

O-288-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3276473
BY TESCO STORES LIMITED
TO REGISTER THE TRADE MARK**

JACK'S

FOR SERVICES IN CLASS 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 412276
BY PEEK & CLOPPENBURG KG**

BACKGROUND AND PLEADINGS

1. On 11 December 2017 an application was filed to register as a UK trade mark the word “JACK’S” in respect of the services in class 35 set out in the table below. The application was originally filed in the name of PTL Limited, which is a subsidiary company of Tesco Plc. The trade mark application was assigned to Tesco Stores Limited on 20 September 2018 and by 3 October 2018 the assignment had been recorded at the registry (UKIPO). For purposes of these proceedings this decision refers to Tesco Stores Limited as “**the Applicant**”.

The Applicant’s services (class 35)
Advertising; business management; business administration; office functions; demonstration of goods; direct mail advertising; distribution of samples; import-export agency services; marketing; organization of exhibitions for commercial or advertising purposes; organization of fashion shows for promotional purposes; organization of trade fairs for commercial or advertising purposes; presentation of goods on communication media, for retail purposes; price comparison services; provision of an on-line marketplace for buyers and sellers of goods and services; sales promotion for others; organisation, operation and supervision of loyalty schemes and incentive schemes; wholesale services, retail services and online retail services connected with the sale of Chemicals, paints, varnishes, preservatives against rust, wood preservatives, filled toner cartridges, bleaching preparations and other substances for laundry use, make-up, cosmetics, beauty care preparations, industrial oils and greases, lubricants, candles; wholesale services, retail services and online retail services connected with the sale of pharmaceutical, medical and veterinary preparations, sanitary preparations for medical purposes, dietary supplements for humans and animals, infant formula, common metals and their alloys, machines other than sewing machines, vacuum cleaners, hand tools and implements [hand operated], cutlery, hand-operated garden tools; wholesale services, retail services and online retail services connected with the sale of alarms, computer hardware, computer software, televisions, speakers, cameras, telecommunication equipment, dental apparatus, babies feeding apparatus, babies bottles, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, barbecues; wholesale services, retail services and online retail services connected with the sale of electric cooking utensils, vehicles, bicycles, roof top carriers,

child carrying seats, fireworks, precious metals and their alloys, jewellery, musical instruments, paper and cardboard, books, printed publications, stationery, leather and imitations of leather, bags, building materials (non-metallic), non-metallic flooring, furniture, mirrors, household or kitchen utensils and containers, ropes, waterproof covers; wholesale services, retail services and online retail services connected with the sale of yarns threads, textiles and substitutes for textiles, bed covers, linen, clothing, footwear, headgear, lace and embroidery, carpets, rugs, mats, games, toys and playthings, gymnastic and sporting articles, decorations for Christmas trees, food and drink, beers, alcoholic beverages, tobacco and smokers articles; information, advisory and consultancy services relating to the aforesaid services; none of the aforementioned in the relation to leather-working machines, hemming machines, pedal drives for sewing machines, sewing machines, scissors, electric, wrapping machines, machines for the textile industry, cutting machines, stitching machines, starters for motors and engines and motors, other than for land vehicles.

2. The application was published for opposition purposes in the Trade Marks Journal on 26 January 2018 and is opposed by Peek & Cloppenburg KG (“**the Opponent**”). The notice of opposition made claims under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“**the Act**”) relying on the Opponent’s ownership of EU trade mark registration No. 014522619 for the trade mark “Jake*s”, which is registered for goods in classes 3, 9, 14, 18, 25 and services in class 35. The full detail of the Opponent’s registration is set out in the table later in this decision where I compare the parties’ goods and services. The Opponent relies on all its registered goods and services, and its opposition is directed against all of the Applicant’s services.
3. The Opponent applied for its trade mark on 1 September 2015; therefore, in relation to the opposed mark, the Opponent’s is an “earlier mark” as defined in section 6 of the Act. The earlier mark completed its registration process on 25 April 2016, so had not been registered long enough to engage the proof of use provisions under section 6A of the Act; the Opponent is therefore able to rely on its earlier mark in these proceedings in respect of all its registered goods and services.
4. The Applicant submitted a Form TM8 notice of defence, including a counterstatement denying the grounds. Although the notice of opposition had included a claim under section 5(3) of the Act, the Opponent filed no evidence and so the only ground carried forward was

under section 5(2)(b) of the Act, where the question to be determined is whether the Applicant's mark is similar to the earlier mark and is to be registered for identical or similar goods or services as the earlier mark, such that there is a likelihood of confusion and that the application should therefore not proceed to registration.

Papers filed, representation and hearing

5. The Opponent is represented by Bird & Bird LLP. Although the Opponent filed no evidence during the evidence rounds, it did file submissions in relation to its section 5(2)(b) claim. An oral hearing of this matter took place before me by video-conference on 24 April 2019. The Opponent chose not to attend the oral hearing, but filed submissions in lieu of attendance.
6. The Applicant is represented by Haseltine Lake Kempner LLP. During the evidence rounds the Applicant filed evidence, which I briefly reference in this decision to the limited extent I consider necessary. At the hearing the Applicant was represented by Alaina Newnes of Counsel, who had duly filed a skeleton argument in advance.

The Applicant's evidence

7. The Applicant's evidence comprised a witness statement dated 12 November 2018 from Matthew Sammon, together with Exhibits MS1 to MS37. At the date of signing the statement, Mr Sammon was a Chartered Trade Mark Attorney and partner at Kempner & Partners LLP. The 37 exhibits are mainly print outs from various websites where the featured brand name involves either "Jack" or "Jake" – including: Jack Wills (MS1 and MS2); Jack Wolfskin (MS3 and MS4); Jack and Jones (MS24 -27); Jake and Maya (MS28- 30); Jake's Direct (MS32). Exhibit MS35 shows several press articles from September 2018 covering the opening by Tesco of its Jack's supermarkets, apparently named after Tesco's founder, Jack Cohen.
8. As the Opponent observed in its submissions in lieu, little context is provided for the Applicant's evidence in the way of background or commentary. The evidence appears derived from internet searches; it tends to show third parties using different trade marks from those under consideration in the present opposition. It is not clear that the marks featured have been put to actual use in the UK before the date that the Applicant filed its application, and the Opponent submitted that the evidence does not establish that the various marks referenced have co-existed, nor that the owners of those marks would have no concern over

the registration of the Applicant's mark. I find that the evidence filed plays no significant role in my consideration of the various aspects of the claims in this opposition.

DECISION

9. Section 5(2)(b) of the Act, 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”.

10. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 include the following:

(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) 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;
- (f) 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;
- (g) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (h) 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;
- (i) 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 the goods and services

11. I have previously set out the Applicant’s services. The goods and services relied on by the Opponent are as follows:

Opponent’s goods and services	
Class	Terms
3	Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.
9	Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.
14	Precious metals and their alloys and goods in precious metals or coated therewith, namely statues and figurines, and statues and figurines consisting

	of precious stones, semi-precious stones, imitations thereof or imitations of precious metals and semi-precious metals, all of the aforesaid being coated with precious metals or their alloys; Decorations and ornaments, horological and chronometric instruments, jewellery of precious metals or semi-precious metals or stones or imitations thereof, or coated therewith; Jewellery, precious stones; Horological and chronometric instruments.
18	Luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather and imitations of leather, animal skins, hides and goods made of these materials, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather straps, leather laces, bandoliers, sheets of imitation leather for further processing.
25	Clothing, footwear, headgear.
35	Advertising; Business management; Business administration; Office functions; Retailing, including via websites and teleshopping, in relation to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather and imitations of leather, fur and pelts, and goods made therefrom, namely luggage, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, backpacks, pouches, shoulder belts and bandoliers, leather thongs, leather laces, bandoliers, sheets of imitation leather for further processing; Arranging and conducting of advertising events and customer loyalty programmes.

12. For reasons that will become apparent when I set out my findings on the likelihood of confusion, I do not consider it necessary to make a full assessment of similarity in relation to the parties' specified goods and services, since I consider it enough for the purposes of this decision to find that there are numerous points of identity and/or similarity, as indeed Ms Newnes admitted at the hearing.

13. For example, I find that even without having reference to the various goods relied on by the Opponent, and making a comparison only on the basis of the parties' services in class 35, it is clear that there are identical terms such as "advertising, business administration, business management, office functions" and that other services may be considered identical on the basis of the inclusion principle articulated in *Gérard Meric*¹. I also note the *Canon*² factors for assessing similarity between the respective goods/services such as their nature, intended purpose and method of use and whether they are in competition with each other or are complementary³. I find that there is clearly a good degree of similarity, for example, between the Applicant's "marketing" and "demonstration of goods" and the Opponent's "advertising". As to the Applicant's wholesale services, Ms Newnes admitted similarity with the Opponent's retail services; and as to all of the Applicant's retail services, Ms Newnes admitted similarity (or higher) with the Opponent's retail services (the level of similarity being higher, including to the point of identity, according to the goods to which the retail services related).
14. In *Avnet*⁴, Jacob J. (as he then was) stated his view that: "... 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." Even bearing that in mind, I find that very few of the services applied could not be considered relevantly similar to those for which the Opponent has protection. Ms Newnes submitted in her skeleton argument that the following three terms in the Applicant's specification may be considered to have a low level of similarity to the Opponent's goods/services:
- i) "organisation of trade fairs for commercial or advertising purposes" – Ms Newnes argued a likely difference as between the general public and businesses. I reject that distinction because the relevant public for certain of the Opponent's services such as advertising and business management clearly involve businesses. Elsewhere in her skeleton argument, Ms Newnes submitted that "organization of exhibitions for commercial or

¹ *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05 judgment of the General Court at paragraph 29

² Case C-39/97, at paragraph 23.

³ I also note the description of "complementary" in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, and note too the relevant factors for assessing similarity (such the respective users of the services) identified by Jacob J (as he then was) in *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

⁴ *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16

advertising purposes” is similar to “advertising” in class 35 on the basis that “it may have the same purpose of allowing consumers to satisfy shopping needs and may coincide in relevant public channels.” I find that dependent on how one construes the terms, “trade fairs” and “exhibitions” may be somewhat interchangeable, such that the organisation of either “for commercial or advertising purposes” may give rise to comparable levels of similarity with “advertising” on the basis of shared users and a degree of purpose and complementarity. I anyway find a medium degree of similarity between the Applicant’s “organisation of trade fairs for commercial or advertising purposes” and the Opponent’s “arranging and conducting of advertising events”, based on common aspects of nature, purpose and users.

- ii) “import-export agency services” – I again reject the submission in the skeleton argument as to a difference in relevant public. While import-export agency services are distinct from managing a business, they may involve providing business advice on how to run and make connections in the supply chain for businesses looking to import and export their products. I find that there is a low degree of similarity with “business management”;
- iii) “information, advisory and consultancy services relating to the aforesaid services” [relating to various wholesale services and retail services]”; Ms Newnes argued that these services had a low level of similarity to business management and business administration in class 35. Managing a business may involve providing advice and consultancy on wholesale and retail services, so there is a degree of overlap in purpose, users and a degree of complementarity. I consider the degree of similarity between these services and business management as perhaps as high as medium.

15. As between the Applicant’s “price comparison services” and the Opponent’s registered goods and services, Ms Newnes argued that there is no similarity. I agree that there is little or no relevant similarity (not even with Opponent’s service of “arranging and conducting of advertising events and customer loyalty programmes”).

The average consumer and the purchasing process

16. In *Hearst Holdings Inc*,⁵ Birss J. explained that “... *trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer*

⁵ *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), at paragraph 60.

who is reasonably well informed and reasonably circumspect ... 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 ...”.

17. The average consumer for the goods and services at issue will include members of the general public, who will encounter the marks, for example, when they access the retail services to buy the variously specified goods such as clothing, sunglasses, jewellery, bags or cosmetics. The average consumer will also encompass business users accessing services such as business administration or office functions. During the evidence rounds the Opponent submitted that in purchasing the goods and services at issue, the average consumer would pay “an average (normal) degree of attention”. In its submissions in lieu of attending the hearing, the Opponent expressed the degree of attention as a “relatively low degree of attention”. I find that that the average business consumer will pay a higher than average degree of attention in selecting such services as advertising, office functions, retail services and advertising. Insofar as the average consumer will be a member of the general public, I find that according to the goods under the retail services at issue – which may run a spectrum of prices, but may include more or less “everyday” goods - the level of attention in choosing from whom to purchase will be average (although I will in this decision allow for a degree of attention lower than that).
18. The average consumer will encounter the marks in relation to the goods and services at issue in promotional publications/advertisements, or on websites or on shop/business signage. I consider the purchase process to be a primarily visual one⁶, but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks in the assessment of a likelihood of confusion.

Distinctiveness of the earlier mark

19. The distinctive character of the earlier mark must be assessed, as the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*, the CJEU stated that:

⁶ See paragraphs 49 and 50 of the judgment of the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 in relation to goods sold in self-service stores.

“[22.] In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

20. The earlier mark is “Jake*s”. The mark is not descriptive or laudatory in relation to the goods or services for which it has been registered, but nor is it an invented word, rather it derives from a name that is not especially out of the ordinary or unfamiliar. In place of an apostrophe that would typically be deployed before the final letter “s” to signify a possessive use of the name, there is a small star or asterisk. I find that the earlier mark may be considered to have an average degree of inherent distinctiveness. There is no evidence of use, promotion, market share or so on, so there is no possible enhancement of the distinctive character.

Comparison of the marks

21. It is clear from *Sabel* 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 CJEU stated in *Bimbo* 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.”

22. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The Opponent’s earlier trade mark:	Jake*s
The Applicant’s contested trade mark:	JACK’S

23. The overall impression of the earlier mark is that it is the single word “Jake*s”, which will be understood as a name, expressed with a possessive final letter “s”. The presence of the asterisk or star is not entirely negligible in the overall impression, but the distinctive and dominant element is the text of the word. The overall impression of the Applicant’s mark is that it is the single word “JACK’S”, which will be understood as a name, expressed with a possessive final letter “s”.⁷

Visual similarity

24. The Opponent argued that the parties’ marks have “high visual similarity”. Its submissions in lieu of attendance at the hearing included the following points:
- Both marks consist of common English words/names, with the same beginning and ending;
 - Neither contains figurative or logo elements;
 - The marks have an identical structure as they are formed by a sequence of four letters, followed by a symbol functioning as a possessive apostrophe and then a fifth letter;
 - Seen overall, the identical structure of the signs and the close sequence of letters and symbol J-A-K-’ *- S make the trade marks look very similar to each other;

⁷ That one mark may here be presented in upper case and the other only starts with an upper-case letter has no bearing in the context of visual comparison. Word marks may be used in different scripts (fonts or typeface); see for example paragraph 47 of *Sadas SA v. OHIM* Case T-364/04.

- The only minor differences between the marks lie in the middle of each word. Where the Applicant has changed a single letter in the middle of the Opponent's mark – i.e. it has removed an 'E' after the 'K', and replaced it with a 'C' before it instead.

25. By contrast, Ms Newnes submitted that the marks are visually similar only to a medium degree. I agree. Although the marks coincide in their length and some of their letters, the differences in such short words are immediately apparent. I give almost no weight to the substitution of the standard possessive apostrophe for the “*” symbol, but the different position of the “K” and the presence in the Applicant’s mark of an “E” rather than a “C” will not go unnoticed by the average consumer. (As the Opponent submitted during evidence rounds, these are “common English words/names, which are instantly recognisable to all members of the public”.)

Aural similarity

26. The short, single syllable marks are aurally similar to the extent that they share an opening letter and closing “K-S” sound, but the “AY” sound in the Opponent’s mark is different from the pronunciation of the “A” in Jack’s. I consider the marks to be aurally similar to medium degree.

Conceptual similarity

27. The marks have in common that the average consumer is likely to perceive each as a male forename, expressed in possessive form. In Case O-276-18, which dealt with an appeal involving the marks SANDRO and SANDRA, Emma Himsworth QC, sitting as the Appointed Person held:

“[28] [The mere fact that the marks] ... can be grouped under a common generic term of ‘names’ does not automatically lead to a finding of conceptual similarity. This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that the public is likely to make a conceptual link.

...

[30] It is therefore necessary to make an assessment of conceptual similarity between names on the basis of each individual case.”

28. In the present proceedings, the Opponent submitted that the marks are conceptually identical or at least highly similar, arguing that both ‘Jack’ and ‘Jake’ are variant forms of the name ‘Jacob’, and the marks therefore share a common concept. Since the Opponent filed no evidence to support that submission I do not accept that to be case, and I anyway do not find that the average consumer would perceive the marks that way. I find - as Ms Newnes submitted - that “JACK” and “JAKE” are standalone and obviously different male names and the average consumer will perceive them as such.

29. Ms Newnes also referred me to the tribunal decision in *JAXKS Trade Mark*⁸, which also involved the Opponent relying on its “Jake*s” trade mark, and where the goods at issues were identical. In that decision the Hearing Officer found that even were the average consumer to construe the Applicant’s trade mark as “JACKS”, “the mere fact that both trade marks convey the concept of a male forename, given that Jake and Jack are both very well-known and different male forenames, is still insufficient to create a likelihood of either direct or indirect confusion.” That decision was upheld on appeal⁹ and the Appointed Person (there too Emma Himsworth QC) concluded:

[“27] In the circumstances, I think that the Hearing Officer was entitled, having found that both ‘Jack’ and ‘Jake’ are ‘male forenames’ to then go on to find that the ‘names’ were both well-known and different, i.e. not conceptually similar such that the similarities between the marks in issue were insufficient to create a likelihood of either direct or indirect confusion.

30. In the present proceedings I likewise consider that even though there may be said to be a degree of conceptual similarity by virtue of their both being male forenames, those names are different; consequently, as regards the conceptual similarity or difference between the marks, the position is more or less neutral.

⁸ Decision BL O-065-16; see paragraph 34 of that decision.

⁹ Decision BL O-424-16; see paragraphs 27-30 of that decision.

Conclusion as to likelihood of confusion

31. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraph 10 above.
32. The Opponent's earlier trade mark has an average degree of inherent distinctiveness. The purchasing process primarily entails encountering the marks visually and the marks have a medium degree of visual similarity. The average consumer may encounter the marks by oral recommendation or reference, and I note that the marks also have medium degree of aural similarity. I have found that the level of attention in the purchasing process will vary but will tend to be average or higher. Clearly at least some of the Applicant's services are identical with and highly similar to those for the Opponent has trade mark protection. I bear in mind that the average consumer rarely has the chance to make direct comparisons between marks and must instead rely on the imperfect picture of them he or she has in his or her mind; I also bear in mind the principle that there is an interdependence of factors, such that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the goods and services.
33. However, even cognisant of all the points in the above paragraph, I find that there is no likelihood of confusion on the part of the relevant public, nor any likelihood of association. The average consumer is deemed to be reasonably well-informed and reasonably circumspect and observant and even if the level of attention brought to the purchasing process were assessed in some instances to fall below average, the marks are sufficiently different to avoid confusion. Despite the overlap between the two marks at issue, people are necessarily accustomed to distinguishing between different personal names in everyday life and they will not confuse these two different names used as trade marks.
34. Ms Newnes submitted that it was in support of the contention that consumers are used to making distinctions between "name" marks that the Opponent filed evidence of "real world" use of various JACK marks in the retail sphere in the UK, such as "JACK WILLS". Ms Newnes also addressed the criticisms that the evidence is not territorially or temporarily limited, by arguing that it shows that the websites are directed at UK consumers - for example, some of the exhibits include an "about us" or "history" section discussing the role of the brand in the UK. Ms Newnes argued that although the screen shots were taken after

the date that the Applicant filed its mark, it is unlikely that they differ significantly from what was available as at the application date. I note these points, but as I indicated above, I make my findings in this decision without any reliance on or necessary reference to the evidence filed.

35. I note the Opponent's submission that the average consumer tends to pay more attention to the beginning of a mark, but I find that the marks at issue are short and since each will be perceived as a whole and the average consumer will recognise at once that they are different marks. There will thus be no direct confusion - the average consumer will not mistake one mark for the other. Nor do I see any basis to believe that there is any likelihood of indirect confusion, whereby the average consumer encountering the respective marks, realising the marks are not the same, would attribute the similarity that exists between the marks/services to the responsible undertakings being the same or economically-linked undertaking¹⁰.
36. In line with the appeal decision in *JAXKS Trade Mark* quoted above, the marks are not conceptually similar such that their similarities are insufficient to create a likelihood of either direct or indirect confusion.
37. For the sake of completeness and the avoidance of doubt, if I had found the marks to be sufficiently similar to sustain a section 5(2)(b) claim, the opposition would have succeeded as against all of the Applicant's services, except for those where I have found there to be low or no similarity with any of the goods or services for which the Opponent has protection, namely: "import-export agency services" and "price comparison services".

COSTS

38. This opposition has failed and the Applicant is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice 2/2016. I make no award in respect of the evidence filed as I did not find it necessary or useful for the decision before me. The award breakdown is as follows:

¹⁰ See, for example, the decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc* Case BL-O/375/10.

Considering the other side's statement and preparing a counterstatement	£200
Preparation of skeleton argument in light of other side's submissions and attendance at hearing	£500
Total	£700

39. I order Peek & Cloppenburg KG to pay Tesco Stores Limited the sum of £700 (seven hundred pounds) which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 28th day of May 2019

Matthew Williams

For the Registrar
