

**O/0235/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL  
REGISTRATION NO. 1595652  
IN THE NAME OF THE GOOD TASTE ANGELS GMBH**

**FOR THE TRADE MARK**

**ROASTCLUB**

**IN CLASSES 3, 7, 8, 11, 21,  
29, 30 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 431219  
BY IKER ZAGO**

## BACKGROUND AND PLEADINGS

1. On 20 April 2021, International Registration (“IR”) No. 1595652 was registered for the word mark shown on the cover page of this decision, based on Australian Trade Mark No. 2139018 in classes 7, 8, 11, 21 and 35 with a priority date of 26 November 2020, and US Trade Mark No. 90342903 in classes 3, 7, 11, 21, 29, 30 and 35, with a priority date of 25 November 2020. With effect from the claimed priority dates, KRUGER ANZ PTY LIMITED (the original holder) designated the United Kingdom for protection of the mark.

2. The designation was accepted and published for opposition purposes on 19 November 2021, in respect of goods and services in classes 3, 7, 8, 11, 21, 29, 30 and 35.

3. On 22 March 2022, ownership of the designated mark was transferred by assignment to THE GOOD TASTE ANGELS GmbH (“the holder”).<sup>1</sup>

4. The designation is opposed by Iker Zago (“the opponent”). The opposition was filed on 21 February 2022 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all goods and services covered by classes 3, 7, 11, 21, 29, 30 and 35 only of the designation (but not its Class 8), as listed under paragraph 22 of this decision. The opponent relies upon the following comparable UK mark:



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<sup>1</sup> On 17 May 2022, the Tribunal wrote to the representatives of the new holder to request confirmation that the holder stood by the statement made in the counterstatement, and that it was aware of and accepted the liability for costs for the whole proceedings in the event that the opposition was successful. This was confirmed by the holder in its letter in response dated 23 May 2022.

UK trade mark registration number 918129478

Filing date: 27 September 2019

Registration date: 11 January 2020

Registered in Classes 30 and 43

Relying on all goods and services, as listed under paragraph xx of this decision.

5. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>2</sup>

6. The opponent submits that the primary, dominant and distinctive element of the earlier mark is "Roast Club", and that the contested mark is wholly contained within the opponent's mark, leading to a high level of visual and aural similarity between the signs. It submits that conceptually, the marks coincide in the identical and distinctive words "Roast Club"/"ROASTCLUB". In view of the similarity between the marks, and the identity and similarity of the opposed goods and the goods and services covered by the earlier mark, the opponent submits that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association. It submits that the designation should be refused for the opposed goods and services under Section 5(2)(b) and it requests that an award of costs be made in favour of the opponent.

7. The holder filed a counterstatement denying the claims. It submits that the conceptual, visual and aural/oral differences between the respective marks are more than sufficient to refute the claim that there exists a likelihood of confusion on the part of the public. The holder requests that the opposition is dismissed in its entirety, that the designation be allowed to proceed to grant of protected status in the UK, and that an award of costs be made in favour of the holder.

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<sup>2</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

8. Only the holder filed written submissions, which will be referred to as and where appropriate during this decision. Neither party elected to file evidence and neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

9. In these proceedings, the opponent is represented by Boulton Wade Tennant LLP and the holder is represented by Bawden & Associates.

### **Preliminary Issues**

10. In paragraph 6 of its Statement of Case, in relation to the opposed goods and services, the opponent gave a brief example of identical/similar terms within the respective specifications, but stated that “a full comparison of the goods and services will be provided during these proceedings”. The Form TM7 was served on the holder and both parties were invited to file evidence and/or written submissions. The holder duly filed written submissions, however, the opponent did not file either submissions or evidence.

11. On 19 December 2022, the Tribunal wrote to the opponent (and copied to the holder), referring to Tribunal Practice Notice (“TPN”) 1/2018, which advises that for claims under Section 5(2), where it is not self-evident why the goods and services covered by an earlier mark are claimed to be identical or similar to the opposed goods, the Tribunal may request further information. In this case, the opposition is directed against a long list of goods and services, some of which appear to be clearly dissimilar to those covered by the earlier mark.

12. The official letter explained that under Section 5(2)(b) of the Act, there can be no likelihood of confusion without the existence of similar goods and services, and it highlighted in particular paragraphs 7 – 11 of the TPN, and requested that the opponent clearly explain why it considers there to be a similarity between the goods and services being relied upon against the goods and services of the designation against which the opposition is directed.

13. The opponent was given until 19 January 2023 to respond, with the proviso that if it chose not to provide further information, or where the basis of the claimed similarity between the respective goods/services remained non-apparent, then the decision maker was likely to find dissimilarity.

14. As the opponent did not respond with any further information, I will take account of this in my decision during the comparison of goods and services.

## **DECISION**

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

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

16. Section 5(2)(b) is relied upon, which reads as follows:

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

(a) ...

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

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

17. Section 5A states:

“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.”

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

...”

19. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than five years before the priority dates claimed for the designation of the contested mark, it is not subject to the use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.

20. I am guided by the following principles which 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*

*Klijnsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”), Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

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

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

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

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

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

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

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

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

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

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

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

## **Comparison of goods and services**

21. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”



22. The goods and services to be compared are:

Opponent's goods and services	Holder's goods and services
	<p><u>Class 3</u>  <i>Cleaning agents; cleaning liquids; descaling agents for household purposes; descaling agents for coffee, tea and cocoa preparation machines; cleaning agents for coffee, tea and cocoa preparation machines; cleaning agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods; descaling agents for coffee, tea and cocoa preparation machines, packaged in individual units, in particular in capsules or pods; flavour enhancers for foodstuffs (essential oils); flavour enhancers for beverages (essential oils); flavour enhancers for foodstuff being essential oils; flavour enhancers for beverages being essential oils; flavour enhancers for coffee being essential oils.</i></p>
	<p><u>Class 7</u>  <i>Electric milk frothers; electric mixers; electric stirrers; electric whisks; coffee grinders (other than hand-operated); electric coffee grinders.</i></p>
	<p><u>Class 11</u>  <i>Electric coffee filter appliances; electric coffee machines; electric coffee percolators; electric espresso machines; electric semi-automatic coffee machines; electric fully automatic coffee machines;</i></p>

	<p><i>electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or beverage powders containing coffee, tea or cocoa; electric coffee roasters; electric coffee roasting machines; electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or coffee-containing, tea-containing or cocoa-containing beverage powder packaged in individual units - in particular in capsules or pods; parts and accessories for all the aforementioned goods; adapters for coffee, tea or cacao capsules; water filters; water filter units; water filter devices; devices for softening water; devices for heating and frothing milk; electric milk coolers; electric milk heaters.</i></p>
	<p><u>Class 21</u>  <i>Crockery; glassware; porcelain crockery; mugs (drinking vessels); glasses (drinking vessels); shakers; mixing cups; household and kitchen containers; drinking bottles; drinking vessels; insulated bottles; insulated drinking cups; insulated coffee cups; reuseable cups for takeaway; hand operated coffee grinders; non-electric coffee filters; coffee filters (other than made from paper), being part of non-electric coffee makers.</i></p>
	<p><u>Class 29</u>  <i>Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods.</i></p>

<p><u>Class 30</u> <i>Coffee; Tea.</i></p>	<p><u>Class 30</u> <i>Coffee, coffee blends, filter coffee, tea, cocoa and substitutes therefor; instant coffee; instant tea; instant cocoa; coffee substitutes; chocolate; chocolate products; confectionery; coffee drinks; tea drinks; fruit tea drinks; cocoa drinks; drinking chocolate; caffeinated, tea-based or cocoa-based beverages; caffeine-containing, cocoa-containing or chocolate-containing beverage powders; packaged coffee, tea, cocoa or coffee-containing, tea-containing or cocoa-containing beverage powder in individual units, in particular in capsules or pods; flavour enhancers for foodstuff (other than essential oils); flavour enhancers for beverages (other than essential oils); flavourings for addition to foodstuff (other than essential oils); flavourings for addition to beverages (other than essential oils).</i></p>
	<p><u>Class 35</u> <i>Wholesale and retail of the following goods (including such services provided via the internet), namely, cleaning products, cleaning liquids, descaling agents for household use, descaling agents for coffee, tea and cocoa preparation machines, cleaning agents for coffee, tea and cocoa preparation machines, cleaning agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods, descaling agents for coffee, tea and cocoa preparation</i></p>

	<p><i>machines packaged in individual units, in particular in capsules or pods, flavour enhancers for foodstuffs (essential oils), flavour enhancers for beverages (essential oils), electric milk frothers, electric stirrers, electric mixers, electric whisks, coffee grinders (other than hand-operated), electric coffee grinders, cutlery, spoons, knives, forks, electric coffee filtering appliances, electric coffee machines, electric coffee percolators, electric espresso machines, semi-automatic electric coffee machines, fully automatic electric coffee machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or beverage powders containing coffee, tea, cocoa, in individual units, in particular in capsules or pods, electric coffee roasters, electric coffee roasting machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or coffee-containing, tea-containing or cocoa-containing beverage powder packaged in individual units, in particular in capsules or pods, parts and accessories for all the aforesaid goods, adapters for coffee, tea and cacao capsules, water filters, water filter units, water filtering apparatus, apparatus for softening water, apparatus for heating and frothing milk, electric milk coolers, electric milk heaters, crockery, glassware, porcelain crockery, mugs (drinking vessels), glasses (drinking vessels),</i></p>
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	<p><i>measuring spoons, shakers, mixing cups, containers for household and kitchen, drinking bottles, drinking vessels, vacuum flasks, insulated drinking cups, insulated coffee cups, reuseable cups for takeaway, manually operated coffee grinders, coffee filters (not made of paper), milk, milk products, milk powder, coffee whiteners for beverages, milk powder packaged in individual units, in particular in capsules or pods, coffee, coffee blends, tea, cocoa and substitutes thereof, instant coffee, instant tea, instant cocoa, coffee substitutes, chocolate, chocolate products, confectionery, coffee beverages, tea beverages, fruit tea beverages, cocoa beverages, drinking chocolate, caffeinated, tea-containing or cocoa-containing beverages, caffeinated, cocoa-containing or chocolate-containing beverage powders, packaged coffee, tea, cocoa or beverage powders containing coffee, tea or cocoa, flavour enhancers for foodstuffs, flavour enhancers for beverages, flavourings for addition to foodstuffs, flavourings for addition to beverages; retail services relating to subscription boxes containing coffee, tea or cocoa.</i></p>
<p><u>Class 43</u>  <i>Services for providing food and drink; Self-service cafeteria services; Restaurant services.</i></p>	

23. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.<sup>3</sup>

24. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.<sup>4</sup>

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

26. 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 OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...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”.<sup>5</sup>

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<sup>3</sup> Paragraph 29

<sup>4</sup> Paragraph 23

<sup>5</sup> Paragraph 82

27. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”<sup>6</sup>

28. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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.”<sup>7</sup>

29. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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<sup>6</sup> Paragraph 5

<sup>7</sup> Paragraph 12

30. In its Statement of Case, the opponent submits that the contested goods and services include the identical terms “*tea*” and “*coffee*” in Class 30, and terms in Classes 3, 7, 11, 21, 29, 30 and 35 that are similar to the goods and services covered by the registration, being substitutes for, connected to, used with or alongside, or relate to, tea and coffee.

31. In its counterstatement, and as referred to in its written submissions, the holder admits that the goods “*Coffee; Tea*” in Class 30 of the opponent’s registration are identical to “*Coffee*” and “*tea*” in Class 30 of the designation, but it submits that other of its Class 30 goods are neither identical nor similar in real terms to “*Coffee*” and “*tea*”. It further submits that none of the remaining goods listed under classes 3, 7, 11, 21 and 29 of the opposed designation “come anywhere close to being ‘similar’ in any respect to the Class 30 goods or Class 43 services of the opponent’s earlier registration”.<sup>8</sup>

32. As mentioned under the Preliminary issues heading of this decision, the opponent was invited to clarify what it considered to be the similarities between the respective goods and services, but it declined to provide any such comparison.<sup>9</sup> In *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.<sup>10</sup> Consequently, in the absence of evidence to the contrary, where I consider that the goods and services are neither identical nor self-evidently similar, I am obliged to make a finding of dissimilarity for the goods and services at issue.

33. In making my comparisons, I am mindful of the fact that the appearance of respective goods and services in the same class is not sufficient in itself to find similarity between those goods and services, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

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<sup>8</sup> See B 4(i) – 4(v) of the holder’s written submissions dated 23 September 2022.

<sup>9</sup> See paragraphs 10-14 of this decision.

<sup>10</sup> Paragraph 20



Class 3, Class 7, Class 11, Class 21

34. All of the goods covered by the above classes of the designation, as listed earlier under paragraph 22, are likely to be used either in conjunction with the opponent's goods in Class 30, being "*Coffee; Tea*", and/or in the course of providing the opponent's services under Class 43, being "*Services for providing food and drink; Self-service cafeteria services; Restaurant services*". For example, Class 3 includes "*descaling agents for coffee, tea and cocoa preparation machines*"; Class 7 includes "*electric coffee grinders*"; Class 11 includes "*electric coffee machines*"; and Class 21 includes "*Crockery*". However, I do not consider that any of the contested goods in these classes are similar in purpose, nature or method of use to any of the opponent's goods and services. I have no evidence to show that the providers of any of the contested goods in these classes commonly trade in either coffee or tea, or would provide the related catering services. As per *Boston Scientific*, I do not consider the holder's goods to be complementary to the opponent's goods and services in a trade mark sense. Further, as Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."<sup>11</sup>

In view of the above, I find all of the holder's goods under classes 3, 7, 11 and 21 to be dissimilar to the opponent's "*Coffee; Tea*" in Class 30 and its "*Services for providing food and drink; Self-service cafeteria services; Restaurant services*" in Class 43.

Class 29

*Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods.*

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<sup>11</sup> Paragraph 18

35. I consider the processes involved in producing the holder's "*Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods*" to be very different to those concerned with the production of the opponent's "*Coffee; Tea*" in Class 30. As such, I consider that each would be provided by different specialist producers. The respective goods are not in competition, and again, I do not consider them to be complementary to each other in a trade mark sense. Although milk products at large may share a general purpose with tea and coffee in that they are all beverages/used with other beverages for human consumption, I do not consider the link sufficient for a finding of similarity between the goods. While the earlier "*Services for providing food and drink; Self-service cafeteria services; Restaurant services*" are likely to utilise the various milk products in the provision of the services, again, this is not sufficient for me to find similarity. Overall, in the absence of evidence to the contrary, I find the holder's "*Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods*" dissimilar to the earlier goods and services being relied upon by the opponent.

### Class 30

*Coffee, coffee blends, filter coffee, tea, ... ; instant coffee; instant tea; coffee drinks; tea drinks; fruit tea drinks; caffeinated, tea-based ... beverages; packaged coffee, tea, ... or coffee-containing, tea-containing ... beverage powder in individual units, in particular in capsules or pods.*

36. The holder has admitted identity between the opponent's "*Coffee; Tea*" and its own same named goods "Coffee" and "tea" in Class 30. I consider that all of the above goods would fall into the category of tea or coffee, and are therefore identical.

*cocoa and substitutes therefor; instant cocoa; coffee substitutes; cocoa drinks; drinking chocolate; cocoa-based beverages; caffeine-containing, cocoa-containing or chocolate-containing beverage powders; cocoa or cocoa-containing beverage powder in individual units, in particular in capsules or pods.*

37. With regard to the aforementioned goods, I disagree with the holder that they are dissimilar to the opponent's "*Coffee; Tea*". In my view, although goods such as "*cocoa and substitutes therefor*" may also be used in cooking, they are commonly used to

make both hot and cold drinks, and as such, they are similar in nature to the earlier beverages, with the same purpose of hydration and/or quenching thirst, and they share the same channels of trade. I also consider the respective goods to be in competition with each other, as the consumer may be one and the same, and who may choose on any given occasion which drink they prefer to partake, be that tea, coffee, cocoa/chocolate or other beverage. I consider the holder's "*cocoa and substitutes therefor; instant cocoa; coffee substitutes; cocoa drinks; drinking chocolate; cocoa-based beverages; caffeine-containing, cocoa-containing or chocolate-containing beverage powders; cocoa or cocoa-containing beverage powder in individual units, in particular in capsules or pods*" to be similar to the opponent's "*Coffee; Tea*" to a high degree.

*chocolate; chocolate products; confectionery*

38. While both sets of goods may be consumed solely for pleasure, the fundamental way in which the holder's "*chocolate; chocolate products; confectionery*" are ingested is different to the way in which the opponent's "*Coffee; Tea*" are partaken, and they each fulfil different needs i.e. hunger versus thirst. The opposing goods are therefore selected for different purposes, and they differ as to their physical nature. I do not consider that the holder's goods are either complementary to, or in competition with the opponent's goods. Although I recognise that the goods are both likely to be found through the same or similar trade channels, they are unlikely to be positioned side by side on supermarket shelves. In *Monster Energy Company v OHIM*, Case T-736/14, the GC upheld that there was no similarity between coffee based beverages and confectionary/sweets resulting from the fact that the goods at issue are sold in the same commercial establishments, share the same distribution channels and are intended for the same consumers.<sup>12</sup> Taking all of the above factors into account, I find no similarity between the holder's "*chocolate; chocolate products; confectionery*" and the earlier "*Coffee; Tea*".

*flavour enhancers for foodstuff (other than essential oils); flavour enhancers for beverages (other than essential oils); flavourings for addition to foodstuff (other than essential oils); flavourings for addition to beverages (other than essential oils).*

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<sup>12</sup> At [30].

39. While the above goods may be added to “*Coffee; Tea*”, I consider them to be different in purpose and core nature, and they are not complementary to the extent that the average consumer would expect them to originate from the same undertaking. Overall, I consider “*flavour enhancers for foodstuff (other than essential oils); flavour enhancers for beverages (other than essential oils); flavourings for addition to foodstuff (other than essential oils); flavourings for addition to beverages (other than essential oils)*” to be dissimilar to the opponent’s “*Coffee; Tea*”.

### Class 35

40. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

41. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

42. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>13</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>14</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>15</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

43. It is clear from the case law that in all instances where the holder's retail services are to be compared with the opponent's goods, the retail services will be different in nature, purpose and method of use to those goods. However, for a finding of similarity between the holder's services and the opponent's goods, the goods being retailed by the holder do not need to be exactly the same as the opponent's goods. Therefore, I am able to find similarity in respect of the goods and the retail services at issue, providing that there is some complementarity and/or shared trade channels. It is

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<sup>13</sup> Case C-411/13 P

<sup>14</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment.

<sup>15</sup> Case C-398/07 P

equally clear that a finding of complementarity does not necessarily mean that the goods and retail services are similar if the consumer would find it unlikely for them to be offered by the same undertaking. I also note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

*Wholesale and retail of the following goods (including such services provided via the internet), namely, coffee, coffee blends, tea, instant coffee; instant tea; coffee beverages; tea beverages; fruit tea beverages; caffeinated, tea-containing beverages; packaged coffee, tea, or beverage powders containing coffee, tea.*

44. Taking the guidance set out above into account, I find the contested "*Wholesale and retail of the following goods (including such services provided via the internet), namely coffee, coffee blends, tea, instant coffee; instant tea; coffee beverages; tea beverages; fruit tea beverages; caffeinated, tea-containing beverages; packaged coffee, tea, or beverage powders containing coffee, tea*" to be similar to the opponent's "*Coffee; Tea*" to a medium degree.

45. For the same reasons as given above in paragraph 44, I consider the contested "*retail services relating to subscription boxes containing coffee, tea*" to be similar to the opponent's "*Coffee; Tea*" to a medium degree.

*Wholesale and retail of the following goods (including such services provided via the internet), namely, cocoa and substitutes thereof, instant cocoa, coffee substitutes, cocoa beverages, drinking chocolate, cocoa-containing beverages, caffeinated, cocoa-containing or chocolate-containing beverage powders, cocoa or beverage powders containing cocoa.*

46. Earlier in this decision, I found the holder's various cocoa based goods to be similar to the opponent's "*Coffee; Tea*" to a high degree. As per Mr Hobbs conclusions in *Tony Van Gulck*, while the holder's aforementioned retail services are not for the exact same goods as registered under the earlier mark, I consider there to be an overlap in channels of trade. Consequently, I consider "*Wholesale and retail of the following goods (including such services provided via the internet), namely, cocoa and substitutes thereof, instant cocoa, coffee substitutes, cocoa beverages, drinking chocolate, cocoa-containing beverages, caffeinated, cocoa-containing or*

*chocolate-containing beverage powders, cocoa or beverage powders containing cocoa*” to be similar to “*Coffee; Tea*” to a low degree.

47. For the same reasons as given above in paragraph 46, I consider the holder’s “*retail services relating to subscription boxes containing cocoa*” to be similar to the opponent’s “*Coffee; Tea*” to a low degree.

*Wholesale and retail of the following goods (including such services provided via the internet), namely, milk, milk products, milk powder, coffee whiteners for beverages, milk powder packaged in individual units, in particular in capsules or pods, chocolate, chocolate products, confectionery, flavour enhancers for foodstuffs, flavour enhancers for beverages, flavourings for addition to foodstuffs, flavourings for addition to beverages.*

48. Having already found no similarity between the holder’s “*Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods; chocolate, chocolate products, confectionery; flavour enhancers for foodstuff (other than essential oils); flavour enhancers for beverages (other than essential oils); flavourings for addition to foodstuff (other than essential oils); flavourings for addition to beverages (other than essential oils)*” and the goods relied upon by the opponent, I consider the retail services for such goods, as listed above, to be dissimilar to the opponent’s “*Coffee; Tea*” in Class 30, and dissimilar to its earlier services in Class 43.

49. In paragraph 34 of this decision, I found dissimilarity between the opponent’s goods and services and all of the earlier goods as covered under classes 3, 7, 11 and 21 of the designation. In the absence of evidence to the contrary, I consider that the wholesale and retail of the holder’s same goods to be even further removed from the earlier goods and services under Class 30 and Class 43. Consequently, I find the following services to be dissimilar to the opponent’s “*Coffee; Tea*” in Class 30 and its “*Services for providing food and drink; Self-service cafeteria services; Restaurant services*” in Class 43:

*Wholesale and retail of the following goods (including such services provided via the internet), namely, cleaning products, cleaning liquids, descaling agents for household use, descaling agents for coffee, tea and cocoa preparation machines, cleaning*

*agents for coffee, tea and cocoa preparation machines, cleaning agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods, descaling agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods, flavour enhancers for foodstuffs (essential oils), flavour enhancers for beverages (essential oils), electric milk frothers, electric stirrers, electric mixers, electric whisks, coffee grinders (other than hand-operated), electric coffee grinders, cutlery, spoons, knives, forks, electric coffee filtering appliances, electric coffee machines, electric coffee percolators, electric espresso machines, semi-automatic electric coffee machines, fully automatic electric coffee machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or beverage powders containing coffee, tea, cocoa, in individual units, in particular in capsules or pods, electric coffee roasters, electric coffee roasting machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or coffee-containing, tea-containing or cocoa-containing beverage powder packaged in individual units, in particular in capsules or pods, parts and accessories for all the aforesaid goods, adapters for coffee, tea and cacao capsules, water filters, water filter units, water filtering apparatus, apparatus for softening water, apparatus for heating and frothing milk, electric milk coolers, electric milk heaters, crockery, glassware, porcelain crockery, mugs (drinking vessels), glasses (drinking vessels), measuring spoons, shakers, mixing cups, containers for household and kitchen, drinking bottles, drinking vessels, vacuum flasks, insulated drinking cups, insulated coffee cups, reuseable cups for takeaway, manually operated coffee grinders, coffee filters (not made of paper).*

50. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to



be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

51. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods and services, with the opposition failing to that extent.

### **The average consumer and the nature of the purchasing act**

52. 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. (as he was then) described the average consumer in these terms:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.<sup>16</sup>

53. 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*.

54. In my view, the average consumer for the competing goods and services will be the general public, although I do not discount business consumers, particularly those who purchase the goods and utilise the retail services for such goods in order to provide food and drink as a service.

55. The cost of the goods will be relatively low, and for some may be a relatively regular purchase, where they are likely to be self-selected from a supermarket or grocery

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<sup>16</sup> Paragraph 60

store, wholesale outlets or via the internet, and will be selected by predominantly visual means, although I do not discount oral recommendations, particularly for beverages which are ordered verbally, such as from a café or restaurant, although it is likely that the choice would be made following the visual inspection of a menu or drinks list.

56. When using the retail services at issue, the average consumer will make their choice based on the range of goods available and prices charged, customer services offered, and other factors, for example, in the case of bricks and mortar retailers, the location of a shop. These are services that the consumer will be using because they wish to purchase the goods stocked.

57. Overall, it is my view that the average consumer who is a member of the general public will pay a medium degree of attention when choosing the goods or retail services, while the professional consumer, who will purchase the goods and use the services more frequently, are likely to pay a higher degree of attention to their selection, but not to the highest degree.

### **Comparison of marks**

58. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”<sup>17</sup>

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<sup>17</sup> Paragraph 34

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

60. The respective trade marks are shown below:

Opponent's trade mark	Holder's trade mark
	<p data-bbox="963 920 1230 958"><b>ROASTCLUB</b></p>

61. In its Statement of Case, the opponent submits that the primary, dominant and distinctive element of its mark is “Roast Club”, and that although the marks contains what would be understood as the additional word “CAFE”, this is secondary to “Roast Club” as the additional word has a comparatively weaker character in the context of the goods and services, it is smaller in size, and is positioned beneath the primary “Roast Club” element. It further submits that the holder’s mark is wholly contained within the earlier mark as its primary, dominant and distinctive element, leading to a high level of visual and aural similarity, and it submits that there is conceptual identity between the competing signs.

62. The holder submits that the two marks *per se* are not actually similar at all, as they each give a very different overall impression, with the earlier mark being presented as a single word in plain block letters, whereas it submits that the opponent’s mark “is a figurative device rendered partly (in the words “Roast Club”) in quite highly stylised red

lettering, and with a differently stylised rendering of the letters “C△FE” there beneath”.<sup>18</sup>

### **Overall impression**

63. The opponent’s mark is a figurative mark which consists of the words “Roast Club” presented side by side and written in a red cursive script in title case, with the word “C△FE” written in capital letters in a light grey typeface which is centred immediately below the words “Roast Club”. To my mind, the average consumer will perceive the word “C△FE” as “CAFÉ”, notwithstanding the letter A is replaced with what appears to be an equilateral triangle, △, with the whole word presented in a smaller and different font to the two words situated above it. All three words are situated in the centre of a pale grey square border, which I consider to be a purely decorative element which serves to frame the words within and which does not add to the trade mark message conveyed by the words. As such, it does little to contribute to the overall impression of the mark, which is dominated by the words “Roast Club”, and which therefore play the greatest role in the overall impression of the mark, while the word “C△FE” plays a much lesser role, although I do not consider it would go completely unnoticed.

64. The holder’s mark is a word mark consisting of a single word “ROASTCLUB”, presented in a standard typeface in capital letters. In my view, there is a natural break between the letter T and the letter C, which would lead the average consumer to perceive it as two separate, dictionary defined words, “ROAST” and “CLUB”. In *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. ... it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-

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<sup>18</sup> See 3, 3(i) of the holder’s written submissions dated 23 September 2022.

Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)”

Neither word dominates, and as the mark contains no other elements, the overall impression therefore rests in the combined (conjoined) words.

### **Visual comparison**

65. Both parties’ trade marks consist of the same nine letters ”R O A S T C L U B”, appearing in the same order, each presented as outlined above under paragraphs 63-64. I do not consider the difference in capitalisation/title case is relevant to the visual impact, as in the case of the holder’s mark, the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. However, the words in common are conjoined in the holder’s mark, but are two separate words in the earlier mark, and the opponent’s mark contains a colour element, as well as the additional word and figurative elements as previously described, which together create a visual disparity between the marks. Considering the marks as a whole, I find there to be a medium degree of visual similarity between the two marks.

### **Aural comparison**

66. The common elements of the competing marks are the word “ROAST” and “CLUB”, which would be pronounced identically in both. The opponent’s mark has the additional word “C△FE” following the common elements. Although I consider the “C△FE” element would not be articulated by some consumers, I consider that where it is voiced by other consumers, they will pronounce it as the word “CAFÉ”. To those consumers who pronounce all the elements of the opponent’s mark, it would be articulated as four syllables, “ROHST-KLUB-KAFF-EH” (roust klʌb kæfeɪ), while the opponent’s mark will be pronounced as two syllables, “ROHST-KLUB” (roust klʌb), rendering the competing marks to be aurally similar to a medium degree. However,

to those consumers who do not articulate the additional word “C△FE” in the earlier mark, the competing marks are aurally identical.

### **Conceptual comparison**

67. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’<sup>19</sup>

68. The opponent submits that conceptually, there is identity between the competing marks which is due to the marks coinciding in the identical and distinctive words “ROAST CLUB”, or if this is not considered to be the case, then the marks are clearly highly similar conceptually.

69. The holder submits that when the words “ROASTCLUB” and “Roast Club” are taken as verbal elements alone, they have no specific recognisable meaning in English. It submits that “the relevant public would certainly not understand the words in either mark to designate a ‘club providing a meeting point for roasters’ (which could be its only conceivable meaning if one were ascribable to these words at all), since there is no such thing as a “ROAST CLUB”.<sup>20</sup> It therefore submits that the marks at issue are conceptually very different in nature and character.

70. I disagree with the submissions of the holder. I remind myself that the matter must be judged through the eyes of the average consumer of the category of products

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<sup>19</sup> Paragraph 8.

<sup>20</sup> See 3(i) of the holder’s written submissions, dated 23 September 2022.

concerned, who is deemed to be reasonably well informed and reasonably circumspect and observant.<sup>21</sup> In both the marks, the word “CLUB” is qualified by the preceding word “ROAST”. To my mind, the word “ROAST” would be understood by a significant proportion of the average consumer in the context of the marks as referring to goods such as coffee beans or cocoa beans which are heated to varying degrees in order to impart flavour and give a distinct flavour. The word “CLUB” is also likely to be understood as referring to an organisation or the place where members of the organisation meet, with a shared interest in such goods. I agree with the holder that this would not be taken as a literal reference to an actual club, but as a figurative reference to goods which may be enjoyed by the members of a metaphorical “Roast Club”.

71. Given the shared concept of the “ROAST CLUB” element of the marks, overall, I consider the marks to be conceptually similar to a high degree.

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

72. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

73. 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-

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<sup>21</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, at [26].

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).”

74. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

75. It is the distinctiveness of the common element that is important here. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, said:

“It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”<sup>22</sup>

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<sup>22</sup> Paragraph 39.



76. The distinctive character of the mark lies in its overall presentation, although as considered earlier in this decision, the mark is dominated by the dictionary defined words “Roast Club”, which play the greatest role in the overall impression of the mark, while the word “C△FE” plays a much lesser role due to its position, its smaller size and the colour contrast against the red lettering of the “Roast Club” element. It is my view that the grey square border does not significantly add to the distinctiveness of the mark, being seen merely as a frame to the words within. The words also allude to goods such as coffee and cocoa, which may be enjoyed by the members of a “Roast Club”, and in particular when those goods are provided at a café dedicated to those members, although I acknowledge that this may be seen as somewhat fanciful.

77. Overall, I consider that the earlier mark is inherently distinctive to no more than a medium degree.

### **Likelihood of confusion**

78. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

79. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

80. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

81. Earlier in this decision, I found there to be no similarity between the opponent's goods and services and the holder's goods in classes 3, 7, 11, 21 and 29 in their entirety, and I found identity/a degree of similarity for some, but not all of the holder's goods and services in classes 30 and 35.

82. I found the purchasing process to be by predominantly visual means, although I do not discount oral recommendations, where the general public will pay a medium degree of attention when choosing the goods or retail services, while the professional consumer are likely to pay a higher degree of attention to their selection, but not to the highest degree.

83. I found the competing trade marks to be visually similar to a medium degree and aurally similar to a medium degree where the opponent's mark is voiced in its entirety, although to those consumers who do not articulate the additional word "C△FE" in the earlier mark, the marks are aurally identical. Overall, I considered the marks to be conceptually similar to a high degree. I considered the earlier mark to possess no more than a medium degree of inherent distinctive character.

84. Although the average consumer views the mark as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind.

85. In my view, the consumer would be likely to recall the words "ROAST CLUB" in each of the competing marks, but be less certain about the exact presentation of the words or about the additional elements present in the earlier mark. This would be the case even taking into account the level of attention paid by the consumer during the selection process. Keeping in mind the identity/similarity between the goods and services of the marks, I find that there is a likelihood of direct confusion for those goods and services for which I found identity or similarity.

86. I accept that there will be some consumers who note the differences between the marks, therefore, taking into account the previously outlined guidance of Mr Iain Purvis

Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

87. 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.

88. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

89. Keeping in mind the global assessment of the competing factors in my decision, given that the earlier mark is dominated by the words “Roast Club”, being the element in common with the holder’s mark, it is my view that those consumers who notice the differences between the marks will conclude that they are attributable to variant brands from the same, or economically connected, undertakings. Consequently, I consider there to be a likelihood of indirect confusion in relation to all goods and services for which I found identity/similarity.

90. The opposition under section 5(2)(b) succeeds in respect of the following goods and services only:

### Class 30

*Coffee, coffee blends, filter coffee, tea, cocoa and substitutes therefor; instant coffee; instant tea; instant cocoa; coffee substitutes; coffee drinks; tea drinks; fruit tea drinks; cocoa drinks; drinking chocolate; caffeinated, tea-based or cocoa-based beverages; caffeine-containing, cocoa-containing or chocolate-containing beverage powders; packaged coffee, tea, cocoa or coffee-containing, tea-containing or cocoa-containing beverage powder in individual units, in particular in capsules or pods.*

### Class 35

*Wholesale and retail of the following goods (including such services provided via the internet), namely, coffee, coffee blends, tea, cocoa and substitutes thereof, instant coffee, instant tea, instant cocoa, coffee substitutes, coffee beverages, tea beverages, fruit tea beverages, cocoa beverages, drinking chocolate, caffeinated, tea-containing or cocoa-containing beverages, caffeinated, cocoa-containing or chocolate-containing beverage powders, packaged coffee, tea, cocoa or beverage powders containing coffee, tea or cocoa; retail services relating to subscription boxes containing coffee, tea or cocoa.*

91. The opposition fails in respect of the remaining goods and services.

## **CONCLUSION**

92. The holder has been partially successful. The IR will be refused protection for the goods and services listed above under paragraph 90, however, subject to any successful appeal, the IR will be granted protection in the UK in respect of the following goods and services only:

### Class 3

*Cleaning agents; cleaning liquids; descaling agents for household purposes; descaling agents for coffee, tea and cocoa preparation machines; cleaning agents for coffee, tea and cocoa preparation machines; cleaning agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods; descaling agents for coffee, tea and cocoa preparation machines, packaged in*

*individual units, in particular in capsules or pods; flavour enhancers for foodstuffs (essential oils); flavour enhancers for beverages (essential oils); flavour enhancers for foodstuff being essential oils; flavour enhancers for beverages being essential oils; flavour enhancers for coffee being essential oils.*

#### Class 7

*Electric milk frothers; electric mixers; electric stirrers; electric whisks; coffee grinders (other than hand-operated); electric coffee grinders.*

#### Class 8

All goods, as they were unopposed. (Namely: *Cutlery; spoons; knives; forks*).

#### Class 11

*Electric coffee filter appliances; electric coffee machines; electric coffee percolators; electric espresso machines; electric semi-automatic coffee machines; electric fully automatic coffee machines; electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or beverage powders containing coffee, tea or cocoa; electric coffee roasters; electric coffee roasting machines; electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or coffee-containing, tea-containing or cocoa-containing beverage powder packaged in individual units - in particular in capsules or pods; parts and accessories for all the aforementioned goods; adapters for coffee, tea or cacao capsules; water filters; water filter units; water filter devices; devices for softening water; devices for heating and frothing milk; electric milk coolers; electric milk heaters.*

#### Class 21

*Crockery; glassware; porcelain crockery; mugs (drinking vessels); glasses (drinking vessels); shakers; mixing cups; household and kitchen containers; drinking bottles; drinking vessels; insulated bottles; insulated drinking cups; insulated coffee cups; reuseable cups for takeaway; hand operated coffee grinders; non-electric coffee filters; coffee filters (other than made from paper), being part of non-electric coffee makers.*

### Class 29

*Milk; milk products; milk powder; coffee whitener for beverages; milk powder packaged in individual units, especially in capsules or pods.*

### Class 30

*Chocolate; chocolate products; confectionery; flavour enhancers for foodstuff (other than essential oils); flavour enhancers for beverages (other than essential oils); flavourings for addition to foodstuff (other than essential oils); flavourings for addition to beverages (other than essential oils).*

### Class 35

*Wholesale and retail of the following goods (including such services provided via the internet), namely, cleaning products, cleaning liquids, descaling agents for household use, descaling agents for coffee, tea and cocoa preparation machines, cleaning agents for coffee, tea and cocoa preparation machines, cleaning agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods, descaling agents for coffee, tea and cocoa preparation machines packaged in individual units, in particular in capsules or pods, flavour enhancers for foodstuffs (essential oils), flavour enhancers for beverages (essential oils), electric milk frothers, electric stirrers, electric mixers, electric whisks, coffee grinders (other than hand-operated), electric coffee grinders, cutlery, spoons, knives, forks, electric coffee filtering appliances, electric coffee machines, electric coffee percolators, electric espresso machines, semi-automatic electric coffee machines, fully automatic electric coffee machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or beverage powders containing coffee, tea, cocoa, in individual units, in particular in capsules or pods, electric coffee roasters, electric coffee roasting machines, electric coffee, tea and cocoa preparation machines for processing coffee, tea, cocoa, milk or milk powder or coffee-containing, tea-containing or cocoa-containing beverage powder packaged in individual units, in particular in capsules or pods, parts and accessories for all the aforesaid goods, adapters for coffee, tea and cacao capsules, water filters, water filter units, water filtering apparatus, apparatus for softening water, apparatus for heating and frothing milk, electric milk coolers, electric milk heaters, crockery, glassware, porcelain crockery, mugs (drinking vessels), glasses (drinking vessels), measuring spoons,*

*shakers, mixing cups, containers for household and kitchen, drinking bottles, drinking vessels, vacuum flasks, insulated drinking cups, insulated coffee cups, reuseable cups for takeaway, manually operated coffee grinders, coffee filters (not made of paper), milk, milk products, milk powder, coffee whiteners for beverages, milk powder packaged in individual units, in particular in capsules or pods, chocolate, chocolate products, confectionery, flavour enhancers for foodstuffs, flavour enhancers for beverages, flavourings for addition to foodstuffs, flavourings for addition to beverages.*

## **COSTS**

93. Both parties have enjoyed a share of success, with the greater part going to the holder, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. I have made a slight reduction to the costs to reflect the partial extent of the success. Applying the guidance in the TPN, I award the holder the sum of £500, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement	£200
Filing written submissions:	£300
<b>Total:</b>	<b>£500</b>

94. I therefore order Iker Zago to pay THE GOOD TASTE ANGELS GmbH the sum of £500. 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 6<sup>th</sup> day of March 2023**

**Suzanne Hitchings**  
**For the Registrar,**  
**the Comptroller-General**