

**O-038-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3200414 BY  
NITROGENE INTERNATIONAL LTD.  
TO REGISTER:**

**NITROGENE**

**AS A TRADE MARK IN CLASSES 3, 14, 25, 26 & 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408538 BY NITRO AG**

## BACKGROUND & PLEADINGS

1. On 5 December 2016, Nitrogene International Ltd. (“the applicant”) applied to register the trade mark **NITROGENE** for goods and services in classes 3, 14, 25, 26 and 38.

The application was published for opposition purposes on 16 December 2016.

2. On 14 February 2017, the application was opposed in full by Nitro AG (“the opponent”). The opposition was originally based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, for reasons which will become clearer later in this decision, I need only refer to the ground based upon section 5(2)(b), in relation to which the opponent relies upon an International Registration designating the European Union (“IREU”) No. 573078 for the trade mark shown below:

# NITRO

which designated the EU on 8 January 2009 and which was granted protection in the EU on 4 September 2012. The opponent indicates that it relies upon all the goods in its registration, shown in paragraph 12 below.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Groom, Wilkes & Wright LLP; the applicant represents itself. Although only the opponent filed evidence, both parties filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent elected to file written submission in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

5. Following the filing of the written submissions, the tribunal wrote to the opponent. In a letter dated 13 December 2017, the Casework examiner stated:

“Upon further inspection, I refer to your evidence and submissions filed 26 June 2017 and further submissions dated 29 September 2017.

### **Section 5(3) & 5(4)(a)**

It is noted that no evidence was filed by the opponent to support these grounds and therefore before a decision is written the Registry is minded to strike out these grounds, as evidence is required to support grounds under section 5(3) and 5(4)(a).

### **Extent of the opposition**

It is also noted that the opponent’s submission state that it wishes to focus on the argument against Classes 25 and 26 of the application, however the form TM7 indicated that the opponent is opposing all the goods applied for by the applicant, which include Classes 3 and 14.

### **Response required**

The opponent is invited to comment on the above observations on or before **5 January 2018**. Failure to comment will result on the opposition only continuing against Classes 25 and 26 based on Section 5(2)(b).”

6. The consequence of the opponent not responding to the tribunal’s letter are clearly set out in the final paragraph. As the opponent did not respond to that letter within the timescale allowed (nor has any response to that letter been received prior to the issuing of this decision), the opponent is deemed to have restricted its opposition to one based solely upon section 5(2)(b) of the Act and directed only against the goods in classes 25 and 26 of the application. The opposition to the remaining goods and services i.e. those in classes 3, 14 and 38 are deemed withdrawn.

## **The opponent's evidence**

7. This consists of a witness statement and exhibits from Sylvie Tate, a trade mark attorney at Groom, Wilkes and Wright LLP. I will return to this evidence later in this decision.

## **DECISION**

8. The opposition is based upon section 5(2)(b) of the Act which reads 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,

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

9. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings, the opponent is relying upon the IREU shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier trade mark had not been protected for more than five years at the date the application was published, it is not subject to the proof of use provisions.

### **Section 5(2)(b) – case law**

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

### **The principles:**

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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

12. The competing goods are as follows:

Opponent	Applicant
<b>Class 25</b> - Clothing for sports. <b>Class 28</b> - Sporting articles particularly snowboards.	<b>Class 25</b> - Clothing; footwear; headgear; swimwear; sportswear; leisurewear. <b>Class 26</b> - Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

13. In approaching the matter, I am guided by the following case law. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) 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;
- e) The extent to which the respective goods or services are competitive. This enquiry 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.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... 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."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."



In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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”.

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

## **Class 25**

14. In its counterstatement, the applicant accepts:

“12...that there are similarities between the goods specified in class 25...”

15. That, however, understates the position. As the opponent's "clothing for sports" is broad enough to include the applicant's: "footwear; headgear; swimwear; sportswear" and "leisurewear" and as the applicant's "clothing" would include the opponent's "clothing for sports", the competing goods are to be regarded as identical on the principles outlined in *Meric*.

## **Class 26**

16. In its submissions filed during the evidence rounds, the opponent states:

"We further contend that the respective goods in classes 25 and 26 are similar. In this regard we Exhibit ST1...referring to an extract from the EUIPO Similarity of Goods and Services Database, which clearly shows that similarity can be found between goods in classes 25 and 26. For example, buttons, hooks and eyes are integral parts of clothing. Often clothing is provided with spare buttons and fastenings. They are complimentary items."

17. As the case law explains, for goods to be regarded as complementary, there must be "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". In addition, in *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found:

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

18. Whilst I note the contents of exhibit ST1, they are not, of course, binding upon me. Given the nature of its goods in class 28, the opponent sensibly bases its submissions

upon its goods in class 25 i.e. “clothing for sports”; I will adopt the same approach. Applying the guidance in, inter alia, *Canon*, *Boston Scientific* and *Les Éditions Albert René*, I am unable to identify any similarity or competitive/complementary relationship between the opponent's goods and the applicant's “pins; needles; artificial flowers”.

19. I will return to “lace” in a moment. The goods that remain are either used to adorn clothing i.e. “embroidery; ribbons; braid” (the first category) or are components of clothing i.e. “buttons; hooks and eyes” (the second category). Although the users of all these goods and those of the opponent may be the same, that level of generality tells one very little. In relation to the first category of goods, these may have a similar physical nature to the opponent's goods. However, their intended purpose and method of use are different and there is no competitive relationship between them. Whilst such goods may be used to adorn articles of clothing, that does not (for the reasons explained in *Les Éditions Albert René*) make them similar nor (in the absence of evidence to suggest that those conducting a trade in clothing also conduct a trade in such goods), does it make them complementary in the sense outlined in *Boston Scientific* i.e. that the consumer would think that the responsibility for the applicant's named goods lies with the opponent. The opposition to “embroidery; ribbons; braid” fails and is dismissed accordingly.

20. As for the second category of goods, the nature of these goods and the opponent's goods is different as is their intended purpose and method of use. There is no competition between such goods. While it is true that such goods have an important role to play in the use of clothing, in relation to complementarity, I reach the same conclusions in relation to this category of goods that I did in relation to the first category of goods and the opposition to “buttons; hooks and eyes” also fails.

21. That leaves “lace” to consider. Lace shares a similar nature to the opponent's goods. Although the method of use differs, once made-up it may be used for a similar purpose i.e. as an item of clothing, a dress for example. Whilst I think the trade channels of the competing goods are likely to differ and there is no complementary

relationship (in the sense envisaged by the case law), in relation to clothing at large there is likely to be an element of competition in that one might buy an item of clothing made of lace or elect to buy lace in the piece and make it up into an item of clothing oneself. However, the opponent's specification in class 25 is for "clothing for sports". Although such goods may be adorned with lace, I think it most unlikely that they would be made of lace. In short, I am not satisfied that there is any meaningful degree of similarity/complementarity between the opponent's goods and "lace" in the applicant's specification and the opposition to lace also fails.

22. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

23. Where there is no similarity, there can be no likelihood of confusion and the opposition to the applicant's goods in class 26 fails and is dismissed accordingly.

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

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods in Class 25 I have found to be identical; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited*,

*J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

25. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

26. In its submissions filed during the evidence rounds, the opponent states:

“In this case the respective goods are mass consumption items aimed at a general public. As such the level of attentiveness of the relevant consumer will be low to average.”

27. The average consumer of the goods at issue is a member of the general public buying on their own behalf or a business user buying on behalf of a commercial

undertaking. As a member of the general public will, for the most part, self-select the goods from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are, as the case law explains, likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten. I see no reason why a business user would not select the goods in much the same way, with intermediaries such as wholesalers and trade-focused sales representatives also likely to feature in the process.

28. In its submissions, the opponent characterises the degree of care the average consumer will display as “low to average”. The cost of the goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing, a member of the public can, I think, be expected to pay an “average” (rather than “low”) degree of attention to their selection. I think a business user selecting for commercial purposes where, for example, larger sums may be in play and contracts may be negotiated over a period of time, is likely to pay a somewhat higher degree of attention when selecting the goods at issue.

### **Comparison of trade marks**

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

30. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
<b>NITRO</b>	NITROGENE

31. In reaching the conclusions which follow, I have taken into account (but do not intend to record here) all the competing submissions on this aspect of the case (that includes the opponent's references to decisions reached by the Opposition division of the EUIPO).

32. The competing trade marks consist of the single word NITRO (presented in an unremarkable font in bold upper case letters) and NITROGENE (presented in block capital letters) respectively. As no part of either word is highlighted or emphasised in any way, there are no distinctive and dominant components. The overall impressions they will convey and their distinctiveness lie in the single words of which they are composed. Having reached those conclusions, I will now compare the competing trade marks from the visual, aural and conceptual standpoints.

33. The competing trade marks are five and nine letters long respectively. The first five letters of the applicant's trade mark are identical to the five letters of which the opponent's trade mark is composed. The last four letters of the applicant's trade mark i.e. GENE have no counterpart in the opponent's trade mark. Bearing in mind the

similarities and differences, but reminding myself that as a general rule the beginnings of trade marks tend to have more visual and aural impact than their endings (*El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), I find the competing trade marks to be visually similar to an above average degree.

34. In relation to aural similarity, the opponent's trade mark is most likely to be pronounced as the two syllable word NI-TRO, whereas the applicant's trade mark will be pronounced as the three syllable word NI-TRO-GENE. As the first two syllables will be articulated in an identical fashion but bearing in mind that the final syllable in the applicant's trade mark will be verbalised and is alien to the opponent's trade mark, results, once again in my view, in an above average degree of aural similarity.

35. Finally, the conceptual comparison. In its counterstatement, the applicant submits that the competing trade marks are conceptually different. It argues that the opponent's trade mark will be construed as "the short form of nitroglycerine or nitromethane, and is commonly used to refer to giving a speed boost or an increase in speed", whereas its trade mark "has no conceptual meaning and is simply a made-up word". The opponent argues that if that is the case, as the applicant's trade mark also contains the letters NITRO, the same conceptual message will be sent by that part of its trade mark resulting "in some degree of conceptual similarity". In the alternative, the opponent submits, inter alia, that consumers would perceive its trade mark "as a prefix used to indicate something "of or containing nitric acid, nitrates or nitrogen" adding that "nitro is a mass noun for compounds in the nitro group" and "all words in the English language beginning with nitro relate in some way to the element". Exhibits ST2 (an extract from the freedictionary.com) and ST3 (an extract from infoplease.com) are provided in support. The opponent concludes:

"As such, we contend that whilst the relevant consumer may not understand the nature or specifics of the nitro group, they would note the distinctive element "nitro" in each of the respective marks, and understand that it was in some way a



reference to nitrogen. The signs would be associated with a similar meaning (something containing nitrogen”...”

36. In my view, the average consumer is most likely to approach the competing trade marks in one of two ways i.e. the word NITRO and its presence as the first five letters of the applicant’s trade mark creates no conceptual imagery in the mind of the average consumer (leading to conceptually neutrality), or the word NITRO, its presence as the first five letters of the applicant’s trade mark and the similarity of the applicant’s trade mark to a word with which the average consumer is likely to be familiar i.e. NITROGEN, will bring to the average consumer’s mind the concept of that element, leading to, at least, a high degree of conceptual similarity between the competing trade marks.

### **Distinctive character of the earlier trade mark**

37. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. I have already commented upon how the average consumer is likely to interpret the opponent’s trade mark above. Whether that is as a word with no meaning or a word which evokes the concept of nitrogen, as any concept that is created is neither descriptive of nor non-

distinctive for clothing, the opponent's earlier trade mark is possessed of a fairly high degree of inherent distinctive character.

### **Conclusion in relation to classes 3, 14, 38**

39. As I explained in paragraph 6, the opponent's failure to respond to the official letter of 13 December 2017, results in the opposition to classes 3, 14 and 38 being deemed withdrawn.

### **Conclusion in relation to class 26**

40. As a consequence of my conclusion in paragraph 23, the opposition to class 26 fails and is dismissed accordingly.

### **Likelihood of confusion in relation to the applicant's goods in class 25**

41. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

42. The competing goods are identical; this is a point in the opponent's favour. Earlier in this decision, I concluded that the average consumer was either a member of the general public or a business user who (whilst not discounting aural considerations) is

most likely to select the goods at issue by predominantly visual means paying at least an average degree of attention during that process. Having assessed the competing trade marks distinctive and dominant components, I found the competing trade marks to be visually and aurally similar to an above average degree, and if not conceptually neutral, conceptually similar to, at least, a high degree. Finally, I assessed the opponent's trade mark to be inherently distinctive to a fairly high degree.

43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

44. In reaching a conclusion, I shall proceed on the basis most favourable to the applicant i.e. that the conceptual position is neutral (the opponent's position is, in my view, even stronger if the presence of the letters NITRO in the applicant's trade mark evoke the same concept as the opponent's trade mark). However, even if the conceptual position is neutral, the fact that the five letters which form the opponent's trade mark are the first five letters of the applicant's trade mark (and the degree of visual and aural similarity which results) are, when combined with the fairly high degree of distinctive character the opponent's trade mark enjoys, likely to lead an average consumer paying an average degree of attention (but who is still susceptible to the effects of imperfect recollection) to mistake one trade mark for the other. That will, in my view, lead to direct confusion. However, even if I am considered to be wrong in that regard, the fact that the competing trade marks coincide in a feature i.e. NITRO which I have concluded is inherently distinctive to a fairly high degree will, at the very least in my view, lead the consumer to think that the identical goods at issue come from the same or economically linked undertakings i.e. there will be indirect confusion. Those conclusions result in the opposition to the application in class 25 succeeding.

## **Overall conclusion**

**45. The opposition to the application in class 25 succeeds, but fails in relation to the goods in class 26. The opposition to the goods and services in classes 3, 14 and 38 are deemed withdrawn. Subject to any successful appeal, the application will be refused in class 25 but may proceed to registration in classes 3, 14, 26 and 38.**

## **Costs**

46. Although both parties have achieved a measure of success, the applicant has been substantially more successful than the opponent. As a consequence, it is, in principle, entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016.

47. In its counterstatement, the applicant asked for the “opposition to be dismissed with costs...”. It repeated this request in its submissions filed during the evidence rounds. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal, in a letter dated 1 September 2017, invited it, inter alia, to indicate whether it intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”.

48. Although the applicant responded to that letter in a letter dated 28 September 2017 (in which it indicated it was content for a decision to be made from the papers on file and renewed its request that the opposition be “dismissed with costs”), as it did not provide a completed pro-forma in the timescale allowed (nor has a completed pro-forma

been received prior to the issuing of this decision) and as it incurred no official fees in the defence of its application, I make no award of costs.

**Dated this 18<sup>th</sup> day of January 2018**

**C J BOWEN**

**For the Registrar**