

O-296-14

TRADE MARKS ACT 1994

DESIGNATION OF THE UK FOR PROTECTION OF INTERNATIONAL

TRADE MARK REGISTRATION No. 523144

AND

OPPOSITION No. 72400

BY CADBURY UK LIMITED

Background and pleadings

1. This is an opposition by Cadbury UK Limited (“Cadbury”) to an application by Goldkenn SA (“Goldkenn”) for international registration 523144 to be protected in the UK. The international mark is SWISSDREAM. The request for protection in the UK was made on 4 July 2011. The request covers:

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (except salad dressings); spices; ice for refreshment.

2. The application for protection in the UK was published in the Trade Marks Journal on 10 February 2012.

3. Cadbury opposes the application on the basis of Sections 5(2)(a),(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The s.5(2) grounds are based on four earlier UK trade marks consisting of, or containing, the words ‘Cadbury(’s)’ and ‘Dream’. The s.5(4)(a) ground is based on Cadbury’s claim to goodwill under, and common law rights in, the words ‘Cadbury’s Dream’ and ‘Dream’ alone. This is as a result of the use of those signs since 1990 in relation to confectionery and dessert products.

4. The opponent submits that the goods for which its earlier marks are registered are either identical or similar to the goods covered by the international mark and that there is a likelihood of confusion.

5. With regard to its claimed goodwill under the signs Cadbury’s Dream and Dream, Cadbury claims that use of Goldkenn’s international mark in the UK would constitute a misrepresentation to the public that the user of the international mark is connected with Cadbury, which would damage Cadbury’s goodwill. Use of the international mark could therefore be prevented under the law of passing off.

6. Goldkenn filed a counterstatement. I note that it:

- accepts that the international mark and some of Cadbury’s earlier marks cover identical goods to the extent that they both cover ‘confectionery’;
- accepts that there is some similarity between ‘preparations made from cereals, bread, pastry and confectionery, ices’ in its own list of goods and some of the goods in class 30 covered by some of the earlier marks;
- denies that ‘Dream’ is the dominant and distinctive element of the earlier marks, pointing out that exclusive rights to the word ‘Dream’ are expressly

disclaimed in the earliest of Cadbury's marks, which is UK registration 1008379 for the word mark CADBURY'S DREAM;

- denies that Cadbury's marks are similar to the international mark;
- denies that there is a likelihood of confusion;
- generally puts the opponent to proof of its claims, and specifically requests proof of use of the earlier marks.

7. Both sides seek an award of costs.

8. Both sides filed evidence and written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.

The evidence

9. Cadbury's evidence takes the form of two witness statements from Mark Hodgkin, who is Senior Counsel, Trademarks, Global Intellectual Property of Mondelez UK Holdings, which is a member of the same group of companies as Cadbury.

10. This evidence indicates that:

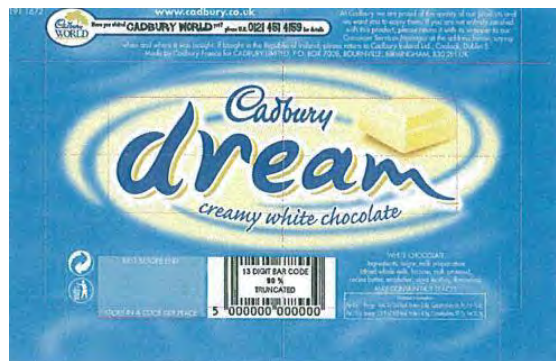
- Cadbury is a long established UK chocolate manufacturer with over 45 chocolate bar products on sale in the UK.
- In January 2002, Cadbury added a white chocolate product branded as Cadbury's Dream to its existing and established range of confectionery products.
- The product consisted of two sizes of chocolate bar and a chocolate egg. A chocolate bar of a third size was subsequently added to the range.
- The launch in 2002 was supported by extensive advertising and marketing with £3.2m spent on TV advertising, including 7 weeks of TV commercials and 3 weeks advertising the product in the Coronation Street credits¹.
- £11.7m worth of chocolate bars and eggs were sold in the 12 week period following the launch in 2002.

¹ An example of such a TV commercial is at exhibit MJH3.

- A typical example of the wrapper used for the product since 2003 looks like this²:



- Prior to that the wrapper looked like this³:



- Invoices issued by Cadbury listed the product as “CAD DREAM BAR”⁴.
- By 2006 retail sales of Cadbury’s Dream chocolate bars and eggs had declined to £2.44m per annum (accounting for 6.57m products), and by 2011 declined further to £0.88m per annum (accounting for 1.62m products).
- In 2011 the products were sold via 1300 convenience stores, 105 Costcutter stores, 114 Londis stores, 832 Martin McColl stores and 10 forecourt and service station outlets. Products in the Dream range are claimed to be available to purchase in 12% of all UK retail outlets that sell confectionery.

² See MJH5 and MJH17

³ See MJH5 and MJH17

⁴ See MJH7

- Miniature versions of the product bearing the Cadbury's Dream mark were sold between 2002 and 2008⁵ in a boxed/tinned assortment product called Cadbury's Heroes. No sales figures are provided for this product.
- The same mark was used on a white chocolate ice cream product launched by Frederick Dairies under licence in 2002. Over £2m worth of ice cream products were sold under the mark between 2007 and 2011 (around £140k in 2011)⁶.
- The mark has also been used in relation to a white chocolate covered biscuit produced under licence by Burton's biscuits. However, it is not clear when this use began and no sales figures are provided⁷.
- Switzerland has a reputation for high quality chocolate⁸.
- Cadbury was prevented from selling a non-Swiss chocolate product under the name Swiss Chalet on the basis of a finding by the High Court that a substantial number of the public would be deceived into thinking it was made from Swiss chocolate⁹.

11. Goldkenn's evidence takes the form of a witness statement by Hazel Mary Buckley, who is a Trade Mark Attorney and Partner in R G C Jenkins & Co, which represents Goldkenn in these proceedings.

12. Ms Buckley's evidence goes to four matters:

- The use of DREAM/DREAMY by other manufacturers/traders in relation to food items, including chocolate.
- The recent lack of availability of Cadbury's Dream products.
- The relatively low sales of Cadbury's Dream products compared to the sales of other Cadbury products.
- Cadbury's inaction against other marks consisting or including the word Dream.

⁵ See exhibit MJH10

⁶ Examples of the words 'Cadbury dream' in use, in 2011, in relation to a white chocolate ice cream are in exhibit MJH8

⁷ Exhibit MJH9 is claimed to show use of the mark, but I can only make out one use of the word 'Dream' and this page has a reference to the year 2013 – after the relevant dates in these proceedings.

⁸ See exhibits MJH12-14

⁹ See exhibit MJH15

13. Ms Buckley exhibits to her statement documents showing the results of investigations, apparently conducted in 2013 (i.e. two years after the application for protection of the international mark). The most relevant results show that:

- A producer of chocolate confectionery called one of its products ‘Dream Bar’¹⁰ and another producer sold a product called ‘Ghirardelli Dark Evening Dream Greenmountain Bar’¹¹.
- Chocolate producers, such as Hotel Chocolat and Lindt, use descriptive terms such as “Our dreamy white chocolate” and “Do you dream in chocolate?” to promote their products¹².
- Other traders in chocolate products make similar use of the word ‘dream’, including a seller of Thornton’s chocolate who stated on a website that “This Thornton’s chocolate is every chocoholics dream!”, and a seller of Leonidas’ Monon Cafe chocolates who described the product as “a chocoholics dream choice”.
- A number of regional companies who provide chocolate fountains at celebratory events in their localities use the word ‘Dream’ in their names¹³, specifically The Chocolate Dream Company, Chocolate Dream and Chocolate Dream Events.
- A trader on Amazon offered a ‘Chocolate Dream’ hamper of chocolate products.
- A seller of Sidoli’s ice cream offered products under the name ‘Sidoli Dream Delight’. Sidoli’s own website offers a product called ‘Sweet Dream Candy Dessert’¹⁴, and a family run business has been selling ice cream under the name ‘Dairy Dreams’ since at least 2010.
- A number of other traders on various well known retail websites were using ‘Dream’ as part of the names used for a range of general food products, including ‘Devon Dream’ (for custard), ‘Dream Topping’ (for a dessert topping), ‘Dark Chocolate Dreams’ (for peanut butter) and ‘Strawberry Dream’ (for marshmallows).

¹⁰ See exhibit HMB1:25

¹¹ See exhibit HMB1:25

¹² The latter phrase appears to have been in use, including some unspecified TV advertising, since 2002.

¹³ The Chocolate Dream Company appears to have been trading under the name since 2007.

¹⁴ This appears to have been available since 2009.

- Searches conducted in 2013 showed that the websites for Ocado, Waitrose, Asda, Tesco and mysupermarket.com had either no products listed under the mark Cadbury's Dream, or only white chocolate covered biscuits.
- An article from a Skynews website from 2008 indicated that the Cadbury's Dream miniature chocolate was removed from the Cadbury's Heroes assortment in 2008 because it was considered that white chocolate had become a specialist choice of only 2% of consumers.
- According to 'Marketing Week' the UK chocolate market was worth £3.6 billion in 2011¹⁵. The Cadbury's Dream mark had only a tiny fraction of this market. Further, it had only a tiny fraction of Cadbury's total sales, e.g. sales of Cadbury's Dairy milk product in 2010 were worth £418m.
- An online report entitled 'Keynote Confectionery 2011 report' included other Cadbury's brands, but not Cadbury's Dream, indicating that it was not considered to be a keynote brand in 2011¹⁶.
- Cadbury failed to oppose numerous other trade marks including the word 'Dream' applied for in class 30 in either the UK or at OHIM, including UK registration 2276946 for the mark 'Chocolate Dream' covering non-medicated confectionery.

Section 5(4)(a)

14. It is convenient to examine the s.5(4)(a) ground of opposition first. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

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

15. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman*

¹⁵ See exhibit HMB1:37

¹⁶ See exhibit HMB1:43

Products Ltd v. Borden Inc. [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (again with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

16. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. addressed the correct approach to assessing whether there is a misrepresentation in the following terms:

“As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

17. I will keep in mind that “misled” means more than being caused to wonder whether there might be a connection between the trade source for two products. As Mr Iain Purvis QC, as a Recorder of the Court, stated that In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC):

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–7 Jacob L.J. stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

18. There is no evidence that Goldkenn used SWISSDREAM in the UK prior to the application to protect the international mark here. Therefore the matter must be assessed as at the effective date of the application for protection of SWISSDREAM in the UK, i.e. 4 July 2011 (“the relevant date”).

19. CADBURY('S) is plainly a household name and 100% distinctive for chocolate products. There is no question in my mind that CADBURY('S) DREAM is (and was from 2002) distinctive of the opponent. I find accordingly.

20. Cadbury claims that the word DREAM alone is also distinctive of its products. The word DREAM has a well known meaning relating to a series of imaginary events during sleep. However, it also has a laudatory meaning, reflected in the sixth meaning for that word provided in Collins English Dictionary, being “a person or thing that is as pleasant, or seemingly unreal as a dream”. This definition reflects well-known usages of DREAM, such as a “dream holiday”. It is also reflected in the evidence, which shows traders in chocolate confectionery using the word in this context, e.g. a seller of Leonidas’ Monon Cafe chocolates described such a product as “a chocoholics dream choice”. This indicates that DREAM is not a word that consumers of chocolate would necessarily rely upon in order to distinguish one particular trade source for a chocolate bar or chocolate ice cream. However, Cadbury had used the composite mark CADBURY’S DREAM for around 9 years (since 2002) by the relevant date. The use had been on a significant scale. Millions of products bearing the mark had been sold prior to the relevant date. Further, Cadbury had promoted its mark heavily at launch, including TV advertising. Further still, the mark had been licensed in relation to an ice cream product since 2007 and a significant trade had also taken place under the mark in respect of that product¹⁷. It is therefore possible that the word DREAM had become distinctive of Cadbury’s products by 2011, even if it was not distinctive of Cadbury at the outset of its trade under the mark CADBURY DREAM in 2002.

21. However, a number of factors indicate that DREAM alone may not have become distinctive of Cadbury. Firstly, the use of the mark in relation to chocolate bars declined throughout the five year period ending in 2011: “only” £0.88m worth of chocolate bars were sold in 2011. Secondly, the evidence shows very little in the way of promotion of the mark in the 5 years leading up to the relevant date. Thirdly, although sales under the mark were on a significant scale, they represented only a tiny fraction of the £3.6 billion UK market for chocolate confectionery, and probably only a very small fraction of the UK market for ice cream. Cadbury itself appears to have considered Cadbury’s Dream as a niche product. Fourthly, there is evidence that Cadbury was not the only user of DREAM in relation to chocolate confectionery products at the relevant date. Fifthly, all the use of DREAM was in conjunction with

¹⁷ It appears that the mark was also licensed for biscuits, but there is no evidence that it was used for those products prior to the relevant date.

the well known house mark CADBURY('S), and in association with particular packaging designs with a consistent blue and cream colour scheme. Consumers did not therefore need to rely on the word DREAM in order to select this product.

22. The declining sales of the principal chocolate bar product are relevant, but I do not regard that as undermining Cadbury's case. The law of passing off has protected signs used on a much lesser scale than that shown here. Further, although the use of the mark had been in decline for some years prior to the relevant date, the extensive publicity around the initial launch in 2002 may still have been remembered by many of the public on seeing goods bearing the mark CADBURY'S DREAM still on sale in 2011.

23. Nor do I regard it as particularly damaging to Cadbury's case that the evidence shows some other traders may have been using DREAM in relation to chocolate products prior to the relevant date. This is partly because the evidence showing the position prior to the relevant date is very thin.

24. Of more significance, given its laudatory meaning, is that there is no direct evidence that anyone regarded DREAM alone as distinctive of Cadbury's products. In *British Sugar plc v James Robertson & Sons Ltd*¹⁸ Jacob. J. (as he then was) considered a trade mark infringement case based on a trade mark registration for TREAT and the use by the defendant of ROBERTSON'S TOFFEE TREAT. In considering how the public would regard the defendant's use the judge said this:

"I turn to consider how the word "Treat" is used here I have no evidence from the public in relation to this question. I have some evidence of internal thinking at Robertson's but the most important thing of all must be my own impression from the label and all the surrounding circumstances. Looking at the label I think the average customer would not see "Treat" used as a trade mark. It is true that it is written as part of a phrase "Toffee Treat" but this is done in a context where the maker's name is plain. It is of course the case that you can have two trade marks used together ("Ford Prefect"), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as anything else. But where it is highly descriptive I see no reason why a member of the public should take the mark as a badge of origin and that is particularly so where the product is a new sort of product, as here. The public are apt to take the name of a novel product as a description rather than a trade mark, particularly where the name is not fancy but is descriptive or laudatory. I do not think Robertson's use is as a trade mark.

I find confirmation for this view by considering what the average consumer, aware of the Robertson product, would think on seeing the name used for a rival product. Suppose for instance that Marks and Spencer produced a product labelled "St Michael Toffee Treat". I think the reaction would be "Oh I

¹⁸ [1996] RPC 281

see M&S are doing a toffee treat too”. And the reaction would be much the same even if no maker's name appeared on the jar: “Oh, someone other than Robertson has gone in for making a toffee treat”.”

25. Admittedly the *Treat* case was about trade mark infringement rather than passing off. Nevertheless as the judge in that case noted, it is a matter of fact whether the public see a laudatory word used in conjunction with a well known trade mark as a secondary trade mark or just as a description of the product.

26. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2006] EWCA 244 (Civ), Jacob L.J. stated that:

“34. The judge also thought the “descriptiveness” of the name affected the question of whether it had a goodwill. But the name is not descriptive in the sense that anyone would describe a business or shop selling mobile phones as a “Phones 4u” business or shop. It is that sort of name which tells you what the business is, but is also obviously intended to be an invented name to denote a particular business. True it is that it is not particularly inventive—“4u” was a bit in vogue—the sort of thing others might well want to use. For that reason it would be unlikely to be accepted for registration as a trade mark without some proof of acquired distinctiveness. But distinctiveness for trade mark registration purposes is not the same concept as descriptiveness—it requires more. I think the judge was wrong to say, as he did:

“The phrase ‘Phones 4u’ is not inherently distinctive. It is a descriptive phrase, although not wholly descriptive in that I accept that it is more likely to acquire distinctiveness through use than a wholly descriptive expression. Nevertheless, there is an onus on the Claimants to satisfy me that it had become distinctive through use.”

This is the language of distinctiveness for trade mark registration, not that for testing whether a goodwill has been established.”

27. In my judgment, the word DREAM (for confectionery) is descriptive (albeit not as highly descriptive as the word TREAT), and it is less obviously a trade mark compared to PHONES 4U. As there is no direct evidence before me on this point, I must make my own assessment about whether Cadbury’s customers and potential customers would have considered DREAM to be a secondary trade mark or merely a laudation of the product. In my view, a significant section of such consumers would have regarded DREAM as a trade mark for the product. However, those consumers would have been aware that the word was simultaneously being used as a laudation of the product. Laudatory words are, by their nature, apt to be used by others trading in the same field. Therefore even the section of Cadbury’s customers who regarded the word DREAM as a secondary brand would have regarded it, by itself, as only weakly distinctive of Cadbury.

28. I turn to the question of whether Goldkenn’s use of SWISSDREAM in relation to the goods covered by the application, including chocolate confectionery and ice cream, would have constituted a misrepresentation to the public. I note that in *Reed Executive v Reed Business Information Limited*¹⁹ Jacob L.J. said this:

“83. Finally, although I agree with the Judge’s questioning of the Court’s proposition of fact that “there is a greater likelihood of confusion with very distinctive marks” there is some truth with the opposite proposition. The Court in *Lloyd* said:

“In determining the distinctive character of a mark, and accordingly in assessing whether it is highly distinctive, it is necessary to make a global 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 from those of other undertakings. In making that assessment account should be taken of all relevant factors and 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”

84. The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive “small differences may suffice” to avoid confusion (*per* Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 RPC 30 at p.43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.

85. It is worth examining why that factual proposition is so – it is because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another. Thus in the cited case “Office Cleaning Association” was sufficiently different from “Office Cleaning Services” to avoid passing off.”

29. I find that Cadbury’s customers and potential customers would not have regarded SWISSDREAM chocolate confectionery as a product sold by Cadbury, or under its control, at the relevant date. This is because:

- The absence of the word CADBURY(’S) would have caused such consumers to question whether this was a product made by, or under the control of, the undertaking responsible for the CADBURY’S DREAM product.
- Even if the word SWISS in SWISSDREAM was seen as a reference to the geographical origin of the chocolate, Cadbury claims no reputation for

¹⁹ [2004] EWCA (Civ) 159

Swiss chocolate so that word would not trigger an association with Cadbury.

30. As regards the point made in the first bullet, I acknowledge that placing another sign in front of a distinctive mark is often insufficient to avoid confusion. See, for example, *Aveda Corporation v Dabur India Limited*²⁰. However, much depends on the distinctiveness of the common element. The word DREAM was only weakly distinctive of Cadbury at the relevant date, although it is true that SWISS was even less distinctive, particularly for chocolate products.

31. As regards the point made in the second bullet, I acknowledge that Cadbury's use of SWISS CHALET was held to be liable to deceive a substantial number of people into thinking that Cadbury sold Swiss chocolate. However, that is more likely when the words CADBURY'S and SWISS appeared on the same label and the consumer was thereby told that this was both a Cadbury's product and made from Swiss chocolate.

32. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*²¹ the CJEU stated, at paragraph 66 of its judgment, that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were to be registered. The same must apply to section 5(4). I must therefore consider the possibility that the words SWISSDREAM will be used in 'handwritten' letters similar to those Cadbury uses for its DREAM products.

33. However, I find that although such use may cause some of Cadbury's customers or potential customers to wonder whether SWISSDREAM might be connected to Cadbury, there wouldn't be a substantial number of persons who assumed that there was an economic connection with Cadbury. I therefore find that the factors stated at paragraph 29 above will be sufficient to avoid deception amongst a substantial number of Cadbury's customers or potential customers.

34. As the use of SWISSDREAM by Goldkenn in relation to chocolate confectionery would not constitute a misrepresentation to the public, the s.5(4)(a) claim is bound to fail for these and the other goods covered by the application.

Section 5(2)(b)

35. Cadbury relies on four earlier marks. One of these is UK registration 1008379, which is for the word mark CADBURY'S DREAM. This mark is registered with the following disclaimer:

²⁰ [2013] 589 (Ch)

²¹ Case C-533/06

“Registration of this mark shall give no right to the exclusive use of the word ‘Dream’.”

36. In *Nestle SA's Trade Mark Application* [2004] EWCA Civ 1008, Mummery L.J. giving the judgment of the Court of Appeal held that:

“An applicant who agrees that the rights conferred by registration shall be subject to a limitation is agreeing, in effect, that the use of the mark outside the limitation is not to be treated as an infringement of the mark notwithstanding that such use would, otherwise, fall within s.10 of the Act.”

37. In *Phones 4u Ltd v Phone4u.co.uk Internet Ltd*, [2006] EWCA Civ 244, Jacob. L.J. agreed with that approach noting that:

“...a disclaimer or limitation amounts to an unconditional binding acceptance by the proprietor that, notwithstanding the rights conferred by the infringement provisions, he cannot assert rights in breach of the condition or outside the limitation.”

38. The only similarity between the mark covered by UK registration 1008379 and Goldkenn’s mark is the word ‘Dream’, which is disclaimed in the earlier mark. It follows from the above that Cadbury cannot rely on 1008379 in order to oppose Goldkenn’s mark. As the opposition based on 1008379 cannot succeed because of the disclaimer, it is not necessary to consider this mark any further.

Proof of use of earlier marks 2359723 CADBURY DREAM and 2279430 CADBURY’S DREAM (figurative)

39. Section 6A of the Act is as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) -

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

40. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

41. The opposed mark was published on 10 February 2012. The relevant five year period for showing use of the earlier marks is therefore 11 February 2007 to 10 February 2012.

42. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. approved the following summary of the case law on genuine use.

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeo SRL v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added

references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

43. UK registration 2359723 consists of the words CADBURY DREAM. It is registered in class 30 for:

Chilled desserts, puddings, mousses, yoghurt, fromage frais. Chilled and frozen confections and desserts.

44. Goldkenn says that if Cadbury has shown use of this mark, it is use in relation to “frozen confections in the form of white chocolate coated ice cream bar on a stick”. I accept that use of the mark in a similar form to that shown at the top of page 4 of this decision (i.e. with Cadbury in a cursive script and in relatively smaller letters compared to the word Dream written in a script reminiscent of handwriting) counts as use of the composite word mark CADBURY DREAM and that this mark was put to genuine use within the relevant period. However, I don’t consider that Goldkenn’s proposed description of the product in relation to which it was used represents a proper description of goods for the purposes of this opposition. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law on this point when he said:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

45. I consider that the proposed inclusion of a description of the type of chocolate used to cover the ice cream, and the ‘bar on a stick’ part of the proposed description, characterise the actual product in relation to which Cadbury has used its word mark. In my judgment, the average consumer would regard the product as a ‘chocolate covered ice cream’ and I adopt that as a fair description of the goods for the purposes of this opposition.

46. Registration 2279430 is a figurative mark which looks like this:



47. There does not appear to be any evidence of use of that exact mark since 2003 when the wrapper design appears to have been changed to the mark shown below²²:

²² The colours shown are not accurate and any differences of colour should be ignored.



48. It is submitted on behalf of Goldkenn that this wasn't use of the mark as registered or "use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" for the purposes of s.6A(4). This is because:

- The position of the word 'Cadbury' in relation to the word 'dream' has changed;
- The replacement of 'Cadbury's with 'Cadbury';
- The word Cadbury being enclosed within its own (blue) swirl in the post 2003 version of the mark, whereas in the form registered it is part of the cream/gold coloured central swirl which encloses the words 'Cadbury' and 'dream';
- The word 'dream' being on a horizontal left to right swoosh design in the post 2003 mark rather than on the centrally positioned cream/gold swirl design;
- The change of position of the square of white chocolate and the removal of the shadowing along its lower edge, which is visible in the registered mark, but not in the post 2003 version.

49. It is submitted on behalf of Cadbury that the changes described do not alter the distinctive character of the mark as registered because the elements of the mark which make it recognisable to consumers are:

- The dominant and distinctive word DREAM;
- The colour and shape of the cube of white chocolate;
- The stylised word 'Cadbury's';
- The blue and cream colour scheme.

50. These elements are claimed to have remained the same throughout. However, that is not correct so far as the word Cadbury's is concerned. The later version of the mark appears to use the word 'Cadbury' instead of 'Cadbury's'. Nothing turns on this. The relevant average consumer may not even notice the difference between these words. Even if he or she did it, it would do nothing to alter the distinctive character of the word 'Cadbury', let alone that of the mark as a whole.

51. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under the similarly worded s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

52. I consider that the change in the position of the word 'Cadbury' in relation to the word 'dream', and possibly the re-positioning of the cube of white chocolate on the wrapper design, would be noticed by the relevant average consumer, but I do not regard those trivial changes as altering the distinctive character of the mark as registered. Registration 2279430 is a figurative mark, so the graphic elements of the mark are not to be regarded as unimportant. I find that the change from a central 'swirl' design to a 'swoosh' design altered the graphic element of the mark quite noticeably. However, I do not regard the rather banal swirl design (or the swoosh) to be a distinctive element of the registered mark and I am therefore prepared to accept that the change to the graphic element of the label should be regarded as an acceptable updating of the registered mark rather than the use of a different mark with a different distinctive character. It follows that Cadbury can rely on UK 2279430 for the purposes of this opposition.

53. Registration 2279430 is registered for:

Chocolate, chocolates, non-medicated confectionery; preparations made from cereal, biscuits, cakes, wafers; snack foods; ice cream and ice cream products, chilled and frozen confections and desserts.

54. The mark has been shown to have been used during the relevant period in relation to a chocolate bar. I therefore consider that 'chocolate bars' is a fair

description of the goods that would accord with the perception of an average consumer. I will use this as the basis of the comparison between earlier mark 2279430 and Goldkenn's international mark.

55. Section 5(2)(b) of the Act is as follows:

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

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

Global comparison with 2359723

56. I do not consider that Cadbury's other earlier marks present any stronger case than UK 2359723, the word mark CADBURY DREAM. I will therefore consider this mark first.

Comparison of goods and services

57. I consider that 'chocolate covered ice cream' is subsumed within, and therefore identical to, 'ices', 'ice for refreshment' and 'confectionery' in the list of goods covered by the international mark. The respective goods are therefore partly identical.

Comparison of marks

58. The respective marks are CADBURY DREAM and SWISSDREAM. Both marks contain the word DREAM as the second of two recognisable words. The other words, 'Cadbury' and 'Swiss' are completely dissimilar to the eye and to the ear. In the later mark, the words are conjoined, which slightly reduces the level of visual similarity. Overall, I find that there is only a modest degree of visual and aural similarity between the marks.

59. The word DREAM has the same meaning in both marks. SWISSDREAM as a whole has no obvious meaning. The word SWISS means 'from Switzerland'. Its most likely meaning in relation to chocolate ice creams is that the chocolate comes from Switzerland. SWISSDREAM may therefore be taken to mean 'dream' chocolate of Swiss origin. The word 'Cadbury' has no meaning other than as a name. Overall, I consider that the shared 'DREAM' meanings create a relatively high level of conceptual similarity between the marks when considered as wholes.

Average consumer and the purchasing act

60. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question²³. In the case of ice cream and ices, the consumer is likely to pay a slightly less than average level of attention when selecting the goods. The selection process is likely to be a primarily visual one, although word of mouth orders and recommendations must also be taken into account.

Distinctive character of the earlier trade mark

61. 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).”

62. The earlier mark as a whole is highly distinctive, but it includes the word DREAM which is low in inherent distinctive character for ice cream and ices because one of its possible meanings describes the high quality of those products. For the reasons given at paragraph 27 above, I find that the word DREAM alone was weakly distinctive of Cadbury's chocolate covered ice cream product at the relevant date as a result of the use made of CADBURY DREAM.

²³ *Lloyd Schuhfabrik Meyer, Case C-342/97*

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

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

64. Consequently, the highly distinctive character of CADBURY does not increase the likelihood of confusion between the marks as wholes. The distinctive character of the DREAM element of the earlier mark is weak.

Likelihood of confusion

65. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2012] EWCA Civ 24 para 51 et seq, the Court of Appeal approved the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95 [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97 [1999] RPC 117, *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 [2000] E.T.M.R. 723, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Case C-334/05P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

66. The respective marks are most similar at a conceptual level, but given the laudatory significance of the word DREAM this does not help Cadbury much because the similarity of concept is not a distinctive one. I find that despite the identity of goods, and making an appropriate allowance for imperfect recollection, the modest level of visual and aural similarity between the marks as wholes is sufficient to rule out the likelihood of direct visual or aural confusion between them.

67. Turning to indirect confusion I note that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. (again as the Appointed Person) said this:

“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).”

68. In the light of my findings so far, it should be clear why I do not consider the word DREAM to be “strikingly distinctive” for ice cream and ices. However, for the reasons given at paragraph 27 above, I accept that, at the relevant date, the mark DREAM was weakly distinctive of Cadbury’s chocolate covered ice cream.

69. The high point of Cadbury’s case is that SWISSDREAM should be considered as DREAM with a wholly non-distinctive addition. I accept that SWISS is non-distinctive for chocolate covered ice cream. I also accept that DREAM has an independent

[albeit weak] distinctive role in the earlier mark. However, it is important to give appropriate weight to the distinguishing power of the house mark CADBURY. I do not consider that *Medion* justifies an approach whereby the CADBURY element of the earlier mark is given little or no weight and the assessment is effectively reduced to comparing DREAM to SWISSDREAM. That would be to turn on its head the CJEU's general guidance that consumers normally perceive marks as wholes. Rather *Medion* should, in my view, be regarded as a specific example of the rule that marks must be compared as wholes and that "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". The presence of the word DREAM in both marks must therefore be given appropriate weight, but the effects of the other elements in the marks, CADBURY and SWISS, must also be given appropriate weight.

70. I must again consider the possibility that the word SWISSDREAM will be used in similar 'handwritten' style letters to those that Cadbury uses for DREAM. However, I find that the combination of:

- The absence of the house mark CADBURY in the international mark;
 - The weak distinctive character of the word DREAM;
 - The fact that SWISS is conjoined with the DREAM in the international mark rather than being used as a separate descriptor in relation to the mark DREAM;
- is sufficient to avoid the risk of indirect confusion.

71. In my view, consumers are most likely to attribute the presence of the word DREAM in both parties' marks as being no more than a coincidence. I therefore find that there is no likelihood of indirect confusion and the s.5(2)(b) ground of opposition based on UK 2359723 fails.

Global comparison with 2279430

Comparison of goods

72. I have already found that this mark is entitled to protection for chocolate bars, which are clearly covered by 'confectionery' in the list of goods for the international mark. Therefore the goods are once again partly identical.

Comparison of marks

73. I have already accepted that the use of the words CADBURY DREAM in different fonts and sizes represents normal and fair use of those words as a trade mark. It follows that Cadbury is no better off relying on the presentation of the words CADBURY'S and DREAM in mark 2279430 than it was relying on the words alone on the basis of mark 2359723. The presence of get-up and colour in mark 2279430, which is not present in the international mark, means that mark 2279430 is less similar to the eye to the international mark compared to word only mark 2359723.

Distinctive character of earlier mark

74. My analysis of earlier mark 2359723 applies also to 2279430. It might be said that as 2279430 covers the core product for which CADBURY'S DREAM has been used, the distinctive character of the mark at the relevant date may have elevated more for chocolate bars than it was for chocolate covered ice cream. I do not accept that. The use of the mark in relation to the core product is bound to have conditioned consumers' perception of the mark in relation to the spin off product. The use of the mark in recent years for both products was relatively modest. The word DREAM is as laudatory and weakly distinctive for chocolate bars as it is for chocolate covered ice cream.

Likelihood of confusion

75. For similar reasons to those already given in relation to mark 2359723 I find that there is no likelihood of confusion between earlier mark 2279430 and Goldken's international mark.

Earlier mark 2331278

76. UK registration 2331278 consists of a series of two marks which look like this.



77. This is the wrapper used for an individual chocolate sweet within the Cadbury's Heroes assortment from 2002 until at least May 2007 (i.e. within part of the relevant period). According to the documents in exhibit MJH10, the wrapper for this product

also changed in 2003 moving from a swirl design to a swoosh design. Because of the 'wings', this mark is visually less similar to the international mark than either earlier marks 2359723 or 2279430. Therefore for the reasons already given in relation to those marks, I find that there is no likelihood of confusion between this mark and Goldkenn's international mark.

Outcome

78. The opposition has failed.

Costs

79. The opposition having failed, Goldkenn SA is entitled to a contribution towards its costs. I order Cadbury UK Limited to pay Goldkenn SA the sum of £1300 within 7 days of the end of the period allowed for appeal.

80. This is made up of:

£400 for considering the notice of opposition and filing a counterstatement;
£700 for filing evidence and considering Cadbury's evidence;
£200 for filing written submissions.

Dated this 7th Day of July 2014

**Allan James
Hearing Officer**