

O/0073/26

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 4128079
BY IBEX ENGLAND LTD
TO REGISTER AS A TRADE MARK:**

ADAPT-FIT

IN CLASS 25

AND

**OPPOSITION THERETO
UNDER NO. 60003624 BY
POETICGEM LIMITED**

Background & Pleadings

1. Ibex England Ltd (“the applicant”), applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed on 22 November 2024 and was published on 6 December 2024 in respect of the following goods:

Class 25: Waist belts; Belts [clothing]; Belts for clothing; Leather belts [clothing]; Belts made of leather; Fabric belts [clothing]; Belts made from imitation leather.

2. On 5 March 2025, Poeticgem Limited (“the opponent”) opposed (using the Fast Track provisions) the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹. The opponent is the proprietor of the UK registration number 03463551 for the following mark:

ADAPT

3. The mark was filed on 3 February 2020 and registered on 8 August 2020 with a priority date 10 December 2019, and the priority country being EUIPO. For the purposes of this opposition, the opponent relies on the following goods and services:

Class 18: belts.

Class 25: clothing; clothing for men, clothing for women, clothing for children, clothing for babies.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Class 35: retail services connected with the sale of clothing for adults and children, baby and toddler clothing, clothing accessories, baby and toddler clothing accessories.

4. Under Section 6(1) of the Act, the opponent's mark clearly qualifies as an earlier trade mark. Further, as the registration of the opponent's mark was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
5. The opponent, in its notice of opposition, claims that the competing marks are visually, aurally and conceptually highly similar for identical or similar goods, giving rise to a direct and indirect likelihood of confusion.
6. The applicant filed a defence denying that the marks are similar. However, in relation to the similarity of the competing specifications, the applicant requested that the opponent prove "*how their [...] products supplied are so similar.*" I will return to this point later in my decision.

Papers Filed and Representation

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
8. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal

with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. I note that the Registry notified the applicant in its official letter dated 18 March 2025 that the appropriate form is a Form TM8 and not TM8N and that the parties are unable to file evidence in fast-track proceedings without requesting leave to do so, providing full reasons for the request. In this regard, the Registry requested the applicant to file an amended Form TM8. Notwithstanding the Registry's direction, the applicant filed its amended TM8 dated 16 April 2024 annexing two pages of evidence. In addition, on 29 May 2025, the applicant sought leave to file evidence. The Registry issued a preliminary view on 26 June 2025, which was automatically confirmed, refusing the applicant's request on the grounds that no explanation has been provided as to what the evidence will show and why such evidence is necessary. For the avoidance of doubt, the evidence included with the TM8 is not admitted into the proceedings and will not be considered in my assessment.
10. Only the opponent filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision. This decision has been taken following a careful consideration of the papers.
11. In these proceedings, the opponent is represented by Wiggin LLP, and the applicant is unrepresented.

Preliminary Issues

12. In its defence, the applicant contends that the parties are not marketing the same products and points out that the term "ADAPT" is already being used online by several other traders in connection with clothing, rendering the opponent's claims unfounded. The applicant also raises that the contested mark serves as a sub-brand intended to be marketed together with its main brand "IBEX ENGLAND". I will address each of these points in turn below.

13. First, I note that since the opponent's mark is not subject to the proof of use requirement, it is entitled to rely on all the goods and services listed under paragraph 3 of this decision, for which the earlier mark is registered. Thus, the assessment I must make is based on a notional and fair use of the terms as registered against all the potential or intended uses of those goods and services and not necessarily the ones in which a party actually trades.² Second, I should highlight that I must determine the matter based on the trade marks before me. Thus, in the absence of particularised written submissions or evidence, it is irrelevant to my assessment whether other traders are using the term "ADAPT" online and in their commercial activities or whether the contested mark will be marketed alongside the main brand "IBEX ENGLAND".

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),

² See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

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

Comparison of Goods & Services

16. The competing goods and services are as follows:

Opponent's goods & services	Applicant's goods
<p>Class 18: belts.</p> <p>Class 25: clothing; clothing for men, clothing for women, clothing for children, clothing for babies.</p> <p>Class 35: retail services connected with the sale of clothing for adults and children, baby and toddler clothing, clothing accessories, baby and toddler clothing accessories.</p>	<p>Class 25: Waist belts; Belts [clothing]; Belts for clothing; Leather belts [clothing]; Belts made of leather; Fabric belts [clothing]; Belts made from imitation leather.</p>

17. The opponent claims that the competing goods are identical or in the alternative they are highly similar.

18. I reproduce here the applicant's claims with reference to the competing goods, which read as follows:

“We supply only leather belts and have therefore applied to use the trademark ADAPT-FIT on a range of leather belts that have a unique fastening. We can only use Class 18 for this type of product and although the opponent has registered the word ADAPT (only) in this use class, it does not sell any products similar to what we're marketing and is unlikely to. [...].”

19. Although the applicant did not explicitly deny identity/similarity of the competing terms in the same manner it did regarding the similarity of the marks, it did request the opponent to prove similarity of the goods. On this basis, I interpret the applicant's position as effectively constituting a denial.³

20. While the applicant contends that it can only use Class 18 for the goods, I note that the goods for which registration is sought fall under Class 25. To clarify, belts which are intended as clothing, including those made of leather (such as waist belts), are indeed proper to Class 25, while the likes of shoulder belts, belts for luggage and saddle belts fall in Class 18. The opponent has protection for the broad term “*clothing*” in Class 25, which by its nature would also encompass the contested goods. For the avoidance of doubt, I consider the applicant's submissions on the “unique fastening” of its belts to have no relevance on the overall similarity between

³ I keep in mind the comments of Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24.

the goods. Therefore, I find the competing goods to be identical under the principle outlined in *Meric*⁴.

Average Consumer and the Purchasing Act

21. 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 *Lidl Great Britain Limited & anor v Tesco Stores Limited & anor* [2024] EWCA Civ 262, Lord Justice Arnold explained:

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group.

18. Thirdly, assessment from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of

⁴ In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 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.”

assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. [...]

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.”⁵

22. The average consumer of the goods will be a member of the general public. The goods can be selected from outlets, stores, 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, but aural considerations will not be ignored in the assessment.⁶ 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 a medium degree of attention when selecting the goods at issue.

Comparison of Trade Marks

23. 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

⁵ Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30.

⁶ 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.”

by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

24. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

25. The marks to be compared are:

Earlier Mark	Contested Mark
ADAPT	ADAPT-FIT

Overall Impression

26. The earlier mark is a word mark. Registration of a word mark protects the word itself.⁷

27. The contested mark consists of the words “ADAPT” and “FIT”, with a hyphen separating the two. I consider that the hyphenated words will be

⁷ See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

seen as a unit conveying the meaning that something can be “adapted to fit”. Therefore, I consider that the overall impression rests in the unit created by the combination of the words it comprises.

Visual Comparison

28. The earlier mark consists of five letters, whereas the contested mark consists of eight and a hyphen. I bear in mind, as a rule of thumb, that the beginnings of marks tend to have more impact than the ends.⁸ In this regard, the competing marks share the same first five letters (“ADAPT”), while differing in the remaining ones and the addition of the hyphen (“ADAPT-FIT”). Taking the overall impression of the marks and the similarities and differences into account, I consider that the marks are visually similar to a medium degree.

Aural Comparison

29. Aurally, the competing marks will be pronounced entirely conventionally. The competing marks will aurally share the same first word, “A-DAPT”, while differing in the articulation of the second word element “-FIT” in the contested mark, which has no verbal counterpart in the earlier mark. I also consider that the hyphen in the contested mark will not be articulated, merely providing a natural break between the words. Considering all the factors, including the overall impression, I find that the degree of aural similarity is medium.

Conceptual Comparison

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v*

⁸ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

OHIM [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

31. I agree with the opponent that the word “ADAPT” is a well-known dictionary word that the average consumer will understand immediately, as it conveys the concept of modifying/adjusting something to suit a new condition or purpose. As to the contested mark, both of the words, namely “ADAPT-FIT”, are commonplace words that the average consumer in the UK will readily understand. The word “ADAPT” will have the same meaning described above. In terms of the word “FIT”, I disagree with the opponent that it will be seen as a synonym for “ADAPT”. In contrast, it is my view that the two words which make up the contested mark will be construed as a unit indicating something that can be adapted to fit. This is reinforced by the hyphen, the purpose of which is commonly to join two or more words to form a compound. In my view, no further concept will be attributed to the mark as a whole. In this context, I consider that the meaning of the word “ADAPT” in the competing marks is highly similar, if not identical, as per its dictionary definition, while the contested mark goes one step further by indicating the purpose of adapting something (e.g. to ensure a proper fit). Taking all the above into account, including the overall impressions, I find that there is a medium degree of conceptual similarity, due to the shared concept of the common word “ADAPT”.

Distinctive Character of the Earlier Trade Mark

32. 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).”

33. 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.
34. The opponent has not shown use of its mark and, thus, it cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the earlier mark to consider. The earlier mark consists of the ordinary and well-known word “ADAPT”. Although the mark is not descriptive of the goods and services in the specification, I consider that it may be vaguely allusive of a potential characteristic of the goods. Therefore, I find that the earlier mark is inherently distinctive to a medium degree.

Likelihood of Confusion

35. 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.⁹ 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.¹⁰
36. 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.
37. 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.

⁹ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁰ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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

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.”

38. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

39. Earlier in this decision I have concluded that:

- the competing goods at issue are identical;
- the average consumer for the goods at issue will be a member of the general public, and the selection process is predominantly visual without discounting aural considerations. The level of attention paid by the general public will be of medium degree;
- the competing marks are visually, aurally, and conceptually similar to a medium degree;
- the earlier mark has a medium degree of inherent distinctiveness.

40. Taking into account the above factors and considering the identical goods in play, there is no likelihood of direct confusion. Notwithstanding the doctrine of imperfect recollection, the differences are sufficient to enable the average consumer to distinguish the respective marks. This is because the divergent word component “-FIT” does not play an independent distinctive role by itself in the overall impression, but rather it creates a unit with the word component “ADAPT-” in the contested mark. Therefore, even though the competing marks share identical beginnings (“ADAPT”), the average consumer will recognise and remember the difference arising from the presence/absence of the dictionary and well-known word “-FIT” in the competing marks. Thus, the overall impressions and various visual,

aural, and conceptual differences between the competing marks previously identified are, in my view, sufficient for the marks to not be directly confused.

41. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

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

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

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

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

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

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹¹

42. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC, 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.
43. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "*a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion*". Arnold LJ agreed, pointing out that there must be a "*proper basis*" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion
44. The comments of Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, are also appropriate in this matter as he considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

¹¹ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

“34. [...] v) if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

45. I must now consider whether the average consumers would believe that there is an economic connection between the marks, or that they are variant marks from the same undertaking, as a result of their shared common element “ADAPT”. I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion.¹² Against this background, the significant proportion of the average consumers is, in my view, more likely to see the differences as consistent with a brand extension. This is because the common element “ADAPT” will be seen as the primary indicator of the undertaking responsible for the goods, and the addition of the word “-FIT” in the contested mark will strongly allude to the intended use or characteristics of the goods, for example, belts designed to be adjusted for optimal/correct fit. Consequently, I consider that the conceptual high similarity or identity of the common element “ADAPT”, with the additional element “-FIT”, referring to the purpose of adapting the goods, would lead the consumer to believe that the marks at issue are from the same or economically linked undertakings. In light of the comments of Mr Purvis QC in *L.A. Sugar*, this is a circumstance where indirect confusion would exist. I make this finding by considering that the competing marks will be perceived as a whole. In any case, any conceptual differences arising between the marks will not suffice in this present case to neutralise the visual¹³ and aural similarities between the marks.¹⁴ Given the identity of the competing goods in question, the average consumer would assume

¹² See *Liverpool Gin Distillery* above.

¹³ On this point, I note that the selection process of the respective goods is predominantly visual. See *New Look* above.

¹⁴ See the comments of the General Court in *Nokia Oyj v OHIM*, Case T-460/07 where it stated: “Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. As a result, I find that there is a likelihood of indirect confusion.

Outcome

46. The opposition under Section 5(2)(b) of the Act is successful in its entirety. Therefore, subject to any successful appeal, the application will be refused.

Costs

47. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Fees	£100
Preparing a statement and considering the other side's statement	£250
Preparing and filing written submissions	£350
Total	£700

48. I, therefore, order Ibex England Ltd to pay to Poeticgem Limited the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of January 2026

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General