

O/0370/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3679654 AND 3679663

BY PTSY LIMITED

TO REGISTER:

Pleased TO SWEET you

AND



IN CLASSES 30 AND 35

AND

OPPOSITIONS THERETO UNDER NUMBERS 430067 AND 430068

BY CHOCOLADEFABRIKEN LINDT & SPRÜNGLI AG

BACKGROUND AND PLEADINGS

1. On 10 August 2021, PTSY Limited (“the applicant”) applied to register the trade marks shown on the cover page of this decision (numbers 3679654 (“the word only application”) and 3679663 (“the stylised application”)) – together “the contested marks” – in the UK. The applications were published for opposition purposes on 8 October 2021 and registration is sought for goods in Class 30 and services in Class 35. These will be listed in the goods and services comparison.

2. On 10 January 2022, Chocoladefabriken Lindt & Sprüngli AG (“the opponent”) opposed the applications under sections 5(2)(b) and 5(3). After failing to file evidence to support its claim to a reputation, the opponent withdrew its 5(3) ground of opposition.

3. The following pleadings relate to both oppositions.

4. Under section 5(2)(b), the opponent originally relied upon three UK trade marks (“the earlier marks”), the details of which are as follows. A hearing took place before me, during which the marks and goods relied upon were narrowed, which I will address in due course.

UK trade mark number 801114289 (“the 289 mark”)

NICE TO SWEET YOU

Filed on 3 April 2021 and registered on 20 March 2013, with a priority date of 6 February 2012.

Relying on goods in Classes 16 and 30.

UK trade mark number 801156414 (“the 414 mark”)



Filed on 25 March 2013 and registered on 4 March 2014, with a priority date of 15 November 2012.

Relying on goods in Class 30.

UK trade mark number 801114290 (“the 290 mark”)

NICE TO
SWEET YOU

Filed on 3 April 2021 and registered on 20 March 2013, with a priority date of 6 February 2012.

Relying on goods in Class 30 and services in Class 35.

5. The opponent claims that the contested marks are similar to the earlier marks and are seeking registration for identical or similar goods and services, resulting in a likelihood of confusion.

6. In accordance with section 6A of the Act, the earlier marks are subject to proof of use; the opponent made a statement of use in relation to all the goods and services relied upon.

7. The applicant filed counterstatements to both oppositions, denying a likelihood of confusion on the basis that none of the marks at issue are identical or similar. The applicant did not put the opponent to proof of use of its earlier marks, the result being that the opponent may rely upon its earlier marks for all the goods and services for which they are registered without having to establish genuine use.

8. Opposition numbers 430067 and 430068 were subsequently consolidated.

9. The opponent is represented by Jan-Caspar Rebling; the applicant represents itself. Only the opponent filed evidence in these proceedings; the applicant filed submissions during the evidence rounds. I will summarise the evidence and submissions to the extent I consider it necessary. A hearing took place before me on 8 February 2023. The opponent was represented by Mr Jan-Caspar Rebling. The applicant chose not to attend but filed written submissions in lieu of attendance.

THE HEARING

10. At the hearing, Mr Rebling confirmed the opponent's position in regard to its three earlier marks in that the 414 mark does not add anything to its case and therefore proceeded on the basis of its 289 mark (the word-only NICE TO SWEET YOU) and 290 mark (the stylised NICE TO SWEET YOU). Further, Mr Rebling stated that for its 289 mark, the only goods being relied upon are those in Class 30 and not those in Class 16. I will proceed with my decision on the basis of these submissions.

PRELIMINARY ISSUES

11. During the evidence rounds, the opponent filed a Form TM9 requesting an extension of time to file its evidence. At the Case Management Conference ("CMC") held by Mr Allan James, it was established that much of the information provided in the TM9 was incorrect. In his post-CMC letter, Mr James stated the following:

"It would plainly have been more helpful if the opponent had set out its real case for an extension of time in the TM9. This may have avoided the need for a CMC. This will be taken into account in the assessment of costs at the end of the proceedings."

12. As such, depending on the outcome of this opposition, any costs award will reflect this.

13. During the course of these proceedings, the applicant has made submissions which I intend to address. I will explain why, as a matter of law, some of the submissions are not relevant to the decision I am required to make.

i. Evidence of use of the earlier marks

In its submissions filed in lieu of attending the hearing, the applicant submits that the opponent has no "brand equity" in its earlier mark and refers to the evidence filed by the opponent as depicting the brand as "Lindt Hello" rather than "Nice To Sweet You". As explained above, in its defence and

counterstatement, the applicant did not request that the opponent prove use of its marks, the result being that the opponent is entitled to rely on its mark as registered without being required to demonstrate genuine use as a trade mark.

ii. Use of the marks in the media and on packaging

How the parties use their marks in the marketplace is not relevant to the decision I am required to make, which is a notional assessment based on the marks as they appear on the register. I will compare those marks later in this decision.

iii. Differences between the parties' goods

The applicant submits that the opponent sells "chocolate and only chocolate" and that 90% of what the applicant sells includes "jelly/hard boiled sweets". What the parties are actually selling is not a relevant factor in these proceedings. The likelihood of confusion is based on a notional assessment of the specifications that each party has applied for. It is the specifications the opponent has registered for its earlier marks and the specifications applied for by the applicant that I will be comparing later in this decision, bearing in mind the factors identified by the relevant case law.

EVIDENCE

14. The opponent filed evidence in the form of the witness statement of Charlotte Allancon, dated 22 August 2022, and its corresponding 15 exhibits (CA1 – CA15). Ms Allancon is the Brand Manager of the opponent's UK subsidiary company: Lindt & Sprüngli (UK) Ltd. The evidence is filed in support of a claim to an enhanced distinctive character of the earlier marks through use.

DECISION

Relevance of EU law

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in

accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case law of EU courts.

Section 5(2)(b)

16. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

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

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

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

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

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“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.”

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

21. Further, in *Kurt Hesse v OHIM*,¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,² the General Court (“GC”) stated that “complementary” means:

“...there is 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.”

22. In *Gérard Meric v OHIM*, the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):³

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

23. I bear in mind that it is permissible to group goods and services together for the purposes of assessment: *Separode Trade Mark*:⁴

“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.”

¹ Case C-50/15 P

² Case T-325/06

³ Case T-133/05

⁴ BL O/399/10

24. Section 60A of the Act is also relevant, which states that:

“(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 to be 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 Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

25. The competing goods and services are shown in the table below:

The opponent’s specifications	The applicant’s specifications
<p><u>The 289 mark</u></p> <p>Class 30: Cocoa; cocoa extracts for human consumption; chocolate beverages; chocolate masses and toppings; chocolate tablets; chocolate goods; chocolate sauces; sugar confectionery; marzipan; marzipan substitutes; pralines, also filled with liquids; pastry and confectionery; edible ices; powders for edible ices; coffee; candy, also with liquid filling; cakes; cookies and biscuits; hollow and filled chocolate shapes.</p>	<p><u>Application number 3679654</u></p> <p>Class 30: Pastries and confectionary; Sugar confectionery; Chocolate; Chocolate products; Substitutes for chocolate; Cereal preparations; Ice cream, sorbets and other edible ices.</p> <p>Class 35: Advertising; The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods, namely, pastries, confectionary, sugar confectionary, chocolate, chocolate</p>

	<p>products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices; Wholesale, retail, retail store, mail-order and on-line retail services connected to the sale of pastries and confectionary, sugar confectionery, chocolate products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices.</p>
<p><u>The 290 mark</u></p> <p>Class 30: Cocoa; cocoa extracts for human consumption and foodstuffs; chocolate beverages; chocolate masses and toppings; chocolate tablets; chocolate goods; chocolate sauces; sugar confectionery; marzipan; marzipan substitutes; pralines, also filled with liquids, particularly with wines and spirits; pastries and confectionery; edible ices; powders for edible ices; coffee; candy, also with liquid filling; cakes; cookies and biscuits; hollow and filled chocolate shapes.</p> <p>Class 35: Retail sale in relation to cocoa, cocoa extracts for human consumption and foodstuffs, chocolate beverages, chocolate masses and toppings, chocolate tablets, chocolate goods, chocolate sauces, sugar confectionery, marzipan, marzipan substitutes, pralines, also filled with</p>	<p><u>Application number 3679663</u></p> <p>Class 30: Pastries and confectionary; Sugar confectionery; Chocolate; Chocolate products; Substitutes for chocolate; Cereal preparations; Ice cream, sorbets and other edible ices.</p> <p>Class 35: Advertising; The bringing together, for the benefit of others, of a variety of goods through online media enabling customers to conveniently view and purchase those goods; Wholesale, retail, retail store, mail-order and on-line retail services connected to the sale of pastries and confectionary, sugar confectionery, chocolate products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices.</p>

liquids, pastries and confectionery, edible ices, powders for edible ices, coffee, candy, also with liquid filling, cakes, cookies and biscuits; franchising, namely imparting of economic know-how.	
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The applicant's Class 30

26. I note that the Class 30 specification is identical in both of the applications.

27. The applicant's *pastries and confectionery* are identical to the opponent's *pastry and confectionery* in its 289 specification and *pastries and confectionery* in its 290 specification.

28. The applicant's *sugar confectionery* falls within the scope of the opponent's *confectionery* in both its specifications; these are identical in line with *Merix*.

29. The applicant's *chocolate* and *chocolate products* are identical to the opponent's *chocolate goods* in both its specifications; these are identical in line with *Merix*.

30. I consider *edible ices* to be food products which have been frozen from a liquid state to a solid state. Therefore, the applicant's *ice cream, sorbets and other edible ices* fall within the scope of the opponent's *edible ices* in both its specifications; these are identical in line with *Merix*.

31. I consider the applicant's *substitutes for chocolate* to be goods similar to chocolate but altered to accommodate certain dietary requirements, including vegan chocolate and dairy-free chocolate. There is some similarity between these goods and the opponent's *chocolate goods* on the basis that they have a shared purpose, will share trade channels and will be available in the same aisles in physical stores and under the same categories online. There is evidently some difference in the ingredients and, as such, the physical nature of the goods, and users may differ based on individual dietary requirements. I do not consider these goods to be in competition with each

other or complementary in line with the case law. Overall, I find the applicant's *substitutes for chocolate* to be similar to a medium degree to the opponent's *chocolate goods*.

32. Finally, I turn to the applicant's *cereal preparations*. This is a situation in which I consider it relevant to refer to the class number in order to interpret the scope of the application.⁵ Since these goods are listed in Class 30, they are taken to refer to prepared or processed cereals for human consumption as opposed to raw or unprocessed cereals (proper to Class 31). Accordingly, *cereal preparations* will include, inter alia, cereal bars. Cereal bars are often found on the same shelves as chocolate bars and I consider them to be in competition, with consumers often choosing between these goods as a snack. As a result, the purpose and users may overlap. Cereal bars may contain chocolate and chocolate bars may contain cereal, so there is an overlap in nature. Overall, I consider the applicant's *cereal preparations* to be similar to a medium degree to the opponent's *chocolate goods*.

The applicant's Class 35

33. The applicant's *advertising* is a broad term that I consider unrelated to the goods and services in the opponent's specifications and so I find no similarity with this service.

34. The applicant's *the bringing together, for the benefit of others, of a variety of goods through online media enabling customers to conveniently view and purchase those goods* in its 663 specification is a broad term not specifically related to any particular goods. I consider that it could encompass the retail services in Class 35 of the opponent's 290 specification, resulting in identity in accordance with *Meric*.

35. The remaining services in the applicant's specifications relate to the retail or sale of the goods listed in its Class 30 specification. The opponent's specification also includes retail services in relation to the goods in its own specifications. Therefore,

⁵ In accordance with *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA).

where I have found similarity between the parties' Class 30 goods, I find the same level of similarity between the related services.

36. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods or services, there is no likelihood of confusion to be considered. Consequently, the opposition has failed in relation to the following services, which may proceed to registration:

Application number 3679654

Class 35: Advertising

Application number 3679663

Class 35: Advertising

The average consumer and the purchasing act

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

38. The relevant goods and services are those for which I have found identity or similarity, the average consumer of which will primarily comprise members of the general public, although I note there will be a group of professional consumers, such as those purchasing the goods to stock stores. For either group of consumers, the goods will be purchased frequently taking into consideration the flavour and nutritional content. Overall, the level of attention will be between a low and medium degree. For the services relating to the sale of those goods, the level of attention will be slightly higher: at a medium level.

39. The goods and services will primarily be selected by visual means, with consumers seeing the mark on the goods themselves or on the physical premises or websites of the stores offering the retail services. Where assistance of retail staff is involved, there will be an aural element to the purchase and so I cannot discount the aural comparison.

Comparison of marks

40. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

41. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade


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.

My approach

42. I will firstly compare each application to the opponent’s 289 (word-only) mark. For completeness, and given its broader specification, I will then briefly compare each application to the opponent’s 290 (stylised) mark.

Comparison with the earlier 289 mark

43. The trade marks to be compared are as follows:

The earlier 289 mark	The applications
<p data-bbox="229 1133 671 1173">NICE TO SWEET YOU</p>	<p data-bbox="751 972 1358 1025">Pleased TO SWEET you</p> 

Overall impression

44. The earlier mark comprises the four words ‘NICE TO SWEET YOU’ in word-only format, with no other elements. The words hang together to create a unit, with the overall impression lying in the four words.

45. The word-only application comprises the four words 'PLEASED TO SWEET YOU' in word-only format in varying casing, with no other elements. Again, the words hang together to create a unit, with the overall impression lying in the four words.

46. The stylised application comprises the same four words as the word-only application but presented over three lines. The words 'Pleased' and 'you' are presented in a stylised, cursive font. The words 'TO SWEET' are presented in block capital letters with a shadowing effect to each letter. The words 'TO SWEET' are in a slightly larger font size than the words 'Pleased' and 'you', though I consider the overall impression of the mark to lie in the mark as a whole.

Visual comparison

47. Visually, the earlier mark and the word-only application coincide in the words 'TO SWEET YOU' and differ in their first words – 'NICE' versus 'Pleased'. Neither mark contains any stylisation or additional elements. I consider them to be visually similar to a medium to high degree.

48. The earlier mark and the stylised application coincide in the words 'TO SWEET YOU'. They differ in their first words and in the stylisation of the application. I consider them to be visually similar to a medium degree.

Aural comparison

49. The earlier mark will be pronounced as the four ordinary dictionary words it comprises. Both applications will also be pronounced as the four ordinary dictionary words they comprise. All the marks overlap in the last three syllables – TO SWEET YOU – and differ in their first syllable. For both applications, I consider there to be a high degree of aural similarity with the earlier mark.



Conceptual comparison

50. To my mind, the earlier mark is a play on the phrase 'pleased to meet you' and the applications a play on the phrase 'nice to meet you', with all marks incorporating the

word 'sweet' in place of 'meet'. In the context of the marks, the words 'pleased' and 'nice' are interchangeable in terms of their meaning. I consider all the marks to be conceptually identical or at least similar to a high degree.

Comparison with the earlier 290 mark

51. The trade marks to be compared are as follows:

The earlier 290 mark	The applications
	<p data-bbox="751 696 1358 752">Pleased TO SWEET you</p> 

Overall impression

52. The earlier mark comprises the four words 'NICE TO SWEET YOU' in stylised block capital letters over two lines: 'NICE TO' on the top line and 'SWEET YOU' on the bottom line. The words hang together to create a unit, with the overall impression lying in the mark as a whole.

53. The overall impression of the applications as explained above is repeated here.

Visual comparison

54. My visual comparison of the marks is similar to that decided above, save for the stylisation of the earlier mark creating a further but slight difference. I consider the earlier stylised mark to be visually similar to a medium degree to the word-only

application and visually similar to a slightly lower than medium degree to the stylised application.

Aural and conceptual comparison

55. My findings as to the aural and conceptual comparisons between the marks are identical for both earlier marks. As a reminder, the marks are aurally similar to a high degree and conceptually either identical or highly similar.

Distinctive character of the earlier marks

56. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, 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 that has been made of it.

58. I will begin by assessing the inherent distinctive character of the earlier marks, which consist of the words 'NICE TO SWEET YOU' either in word-only or in a stylised font. I have already found that the mark is likely to be seen as a play on the phrase 'nice to meet you' with 'sweet' used in place of 'meet'. The phrase is somewhat creative, though it alludes to the goods and services relating to something sweet, i.e. confectionary and chocolate, for example. I consider both earlier marks to have a medium degree of inherent distinctive character.

59. Turning now to consider whether the distinctiveness of the earlier marks has been enhanced through use, I refer to the opponent's evidence of use. Evidence relating to the opponent as a whole, where it has not targeted the NICE TO SWEET YOU earlier marks, - i.e. the opponent's total sales of £235 million, for example - is not relevant to my assessment here; it is the use and promotion of the earlier marks which is pertinent.

60. Sales figures have been provided for the "NICE TO SWEET YOU" range – approximately £1.1m in 2020, £120k in 2021 and £1k in 2022.⁶ Promotion of the earlier marks is said to have taken place between August and October 2014, with some images provided to show road side advertisements and screen advertisements at supermarkets.⁷ Press coverage has been provided for the years 2013 to 2014⁸ as well as one undated image of a display featuring the earlier stylised mark in a supermarket⁹ and a handful of social media posts, either dated in 2014 or undated.¹⁰ There are no figures on the market share held by the earlier marks or on the amount spent on advertising those marks.

⁶ The witness statement of Charlotte Allanson at paragraph 11 and Exhibit CA3.

⁷ Paragraph 15 and Exhibits CA6-CA8.

⁸ Exhibits CA9-CA15.

⁹ Exhibit CA2.

¹⁰ Exhibits CA4 and CA5.

61. The evidence as a whole is insufficient for me to be persuaded that the earlier marks are known to consumers in the UK to such an extent that their distinctive character has been enhanced through use. The sales figures for NICE TO SWEET YOU products are fairly small bearing in mind the relevant industry and they dropped dramatically between 2020 and 2021. There is no evidence of promoting the mark beyond 2014 and no market share or advertising figures. The inherent distinctiveness of the earlier marks remains at a medium degree.

Likelihood of confusion

62. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*) from the perspective of the average consumer. In making my assessment, I must keep 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*). The factors considered above have a degree of interdependency (*Canon*): for example, 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.

63. I have found all the marks to be visually similar to between a slightly lower than medium degree and a medium to high degree, aurally similar to a high degree and conceptually identical or highly similar. I have found the earlier marks to have a medium degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a professional who, paying a low to medium degree of attention for the goods and a medium degree of attention for the services, selects them predominantly by visual means, though I do not entirely discount the aural consideration.

64. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

“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 recognised 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).”

65. I bear in mind that the applicant’s marks and the opponent’s marks begin with different words and that the beginnings of marks tend to have more visual and aural

impact than the ends.¹¹ However, common elements at the end of marks may also be sufficient to create a likelihood of confusion.¹² I have found in my decision that the words which differ – PLEASED and NICE – in the context of the marks are interchangeable and that the marks as wholes convey an identical, or at least highly similar, concept. The conceptual hook for the marks will be the same, i.e. a play on the phrase “pleased to meet you” or “nice to meet you”. Whether the mark contains the word PLEASED or NICE may be forgotten by the average consumer. Therefore, it is possible that the average consumer will imperfectly recall either of the earlier marks as either of the applicant’s marks, or vice versa. I find there to be a likelihood of direct confusion.

66. In case I am wrong in my finding of direct confusion, I will now consider whether there is a likelihood of indirect confusion. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

67. Given that the words PLEASED and NICE can be used interchangeably in the context of the marks at issue whilst retaining the same meaning, to my mind it is entirely plausible that the average consumer will see the change in word as a brand variant. The earlier marks have a medium degree of inherent distinctive character and whilst the word SWEET within the marks is allusive for sweet goods, the play on the phrase “nice to meet you” is somewhat creative and consumers are more likely to think the replacement of the word NICE with PLEASED is another brand used by the same undertaking rather than two undertakings using highly similar versions of the same phrase. I find there to be a likelihood of indirect confusion.

¹¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹² *Bristol Global Co Ltd v EUIPO*, T-194/14.

CONCLUSION

68. The oppositions partially succeed and the applications are refused for the following goods and services:

Application number 3679654

Class 30: Pastries and confectionary; Sugar confectionery; Chocolate; Chocolate products; Substitutes for chocolate; Cereal preparations; Ice cream, sorbets and other edible ices.

Class 35: The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods, namely, pastries, confectionary, sugar confectionary, chocolate, chocolate products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices; Wholesale, retail, retail store, mail-order and on-line retail services connected to the sale of pastries and confectionary, sugar confectionery, chocolate products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices.

Application number 3679663

Class 30: Pastries and confectionary; Sugar confectionery; Chocolate; Chocolate products; Substitutes for chocolate; Cereal preparations; Ice cream, sorbets and other edible ices.

Class 35: The bringing together, for the benefit of others, of a variety of goods through online media enabling customers to conveniently view and purchase those goods; Wholesale, retail, retail store, mail-order and on-line retail services connected to the sale of pastries and confectionary, sugar confectionery, chocolate products, substitutes for chocolate, cereal preparations, ice cream, sorbets and other edible ices.

69. The applications may proceed as follows:

Application number 3679654

Class 35: Advertising

Application number 3679663

Class 35: Advertising

COSTS

70. The opponent has been successful for the most part and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I have made a deduction for the applicant's partial success and, in line with my comments at paragraphs 11 and 12, above, have not made an award in relation to the CMC. Although these proceedings involved two consolidated oppositions, I bear in mind that the issues were overlapping. In the circumstances, I award the opponent the sum of £1260, calculated as follows:

Official fees in two oppositions	£200 ¹³
Preparing statements and considering the other side's statements	£300
Preparing evidence and considering the other side's submissions	£500
Preparing for and attending a hearing	£400
Sub-total	£1400
10% reduction for applicant's success	- £140

¹³ Reduced from £400 to take account of the opponent's failure to file evidence in relation to the section 5(3) ground of opposition, which was subsequently withdrawn.

Total

£1260

71. I therefore order PTSY Limited to pay Chocoladefabriken Lindt & Sprüngli AG the sum of £1260. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 18th day of April 2023

E FISHER (née VENABLES)

For the Registrar