

O/0067/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03669810 BY
BREAKFAST HEROS LIMITED
TO REGISTER THE TRADE MARK:**

SUPERZEROS

IN CLASS 30

AND

**OPPOSITION THERETO
UNDER NO. 427623
BY
JACOBS DOUWE EGBERTS RTL SCC SG PTE. LTD.**

BACKGROUND & PLEADINGS

1. Breakfast Heros Limited (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 16 July 2021. It was accepted and published in the Trade Marks Journal on 3 September 2021 for the following goods:

Class 30: Cereals; cereal powders; breakfast cereals; cereal bars; cereal based energy bars; cereal preparations; cereal snacks; cereal based snack foods; processed cereals; cereal breakfast foods; foodstuffs made from cereals; cereal-based meal replacement bars; ready-to-eat cereals; porridge; grits; muesli; muesli bars; snacks made from muesli; oat-based foods; oat-based cereal; biscuits; cakes; tarts; pastries; bread; gluten free bread; food flavourings; food flavourings for cereals; flavourings for beverages; coffee beverages; cocoa beverages; tea beverages; chocolate beverages; coffee based beverages; cocoa based beverages; tea based beverages; chocolate based beverages; chickpea based breakfast cereals; soy based breakfast cereals; whey protein based breakfast cereals; processed quinoa; oat cakes; crackers; pancakes; low-carbohydrate confectionery.

2. JACOBS DOUWE EGBERTS RTL SCC SG PTE. LTD. (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the International Registration number 01522013 for the following mark:



3. The mark designated the UK on 14 August 2020, and protection of the International Registration in the UK was conferred on 26 February 2021 for various goods in Class 30, as shown later in this decision.
4. For the purpose of this opposition, the opponent relies on all of its Class 30 goods.
5. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's earlier mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
6. In its amended notice of opposition, the opponent argues that:
 - “1) The respective marks are prefixed with the identical word SUPER.
 - 2) The respective goods are identical and/or similar.
 - 3) The similarity of the respective marks coupled with the identity and/or similarity of goods will give rise to a likelihood of confusion.”
7. In response, the applicant filed a counterstatement, denying similarity between the competing marks. Nevertheless, it admits that “the following Contested Goods are identical or similar to certain goods covered by the Opponent's Registration: "coffee based beverages", "cereal bars", "cereal preparations", "coffee beverages" and "cereal based snack foods". However, the Applicant denies that the remaining Contested Goods are identical or similar to any of the goods covered by the Opponent's Registration. The Opponent is put to strict proof of this claim.”
8. Only the applicant filed evidence in these proceedings. It consists of a witness statement dated 14 August 2022 by Noel Anthony Eves, the director and founder of the applicant, introducing 2 Exhibits. According to the witness statement, the purpose of the evidence is “to show that the

word SUPER is non-distinctive on and in relation to cereal products and cereal-based products”. In this respect, the applicant’s evidence demonstrates a selection of UK trade mark registrations and website screenshots of cereal products containing the word element “SUPER”, all owned by third parties. Whilst I considered the evidence filed, it must be noted that this is irrelevant to the matter at hand. This is because the task before me is to compare the competing marks and goods in Class 30, assessing the likelihood of confusion.

9. Both parties filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
10. In these proceedings, the opponent is represented by Wilson Gunn and the applicant by Bird & Bird LLP.
11. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to trade mark case law of EU courts.

DECISION

Section 5(2)(b)

12. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“A trade mark shall not be registered if because-

[...]

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

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

13. The principles, considered in this opposition, stem from decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. In assessing the similarity of the goods or services concerned [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter

alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

16. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

19. The competing goods to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods
<p>Class 30: Coffee; instant coffee; coffee substitutes; coffee extracts; decaffeinated coffee; coffee capsules, filled; coffee pods, filled; iced coffee; coffee-based beverages; coffee beverages containing milk, milk powder, coffee substitutes, cocoa, chocolate, cereals, fruits, sugar, herbs or spices or a combination of these products; cereal preparations; cereal bars; cereal-based snack food; noodle-based prepared meals; noodles / ribbon vermicelli; vermicelli [noodles]; udon noodles; soba noodles.</p>	<p>Class 30: Cereals; cereal powders; breakfast cereals; cereal bars; cereal based energy bars; cereal preparations; cereal snacks; cereal based snack foods; processed cereals; cereal breakfast foods; foodstuffs made from cereals; cereal-based meal replacement bars; ready-to-eat cereals; porridge; grits; muesli; muesli bars; snacks made from muesli; oat-based foods; oat-based cereal; biscuits; cakes; tarts; pastries; bread; gluten free bread; food flavourings; food flavourings for cereals; flavourings for beverages; coffee beverages; cocoa beverages; tea beverages; chocolate beverages; coffee based beverages; cocoa based beverages; tea based beverages; chocolate based beverages; chickpea based breakfast cereals; soy based breakfast cereals; whey protein based breakfast cereals; processed quinoa; oat cakes; crackers; pancakes; low-carbohydrate confectionery.</p>

20. In summary, the opponent submits that the contested terms “*Cereals; cereal powders; breakfast cereals; cereal bars; cereal based energy bars; cereal preparations; cereal snacks; cereal based snack foods; processed cereals; cereal breakfast foods; foodstuffs made from cereals; cereal-based meal replacement bars; ready-to-eat cereals; porridge; grits; muesli; muesli bars; snacks made from muesli; oatbased foods; oat-based cereal; coffee beverages; cocoa beverages; chocolate beverages; coffee based beverages; cocoa based beverages; chocolate based beverages; chickpea based breakfast cereals; soy based breakfast cereals; whey protein based breakfast cereals*” are “clearly identical bearing in mind

Meric. As far as the remaining items are concerned, we submit that they [are] similar at least to a medium degree because they meet the criteria a), b), d) and e) identified in *British Sugar*. In addition, the Applicant's "tea beverages and tea-based beverages" meet the criteria c) and f) and are similar to "coffee and coffee-based beverages". [...] Thus, "food flavourings; food flavourings for cereals; flavourings for beverages" are similar to the Opponent's goods due to being complementary in addition to meeting the criteria b), d) and e) identified in *British Sugar*."

21. As mentioned earlier in this decision, the applicant, in its notice of defence, admitted that the goods "*coffee based beverages; cereal bars; cereal preparations; coffee beverages; cereal based snack foods*" are identical or similar, stating that the remaining terms are neither identical nor similar.
22. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.¹

Coffee based beverages; cereal bars; cereal preparations; coffee beverages; cereal based snack foods

23. The applicant admits that the above contested terms are identical, as they are self-evidently identically worded.

Cereal powders

24. I consider the contested goods to be another term for "*cereal preparations*", which are cereals in a processed form, such as power or paste, appearing in the earlier specification. Thus, I find them to be identical.

¹ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Cereals; cereal snacks

25. The contested term is a broad term that will readily cover the earlier terms “*cereal preparations; cereal bars; cereal-based snack food*”. Thus, based on *Merix*, I find them to be identical.

Cereal based energy bars; cereal-based meal replacement bars

26. The earlier terms “*cereal bars; cereal-based snack food*” are broad terms that will encapsulate the above contested terms, rendering them *Merix* identical.

Muesli bars; snacks made from muesli

27. The contested goods are products that are made from a type of a cereal, i.e. muesli, intended to be consumed as a snack. As a consequence, the contested goods will fall within the broad earlier terms “*cereal bars; cereal-based snack food*”. These goods can, therefore, be considered identical on the principle outlined in *Merix*.

Oat-based foods; grits; muesli; porridge; processed quinoa

The opponent’s goods “*Cereal preparations*” are broad enough to cover the contested terms. These goods can, therefore, be considered identical on the principle outlined in *Merix*. If I am wrong in this finding, then these goods will all be in competition (being alternative breakfast/cereal-based foods). They will also overlap in use, user, method of use, nature and trade channels sold in the same supermarket aisles. As a result, the goods will be highly similar.

Cakes; oat cakes; tarts; pancakes; pastries

28. The contested goods are a variety of products that are considered to be treats of some sort. I consider that there is similarity between the contested goods and the opponent’s “*cereal bars; cereal-based snack food*”. There

is an overlap in nature and purpose, as the competing goods could be made of the same ingredients and consumed for enjoyment of food. They could also share the same users, and trade channels, sold in close proximity from each other. There may be a degree of competition, as one can choose one over the other. Considering these factors together, I find the respective goods and services to be similar to a high degree.

Crackers; biscuits

29. The contested goods are flour-based goods intended to be consumed as a snack. The contested goods may share the same general nature and purpose with the opponent's "*cereal bars; cereal-based snack food*" goods. The users, method of use, and trade channels could be the same. I consider that there is competition between the respective goods but no complementarity. I find them to be similar to a high degree.

Breakfast cereals; cereal breakfast foods; chickpea based breakfast cereals; foodstuffs made from cereals; oat-based cereal; processed cereals; ready-to-eat cereals; soy based breakfast cereals; whey protein based breakfast cereals

30. The contested goods are all cereal based meals made from grains. The closest comparable terms from the earlier specification are "*cereal preparations*". Thus, they can be considered identical on the principle outlined in *Meric*, or else highly similar.
31. If I am wrong on this finding, the contested goods share the same general nature and purpose with the opponent's "*cereal bars; cereal-based snack food*". This is because the average consumer would perceive breakfast cereals to be a complete meal rather than something eaten in between meals or as a particularly small and light meal. The users and channels of trade may overlap with the competing goods sold in supermarkets but not in very close proximity. I do not consider there to be any complementarity

or competition between the goods. Thus, I find them to be similar to a medium degree.

Chocolate based beverages; chocolate beverages; cocoa based beverages; cocoa beverages; tea based beverages; tea beverages

32. I consider that the applicant's goods are similar to the opponent's "*coffee; coffee beverages containing milk, milk powder, coffee substitutes, cocoa, chocolate, cereals, fruits, sugar, herbs or spices or a combination of these products*". These goods share the same general nature, purpose, method of use and users. I consider that there is an overlap in trade channels as they will commonly be sold in the same aisle in a supermarket in close proximity from each other. There may also be a competitive relationship between the goods, but I do not consider them to be complementary. Taking all of the above into account, I consider these goods to be similar to a medium degree.

Bread; gluten free bread

33. The contested goods are cooked/baked dough that could be made, for example, of wheat, oat, rye, or rice. The closest comparable term from the opponent's specification is "*cereal preparations*". The competing goods do not share the same nature, as the contested goods are the end-products against the earlier goods, which are a mix or pre-cooked/-baked dough. However, they overlap in the general purpose, that of sustenance. There is an overlap in users as the competing goods will be bought by members of the general public. There is an element of competition in the sense that the consumers may choose to buy either the end-product or the mix to make fresh bread at home. I also consider that there is overlap in trade channels as the competing goods could be sold in supermarkets or bakeries. I find these goods to be similar to a medium degree.

Low-carbohydrate confectionery

34. The contested goods are food products that can be consumed as a snack. On this basis, the closest comparable terms from the earlier specification are “*cereal bars; cereal-based snack food*”. The competing goods share the same purpose and could be similar in nature. There is an overlap in users and method of use. However, I am doubtful whether these would be sold close to each other. I note that the earlier goods could compete to a certain degree with the contested goods. I therefore find them to be similar to a medium degree.

Food flavourings; food flavourings for cereals; flavourings for beverages

35. The contested goods are ingredients that enhance the flavour of food or beverages. I do not consider these goods to have a direct counterpart within the earlier specification. Also, I note that there is no complementarity between the contested goods and the earlier “*coffee; cereal preparations; cereal bars; cereal-based snack food*” within the confines of the case law. However, I agree with the opponent that there is a general overlap in relation to the users, namely general public at large, and trade channels. In contrast, the competing goods differ in nature, purpose, and method of use. Thus, I consider there is a very low similarity between the respective goods.

Average Consumer and the Purchasing Act

36. The average consumer is deemed to be reasonably well informed, observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

37. The goods at issue in Class 30 are various food or drink items, all of which would be purchased and consumed by the general public. These are inexpensive goods purchased through primarily visual means, most often selected from shops or supermarket shelves or on their online equivalents. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Whilst the average consumer will predominantly purchase them following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing them will be no more than average as the average consumer is likely to consider dietary requirements, flavour and/or nutritional information.

Comparison of Trade Marks


38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

39. 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.

40. The marks to be compared are:

Opponent's Mark	Applicants' Mark
	SUPERZEROS

Overall Impression

41. The contested mark consists of the single word “SUPERZEROS” presented in a standard font and upper case. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.² The overall impression of the earlier mark lies in the conjoined words, with neither word component dominating the other.

42. The earlier mark comprises of the word element “SUPER” in red upper case and standard script, appearing slightly enlarged in the middle. The word “SUPER” is encased by a green wreath with a grey background

² See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

extending outwards from it. Whilst I acknowledge that the average consumer may attribute a descriptive meaning in the word element “SUPER”, it has the greatest weight in the overall impression, with the wreath device playing a less significant role as it could be seen as a decorative element of the mark.

Visual comparison

43. The word element of the earlier mark, “SUPER”, is five letters long, whereas the contested, “SUPERZEROS”, is ten. The entirety of the opponent’s mark, “SUPER”, is incorporated in the applicant’s mark. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,³ the common word element “SUPER” positioned at the beginning of the contested mark creates the only point of visual similarity. In contrast, the second component of the conjoined word element, “-ZEROS”, in the contested mark will be a point of visual difference. The wreath device element in the earlier mark introduces a further visual difference. The font colour divergence of the word elements in the competing marks will play no material role due to the notional and fair use of the contested word mark in any standard font, case, and colour. Considering all the factors, including the overall impression of the marks, I find them visually similar to a low degree.

Aural comparison

44. On the one hand, the earlier mark is a two-syllable mark which the average consumer will articulate as “SOO-PER”. On the other, the contested mark is four syllables long and will be pronounced as “SOO-PER-ZEE-ROWS”, sharing the first and second syllables of the earlier mark. I do not consider that the average consumer will attempt to articulate the figurative elements

³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

in the earlier mark. Therefore, I consider that the marks are aurally similar to a degree that is between low and medium.

Conceptual comparison

45. The opponent submits that:

“This similarity is in no way diminished by the addition of the word ZEROS in the contested mark as the average consumer will perceive said mark as being a combination of the words SUPER and ZEROS conjoined and will be pronounced as two separate words.”

46. The applicant submits that:

“As noted above, the Opposed Mark will be perceived as a play on the word 'SUPERHEROES'. In relation to the relevant goods in class 30, namely cereal products and related goods, the 'ZEROS' aspect of the Opposed Mark will be viewed as a reference to the absence of calories and health benefits of the relevant goods. The Earlier Mark will be perceived as a laudatory reference to the quality of the goods and the wreath will be seen as a reference to Ancient Rome or Ancient Greece, with connotations of victory, emperors and high-ranking status. As a result, the marks are conceptually different.”

47. I note that the competing marks share a conceptual similarity, emanating from the common use of the word “SUPER”, which is a well-known and ordinary dictionary word, conveying the meaning of excellence with a laudatory connotation. The conceptual difference between the competing marks is based on the second word component of the contested mark, “-ZEROS”, which will be easily grasped by the average consumer, qualified by the first word component, “SUPER-”. In the absence of evidence, I am not convinced that the entirety of the general public will understand the play on words and the reference relating to calories as per applicant’s submissions. Further, the presence/absence of the wreath device will also

add to the conceptual difference between the marks. Taking all of this into account, I conclude that the respective marks share a low level of conceptual similarity.

Distinctive Character of The Earlier Trade Mark

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

49. 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.

50. The opponent has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. I bear in mind that only the common elements between the respective marks should be considered to evaluate the relevant (to the question of confusion) distinctiveness.⁴ In this regard, the device element adds to the distinctiveness of the earlier mark, but I note that there is no counterpart in the contested mark, so this is unlikely to increase the likelihood of confusion. As noted above, the common word element (common in comparison to “SUPERZEROS”) “SUPER”, conveying the meaning of excellence, gives a descriptive quality to the mark. Thus, I consider the inherent distinctiveness to be of a low degree, with the distinctiveness of the word element “SUPER” being even lower, boosted slightly by the stylisation of the word element and the wreath device.

Likelihood of Confusion

51. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle i.e. that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁵ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

⁵ See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁶

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the marks are different, but concludes, due to the similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).
53. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

⁶ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

54. 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.”

55. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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).”

I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.⁷

56. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

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

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

58. Earlier in this decision I have concluded that:

⁷ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

- the goods at issue range from identical to similar to a very low degree;
- the average consumer of the parties' goods is a member of the general public, who will select the goods by predominantly visual means, but without dismissing the aural means. The attention will normally be no more than average;
- the competing marks are visually similar to a low degree, aurally similar between a low and medium degree, and conceptually similar to a low degree;
- the earlier mark possesses a low degree, with the distinctiveness of the word element "SUPER" being even lower, boosted slightly by the stylisation of the word element and the wreath device.

59. Before considering the question of likelihood of confusion, I note that whilst the distinctive character of the earlier mark is not especially strong, this does not preclude a likelihood of confusion.⁸

60. Taking into account the above factors, I find that there is no likelihood of direct confusion. It is my view that the average consumer will not forget the additional and divergent word component "-ZEROS" in the contested mark, thereby aiding them in distinguishing the marks. I do not consider that the average consumer would mistake one mark for the other, even on identical goods. In reaching this finding, I have borne in mind the concept of imperfect recollection, but my view is that the differences between the marks are sufficient, and, as a result, they will not be misremembered/misrecalled as each other.

⁸ See for instance paragraph 45 of the CJEU ruling in *L'Oréal SA v OHIM*, Case C-235/05 P.

61. In terms of indirect confusion, even when the average consumer identifies the differences between the marks, I cannot see a reason why they would put the common use of the laudatory word element 'super' as linking the two marks by way of the same or an economically linked undertaking. This is mainly because the contested mark will be viewed as a whole, "SUPERZEROS", where the first word component, "SUPER-", will qualify the second, "-ZEROS". As a result, I do not consider that the additional and second word component "-ZEROS" would represent an obvious brand extension or sub-brand. I find that the guidance given in *Duebros* is more apt for this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse the two. Thus, I consider that there is no likelihood of indirect confusion. This finding extends to the goods for which I found any degree of similarity.

OUTCOME

62. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.**

COSTS

63. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Considering the other side's statement and preparing a counterstatement	£200
Preparing and filing written submissions and considering and commenting on the other side's submissions	£500
Total	£700

64. I am not awarding costs for the preparation of evidence as it was considered irrelevant to the decision made in this case.
65. I, therefore, order JACOBS DOUWE EGBERTS RTL SCC SG PTE. LTD. to pay Breakfast Heros Limited the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of January 2023

**Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General**