

**O/0435/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK003625652  
BY BRITANNIA INDUSTRIES LIMITED  
TO REGISTER:**



**AS A TRADE MARK IN CLASS 30**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 428788 BY  
BRITANNIA INDUSTRIES LIMITED**

## BACKGROUND AND PLEADINGS

1. On 13 April 2021, Britannia Industries Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:<sup>1</sup>

Class 30: Almond confectionery; Biscuits; Bread; Bread rolls; Buns; Croissants; Cakes; Cheeseburgers [sandwiches]; Chips (Cereal Products); Condiments; Cookies; Corn flakes; Maize flakes; Oat flakes; Crackers; Custard; Flour; Gingerbread; Macaroons [pastry]; Malt biscuits; Muesli; Pancakes; Pastries; Rice cakes; Rice based snack food; Rusks; Seasonings; Cereal-based snack foods; Wheat flour.

2. The applicant’s mark was published for opposition purposes on 3 September 2021 and, on 3 December 2021, it was opposed by Britannia Superfine Limited (“the opponent”). The opposition is based on sections 5(2)(b) and 3(3)(b) of the Trade Marks Act 1994 (“the Act”).
3. Under the 5(2)(b) ground, the opponent relies on the following marks:

BRITANNIA

UK registration no: 912242988

Filing date 22 October 2013; registration date 22 March 2014

Relying on all goods, namely:

Class 1: Sugar alcohols; sugar substitutes (chemical -).

Class 30: Flour and preparations made from flour; preparations made from cereals; bread and bread products, bread rolls, buns, pastries and

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<sup>1</sup> The applicant’s specification was amended by way of a Form TM21B dated 30 November 2022. While the opponent did not expressly maintain its opposition in light of the Form TM21B, it did file evidence in reply and subsequently filed submissions in lieu of a hearing. From this it is clear that the opponent’s intention was to maintain the opposition.

pastry products; dough and dough products; croissants, cakes, decorations for cakes, tarts, biscuits, pies and preparations for making all the aforesaid goods; chocolate and chocolate products; cocoa, sugar, rice; honey, treacle, yeast; baking powder; spices; ices; salt, mustard; fondants, icing, fondant icing, sweets, petit fours; boiled sugar; boiled sugar confectionery; boiled sugar sweetmeats; bonbons made of sugar; cakes of sugar-bounded millet or popped rice (okoshi); candy [sugar]; caramelised sugar; cereal preparations coated with sugar and honey; confectionery made of sugar; crystal sugar [not confectionery]; crystal sugar pieces [confectionery]; cube sugar; dried sugared cakes of rice flour (rakugan); foamed sugar pastilles; foamed sugar sweets; foodstuffs made of sugar for making a dessert; foodstuffs made of sugar for sweetening desserts; fruit sugar; granulated sugar; grape sugar; icing sugar; invert sugar; invert sugar cream [artificial honey]; liquid sugar; palm sugar; powdered sugar; powdered sugar for preparing isotonic beverages; sugar almonds; sugar candies (non-medicated -); sugar candy [for food]; sugar-coated coffee beans; sugar-coated hard caramels; sugar for making conserves of fruit; sugar for making jams; sugar for making jellies; sugar-free chewing gum; sugar other than for medical use; sugar substitutes; sugared almonds; sugared beans (ama-natto); sugarless candies; sugarless chewing gum; sugarless sweets; sugars, natural sweeteners, sweet coatings and fillings; bee products; sweet bean jam coated with sugared-bean based soft shell [nerikiri]; sweets; white sugar, brown sugar, castor sugar, granulated sugar, icing sugar.

("the opponent's first mark");



UK registration no: 2275635

Filing date 19 July 2001; registration date 30 May 2023

Relying on all goods, namely:

Class 30: Chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings; more particularly pure chocolate, chocolate chips, chocolate decorations, chocolate flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings.

("the opponent's second mark"); and



UK registration no: 902533131<sup>2</sup>

Filing date 8 January 2002; registration date 10 March 2004

Relying on all goods, namely:

Class 30: Flour and preparations made from flour; preparations made from cereals; bread and bread products, bread rolls, buns, pastries and pastry products; dough and dough products; croissants, cakes, decorations for cakes, tarts, biscuits, pies and preparations for

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<sup>2</sup> The opponent's first and third marks are comparable trade marks. They are based on the opponent's earlier EUTMs, being registration numbers 012242988 and 02533131. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

making all the aforesaid goods; chocolate and chocolate products; cocoa, sugar, rice; honey, treacle, yeast; baking powder; spices; ices; salt, mustard; fondants, icing, fondant icing, sweets, petit fours.

("the opponent's third mark").

4. Under its 5(2)(b) ground, the opponent claims that as the marks primarily consist of the word 'BRITANNIA' and as the goods at issue are either identical or highly similar, there exists a likelihood of confusion between them.
5. In respect of the 3(3)(b) ground, the opponent argues that the applicant's mark features the word 'BRITANNIA' and as the applicant is from the State of West Bengal, India, the use of 'BRITANNIA' is of such a nature as to deceive the public as to the geographical origin of the goods if they are not produced in the United Kingdom.
6. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use for its marks for the goods relied upon.
7. The opponent is represented by Beck Greener LLP and the applicant is represented by Adamson Jones. While only the opponent filed evidence in chief, the applicant did file written submissions. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## PRELIMINARY ISSUE

9. In the applicant's counterstatement, it argues that the word 'BRITANNIA' is a clear reference to the applicant itself, being named Britannia Industries Limited. Further, the applicant states that it has been using the word 'BRITANNIA' as a house mark since as early as 1918. The counterstatement then discusses six trade marks registered on the UK trade marks register, all of which are registered for class 30 goods and include the word 'BRITANNIA'. The applicant notes that these marks were not opposed by the opponent.
10. While I appreciate it may have been the intention of the applicant for its mark to refer to the company itself, this has no impact on the present decision unless it can be shown in evidence that consumers associate 'BRITANNIA' with the applicant company. However, as the applicant has not filed any evidence, the first point that 'BRITANNIA' is a clear reference to the applicant itself is unsupported. As for the second point raised regarding the existence of six marks on the UK trade marks register, this is of no assistance. There is no express reason as to why the applicant raised this point but if it was with the intention to support an argument of honest concurrent use, it would be required to file evidence of its own use of the marks in the marketplace. It did not do so. Alternatively, if it was the intention to diminish the distinctive character of the opponent's marks due to an alleged common use of 'BRITANNIA' in other trade marks, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06 wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element

has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71). “

11. While the applicant has referred to the existence of these marks on the register, there is no evidence of any use in the marketplace. Therefore, their mere existence on the register is of no assistance to the applicant. Lastly, the fact that the opponent did not seek to oppose these marks is of no relevance either. The assessment I must make is based on the facts of the present case and the decision by the opponent to not file oppositions to the applicant's other marks is not a factor that I am required to consider.

## **EVIDENCE**



12. As above, only the opponent filed evidence in chief. This was in the form of the witness statement of Gillian Manser dated 24 August 2022. Ms Manser is the Company Secretary of the opponent, a role she has held since 22 August 2005. Mr Manser's statement is accompanied by 15 exhibits, being those labelled Exhibits GM1 to GM15.

13. I will refer to points from the evidence or submissions where necessary.

## **DECISION**

### **Proof of use**

14. In respect of the proof of use issue, the applicant has submitted as follows:

“We have reviewed the evidence which has been supplied by way of Gillian Manser's witness statement and Exhibits GM1 -- GM15 and make the following comments. From review of the evidence of use submitted by the Opponent, in particular   Exhibits GM8 and GM9 the Opponent has,

in our opinion, only demonstrated use in connection with the following goods under the Opponent's logo marks ( and ):

*Chocolate: fudge; honeycomb; fondant; frosting; icing; sweet dessert sauces; dessert sugar decorations; jelly sweets: marshmallows; sugar (hereinafter referred to as 'Opponent's actual goods')*"

15. The applicant then goes on to state that, having carefully reviewed the evidence against the specification for each mark relied upon, it has arrived at the following specification, which it considers to be fair and reasonable:

The opponent's first mark

Class 30: Cakes, decorations for cakes and preparations for making all the aforesaid goods; chocolate and chocolate products; cocoa; sugar; fondants, icing, fondant icing, sweets; candy [sugar]; caramelised sugar; confectionery made of sugar; crystal sugar [not confectionery]; crystal sugar pieces [confectionery]; formed sugar pastilles; foamed sugar sweets; fruit sugar; granulated sugar; icing sugar; powdered sugar; sugar almonds; sugar candies (non-medicated -); sugar candy [for food]; sugar-coated hard caramels; sugar for making conserves of fruit; sugar for jams; sugar for making jellies; sugar other than for medical use; sugar substitutes; sugared almonds; sugarless sweets; sugars, natural sweeteners, sweet coatings and fillings; coated with sugared-bean based soft shell [nerikiri]; sweets; white sugar, brown sugar, castor sugar, granulated sugar, icing sugar.

The opponent's second mark

Class 30: Chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings; more particularly pure chocolate, chocolate chips, chocolate decorations, chocolate



flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings.

The opponent's third mark

Class 30: Cakes, decorations for cakes and preparations for making all the aforesaid goods; chocolate and chocolate products; cocoa, sugar, fondants, icing, fondant icing and sweets.

16. Despite offering a fair specification for the first mark, the applicant goes on to confirm that its position is that use has only been shown for the second and third marks and the words 'BRITANNIA SUPERFINE' (which I note is not a mark at issue) but not 'BRITANNIA' solus (being the opponent's first mark). To me, this appears somewhat contradictory as it is unclear why a fair specification for the first mark has been offered when use of the same has been denied. The assertion that the opponent's first mark has not been put to use is noted, however, I am of the view that the admission relating to the opponent's second and third marks together with 'BRITANNIA SUPERFINE' (as words only) is sufficient to proceed that use is also accepted for the first mark. I say this in light of the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 (which concerned the use of one mark with, or as part of, another mark) wherein the Court of Justice of the European Union ("CJEU") found that:

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

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

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

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

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

17. As above, use of a mark as part of a composite mark or in conjunction with another mark can be considered genuine use so long as that mark continues to be perceived as indicative of the origin of the goods at issue. Firstly, the opponent’s use of ‘BRITANNIA’ can be said to be use as part of its composite second and third marks (and the use of ‘BRITANNIA SUPERFINE’ as words only). Secondly, I consider that the word ‘BRITANNIA’, when viewed as part of these marks, will

continue to be perceived as an indicator of the origin of the goods at issue. This is on the basis that, in my view, 'SUPERFINE' is not particularly distinctive from a trade mark perspective (for reasons I will come to discuss in greater detail below). In light of the above, I consider that the opponent's use of its second and third marks and the accepted use of 'BRITANNIA SUPERFINE' as words only are sufficient to be considered use of the opponent's first mark as registered. Given the accepted use of these by the applicant, I am content to proceed on the basis that it also constitutes acceptance of the opponent's first mark.

### Fair specification

18. Having reviewed the evidence, I am in agreement with the applicant that use of the marks has not been shown in respect of all of the goods at issue. Generally, I note that a majority of the exhibited evidence showing specific products is undated and, therefore, cannot be said to demonstrate what products were sold during the relevant period. As a direct example of this, I wish to discuss the fact that the opponent's first and second marks include the term "preparations made from cereals". On the opponent's 'product list' that is provided in the evidence,<sup>3</sup> I note the presence of goods such as 'milk chocolate crispies'. These are, in my view, chocolate covered puffed rice snacks and can, therefore, be said to be "preparations made from cereals". However, the print-out of the product list is undated and I have nothing before me to suggest that these goods were actually sold during the relevant period. In furtherance of this point, I note that the narrative evidence of Ms Manser explains that this print-out is an 'early product list' and is exhibited alongside a 'more recent product list'<sup>4</sup> (which is also undated) in order to demonstrate the variance of the opponent's goods over time. I note that the later product list does not show any products that can be said to be rice based.

19. Given that the applicant has made an admission of use for various goods by proposing a fair specification for the opponent's marks, I do not intend to labour over this point in any great detail. However, I do wish to discuss the applicant's submissions wherein it argues that evidence provided, namely the product list

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<sup>3</sup> See page 5 of Exhibit GM10

<sup>4</sup> Exhibit GM11

which shows heavy industrial processes<sup>5</sup> and invoices of sales to businesses (which it claims to show sales of the opponent's raw product ingredients to business in order to make its own goods),<sup>6</sup> demonstrates that the opponent is a business to business seller and not one that sells to the consumer. While these submissions are noted, they appear somewhat contradictory to the proposed specification put forward by the applicant which makes no reference to any form of limitation in line with the aforementioned argument. In addition, I note that Ms Manser's narrative evidence sets out that the opponent's goods are widely distributed in the UK via nationwide supermarkets such as Tesco, Lidl, Morrison's, Sainsbury's and ASDA.<sup>7</sup> Further, the opponent has provided examples of packaging for its goods which show products that are clearly aimed at consumers.<sup>8</sup> I appreciate that the majority of this evidence is undated but I note that some of the images have approval dates within the relevant period, such as 12 April and 1 May 2019<sup>9</sup> therefore indicating that goods were directed at consumers during this time. While the applicant's submissions are noted, I see no reason as to why I should disbelieve the aforementioned narrative evidence of Ms Manser. Further, I reiterate the point that the applicant's proposed specifications consist of no limitation and, as such, can be said to be an admission that use has been shown for those goods listed which are sufficiently broad enough to cover goods sold to consumers.

20. Taking all of the above into account, I consider it appropriate to proceed on the basis of the proposed fair specification put forward by the applicant. Rather than repeat those goods here, I refer to paragraph 15 above and consider that the goods reproduced under that paragraph are the goods that the opponent may rely upon for all of its marks.

### **Section 5(2)(b): legislation and case law**

21. Section 5(2)(b) of the Act reads as follows:

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<sup>5</sup> Exhibit GM11

<sup>6</sup> Exhibit GM14

<sup>7</sup> See paragraph 14 of the witness statement of Ms Manser

<sup>8</sup> See Exhibits GM9 and GM15

<sup>9</sup> See pages 1 and 7 of Exhibit GM15

“(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 or association with the earlier trade mark.”

22. Section 5A of the Act states as follows:

“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.”

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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 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

24. The competing goods are as follows:

The opponent's goods	The applicant's goods
<p><i>The opponent's first mark</i></p> <p><u>Class 30</u> Cakes, decorations for cakes and preparations for making all the aforesaid goods; chocolate and chocolate products; cocoa; sugar; fondants, icing, fondant icing, sweets; candy [sugar]; caramelised sugar; confectionery made of sugar; crystal sugar [not confectionery]; crystal sugar pieces [confectionery]; formed sugar pastilles; foamed sugar sweets; fruit sugar; granulated sugar; icing sugar; powdered sugar; sugar almonds; sugar candies (non-medicated -); sugar candy [for food]; sugar-coated hard caramels; sugar for making conserves of fruit; sugar for jams; sugar for making jellies; sugar other than for medical use; sugar substitutes; sugared almonds; sugarless sweets; sugars, natural sweeteners, sweet</p>	<p><u>Class 30</u> Almond confectionery; Biscuits; Bread; Bread rolls; Buns; Croissants; Cakes; Cheeseburgers [sandwiches]; Chips (Cereal Products); Condiments; Cookies; Corn flakes; Maize flakes; Oat flakes; Crackers; Custard; Flour; Gingerbread; Macaroons [pastry]; Malt biscuits; Muesli; Pancakes; Pastries; Rice cakes; Rice based snack food; Rusks; Seasonings; Cereal-based snack foods; Wheat flour.</p>

coatings and fillings; coated with sugared-bean based soft shell [nerikiri]; sweets; white sugar, brown sugar, castor sugar, granulated sugar, icing sugar.

*The opponent's second mark*

Class 30

Chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings; more particularly pure chocolate, chocolate chips, chocolate decorations, chocolate flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings.

*The opponent's third mark*

Class 30

Cakes, decorations for cakes and preparations for making all the aforesaid goods; chocolate and chocolate products; cocoa, sugar, fondants, icing, fondant icing and sweets.

25. When making the comparison assessing the similarity of the goods, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:



“[...] 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”.

26. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

27. I have submissions from both parties in respect of the comparison of the goods. I confirm that I have taken these into account in making the following comparison and while I do not intend to address the entirety of the submissions in full, I do wish to address two points briefly. First, the submissions of the opponent set out that the goods in the applicant's specification are:

“20. [...] ingredients commonly used together with or indeed as substitutes for the very same goods sold by the Opponent or goods made therewith. By way of example *Almond confectionery* would probably include marzipan since the latter is a confectionery made using almond flour. The alternative, almond flavoured chocolate or almond flavoured icing sugar would be included in the term *Almond confectionery* all of which are identical to the goods sold by the Opponent. Biscuits, which are small baked unleavened cakes, are made using the Opponent’s ingredients and therefore have the same character and nature as the opponents’ goods. For example, chocolate biscuits such as say a **KIT KAT** is sold through the same channels of trade as any other of the numerous chocolate confectionery products sold by the Opponent.

21. In short, the goods applied for are bakery ingredients and bakery products generally and fall to be the same nature of goods as those for which the earlier marks are registered.” (original emphasis included)

28. The opponent’s position that the parties’ goods are similar because the applicant’s goods are ingredients of the opponent’s goods is incorrect. On this point, I am reminded of the case of *Les Éditions Albert René v OHIM*, Case T-336/03, wherein the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

29. While I will still proceed to consider the general *Treat* factors accordingly, the above submissions of the opponent are of no particular assistance here. Turning to the second point I wish to make; I note that the applicant’s submissions make reference to the point regarding the different consumers of the parties’ goods. This is a point I have addressed at paragraphs 18 and 19 above wherein I considered

a fair specification. Following on from what I said in that assessment, I do not consider that this argument is of any relevance here.

30. While the opponent's marks have different specifications, there is some overlap between them. As far as it is appropriate to do so, I will deal with the specifications together.

31. A preliminary point I wish to make in respect of the opponent's second mark's specification is that its first term covers a range of different goods, being "chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings". This is followed by a second term, being "more particularly pure chocolate, chocolate chips, chocolate decorations, chocolate flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings". My interpretation of the second term is that it sets out that the goods in the first term in are particularly focused on pure chocolate, chocolate chips, chocolate decorations, chocolate flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings. Having said that, the use of the phrasing 'more particularly' is not the same as the use of 'namely' in that it does not limit the term to only those goods that follow. Instead, 'more particularly' simply indicates the primary focus of the specification and while that may be the focus of the opponent, it is not limited to using "chocolate", for example, in the ways set out in the second term.

### *Cakes*

32. "Cakes" appears in both the opponent's first and third marks' specifications so is, therefore, self-evidently identical.

33. While the opponent's second mark's specification includes the term "cake decorations", I consider that the best case for the opponent is to compare "cake" with "chocolate", being another term present in the second mark's specification. Both of these goods are sweet treats that can be eaten either as a snack or a dessert. Despite their different physical natures (one being a solid chocolate and the other being a baked good), there is some overlap in this factor as both goods

will be viewed simply as a sweet treat or dessert. The same can be said for method of use and purpose in that, broadly speaking, both goods will be consumed by the user in the ordinary way for the same purposes, being to satisfy ones appetite. However, I appreciate that the overlap in these factors is somewhat superficial on the basis that the definition of a treat consumed in the ordinary way for the sake of appeasing ones appetite is rather broad. In addition to these factors, I consider that there is an overlap in user in that all of these goods are targeted, generally, at members of the relevant public. On this point, I consider that there is a degree of competition between these goods as a user looking for a sweet treat or dessert may elect to have chocolate over a cake, or vice versa. As for trade channels, I appreciate that there are some large food producers that produce both chocolate and cakes, however, I have nothing before me to suggest that such a practice is common in trade. I do, however, appreciate that chocolate and cakes are likely to be sold in general retailers such as supermarkets but I do not consider that they will necessarily be found in the same aisles or on the same shelves meaning that any overlap in trade channels is limited. Bearing in mind the limited nature of the overlaps discussed above, I am of the view that these goods are similar to a low degree.

#### *Almond confectionery*

34. The above term includes various confectionery goods that are primarily made of almonds which can cover goods such as sugared almonds. The opponent's first mark's specification includes terms such as "sugar almonds" and "sugared almonds" which are goods that are encompassed by the applicant's term. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

35. The opponent's third mark consists of the term "sweets". This is a very broad term and can be said to cover various types of confectionery, including those made of almond. As a result, I consider that "sweets" is sufficiently broad enough to cover almond confectionery and, therefore, find that these goods are identical under the principle outlined in *Meric*.

36. As for the opponent's second mark, this does not share any goods that can be said to encompass, or be encompassed by the above goods. However, it does include the term "chocolate" and I consider that this share some degree of similarity with the above goods. I say this on the basis that these goods are both edible sweet treats and, therefore, following the same reasons discussed at paragraph 33 above, share some overlap in nature, method of use and purpose (albeit also superficial for the same reasons as discussed above). I also make the same findings in respect of user and trade channels too. All of which, in my view, result in a finding that these goods are similar to a low degree.

*Biscuits; cookies; gingerbread; malt biscuits; rusks; pastries; macaroons [pastry]; rice based snack food; cereal-based snack foods; rice cakes; pancakes.*

37. I find that these goods are similar to "cakes", which is present in both the opponent's first and third marks' specifications. Both parties' goods can be said to cover a wide range of sweet treats that can be consumed as a snack or as a dessert (insofar as the rice based goods are concerned, I see no reason why these goods cannot cover marshmallow rice snacks, for example). Therefore, I find that there is some overlap in nature, method of use and purpose between the applicant's goods and that of the opponent (I consider it somewhat limited for the same reasons expressed at paragraph 33 above). Further, the goods are likely to overlap in trade channels on the basis that producers of cookies and biscuits, for example, may also produce and sell cakes. Additionally, all of these goods may be found in the same bakeries or in the same sections of larger retailers such as supermarkets. All of these goods are likely to be purchased by the same consumers meaning that the user base for these goods overlaps. Lastly, there is also a degree of competition between these goods as a user may elect to buy a cake as a sweet treat over a cookie, and vice versa. Taking all of this into account, I consider that these goods are similar to a medium degree.

38. The opponent's second mark consists of the term "chocolate". I consider that this is similar to the above goods to a degree and I make this finding using the same reasoning discussed at paragraph 33 above wherein I consider "chocolate" and

“cake”. I see no reason why the same reasoning cannot apply to “chocolate” and the above goods. Therefore, I consider that these goods are similar to a low degree.

*Bread; bread rolls; buns.*

39. The above goods are broad terms that can include various types of sweetened breads such as, for example, cinnamon buns, iced buns, panettone and Belgian buns. As such, I am of the view that the findings made in paragraph 37 above apply to these goods also. This means that these goods are similar to a medium degree with “cakes” in the opponent’s first and third marks’ specifications.

40. Given what I have said in the preceding paragraph regarding the types of sweet goods the above terms cover, I make a similar finding here between these goods and “chocolate” in the opponent’s second mark’s specification as I have at paragraph 33 above. Following the reasoning set out in that paragraph, I find that these goods are similar to a low degree.

*Croissants.*

41. I make a similar finding in respect of these goods as I have with the goods discussed at paragraph 37 above. While I appreciate that plain croissants are not, generally, considered sweet treats, the applicant’s term is sufficiently broad so as to cover chocolate or almond croissants which are ultimately types of sweet pastries. As such, they can be said to be similar to a medium degree with the opponent’s “cakes in the opponent’s first and third marks’ specifications.

42. Referring again to the reasons set out in paragraph 33 above, I consider that “croissants” and “chocolate” in the opponent’s second mark’s specification are similar to a low degree.

*Cheeseburgers [sandwiches]; Chips (Cereal Products); Crackers.*

43. The above goods are savoury food items (the latter two terms are likely to include goods such as corn chips and water biscuits). While these goods are consumable foods, this does not automatically mean that they are similar to any meaningful degree with the opponent's goods. I appreciate that the users will overlap between these goods and that given that the purpose of all of the goods is to be eaten, there is an overlap in purpose also, albeit to a superficial degree. The nature of the goods differ and so too do the trade channels. Lastly, the goods are not complementary or competitive. Overall, the simple fact that these goods are food products that will be consumed by members of the general public is not sufficient to warrant a finding of similarity between them. These goods are, therefore, dissimilar.

*Corn flakes; Maize flakes; Oat flakes; Muesli.*

44. It is my understanding that the above goods are a range of cereals. I see no reason why any of these goods can be said to be sweet treats and, as a result, I find that there is no obvious level of similarity between these goods and those of the opponent. These goods are, therefore, dissimilar.

*Condiments; Seasonings.*

45. Upon the plain reading of the above goods, I do not consider that they would extend to cover sweet goods such as chocolate sauces or cocoa powder, for example. Instead, it is my understanding that they relate to savoury goods only. For example, the term "condiments" covers goods such as ketchup, mayonnaise and hot sauces and "seasonings" covers goods such as salt, pepper and paprika. I note that neither of the opponent's first or third mark's specifications include goods that can be said to share any obvious level of similarity with the above goods. These goods are, therefore, dissimilar.

46. As for the opponent's second mark, this includes the goods "sauces". On its own, this can be viewed as covering savoury sauces, however, it is helpful to view this term in the context of the specification as a whole, being:

"Chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings; more particularly pure chocolate, chocolate chips, chocolate decorations, chocolate flavoured coatings, ice-cream coatings, fondants and icings, cake decorations, sauces and fillings."

47. This means that the sauces referred to are related to chocolate, chocolate compounds, fondant, fudge, cake decorations and ice-cream coatings and not savoury ones. As a result, I find that there is no obvious level of similarity with the above goods and the goods in the opponent's second mark's specification. They are, therefore, dissimilar.

#### *Custard.*

48. The above goods describes a creamy sauce that consists mainly of milk or cream and sugar. It is commonly used as an accompaniment to desserts. I accept that there will be overlap in user between this good and "cakes" in the opponent's first and third marks' specifications in that the goods will both be used by members of the general public. The purpose of both goods will also overlap in that they will be sweet consumable goods that will, commonly, be eaten as a dessert. I consider that any overlap in trade channels will be superficial as, other than both being sold via general retailers such as supermarkets, the producers of the goods differ. I do not consider these goods to be in competition because custard is not typically eaten on its own as a dessert but is normally used as an accompaniment. Any such competition arising from custard being eaten on its own as a dessert itself is, therefore, limited. The goods will differ in nature and method of use and I do not consider them to be complementary. Overall, I consider that these goods are similar to a low degree.



49. Turning to the opponent's second mark, I see no reason why the above good would share any obvious level of similarity with "chocolate", or any other goods in that mark's specification for that matter. The above term is, therefore, dissimilar to any goods in the opponent's second mark's specification.

*Flour; Wheat flour.*

50. While I appreciate that "cakes" in the opponent's first and third marks' specifications are made of flour, I have discussed above that just because a particular good is used as an ingredient of another does not suffice in itself to show that it is similar to the finished good. Aside from this point, I see no reason why any of the necessary factors between these goods will overlap. Instead, I have identified that the closest terms in the opponent's specifications to the above goods are the range of sugar goods in the opponent's first and third marks' specifications, namely "sugar" and "white sugar, brown sugar, castor sugar, granulated sugar, icing sugar". This is on the basis that, as far as I understand it, sugar and flour are often found in the same home baking aisles in general retailers such as supermarkets. While that may be the case, I do not consider that it is common in the trade for an undertaking that produces flour to also produce sugar. On this point, I note that I have nothing before me to suggest otherwise. As a result, any overlap in trade channels is somewhat limited. Aside from a broad overlap in user in that both goods are selected by members of the general public, I do not consider that any of the remaining factors overlap. Overall, I do not consider that a broad overlap in user and a limited overlap in trade channels are sufficient to warrant a finding that these goods are similar to any degree. They are, therefore, dissimilar. For the avoidance of doubt, the above goods are also dissimilar to any of the goods in the opponent's second mark's specification.

51. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against those services will fail.<sup>10</sup> However, the opposition against the remaining

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<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

services may proceed. For the avoidance of doubt, the dissimilar goods (being those against which the opposition now fails) are as follows:

Class 30: Cheeseburgers [sandwiches]; Chips (Cereal Products); Crackers; Corn flakes; Maize flakes; Oat flakes; Muesli; Condiments; Seasonings; Flour; Wheat flour.

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

52. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 then was) described the average consumer in these terms:

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

53. For the most part, the parties' goods will be purchased by members of the general public at large. As I have discussed above, the applicant's position is that the parties goods are aimed at different average consumers. While I do not agree that the opponent's goods are solely aimed at business users, I accept that both parties goods can be purchased by this group of consumers who will be looking to select them to stock in their businesses or to use in the manufacturing process (“chocolate”, for example, is so broad that it can be used in the manufacturing process of bakery goods).

54. For members of the general public, the goods at issue are most likely to be sold through a range of retail outlets such as supermarkets and their online equivalents. Some of the goods will also be sold in restaurants and cafes. In retail outlets, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as restaurants and cafes, the goods are likely to be ordered aurally but the selection is likely to take place after having viewed the goods on display behind glass counters or on menus. As a result, the selection process for the goods at issue will predominantly be visual although I do not discount an aural component playing a part by way of word of mouth recommendations. For these consumers, the goods are everyday food products that are likely to be purchased on a regular basis. The cost of the goods will likely be inexpensive. When selecting the goods, these consumers are likely to consider such things as the ingredients, nutritional content and flavour. For the most part, I consider that the average consumer is likely to pay a medium degree of attention during the selection process of the goods. That being said, I appreciate that some goods are likely to be more casual purchases (such as confectionery snacks selected at a checkout). For these goods, the degree of attention paid will be lower.

55. For business users, I consider that the goods at issue are likely to be purchased from the producer of the goods directly or via specialised retailers, both of which are also likely to sell the goods online. The goods are likely to be selected having either viewed them in a brochure or, if selected online, from an image displayed on a webpage. While I consider that the visual component will dominate this process, I do not discount an aural component playing a part as a result of discussions with sales representatives or assistants. The costs of these goods will be relatively inexpensive and while I appreciate that they will be important to the operation of the user's business, this does not necessarily mean that the attention paid will be high. I make this finding because the business user will still consider similar factors to the ones discussed in the preceding paragraph and I see no reason as to why this would result in the degree of attention extending to higher than medium. To

confirm, I consider that business users will pay a medium degree of attention during the selection process.

### **Distinctive character of the opponent's marks**

56. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

57. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, 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. In its notice of opposition, the opponent

claimed to have a substantial reputation in its marks. While reputation is an issue under section 5(3) (being a ground not at issue here), I will take this pleading to be in line with a claim to its marks having an enhanced degree of distinctive character through the use made of them. Even if I am wrong to take the pleadings in this way, I note that the opponent has filed evidence of use and even without a specific pleading in support of such an argument, it is incumbent on me to consider enhanced distinctiveness in light of the evidence filed. Before doing so however, I will first consider the inherent position.

58. The opponent's first mark is the word 'BRITANNIA' only. Britannia is the national personification of Great Britain, being *a female warrior carrying a trident and wearing a helmet, personifying Great Britain or the British Empire*.<sup>11</sup> While I do not consider that the majority of average consumers would understand the specific meaning of being a 'personification' of Great Britain or the British Empire they would be aware that it relates to Great Britain itself or the British Empire at large. While not directly descriptive of the goods at issue, the connection to Great Britain or the British Empire at large may be understood as being allusive to the origin of the goods at issue. Overall, I am of the view that the opponent's first mark is inherently distinctive to between a low and medium degree.

59. I turn now to the opponent's second and third marks. Given that they are identical marks (save for their use of colour), I can deal with these together. The marks consist of the words 'BRITANNIA SUPERFINE' that sit in the centre of the mark and surrounded by a circular device that is black and white in the second mark but red, white and blue in the third. The device appears in such a way that will be seen as a variant depiction of the Union Jack flag. This is reinforced by the fact that the word element consists of 'BRITANNIA' which will be understood in the same way as discussed in the preceding paragraph. As for the word 'SUPERFINE', I note that this is a dictionary word and, while that may be the case, I am of the view that this will not be known to the majority of average consumers who will, instead, simply see the word as the conjoining of 'SUPER' and 'FINE'. In the context of the goods at issue, this will be understood as an indication that the goods at issue are of a

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<sup>11</sup> <https://www.collinsdictionary.com/dictionary/english/britannia>

very high (or exceptional) quality. This will be viewed as laudatory and I do not consider that it will contribute to the distinctiveness of the marks as whole beyond what is created by 'BRITANNIA', which, as above, is distinctive to between a low and medium degree. As for the device element, I find that it will reinforce the concept of Britannia (in that it will be seen as a Union Jack, regardless of whether it is displayed in colour or black and white). Having said that, it is a stylistic addition and I consider that it will increase the distinctiveness created by the word element by a small degree. Overall, I consider that the opponent's second and third marks enjoy a medium degree of inherent distinctive character.

60. Turning to the evidence in respect of the position regarding enhanced distinctiveness, I note that the opponent has provided turnover figures for the years of 2015 to 2021 (2022 figures are provided but this is after the relevant date, being 13 April 2021). These are as follows:

<b>Year:</b>	<b>Turnover (£):</b>
2015:	25,810,426
2016:	27,106,817
2017:	29,962,774
2018:	31,426,393
2019:	34,757,011
2020:	41,929,822
2021:	43,175,000
Total:	234,168,243

61. While I appreciate that the above figures are significant, I have no evidence before me as to the size of the relevant markets against which this turnover is to be compared. In the context of the goods at issue (being goods that are in the chocolate, confectionery and bakery markets), I am of the view that the relevant markets are enormous with turnover in the range of billions of pounds per annum. As a result, I consider that the turnover provided represents a relatively low market share.

62. While the evidence only shows seven years' worth of turnover, it is clear in the context of the evidence as a whole that the opponent already operated a sizeable business for a number of years prior to 2015 (being the first year for which turnover is provided). I say this because the turnover for 2015 was £25,819,426 and I do not consider that such a turnover would have accrued overnight but, instead, steadily built over a number of years. This position is supported further by the narrative evidence of Ms Manser wherein she confirmed that the opponent began operating in 1953 and, from at least 1991, was using the 'BRITANNIA SUPERFINE' marks.

63. The evidence includes a number of print-outs that Ms Manser claims to be promotional materials and magazine articles from 1991.<sup>12</sup> While this is noted, I have a number of issues with this evidence. Firstly, it only points to press coverage and promotional attempts in 1991, being 30 years prior to the relevant date. Secondly, there is nothing to suggest the reach of this press coverage/promotion amongst the average consumer base. As a result, I am of the view that this evidence is of no assistance to me in determining the position as at the relevant date. In addition, I note that there is no evidence as to the opponent's advertising expenditure in recent years and neither is there any evidence of any recent advertising campaigns.

64. Taking all of the above into account, I do not consider that it is sufficient to warrant a finding that the distinctiveness of the opponent's marks has been enhanced beyond the inherent levels. I make this finding on the basis that while the turnover is significant, it is likely to be low in the context of the markets at issue. Therefore, any market share enjoyed by the opponent is likely to be very low, particularly given the nature of the markets at issue, in that they are likely to be very competitive. Further, even though the opponent's use of its marks is long standing (going back to at least 1991), I note that there is no evidence of any marketing or advertising efforts in the 30 years prior to the relevant date. On balance, I do not consider that the use shown is demonstrative of the fact that a proportion of the relevant section of the public would, because of the mark, identify the goods as originating from a

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<sup>12</sup> Exhibit GM7

particular undertaking. As a result, the inherent position applies, namely that the opponent's first mark is inherently distinctive to between a low and medium degree and its second and third marks are inherently distinctive to a medium degree.

### **Comparison of the marks**

65. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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.




66. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

67. 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.

68. The respective trade marks are shown below:



The opponent's marks	The applicant's mark
<p data-bbox="371 309 767 398">BRITANNIA ("the opponent's first mark")</p>  <p data-bbox="347 734 794 768">("the opponent's second mark")</p>  <p data-bbox="368 1126 774 1160">("the opponent's third mark")</p>	

69. I have submissions from both parties in respect of the comparison of the marks at issue. I have taken these into account and while I do not intend to reproduce them here I will, if necessary, refer to them below.

### Overall Impression

#### *The applicant's mark*

70. The applicant's mark is a figurative mark consisting of a number of elements. The first element, being the one that sits at the top of the mark, is the word 'BRITANNIA' in a standard white typeface. This sits on its own background that is made up of three different shades of grey. The second element is the word 'Treat'. This is displayed in white standard typeface, albeit with the 'e' and 'a' stylised to a degree.

The applicant submits that the stylisation makes it appear as though the 'e' is eating the letters 'a' and 't'. While I accept that the stylisation may make it appear as though the 'e' and 'a' are faces, I do not consider that the average consumer would necessarily notice this. All elements sit on a dark grey background that conforms to their shapes. The stylisation and presentation of the mark will be noticed but it will play a secondary role. I appreciate that it can be said that 'Treat', being the largest element, dominates the overall impression of the mark. However, for reasons that I will come to discuss when conducting a conceptual comparison, I do not consider that to be the case. Instead, I consider that it shares an equal role with the word 'BRITANNIA'.

#### *The opponent's first mark*

71. The opponent's first mark is the word 'BRITANNIA' only. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

#### *The opponent's second and third marks*

72. Aside from their use of colour, these marks are the same and I will assess them together. These marks consist of a word and device element. The words are 'BRITANNIA SUPERFINE' in a standard black typeface. These words sit on a rectangular background (which is grey in the second mark and red in the third) which itself sits on a large circular device that consists of a number of crosses presented in different colours. In the second mark, the device is black, white and grey whereas in the third mark the device is red, white and blue. Given that average consumers are naturally drawn to elements of marks that can be read, I consider that the overall impression of these marks is dominated by the words 'BRITANNIA SUPERFINE' with the device element playing a secondary role.

## Visual Comparison

### *The opponent's first mark and the applicant's mark*

73. Visually, the marks coincide in their use of 'BRITANNIA'. This is the only element of the opponent's mark and the first element of the applicant's (on the basis that it sits at the top and will, therefore, be encountered first). None of the other elements in the applicant's mark have any counterpart in the opponent's mark. In making this assessment, I remind myself that (1) the opponent's mark is a word only mark and can be presented in any standard typeface (including that used by the applicant) and (2) consumers tend to focus on the beginnings of marks,<sup>13</sup> being where the present similarity lies. That being said, I note the considerable stylistic differences presented by the applicant's mark. Taking all of this into account, I consider that the marks are visually similar to between a low and medium degree.

### *The opponent's second and third marks and the applicant's mark*

74. Stylistically, these marks are very different. However, like the marks assessed above, they share the word 'BRITANNIA'. This is where the similarity ends and all of the remaining elements across the marks are different. While I note the shared use of 'BRITANNIA', being at the beginnings of the marks, I cannot ignore the stylistic differences and taking all of this into account, I find that these marks are similar to a low degree.

## Aural Comparison

### *The opponent's first mark and the applicant's mark*

75. Depending on whether 'BRITANNIA' is pronounced as 'BRT-ANN-YA' or 'BRIT-ANN-E-AH', the opponent's first mark consists of either three or four syllables. Depending on the same factor, the applicant's mark will consist of either four or

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

five syllables with 'BRITANNIA' pronounced as above and 'Treat' pronounced in the ordinary way. The first three (or four) syllables are identical with the only difference coming in the presence of the last syllable in the applicant's mark. Overall, I consider that the marks are aurally similar to a high degree.

*The opponent's second and third marks and the applicant's mark*

76. My comments regarding the pronunciation of 'BRITANNIA' in the preceding paragraph mean that the opponent's second and third marks consists of either six or seven syllables with 'BRITANNIA' pronounced as above and 'SUPERFINE' pronounced in the ordinary way. The applicant's mark will be pronounced as above. The first three (or four) syllables of these marks are identical with only the fourth syllable in the applicant's mark being different. Further points of difference for these marks come in the pronunciation of 'SUPERFINE' in the opponent's marks. These added points of difference will reduce the level of similarity between these marks but not considerably so. Overall, I consider that these marks are aurally similar to a medium degree.

Conceptual Comparison

77. I have discussed the meaning of 'BRITANNIA' at paragraph 58 above and I find that this applies to the use of that word across all of the marks at issue, namely that while the majority of average consumers may not know it means the national personification of Great Britain or the British Empire, they would understand that it relates to Great Britain or the British Empire. This is the only conceptual element of the opponent's first mark. As for its second and third marks, the addition of 'SUPERFINE' is also as above (see paragraph 59). I remind myself that this will be seen as laudatory in that it will be understood as an indication that the goods at issue are of a very high (or exceptional) quality. The addition of the device element will, in my view, reinforce the concept of Great Britain as it will be understood as a depiction of the Union Jack flag. Turning to the applicant's mark, I find that the word 'Treat' will be seen as allusive to the fact that the goods at issue are sweet treats.

78. Comparing the marks, there is a clear similarity on the basis that the word 'BRITANNA' will be understood as having the same meaning. Having said that, there is a point of conceptual difference created by the word 'Treat'. When compared with the opponent's first mark, I am of the view that this difference will be limited due to its allusive nature. As a result, I consider the opponent's first mark and the applicant's mark are conceptually similar to a high degree. While the same points of similarity and difference exist between the applicant's mark and the opponent's second and third marks, there are further points of difference in the presence of a Union Jack device and the word 'SUPERFINE'. While the Union Jack is not present in the applicant's mark, the concept it provides is not greatly removed from the concept created by the word 'BRITANNIA'. It, therefore, acts as a very slight point of conceptual difference. As for the word 'SUPERFINE', this is laudatory to the quality of goods so, like 'Treat', its impact as a point of conceptual difference is only slight. Overall, I consider that the applicant's mark and the opponent's second mark are conceptually similar to between a medium and high degree.

### **Likelihood of confusion**

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

80. I have found the parties' goods range from being identical to similar to a low degree.

I have found the average consumer for the goods to be either members of the general public or business users who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue, however, for some goods, members of the general public may pay a lower degree of attention. I have found that the opponent's first mark is inherently distinctive to between a low and medium degree and its second mark is inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found the applicant's mark to be visually similar to between a low and medium degree and aurally and conceptually similar to a high degree with the opponents' first mark and visually similar to a low degree, aurally similar to a medium degree and conceptually similar to between a medium and high degree with the opponents' second and third marks.

81. In considering direct confusion, I appreciate that the marks all share the same common element, being 'BRITANNIA', and that I have found the word 'Treat' in the applicant's mark to be allusive. I also appreciate that 'BRITANNIA' is the only element in the opponent's first mark. However, despite all of this, I am of the view that the word 'Treat' will not be overlooked, particularly given its size and placement within the applicant's mark. I consider this point alone to be sufficient to find that none of the marks at issue will be directly confused for each other. Therefore, it is of no further assistance to consider the additional elements in the opponent's second and third marks. Even in doing so, they would clearly be differences that point against the chance that the parties' marks would be misremembered or inaccurately recalled as one another. Consequently, I find that there is no likelihood of direct confusion between any of the marks at issue, even in circumstances where the average consumer pays a lower degree of attention in selecting the goods at issue. I will now proceed to consider indirect confusion.

82. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., 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 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)”.

83. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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.

84. In considering indirect confusion, I consider it necessary to deal with the opponent’s marks separately. I will begin with the opponent’s first mark before moving to consider its second and third marks together.

85. Indirect confusion involves instances where the consumer notices the differences between marks. In the present case, I have found that the opponent’s use of the word ‘BRITANNIA’ is distinctive to a low and medium degree. While that may be the case, I remind myself that a finding of a mark having a weak distinctive character does not preclude a likelihood of confusion.<sup>14</sup> In the current assessment, I must consider whether the average consumer would, upon viewing the marks, believe that the marks originate from the same or economically connected undertakings. In viewing the applicant’s mark, I am of the view that, regardless of its role in the overall impression of the mark, the allusive nature of the word ‘Treat’ is such that the average consumer would consider ‘BRITANNIA’ to be the reference to the undertaking responsible, with ‘Treat’ understood as a reference to the nature of the goods, being ‘sweet treats’. As a result, I find that the addition of ‘Treat’ is something that the average consumer would consider as an indicator that is entirely consistent with a sub-brand or brand extension of the ‘BRITANNIA’ undertaking, namely one that offers ‘sweet treats’. While I appreciate that ‘BRITANNIA’ is of a relatively weaker degree of distinctive character, it is not so low that its shared use would be considered coincidental use by two separate undertakings. As for the stylistic differences, these will be noticed but do nothing to point away from the average consumer reaching the aforementioned conclusion.

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<sup>14</sup> *L’Oréal SA v OHIM*, Case C-235/05 P



Taking all of this into account and bearing in mind the comments of Arnold LJ in *Liverpool Gin* (set out in the preceding paragraph), I conclude that the average consumer would be indirectly confused by the marks as they would view them as being from the same or economically connected undertakings. Consequently, I find there to be a likelihood of confusion between the applicant's mark and the opponent's first mark. Further, due to the fact that the marks at issue will be viewed on a range of foodstuffs, I consider that this finding applies even where the goods at issue are similar to only a low degree.

86. I turn now to consider the opponent's second and third marks. The differences between these marks and the applicant's are, clearly, more visually striking than those discussed in the preceding paragraph. While I bear these visual differences in mind and acknowledge the role that the visual component plays in the selection process for the goods at issue, I am of the view that the marks will be indirectly confused for one another. Firstly, the stylisation elements of the opponent's marks will still be viewed as connecting to the concept of 'BRITANNIA' and, therefore, I do not consider that much weight will be placed on them by the average consumer. Secondly, such differences in stylisation are likely to be put down to being either alternative marks used by the same or economically connected undertakings or as re-branding efforts from the 'BRITANNIA' undertaking. Turning to the differences created by the words 'SUPERFINE' and 'Treat', I remind myself that I have found these to be laudatory and allusive, respectively. As such, I consider it likely that the average consumer will consider them to be indicators of different sub-brands or brand extensions of the 'BRITANNIA' brand. For example, 'Treat' will be understood as a reference to 'BRITANNIA's' range of 'sweet treats' and 'SUPERFINE' will be understood as 'BRITANNIA's' more upmarket range of high-quality goods. This leaves the consumer with the impression that 'BRITANNIA' is the indicator of origin for the marks in question. As above, I appreciate that 'BRITANNIA' is of a relatively weaker degree of distinctive character, however, it is not so low that its shared use would be considered coincidental use by two separate undertakings. Consequently, I find there to be a likelihood of confusion between the applicant's mark and the opponent's second and third marks. In addition, I repeat here what I have said above in that because the marks at issue

will be viewed on a range of foodstuffs, I consider that this finding applies even where the goods at issue are similar to only a low degree.

87. As a result of my above findings, the opposition reliant upon the 5(2)(b) grounds succeeds in relation to the majority of the goods for which the applicant's mark sought to register. However, it fails against the following goods, which I have found to be dissimilar:

Class 30: Cheeseburgers [sandwiches]; Chips (Cereal Products); Crackers; Corn flakes; Maize flakes; Oat flakes; Muesli; Condiments; Seasonings; Flour; Wheat flour.

88. I will now proceed to consider the 3(3)(b) ground.

### **Section 3(3)(b)**

89. Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is—

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

90. The opponent's pleaded case under the present ground is that the applicant is seeking registration for a trade mark featuring the word 'BRITANNIA' prominently. It claims that 'BRITANNIA' is a national personification of Great Britain and is a name synonymous with the geographical origin of Great Britain and/or the United Kingdom. The opponent argues that because the applicant is from the State of West Bengal in India, use of the word 'BRITANNIA' is of such a nature as to deceive the public as to the geographical origin of the goods, if they are not produced in the United Kingdom.

91. In its submissions, the opponent argued that the applicant has not sought to challenge the evidence submitted before the Tribunal and the 3(3)(b) ground should be accepted as it stands, namely that the use of 'BRITANNIA' in the applicant's mark would be misleading if the goods do not originate from the United Kingdom. On this point, I note that the applicant denied the 3(3)(b) grounds in its entirety in its counterstatement. Further, the evidence submitted by the opponent in respect of this ground is merely the narrative evidence of Ms Manser, namely paragraph 18 of her statement, which states the following:

"I note that the Applicant uses the word **BRITANNIA** in the trade mark **BRITANNIA TREAT figurative**, which would be understood by ordinary consumers to indicate that the goods originate from the United Kingdom because **BRITANNIA** is a personification of the United Kingdom. However, it appears that the Applicant is in fact based in India and it would therefore appear that use of the word **BRITANNIA** in the trade mark **BRITANNIA TREAT figurative** would be misleading if the goods do not originate from the United Kingdom." (original emphasis included)

92. While noted, this is not evidence of fact and is, instead, the opinion of Ms Manser as to how 'BRITANNIA' would be perceived by average consumers. There is no supporting evidence on this point and the applicant's failure to respond to this is not fatal to its defence as I do not consider that the evidence is of any real assistance to the assessment I must make. In addition, I note that the opponent's submissions refer to the acceptance by the applicant (in paragraph 8 of its own counterstatement) to the fact that "the only conceptual meaning that can be attached to the word BRITANNIA is the national personification of Britain". While this point is noted, the assessment I must make is how the average consumer perceives the word 'BRITANNIA', not how the applicant itself perceives it.

93. In its defence, I note that the applicant argues that the word 'BRITANNIA' will be understood as indicating the applicant company itself. I have discussed this as a preliminary issue above and, as discussed there, the applicant has provided no

evidence to support such an argument. Therefore, I consider that it carries no weight in the present ground.

94. Turning now to assess where the applicant's mark is deceptive, I remind myself of the below summary of the law relating to section 3(3)(b) (and the equivalent provisions in EU law) as set out by Professor Phillip Johnson, sitting as the Appointed Person, at paragraph 84 of his decision in *TWG TEA COMPANY v MARIAGE FRÈRES SA*, Case BL O/358/17.

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: *C-87/97 Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; *C259/04 Emanuel*, ECLI:EU:C:2006:215, paragraph 47; *C-689/15 W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer): *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 55;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder's Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the deception must have some material effect on consumer behaviour: *CFA Institute's Application* [2007] ETMR 76, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) Only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05 *HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) Where a mark does not convey a sufficiently specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16 *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) Once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T-29/16 *Caffè Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) Where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T41/05 *SIMS — École de ski internationale v OHIM*, EU:T:2991:200, paragraph 50; *Caffè Nero*, paragraph 47.”

95. In *Emanuel*, the CJEU referred to the perceptions of the average consumer. In *Gut Springenheide and Tusky v Oberkreisdirektor des Kreises Steinfurt*, Case C-210/96, the CJEU stated that the average consumer is “reasonably well-informed and reasonably observant and circumspect.”<sup>15</sup>

96. This first issue I wish to raise in respect of the opponent’s pleaded case is that, as above, it claims that as the applicant is based in West Bengal in India, use of the word ‘BRITANNIA’ is deceptive. On this point, I remind myself that section 3(3)(b) claims relate to the actual mark at issue and the message it sends, not the nature or location of the proprietor of that mark (in this case, the applicant). Therefore, there is no real merit in the opponent’s argument that the applicant’s mark is

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<sup>15</sup> See also *Hearst Holdings*, cited at paragraph 52 of this decision

deceptive simply because the applicant is based in West Bengal in India. Despite this, I will still continue to consider the claim that 'BRITANNIA' is deceptive if the goods are not produced in Great Britain.

97. For a mark to be deceptive, the message given must be clear enough for deception of the average consumer to take place.<sup>16</sup> In the present case, I have found that the word 'BRITANNIA' may be seen as alluding to the origin of the goods, however, I do not consider that the message of 'BRITANNIA' in the applicant's mark is direct enough to be viewed by the average consumer as attempting to convey a message that the goods at issue are British made. For example, if the goods were to be emblazoned with the words 'BRITISH MADE', for example, then it would be a clear message as to the origin of those goods. In the event that they were not British goods then, clearly, there would be a serious risk of deception to the average consumer who would select them on the basis that they were made in Great Britain. This is not the case here and while I accept that the applicant's mark may call to mind, to a certain extent, something connected with Great Britain, 'BRITANNIA' is not a designation which is sufficiently specific to be capable of giving rise to actual deceit or a sufficiently serious risk that the consumer will be deceived.

98. Alternatively, I consider it possible that the message of 'BRITANNIA' may also be allusive to the British Empire, of which India was a part. So if I am wrong in my findings in the preceding paragraph and the consumer did consider 'BRITANNIA' as an indicator of origin, I do not consider that upon reading the packaging to find that the goods originate from India (so long as that is the case, of course), they would be deceived. This is on the basis that it is widely understood that India was a part of the British Empire. I accept that I have no evidence confirming this point and while I am conscious not to consider that my own knowledge is more widespread than it is, I do not consider it a point of serious dispute to suggest that it is commonly understood that India was a part of the British Empire.<sup>17</sup>

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<sup>16</sup> *HUP Usługi Polska sp. z o.o. v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 248/05

<sup>17</sup> *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

99. In light of my findings above, I do not consider that the applicant's mark is deceptive and, therefore, it is not objectionable under the 3(3)(b) ground. This ground, therefore, fails.

## CONCLUSION

100. The opposition succeeds against a majority of the goods opposed and the applicant's mark is, therefore, refused for the following goods:

Class 30: Almond confectionery; Biscuits; Bread; Bread rolls; Buns; Croissants; Cakes; Cookies; Custard; Gingerbread; Macaroons [pastry]; Malt biscuits; Pancakes; Pastries; Rice cakes; Rice based snack food; Rusks; Cereal-based snack foods;

101. However, the applicant's mark may proceed to registration for the following goods, being those against which the opposition has failed:

Class 30: Cheeseburgers [sandwiches]; Chips (Cereal Products); Crackers; Corn flakes; Maize flakes; Oat flakes; Muesli; Condiments; Seasonings; Flour; Wheat flour.

## COSTS

102. While the opposition has failed against some goods, the opponent has enjoyed the greater degree of success. It is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Having said that, I consider that the costs award should be reduced by 40% to reflect the applicant's success.

103. In the circumstances, I award the opponent the sum of **£800** as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition:	£200
Preparing evidence:	£500
Filing written submissions:	£300
<b>Sub-total:</b>	<b>£1,000</b>
<i>Reduction of 40%:</i>	<i>-£400</i>
Official fees:	£200
<b>Total:</b>	<b>£800</b>

104. I hereby order Britannia Industries Limited to pay Britannia Superfine Limited the sum of £800. The above 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 conclusion of the appeal proceedings.

**Dated this 10<sup>th</sup> day of May 2023**

**A COOPER**  
**For the Registrar**