



Neutral Citation Number: [2024] EWHC 319 (Ch)

Appeal No. CH-2023-000195

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
CHANCERY APPEALS (ChD)
ON APPEAL FROM THE TRADE MARKS REGISTRY OF THE UK IPO
PURSUANT TO SECTION 76 OF THE TRADE MARKS ACT 1994

In the matter of UK Trade Mark Application No. 3403664
AND the opposition thereto under No. 418020
AND on appeal from the Registrar's Decision No. O/0800/23

Royal Courts of Justice
Strand, London
WC2A 2LL

Date: Monday, 12th February 2024

Before:

MR. JUSTICE HOLGATE

Between:

EXTREME E LIMITED

Appellant /
Applicant

- and -

EXTREME NETWORKS LIMITED

Respondent /
Opponent

MS. CHARLOTTE BLYTHE (instructed by **Bird & Bird LLP**) appeared on behalf of the
Claimants

MR. AARON WOOD (instructed by **Brandsmiths**) appeared on behalf of the
Respondent/Opponent

Approved Judgment

This judgment was handed down remotely at 10.30am on 15 February 2024 by circulation to the parties or their representatives by e-mail and by release to the National Archives.

.....

THE HON. MR JUSTICE HOLGATE

Digital Transcription by Marten Walsh Cherer Ltd.,
2nd Floor, Quality House, 6-9 Quality Court, Chancery Lane, London WC2A 1HP.
Telephone No: 020 7067 2900. DX 410 LDE
Email: info@martenwalshcherer.com
Web: www.martenwalshcherer.com

MR. JUSTICE HOLGATE :

1. On 31st May 2019 Extreme E Limited, the appellant, applied to register a trade mark ("the contested mark"). On 10th September 2019, the application was partially opposed by the respondent, Extreme Networks Limited, pursuant to section 5(2)(b) of the Trade Marks Act 1994 ("the 1994 Act"), relying upon their own trade mark registered on 22nd May 2019 ("the earlier mark"). Their opposition related to class 41 and class 43 services covered by the contested mark.
2. The earlier mark shows the word "EXTREME" running horizontally beneath an oval device which contains the letter "E" and below that the letter "X" or a cross. The contested mark shows the message "EXREME.E" running vertically on the right-hand side. To the left there is a square device with a cross or letter "X" within it. There is a vertical line down the centre of the square on either side of which the colours are inverted.
3. The respondent contended that the contested mark is similar to the earlier mark, the services are identical or similar, and consequently there exists a likelihood of confusion on the part of the public. Because the respondent's opposition was partial, section 5A of the 1994 Act was engaged.
4. The matter came before a Hearing Officer on 31st May 2023, she issued her decision on 21st August 2023 (decision number O/0800/23). She upheld the opposition in part.
5. The appellant appeals against that decision under section 76 of the 1994 Act. The parties did not seek to rely upon any evidence before the Officer, or even an agreed statement of facts. They simply filed short skeletons and made further oral submissions at the hearing. It is common ground that the respondent bore the onus of satisfying the Officer on its grounds of opposition.
6. The Officer summarised a number of well-established legal principles at paragraphs 10 to 16 of her decision. The summary included the list of principles relating to likelihood of confusion set out by Mellor J in *Lifestyle Equities CV v Royal County of Berkshire Polo Club* [2022] EWHC 1839 at [48], factors for assessing similarity set out by Jacobs J (as he then was) in *British Sugar plc v James Robertson & Sons Limited* [1996] RPC 281 and an explanation of complementarity.
7. At paragraphs 17 to 46 the Officer assessed whether the services of the appellant and the respondent to which their respective marks related were identical, similar or dissimilar and, if similar, the degree of similarity.
8. At paragraphs 47 to 49 the Officer addressed the average consumer and the nature of the purchasing act. At paragraphs 50 to 57 she made her comparison of the marks. At paragraphs 58 to 60 she addressed the distinctiveness of the respondent's mark.
9. At paragraphs 61 to 63 she addressed the likelihood of confusion in the light of her earlier findings. Her ultimate conclusion was that there would be direct or indirect confusion for the services that she had found to be identical or similar.

10. The principles governing the approach taken by this court to an appeal under section 76 have been helpfully summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24].
11. The appeal court should acknowledge and respect the specialist expertise of the Hearing Officer and be cautious about interfering with her decision.
12. The appellant advances six grounds of appeal. Ground 1 challenges the Officer's conclusions on similarity in relation to three services falling within class 41. Ground 1 therefore relates to a threshold which had to be satisfied before issues relating to similarity between the marks and likelihood of confusion could arise. It is common ground that, insofar as the court upholds ground 1, the Officer's finding of similarity would be replaced by a finding of dissimilarity, and the registration of the contested mark would include those disputed services (subject to the remaining grounds of appeal). There would be no need to remit the matter to the Registrar on that issue.
13. Grounds 2 to 6 concern findings by the Officer relating to her comparison of the marks and likelihood of confusion. Ms. Blythe on behalf of the appellant says that grounds 2 to 4 are each freestanding matters, but she accepts that grounds 5 and 6 have to go together; success on one of those two grounds without the other would be insufficient.
14. Success on one or more of grounds 2 to 4 and/or grounds 5 and 6 would affect the registration of the contested mark as a whole. It would also be necessary for the court to consider whether it could resolve the issue itself or whether the matter should be remitted.

Ground 1

15. The appellant challenges the Officer's findings on similarity in paragraphs 21, 22 and 43 of the decision which relate respectively to the following activities:-
 - ".... Cultural activities; organisation of sporting and cultural events and activities; organisation of exhibitions for cultural and educational purposes."
 - "Organisation of motor vehicle races; entertainment in the form of live motor sport races; entertainment in the form of live shows and events relating to motoring or motor vehicles; organisation of real or virtual sports, competitions, particularly mechanical sports competitions."
 - "Organisation and conducting of award ceremonies and gala ceremonies for entertainment purposes."
16. Each of these fell to be compared with the respondent's activity "booking of seating for shows".
17. In paragraph 21, dealing with the first of those three matters the Officer said:-
 - "Mr. Wood submitted that these terms could include the provision of theatre shows and that there is, therefore, some similarity with 'booking of seats for shows' in the opponent's

specification. I agree. The same businesses that provide and organize shows are also likely to provide services for the booking of seats. There is an overlap in user. I also consider the services to be complementary. The nature, purpose and method of use differ. Consequently, I consider the services to be similar to a medium degree."

18. In paragraph 22 the Officer said in relation to the second group of activities:-

"I accept that the organization of different types of events would also involve the provision of a booking service for seats at that event. Consequently, there would be some overlap in nature, user, method of use and purpose with the opponent's 'booking of seats for shows'. I do not consider it likely that the trade channels would overlap significantly, nor do I consider there to be complementarity or competition. Consequently, I consider there to be a medium degree of similarity."

19. In paragraph 43, with regard to the third set of activities the Officer said:-

"I consider that the same reasoning applies to these services as set out in paragraph 22 above. Consequently, these services are similar to a medium degree."

20. It is necessary to see how the matter was put before the Officer. In the respondent's initial written representations to the Trade Mark Registry dated 27th February 2020, no specific comparison was made of the activities dealt with in paragraphs 21, 22 and 43 of the decision. The respondent simply compared all of the activities covered by each mark as a whole.

21. In its brief skeleton argument dated 30th May 2023 the respondent made some comparisons between specific activities, but nothing was said about the comparisons the subject of paragraphs 21, 22 and 43 of the decision. Paragraph 21 of the decision covers three types of activity. They are firstly, cultural activities, secondly, organisation of sporting and cultural events and activities and thirdly, organisation of exhibitions for cultural and educational purposes. Here sporting events were only referred to as part of the second term.

22. During the hearing before the Officer, Mr. Wood, for the respondent, said that it was unclear what was the full scope of "cultural activities", but it would potentially include shows and that was similar to booking of seats for shows. He said that because the people providing the shows as a cultural activity would also be providing the booking of seats, there would be an overlap with the respondent's activity of booking of seats for shows.

23. Later on in his submissions, he addressed items in the appellant's application such as organisation of sporting activities and motor vehicle races and similar expressions, which he compared to the respondent's activity of gambling. That specific comparison was not accepted by the Officer.

24. He then went on to make a comparison between the organisation of cultural events and the organisation of exhibitions for cultural and educational purposes on the one hand and on the other the booking of seats for shows. But the respondent never suggested that the organisation of sports events or motor races was similar to the booking of seats for shows. Consequently, Ms. Blythe did not address that point at the hearing. There was no apparent need to do so.
25. In this appeal the parties agree that in paragraph 21 of her decision the Officer accepted Mr. Wood's submission on similarity between on the one hand cultural activities, organisation of cultural events and activities, organisation of exhibitions for cultural and educational purposes and on the other the booking of seats for shows. However, she extended that point to cover similarity between the organisation of sporting events and the booking of seats for shows. In paragraph 22, she then extended that same point to a comparison between the booking of seats for shows and the organisation of the motor sport activities there set out. In paragraph 43 she then applied the reasoning in paragraph 22 to the comparison with organisation and conducting of award or gala ceremonies for entertainment purposes.
26. Ms. Blythe relies upon this statement of principle in the judgment of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 at p.18:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."
27. Mr. Wood rightly said that that had been an infringement case, but he accepted that the same principle applies in the consideration of disputes concerning opposition to the registration of a trade mark. Ms. Blythe agreed.
28. Ms. Blythe submitted that organisers of sporting and cultural activities and events and of exhibitions may sell tickets to their own events or shows but they do not sell tickets to events or shows of third parties or in the market generally. They are not competing for a share in that market. They do not operate, for example, as a ticket agency. The selling of a ticket for the event being organised is incidental to the core business of organising the relevant activities. It is not clear that *Avnet* was relied upon in submissions before the Officer but the respondent does not object to the appellant advancing its submissions in this way.
29. Ultimately, Mr. Wood's response to that submission was that in the third sentence of paragraph 21 of the decision, the Officer was stating that organisers of shows are likely to provide for the booking of seats not only for their own events but also those of third parties. But Mr. Wood very fairly accepted that if paragraph 21 of the decision is not to be read in the way he suggests, in other words it means that the organisers of shows sell seats for their own events but not third party events, then the Officer "probably fell into error". With respect he did not advance any submissions against the analysis by Ms. Blythe as such.

30. From the transcript of the hearing before the Officer it is plain that it was not suggested to her that organisers of shows or events would sell any tickets other than for their own shows and events.
31. Although both parties agreed that the Officer was entitled to come to her own view of the matter and that would not involve procedural unfairness, there is nothing in the decision to indicate that her reasoning was based on organisers of shows or events selling seats for third party events. If she had taken that wider view, in my judgment, she would have been bound to say so in express terms, partly in order to comply with her duty to give reasons (see rule 69 of the Trade Marks Rules 2008 SI 2008 No.1797). In my judgment parties familiar with the issues and submissions in this case would have no reason to think that the Officer had taken that wider view of the activities proposed for the contested mark. If I had considered that it was possible to read paragraph 21 in the wider manner contended for by Mr. Wood, in other words as covering seat sales for third party shows and events, I would have had no hesitation in concluding that there was failure to give adequate reasons, applying established principles, and I would have upheld this first part of ground 1 on that basis.
32. However, I prefer to say that the Officer did not reach a conclusion in paragraph 21 by relying upon a point which is not contained in the decision at all, and which would have involved a breach of the duty to give reasons. Instead, she proceeded on the basis that organisers sell tickets for their own events but not third party events. In these circumstances, I agree with Ms. Blythe's analysis based on *Avnet*. The same analysis applies to paragraphs 22 and 43 of the decision. In my judgment it follows that none of the appellant's activities described in paragraphs 21, 22 and 43 of the decision could be reasonably said to be similar to an activity covered by the existing mark, in particular the booking of seats for shows.
33. On the submissions before me, the mere fact that seats may be booked for shows by members of the public cannot create a material overlap sufficient to support a finding of similarity. In relation to the existing mark, seats may be booked for shows organised by third parties, but that activity does not include the organising of shows. In relation to the contested mark, the core or substance of the activity relates to the organising of shows (and events) for which the booking of seats (where available) is merely incidental and no booking of seats for third party shows (and events) is involved.
34. As previously explained, it would be inappropriate to remit the matter on this point. Instead, the registration of the contested mark should include the activities to which paragraphs 21, 22 and 43 of the decision relate. That is sufficient to decide ground 1.
35. I will briefly deal with the remaining points which concern sport related matters. Ms. Blythe's submissions applied to the organising of sporting events under paragraph 21 and the whole of paragraph 22. I do not accept her suggestion that the word "show" is used for the existing mark only in the sense of a theatrical show. The term would include such a show, but it would also embrace shows of all kinds whether inside a building or outside. A show could include a display or exhibition or a spectacle or entertainment of some kind, but it would have to be something for which seats could be booked. Although a sporting event may well be watched by spectators, that is insufficient to make it a show.

36. To the average consumer the core or substance of a sporting event is a game or activity which involves physical exercise and/or skill. A football or rugby match would not ordinarily be described as a show, even in the case of an exhibition tennis match the focus is still on the sport. The Officer's decision does not supply any reasoning as to why a sporting event or motor sport event should be considered as a show. There is nothing to suggest that these issues were considered. The point was not advanced by the respondent. The decision in paragraphs 21 and 22 in relation to sport-related matters cannot stand.
37. In addition, I accept Ms. Blythe's submission that sporting events do not necessarily involve the use of seats or, even where they do, seating which is bookable. It does not appear from the decision that those matters were taken into consideration by the Officer. Certainly she gave no reasoning in relation to them. To that extent also ground 1 succeeds.

Ground 2

38. This ground relates to the Officer's visual comparison of the two marks, as set out in paragraphs 53-55 of the decision. It is submitted that she made two errors in paragraphs 53 and 54 which led to an erroneous conclusion in paragraph 55 and that the marks were similar to a material degree.

39. Paragraphs 53 and 54 read:

"53. The opponent's mark consists of the word EXTREME presented in a standard title case font. Above that word is an oval device, containing the letter E (in lower case) and either the letter X or a cross-device, depending on how it is perceived. The eye is naturally drawn to the word EXTREME, but given the size of the device, I consider that they play a roughly equal role in the overall impression.

"54. The applicant's mark consists of the word EXTREME.E, presented vertically. This is presented alongside a square device, with a cross (or letter X) within it. The colours appear in greyscale and there is a vertical line down the centre of the device, along which the colours are inverted. Again, the eye is naturally drawn to the element that can be read, but given the size of the device, I consider them to play a roughly equal role in the overall impression."

40. In summary, it submitted that the Officer should have found, firstly, in the case of both marks the eye is drawn to the device rather than the word "EXTREME" or "EXTREME.E". Secondly, the Officer erred in saying that in each mark the device and the word "elements" play a roughly equal role in the overall impression. She should have found that the devices were the more important element in each mark.
41. Ms. Blythe accepted that these were matters of degree and judgment. She also accepted that she has to surmount a high bar and persuade the court that, in effect, the Officer's conclusions were irrational or perverse. She rightly said that her contentions are of a kind which are incapable of further elaboration. For my part, I find it impossible to say

that the Officer's conclusions lay beyond the range of judgments to which a decision maker could properly come.

42. In paragraph 55 of her decision, the Officer said:

"55. Visually, the marks overlap in that they both contain the word EXTREME, the letter E (albeit it is within the device in the opponent's mark) and a device which contain a cross (or the letter X). They differ in the presentation of the device, the orientation of the text and the addition of the 'dot' in the applicant's mark. Taking all of this into account, I consider the marks to be visually similar to a medium degree."

43. The appellant submitted that the Officer gave the "word element" too much relative weight in her judgment. But it was a matter of judgment. It is not open to criticism on appeal. It was not unreasonable or perverse.

Ground 3

44. Ground 3 relates to the Officer's aural comparison of the marks at paragraph 56 of her decision, which reads as follows:

"56. Aurally, because the letters E and X (if the latter is perceived as a letter) in the opponent's mark are presented within the device, I consider it unlikely that they will be articulated. In my view, the only element of the opponent's mark which is likely to be pronounced is the word EXTREME. The applicant's mark is most likely to be pronounced EXTREME-EEE. Again, I do not consider the X (if it is perceived as such) will be articulated due to its incorporation into the device. Consequently, I consider the marks to be aurally highly similar. Even if I am wrong and all of the letters are articulated, this will result in the opponent's mark being pronounced EEE-EXXEXTREME or EXX-EXTREME (if the letters E and X are pronounced as one 'word'). The applicant's mark will be pronounced EXX-EXTREME-EEE. In my view, in either case, there is a high degree of aural similarity."

45. In her skeleton, Ms. Blythe makes two criticisms. First, the Officer should have concluded that the letters E and X in the device of the earlier mark would be pronounced. She says the E and X would be seen by consumers as part of the brand name and not just the word "EXTREME". She says the letters are unstylised. The appellant's case is that the symbols inside the device of its mark would not be pronounced. Second, she submits that the Officer erred in concluding that if the letters in the device of the earlier mark are pronounced, then "automatically" the letters in the device of the contested mark would also be pronounced.
46. I reject the first criticism. The Officer's judgment was a permissible one. It was not unreasonable. The court is not entitled to substitute a different opinion to the Officer's judgment on this point or otherwise to intervene.

47. As to the second issue, I reject the criticism that the Officer's treatment of the contested mark was "automatic" as if to imply that she failed to exercise any judgment. Her primary judgment was that in the case of both marks the letter or letters within the device are unlikely to be articulated. As I have said, there is no basis for challenging in this court her judgment that the marks should not be differentiated in that respect. It was a reasonable conclusion.
48. In these circumstances, it was also reasonable for the Officer to pose the question: What if she was wrong about that judgment? She dealt with that question without, as a matter of her judgment, finding it appropriate to draw a distinction between the marks. She did not treat the matter as "automatic".
49. It is said that the respondent did not suggest in the proceedings below that the device in the contested mark would be pronounced. But the appellant does not say here that the Officer was bound by that stance or that her conclusions involved any procedural unfairness.
50. There was nothing unreasonable about the Officer's judgment that as a matter degree in relation to each of the two comparisons she made there was a high degree of aural similarity. Ground 3 must be rejected.

Ground 4

51. This challenges paragraph 60 of the decision in which the Officer dealt with the inherent distinctiveness of the earlier mark. Paragraph 60 reads as follows:

"60. The opponent has not pleaded that the distinctiveness of its mark has been enhanced through use, nor has it filed any evidence to support such a finding. Consequently, I have only the inherent position to consider. The word EXTREME in the opponent's mark will be given its ordinary dictionary meaning i.e. very great in degree or intensity. This may be seen as descriptive for some of the services (such as those relating to sport). Otherwise, I do not consider it to have any particular meaning in relation to the services. Consequently, I consider it to be inherently distinctive to a low degree, or to a medium degree, depending on the services. I accept that the device increases the distinctiveness of the mark overall to either between a low and medium degree or to a slightly higher than medium degree (depending upon the starting point)."
52. Thus, the Officer treated "EXTREME" in the respondent's mark as meaning "very great in degree or intensity". The appellant submits that she ought to have found that the word EXTREME was descriptive, or at the very least allusive, across all of the respondent's services and not just some of the services, such as those relating to sport. It is then said that it would follow that she would have found that the respondent's mark has a degree of inherent distinctiveness between low and medium in respect of all of its services.
53. With respect, there are two flaws in the argument. In her submissions Ms. Blythe said that the Officer's finding was that "EXTREME" was distinctive to a level lying at a

point somewhere between low and medium. That is not what the Officer said. She found that the word "EXTREME" was "distinctive to a low degree, or to a medium degree, depending on the services". Thus her conclusion was that the degree of distinctiveness varied according to the service. That was a matter of judgment open to the Officer. I see no basis upon which the court could say that she was not entitled to reach that conclusion.

54. The same applies to the second issue. In her skeleton, Ms. Blythe referred to a number of the respondent's services apart from sports, examples of which she claimed could be described as "extreme" in the sense used by the Officer. The examples included the provision of food of an extreme type or in an extreme venue, or hotel services of an extreme type or where the decor is extreme. I remind myself that the submission is not based on any evidence given to the Officer. More importantly, and in any event, Ms. Blythe rightly accepted that this raises an issue of degree and judgment. I do not see how the Officer's judgment could be treated as unreasonable.

Grounds 5 and 6

55. Grounds 5 and 6 relate to the Officer's findings on likelihood of confusion. Ground 5 challenges the Officer's conclusion on direct confusion and ground 6 challenges her conclusion on indirect confusion. As stated above, the appellant needs to succeed on both grounds 5 and 6 in order for the court to overturn the Officer's conclusion that because of the similarities she had found there was a likelihood of confusion on the part of the public. If, for example, ground 5 succeeded in relation to direct confusion but ground 6 failed on indirect confusion, the court could not intervene on ground 5 alone.
56. In paragraph 61 of her decision the Officer said:

"61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective services may be offset by a greater degree of similarity between the respective marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind."

57. In paragraph 62, the Officer drew together her earlier findings on similarity of services and the marks, the attributes of the average consumer and of the purchasing process for the services and the distinctiveness of the earlier mark.

58. In paragraph 63 she briefly gave her overall conclusion on likelihood of confusion:

"63. I will carry out my assessment on the basis that the earlier mark is inherently distinctive to between a low and medium degree, as that represents the applicant's best case. In my view, even in those circumstances, the marks are likely to be mistakenly recalled or misremembered as each other. Notwithstanding the relatively low distinctiveness of the common word, EXTREME, the common word, combined with devices which incorporate a cross (or the letter X) and the addition of the letter E to both marks, is likely to result in them being misremembered when taking into account imperfect recollection. Even if the differences between them are identified, I consider it likely that they will be viewed as an alternative mark being used by the same undertaking. There is direct and indirect confusion for all services that I have found to be identical or similar."

59. In *Axogen* at [25] Joanna Smith J referred to established case law which explains why, given the multifactorial nature of likelihood of confusion, an appellate court is generally reluctant to interfere with an Officer's conclusions on that issue. In general an appellant must show a distinct or material error of principle or that the judgment reached was irrational.
60. In *Liverpool Gin Distillery Limited v Sazerac Brands LLC* [2021] EWCA Civ 1207, Arnold LJ summarised the legal principles governing the distinction between direct and indirect confusion [10]-[12]. Direct confusion occurs where the average consumer would mistake the sign complained of for the existing trade mark. Indirect confusion is where the average consumer would not make that mistake, but believes that the similarity between the marks and services is because the undertaking responsible is the same or related. Arnold LJ said that it is important to remember that these mistakes are very different in nature. Direct mistake involves no process of reasoning. It is a simple matter of mistaking one mark for another. Indirect confusion however must involve a mental process of some kind on the part of the average consumer when he sees, or recalls seeing, the later mark.
61. In *LA Sugar Ltd v Back Beat Inc* (O/375/10) Mr. Iain Purvis QC sitting as the Appointed Person identified at [17] three categories into which cases of indirect confusion tend to fall. In the *Liverpool Gin Distillery* case Arnold LJ said at [12] that that explanation was helpful but not exhaustive. At [13] he said that where there is no likelihood of direct confusion, a proper basis must be shown for concluding that there is a likelihood of indirect confusion.
62. I will summarise the parties' cases before the Officer. Initially, Mr. Wood for the respondent asserted that there would be a likelihood of confusion with very little explanation (see p.26 of the transcript). The skeleton argument for his client had been similarly terse. The Officer had to ask during the hearing whether the respondent was claiming direct or indirect confusion or both (see p.27 of the transcript). Mr. Wood replied that both marks had the same three elements and so there was a possibility of direct confusion. Later on at p.60 he said "direct confusion is not the strongest part of our case" but it was a point which he said needed to be considered.

63. On indirect confusion, he made his submissions by referring to the three categories in *LA Sugar*. He said it was arguable that only one company would use "EXTREME" so that the case fell into the first category. He appears not to have relied on the second category (see p.29 of the transcript). With a logo mark it was more difficult to say than in the case of a word mark that it was a brand extension or variant mark falling within the third category "but it is not inconceivable".
64. Ms. Blythe submitted to the Officer that there was no prospect of direct confusion. She said that they were both configurative marks where the device is prominent and eye-catching. There was no prospect of them being mistaken for each other. On indirect confusion where an average consumer is aware of the differences between the marks, she submitted that no such confusion was likely to arise. She went through each of the three categories in *LA Sugar* giving brief reasons in support of her submissions.
65. On direct confusion, the Officer concluded that the marks were likely to be mistakenly recalled or misremembered as each other. In this respect, she relied upon the common word EXTREME combined with devices which incorporate a cross or letter X and the addition of letter E. Her reasoning in paragraph 63 must be considered in the light of her summary of her conclusions in paragraph 62 and the earlier paragraphs from which they were drawn. The attack in grounds 2 to 4 on parts of that reasoning has failed. So the Officer must have taken into account, for example, the fact that visual considerations are likely to dominate the process of selecting services but the aural component should not be discounted. Visual similarity between the marks was to a medium degree and aural similarity to a high degree. Conceptually they were identical or highly similar. She must also have had in mind her findings in paragraphs 55.
66. The Officer reached an overall judgment on direct confusion in paragraph 63, which in my judgment cannot be criticised as lying outside the range of rational responses to the material before her and in the context of her earlier findings.
67. It follows that the appellant's challenge under ground 6 is academic but I will consider it. Here the conclusion appears in the penultimate sentence of paragraph 63:
- "Even if the differences between them are identified, I consider it likely that they will be viewed as an alternative mark being used by the same undertaking."
68. That sentence, too, must be read in the context of the Officer's earlier reasoning in her decision and not in isolation. In substance, it represents the mental process described in the last sentence of [16] in *LA Sugar*.
69. The Officer did not analyse the three examples of categories in [17] of *LA Sugar*, but in *The Matter of the Trade Mark Application by Duebros Limited* (3100534), Mr. James Mellor QC (as he then was) said at [81] that that paragraph should not be applied as something akin to a statutory test.

"In particular, it is important that the detail of each of the sub-paragraphs does not provoke the tribunal into too detailed an analysis of what ... should be an emulation of an instinctive reaction in the mind of the average consumer when encountering

the later mark with an imperfect recollection of the earlier mark in mind."

70. In paragraph 81.2 he added:

"It is not a process of analysis or reasoning, but an impression or instinctive reaction."

(See also the decisions cited in footnote 127 on page 459 of Kerly's Law of Trade Marks and Trade Names (17th edition)).

71. I also bear in mind the statement by Arnold J (as he then was) in *Interflora Inc v Marks and Spencer* [2013] EWHC 1291 (Ch) at [224]. The likelihood of confusion "does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention."

72. Although the reasoning given by the Officer in this case could not have been any shorter, looking at the matter overall, I am not persuaded that it was inadequate as a matter of law, or that her conclusion was unreasonable or wrong, or that there was any other basis upon which this court should intervene under ground 6.

Conclusion

73. For the above reasons I allow the appeal solely on ground 1.
