminishing the ability of the Opponent's BISCOFF Mark to act as a clear indicator of trade origin.

16. Accordingly, use of the trade mark the subject of the Application would take unfair advantage of, or be detrimental to the distinctive character and reputation of the BISCOFF Mark of the Opponent."

84. Paragraphs 12 to 15 explain why the opponent claims the three types of damage will arise. Paragraphs 12 and 15 explain the reasons for the claim of detriment to distinctive character. Paragraph 14 explains the reason for the claim of detriment to repute. Paragraph 13 explains the reason for the claim of unfair advantage. The latter is entirely predicated upon the opponent's customers or potential customers believing that the applicant's goods are those of the opponent or of an undertaking economically linked to the opponent. There does not, therefore, appear to me to be any unfair advantage pleading over and above the circumstances described in question 3 of the Form TM7, as quoted above. There is no separately pleaded image transfer claim. Consequently, this head of damage is not made out in relation to those goods in the applicant's specification that I have found to be dissimilar and does not take the opponent any further than its section 5(2)(b) claim.

85. The same applies to the first half of the opponent's pleadings regarding detriment to repute, at paragraph 14 of its Statement of Grounds. The other half of the paragraph speculates that there would be detriment to repute if the applicant's goods were of a different quality to those of the opponent (presumably, poorer quality). Speculation about poor quality goods harming the earlier mark, when there is no evidence that the later mark has been used, is not a basis for a claim to detriment to repute.²⁵

85. Although not particularly well expressed, I consider that the opponent's claim to detriment to distinctive character, in paragraph 15 of its Statement of Grounds, is properly pleaded. As set out in *Intel*, detriment to the distinctive character of an 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. Any finding in favour of the opponent must not be the result of mere suppositions. Whilst the opponent does not have to provide evidence of actual detriment, there must be a serious risk of such detriment arising from logical deduction. In *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch), Henderson J. held that a change in consumers' economic behaviour could be inferred from the inherent probabilities of the situation. He said:

"133. Is there evidence of a change in economic behaviour brought about by the use of the Vegas signs? In the nature of things, direct evidence of such a change is likely to be hard to find in cases of the present type, although Mrs F provides a suggestive example of a customer who was nearly persuaded to change her allegiance as a result of a perceived connection between 32Red and 32Vegas. However, I see no reason why I should not have regard to the inherent probabilities of the situation, and in particular to the contrast between the marketing models of the two casinos. The similarity of their names, and the fact that 32Vegas was always operated as one of a number of linked casinos on the carousel model, lead me to conclude that an average online gambler would have been far readier to switch his allegiance from 32Red to 32Vegas,

²⁵ *Champagne Louis Roederer v J Garcia Carrion S.A. & Others* [2015] EWHC 2760 (Ch) and *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni, sitting as the Appointed Person.

or to play with 32Vegas in the first place, than he would have been in the absence of such similarity. These are changes in economic behaviour, and I am satisfied on the balance of probabilities that such changes are likely to have occurred to a significant extent.”

86. There will be detriment to distinctive character for the applicant’s goods for which there is a likelihood of confusion, except for *ice*, because confusion necessarily means that the earlier mark’s ability to identify the goods for which it has a reputation is weakened. The opponent’s evidence shows a strong market position, with a clear sales and marketing strategy based on goods with a caramelised biscuit flavour, so much so that the evidence suggests BISCOFF has something of a cult status. It is a logical deduction from that evidence that the presence on the market of another mark, highly visually similar, for *coffee*, *cocoa* and *coffee substitutes*, which can be and often are caramel flavoured, will weaken the hold of BISCOFF on the mind of the public, damaging its ability to create an immediate association with the opponent. That is likely to affect the functions of the earlier mark, including the origin and advertising functions, which enable it to attract and retain customers. This is seriously likely to result in an eventual change in the economic behaviour of the opponent’s customers and potential customers. BISCOFF will stand out less from the crowd and consumers will therefore be less likely to select BISCOFF goods.

Section 5(3) outcome

87. The section 5(3) claim to detriment to distinctive character succeeds in relation to *Coffee, cocoa, coffee substitutes; preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles.*

Section 5(4)(a)

88. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

89. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

90. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

91. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

92. In a case where the contested mark is unused, it is the date when the application was made for the contested mark (in this case, 29 May 2020) which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.²⁶ The applicant has not filed evidence that it has used its mark, which means that the relevant date is 29 May 2020. The opponent must show that it had sufficient goodwill at that date to bring the claim. I consider that it has shown evidence of a substantial goodwill in relation to the goods for which I found enhanced distinctive character and a reputation. There is no, or insufficient, evidence in relation to the other goods of the earlier mark's specification.

²⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander KC, sitting as the Appointed Person.

93. Although the average consumer test is not strictly the same as the 'substantial number' test, in the light of the Court of Appeal's judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. I find that there would be misrepresentation in respect of all of the applicant's goods for which I found a likelihood of confusion, save for *ice*. Edible ice is covered by notional and fair use of the registered specification, but the opponent does not have goodwill in relation to edible ice, which is simply frozen water.

94. I also find that misrepresentation would occur in relation to *coffee, cocoa, coffee substitutes*. Although I found that these goods were not similar according to the caselaw for assessing a likelihood of confusion under section 5(2)(b), these are goods which can be, and often are, caramel flavoured, which is a large part of what moves consumers to buy the opponent's goods. They are near enough to the opponent's field of commercial activity that a substantial number of the opponent's customers or potential customers will be misled into purchasing the applicant's goods, believing them to be the opponent's goods.²⁷ However, the remainder of the applicant's goods, *tea, sugar, rice, tapioca, sago, Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices; Ice*, are further removed from the goods for which the opponent has goodwill and the nature of that goodwill. I find that the ground is not made out for these goods.

95. Damage will follow as a result of misrepresentation; for example, by loss of trade or dissatisfactory quality of the applicant's goods. The section 5(4)(a) ground succeeds in relation to *Coffee, cocoa, coffee substitutes; preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake*

²⁷ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J.

snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles.

Overall outcome

96. The opposition partially succeeds. The application is refused for:

Coffee, cocoa, coffee substitutes; preparations made from cereals, bread, bread substitutes and other bread products; Cereal-based snack food; Biscuits, pastry and confectionery; Chocolate and chocolate-based products or products containing chocolate; Bakery goods; Chocolate creams; Cocoa based creams in the form of spreads; Rice-based snack food; Rice cake snacks; Fruit cake snacks; Snack bars containing a mixture of cereals, nuts and dried fruit; Cake mixes; Edible ices; Honey, treacles; Ice.

97. The opposition fails in respect of the following goods, for which the application may proceed to registration:

Tea, sugar, rice, tapioca, sago, Flour; Pizzas and preparations for pizzas; Yeast, baking-powder; Salt, mustard; Vinegar, sauces (condiments); Spices.

Costs

98. The opponent has had the greater share of success and is entitled to a contribution towards its costs, reduced to take account of the measure of success on the part of the applicant. Awards of costs are governed by Tribunal Practice Notice 2/2016. I award costs as follows:

Statutory fee for the opposition	£200
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Preparing a statement and considering the counterstatement	£350
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Preparing evidence and considering

the applicant's evidence	£1000
Written submissions in lieu of a hearing	£350
Less 25%	£475
Total	£1425

99. I order Barilla G. e R. Fratelli-Società Per Azioni to pay to Lotus Bakeries, naamloze vennootschap the sum of **£1425**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of September 2022

Judi Pike
For the Registrar