

**O/905/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03538383 BY  
NIDHISH GUPTA  
TO REGISTER AS A TRADE MARK:**



**IN CLASSES 24, 25 & 28**

**AND**

**OPPOSITION THERETO  
UNDER NO. 423192  
BY SEGWAY INC.**

## Background & Pleadings

1. Nidhish Gupta (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 29 September 2020. It was accepted and published in the Trade Marks Journal on 13 November 2020 in respect of the following goods:

**Class 24:** Textiles and substitutes for textiles; Labels of Textile, Household linen; Curtains of textile or plastic.

**Class 25:** Clothing, footwear, headwear.

**Class 28:** Games, toys and playthings; Video game apparatus, Gymnastic and sporting articles, Decorations for Christmas trees.

2. SEGWAY INC. (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In conjunction with the Section 5(2)(b) ground, this opposition was also initially based on Sections 5(3) of the Act against the contested mark. However, the Tribunal with a letter, dated 16 April 2021, informed the parties that the grounds of opposition were reduced to Section 5(2)(b) of the Act for the earlier right below as the opponent relied on a UK comparable trade mark before the IP Completion Date for the Section 5(3) ground. As a result, the opposition has been reduced to Section 5(2)(b). The opponent is the proprietor of the UK registration number 03358847 for the following mark:



3. The opponent’s mark was filed on 5 December 2018 and registered on 8 March 2019. The opponent relies on part of the goods for the purposes of this opposition proceedings, which are as follows:

**Class 9:** Computer programs [downloadable software].

**Class 25:** Clothing; Cyclists' clothing; footwear; Non-slipping devices for footwear; Fittings of metal for footwear; Galoshes; Hosiery; Gloves [clothing]; Hats; Soles for footwear; Headwear; Head sweatbands; Caps.

**Class 28:** Scooters [toys]; Chess sets; Chess games; Chessboards; Balls for games; Stationary exercise bicycles; Skateboards; Roller skates; Knee guards [sports articles]; In-line roller skates; Hunting game calls; Hand pads for sports use; Whistles [toys]; Neck guards/protection [sports articles]; Shin guards; Shin pads; Gloves for games; Wristband [sports articles].

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. Further, as protection of the opponent's earlier mark was conferred less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent in its notice of opposition claims that the contested mark is visually very similar to the earlier mark. The opponent also asserts that the competing goods are identical and/or similar to the goods of the earlier mark.
6. The applicant filed an amended defence and counterstatement, denying any similarity between the marks, stating that the "marks are totally different and unique in representation". I will return to these points later in my decision. The applicant denies any claimed identity/similarity between the goods.
7. Both of the parties filed evidence in these proceedings. None of the parties filed submissions during the evidence rounds.

8. No hearing was requested and so this decision is taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by Hassler International and the applicant is a litigant in person.
10. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **Evidence**

### **Opponent's Evidence**

11. The opponent's evidence consists of a witness statement by Yanan Sun, the director of Hassler International Germany, a position which they have held since 2017.

### **Applicants' Evidence**

12. The applicant's evidence consists of a witness statement by Nidhish Gupta, the applicant himself, who is the Director of Athletes Points Private Limited.
13. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## Decision

### Section 5(2)(b)

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

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

[...]

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

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

15. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of Goods**

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

17. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

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

“(a) The respective uses of the respective goods or services;  
(b) The respective users of the respective goods or services;  
(c) The physical nature of the goods or acts of service;  
(d) The respective trade channels through which the goods or services reach the market;  
(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;  
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

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

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



ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect.

Where words of 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.”

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

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

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

<b>Opponent’s Goods</b>	<b>Applicant’s Goods</b>
<b>Class 9:</b> Computer programs [downloadable software].	
	<b>Class 24:</b> Textiles and substitutes for textiles; Labels of Textile, Household linen; Curtains of textile or plastic.
<b>Class 25:</b> Clothing; Cyclists' clothing; footwear; Non-slipping devices for footwear; Fittings of metal for footwear; Galoshes; Hosiery; Gloves [clothing]; Hats; Soles for footwear; Headwear; Head sweatbands; Caps.	<b>Class 25:</b> Clothing, footwear, headwear.

<p><b>Class 28:</b> Scooters [toys]; Chess sets; Chess games; Chessboards; Balls for games; Stationary exercise bicycles; Skateboards; Roller skates; Knee guards [sports articles]; In-line roller skates; Hunting game calls; Hand pads for sports use; Whistles [toys]; Neck guards/protection [sports articles]; Shin guards; Shin pads; Gloves for games; Wristband [sports articles].</p>	<p><b>Class 28:</b> Games, toys and playthings; Video game apparatus, Gymnastic and sporting articles, Decorations for Christmas trees.</p>
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24. In its statement of grounds, the opponent contends that:

“The Contested Goods are identical or similar to the goods for which the Earlier Trade Marks are registered. The Class 24 and Class 25 of the Contested Goods are related to textiles and clothing. These goods are therefore identical or similar to the goods for which the Earlier Trade Marks are registered as they have the same or related purposes, would be used in conjunction with one another and would be sold through the same trade channels to the same consumers. [...] Since textiles are closely related industry to clothing, it is inevitable to be traded among the same channels. Especially, cloth printed with the logos can be produced into clothes.”

25. In his counterstatement, the applicant denies any identity/similarity between the respective goods, stating:

“Therefore, the rest of the contents of the said para are also denied, as it is not mandatory that the goods and services of the Applicant would be used in conjunction with one another and it also not mandatory that the goods and services would be sold through the same trade channels to the same consumers, rather it is based on the choice and selection of the consumer and industry members, which brand's goods they want to buy.”

26. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are

sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>1</sup>

Clothing, footwear, headwear

27. The contested goods are identically worded as in the opponent's specification. Therefore, I find them to be identical on the basis set out in *Meric*.

Games, toys and playthings

28. The contested goods are broad terms that could readily cover the opponent's "Scooters [toys]; Chess sets; Chess games; Chessboards; Balls for games; Whistles [toys]; Gloves for games". Thus, I find them to be identical as per *Meric*.

[...] Gymnastic and sporting articles [...]

29. The contested terms are broad enough to encapsulate the opponent's terms "Stationary exercise bicycles; Skateboards; Roller skates; Knee guards [sports articles]; In-line roller skates; Hand pads for sports use; Neck guards/protection [sports articles]; Shin guards; Shin pads; Wristband [sports articles]." Therefore, the respective goods are identical in accordance with *Meric*.

Video game apparatus [...]

30. The contested goods are video game machines, such as consoles or arcades. The opponent's term "Computer programs [downloadable software]" in Class 9, which is the closest term, includes video games programs/software. The nature of the goods differs (software v hardware). However, there is complementarity between the respective items as the opponent's goods are indispensable for the use of the contested goods.

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

Further, I consider there to be an overlap in users, trade channels, and purpose. Therefore, I find a medium to high degree of similarity.

*Textiles and substitutes for textiles; [...] Household linen; Curtains of textile or plastic*

31. The contested goods are all materials intended to clothe or decorate. The closest comparable term in the earlier specification is the term “*Clothing*” in Class 25. Although the respective goods are made from the same materials, it is superficial to find similarity. This is because the contested goods are raw materials, which are components of other goods, and, thus, they fulfil different purpose from the earlier goods. In more detail, the earlier goods in Class 25 are intended to be worn to cover the human body either for its protection or for aesthetic purposes. In contrast, the contested goods are all fabrics that can be used to manufacture clothing items or for household purposes and interior decoration. However, the trade channels will be different as the contested goods will not be sold in the same stores and outlets as the earlier goods in Class 25, and they are not usually manufactured by the same undertaking. In this respect, they are not in competition nor complementary. I find the goods to be dissimilar.

*Labels of Textile [...]*

32. The contested goods are intended to provide important information about the garment to the consumer, such as the fibre content. I can see no meaningful similarity in terms of the nature, intended purpose, or method of use nor are the goods at issue in competition with the opponent’s goods in Class 25. Even though the earlier goods could be part of the opponent’s Class 25 goods, such as clothing labels, they will not be considered to be complementary “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”. Thus, I find them to be dissimilar.

### Decorations for Christmas trees

33. I can see no obvious aspect of similarity between the above contested goods in Class 28 and the goods in the opponent's specification, nor has the opponent made any submissions to the contrary. Therefore, I find them to be dissimilar.

### **Average Consumer and the Purchasing Act**

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

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

35. The goods at issue cover a range of items. The average consumer of the goods will be a member of the general public, but there is also the potential for specialised customers for certain goods. The goods can be selected from outlets, stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question,

particularly clothes in Class 25,<sup>2</sup> but aural considerations will not be ignored in the assessment. The cost of the goods may vary, but in any case, and irrespective of the cost, the average consumer may examine the products to ensure that they select the correct type, quality, size and/or aesthetic appearance. In this regard, the average consumer is likely to pay an average degree of attention when selecting the goods at issue.

### **Comparison of Trade Marks**

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



37. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features

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<sup>2</sup> The General Court highlighted this in *New Look Ltd v OHIM Cases T-117/03 to T-119/03* and T-171/03, at paragraph 50: “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.”

which are not negligible and therefore contribute to the overall impressions created by the marks.

38. The marks to be compared are:

Opponent's Mark	Applicant's Mark
	

#### Overall Impression

39. The earlier mark solely consists of a figurative element, which the opponent in its statement of grounds describes as “a person having a moving motion to the right by spreading the arms to the left”. It is my view that the figurative element could be characterised either as an abstract shape of a human figure or a highly stylised letter ‘i’ with three parallel lines extending to its left side. The overall impression lies in the mark as a whole.

40. The applicant’s mark consists of the figurative element and the word element “INCITE”. The latter element is positioned underneath the former in block capital letters and standard typeface. To my mind, the figurative element represents either an abstract human figure propelling itself forward or a highly stylised letter ‘i’. The figurative element and the verbal element make a roughly equal contribution in the overall impression.

#### Visual Comparison

41. The opponent claims in its notice of opposition that:

“Visually, the logos of the Application and the Earlier Trade Marks are very similar, both symbolizing a person having a moving motion to the right by spreading the arms to the left. The styles of the drawings are



very similar, black and white with a black dot on the top to symbolize the head, while the head and the body have a proportion similar to a sufficient degree that the logo of the Application can easily be mistaken by customers if diligent care were not given to differentiate the two logos.”

42. However, the applicant contends that:

“It is specifically and categorically denied that the Logo of the Applicant and the Opponent are very similar. It is also denied that both symbolizing a person having a moving motion to the right by spreading the arms to the left. It is denied that the styles of the drawings are very similar, black and white with a black dot on the top to symbolize the head and the body have a proportion similar to a sufficient degree that the logo of the Applicant can easily be mistaken by customers if diligent care were not given to differentiate the two logos.

The above denials are based on the fact that the Logo of the Applicant and the impugned logo of the Opponent are visually, structurally and graphically different. Thus, there lies no identity or similarity between the both.”

43. As delineated previously, whilst visually the competing marks represent either an abstract shape of a human figure or a highly stylised letter ‘i’ as a whole, their depiction is significantly different. Although the competing marks contain a black dot above a stylised line, the stylisation of the line below the dot is distinctively different, with one being a fully black curved/elongated line with pointy edges and the other oblong, nearly forming a 90-degree angle line with three horizontal lines extending to the left. I also remind myself of the comments of Iain Purvis, K.C., sitting as the Appointed Person, in *The Royal Academy of Arts v Errea Sport S.p.A*, BL O/010/16, where it was stated:

“13 [...] I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso’s Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs’ portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses).”

There is also an additional point of visual difference based on the presence of the additional word element “INCITE” in the contested mark. Taking into account the above and the overall impressions of the marks, I find that there is a very low degree of similarity.

#### Aural Comparison

44. The correct approach to conducting an aural comparison of figurative marks was clarified by the General Court in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10, in which it stated:

“46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.”

45. Against this background, the average consumer will not attempt to pronounce the earlier mark nor the figurative element in the contested mark. However, the contested mark contains the verbal element “INCITE” which will be articulated as “IN-SAYT”. Therefore, the marks are aurally dissimilar.

## Conceptual Comparison

46. The competing marks share some conceptual similarity. This is on the basis that the figurative elements in the respective marks could be perceived either as an abstract shape of a human figure or a highly stylised letter 'i'. In any event, regardless of how the average consumer conceptualises the figurative elements, they are likely to form the same concept in the competing marks. That said, the conceptual similarity is only limited to how the consumer would construe the depiction of these elements without extracting any further concept from them. Nevertheless, there is a key conceptual difference between the marks due to the presence of the verbal element in the contested mark. The UK average consumer will identify the meaning of the dictionary word "INCITE", which means to provoke, cause to act or occur. Overall, taking into account the various factors and the overall impressions of the marks, I find the respective marks to be conceptually similar to a low degree.

## **Distinctive Character of the Earlier Trade Mark**

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

"In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services

for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
49. Whilst the opponent has provided some evidence of its activities, the materials filed do not assist as the majority of them appear to be in different foreign languages, including German. Thus, I have only the inherent distinctiveness of the earlier mark to consider. As detailed above, the average consumer will conceptualise the earlier mark either as an abstract shape of a human figure or a highly stylised letter ‘i’. I note that there is no apparent link between the mark and the goods concerned. This does appear to be a fairly fanciful choice of mark. Therefore, I find that the mark is inherently distinctive to a slightly above average degree.

### **Likelihood of Confusion**

50. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree

of similarity between the marks, and vice versa.<sup>3</sup> It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>4</sup>

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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<sup>3</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>4</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

I note that the categories identified above by Mr Purvis K.C. are not exhaustive.<sup>5</sup>

52. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

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

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually,

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<sup>5</sup> *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

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

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

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

53. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor K.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
54. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against

a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

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

55. Earlier in this decision I have concluded that:

- the goods at issue range from identical to dissimilar;
- the average consumer is a member of the general public and specialised customers. The selection process is predominantly visual without discounting aural considerations. The average consumer may examine the products to ensure that they select the correct type, quality, size and/or aesthetic appearance. The level of attention paid will be average;
- the competing marks are visually similar to a very low degree, aurally dissimilar, and conceptually similar to a low degree;
- the earlier mark has a slightly above average degree of inherent distinctiveness. The use is not sufficient to establish enhanced distinctiveness of the mark.



56. The likelihood of confusion does not arise in relation to the application's goods which are dissimilar to the earlier mark's goods.<sup>6</sup> **The opposition cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

**Class 24:** Textiles and substitutes for textiles; Labels of Textile, Household linen; Curtains of textile or plastic.

**Class 28:** Decorations for Christmas trees.

57. Taking into account the above factors, I find that there is no likelihood of direct confusion for identical goods. This is because there is a very low degree of visual similarity and no aural similarity, with visual inspection dominating the selection process, and the additional and divergent word element "INCITE" in the contested mark, is more likely to be noticed by the average consumer. I do not consider that the average consumer would overlook these differences and mistake one mark for the other, even on identical goods. In reaching this finding, I have, of course, borne in mind the concept of imperfect recollection, but my view is that the differences are sufficiently stark that the marks will not be misremembered/misrecalled as each other. It follows that there will be no direct confusion. This finding extends to the goods that I found to be similar to a medium to high degree.
58. In terms of indirect confusion, even when the average consumer identifies the differences between the marks, I cannot see a reason why they would put the low degree of conceptual similarity, stemming from the figurative elements, as linking the two marks by way of the same or an economically linked undertaking. Notwithstanding the principle of imperfect recollection, the mere fact that the marks are conceptually similar will not suffice.<sup>7</sup> I do not consider that the average consumer will view the different visual representation of the figurative elements in the competing marks, coupled

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<sup>6</sup> Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

<sup>7</sup> See, for example, Case C-251/95, *SABEL BV v Puma AG*.

with the presence/absence of the word element “INCITE”, as a logical re-branding of one another or an alternative mark originating from the same or economically linked undertakings. Consequently, I find that there is no likelihood of indirect confusion. This finding extends to the goods that I found to be similar to a medium to high degree.

### **Outcome**

59. The opposition under Section 5(2)(b) of the Act is **unsuccessful in its entirety**. Therefore, subject to appeal, the application can proceed to registration.

### **Costs**

60. The applicant has been successful and is entitled to a contribution towards its costs. The applicant was not professionally represented and had to submit a completed cost proforma to the Tribunal, outlining the number of hours spent on these proceedings. In an official letter to the parties, dated 28 July 2022, the Tribunal stated that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.” As the applicant elected not to complete a costs pro-forma and as he has incurred no official fees in the defence of his application, I make no order as to costs.

61. The appeal period begins from the date of this decision.

**Dated this 19<sup>th</sup> day of October 2022**

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