O/0331/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00004140684

TO REGISTER THE TRADE MARK

IN CLASSES 16 AND 25

AND IN THE MATTER OF APPLICATION NO. UK00004140672

TO REGISTER THE TRADE MARK SERIES

AND

IN CLASS 25

BY BLACK DIAMONDS FAMILY LTD AND

THE OPPOSITIONS THERETO UNDER NOS. OP000453489 AND OP000453495

BY BLACK DIAMOND EQUIPMENT, LTD

BACKGROUND AND PLEADINGS

1. On 24 December 2024 Black Diamonds Family LTD ("***the Applicant***") applied to register in the UK the trade marks shown on the cover page of this decision, under number UK00004140684 ("***the '684 mark***") and number UK00004140672 ("***the '672 mark***"). On 10 January 2025 the '684 mark was accepted and published in the Trade Marks Journal in respect of the following goods:

   Class 16: Stickers; Stickers [stationery].

   Class 25: Printed t-shirts; T-shirts; Tee-shirts.

2. On 10 January 2025 the '672 mark was accepted and published in the Trade Marks Journal in respect of the following goods:

   Class 25: Clothing; Jerseys [clothing]; Casual clothing; Clothing for sports; Sports clothing; Athletic clothing.

3. On 10 April 2025 Black Diamond Equipment Ltd ("***the Opponent***") opposed the applications in their totality under section 5(2)(b) of the Trade Marks Act 1994 ("***the Act***").[1] For both oppositions the Opponent relies upon the following trade marks ("***the Earlier Marks***"):

   1) International trade mark (IR) number WO0000000854464 ("***the first earlier mark***")

      Registration date: 23 June 2005

      Date protection conferred in the UK: 24 February 2008

      Priority date: 11 February 2005 (priority claimed from Swiss trade mark number 534788)

      Representation: BLACK DIAMOND

[1] With the official letter of 6 May 2025, the Office informed the parties that oppositions 453488 and 453494 were being consolidated.

Relying upon the following goods:

Class 25: Clothing, belts, clothing for sports, leisure and climbing, ski clothing included in this class, shoes, trainers, hiking boots and shoes, climbing shoes, headgear; all these goods excluding luxury goods.

2) UKTM number 00918236116 ("***the second earlier mark***")

Filing date: 11 May 2020

Registration date: 7 November 2020

Representation: 

Relying upon the following goods:

Class 25: Clothing, footwear, headgear; clothing in the nature of sportswear, namely, shirts, sweatshirts, t-shirts, vests, pullovers, jackets, pants, shorts, socks, stockings, gloves, gaiters, hats, mittens, shoes, boots, footwear; parts, components, fixtures and fittings for all the aforesaid goods.

4. By virtue of their earlier filing and priority dates, the registrations qualify as earlier marks under section 6(1) of the Act. As the first earlier mark completed its registration procedure more than five years before the filing dates of the applications, it is, in principle, subject to the use provisions set out in section 6A of the Act. The Opponent has stated that it has used the mark for all the goods relied on. In its defences the Applicant did not request that the Opponent prove use of the first earlier mark. Therefore, the Opponent is entitled to rely upon all the goods on which the oppositions are based without demonstrating that it has used the first earlier mark.

5. The second earlier mark is a comparable mark.[2] As the second earlier mark had not completed its registration process more than five years before the filing date of the applications in issue, it is not subject to the use conditions under section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

6. In its notices of opposition, the Opponent states that the competing goods are identical or at least similar. It is also contended that the Earlier Marks are highly similar visually and conceptually to the '684 mark and that there is a high degree of similarity visually, aurally and conceptually between the Earlier Marks and the '672 mark. Thus, the Opponent requests the applications be refused for all the applied-for goods.

7. The Applicant filed a defence and counterstatement for both oppositions denying the Opponent's claims.

8. The Applicant is not legally represented. The Opponent is represented by Appleyard Lees IP LLP.

Relevance of EU law

9. 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.

EVIDENCE AND SUBMISSIONS

10. During the evidence rounds the Opponent filed evidence in chief in the form of a witness statement from David Moy, partner and LLP designated member of Appleyard Lees IP LLP (the Opponent's representative), dated 7 July 2025 and

[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

Exhibits DM1EX1 – DM1EX7. The Applicant did not file evidence or written submissions. Neither party requested a hearing, but the Opponent filed written submissions in lieu of a hearing. The Opponent's evidence and submissions will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

PRELIMINARY MATTERS

The Applicant does not market the same goods as the Opponent

11. In its defences the Applicant submits that they "*[…] do not provide the same goods or services that Black Diamond Equipment [the Opponent] does. We don't provide any service or goods related to Climbing, Skiing or Trail running gear*".

12. Although I appreciate the Applicant's statement in this regard, I am required to make the assessment of the likelihood of confusion notionally and objectively based on the Opponent's goods, as registered, and the Applicants' goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods that those marks have been used in relation to thus far. Rather, I must consider all of the circumstances in which the mark applied for might be used if it were registered.[3] This is because trade mark registrations are items of property which may be sold by the Applicant and/or Opponent to third parties in the future and may therefore be used in a different way, or upon/in relation to different goods, than those used by the current proprietors of those marks. In this connection, in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-171/06P, the Court of Justice of the European Union ("CJEU") stated:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take

[3] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

13. As such, it is not appropriate for me to take that factor into account in my assessment. However, I will make an assessment, later in this decision, on the degree of similarity (or lack thereof) between the parties' respective goods.

The contested applications' stylisation is not distinctive for class 25 goods

14. The Opponent filed evidence and submissions arguing that the representation of diamonds (black or white) as contained in the contested marks are non-distinctive for class 25 clothing goods.[4] To this regard the Opponent filed extracts from the Registry showing results for an image search for "precious stones" (jewellery) for class 25.[5] The Opponent reports that the search gave 380 results that also included the contested applications. Whilst I appreciate the Opponent's argument, I note, first, that the contested applications were accepted for registration and, thus, at least some degree of distinctiveness must be assumed for these marks.[6] Second, the extracts of the Registry featured in the Opponent's evidence exclusively indicate that the search found 380 results but only the contested marks are reproduced in the evidence. Therefore, absent further evidence or clarification from the Opponent, I am unable to determine the nature of the stylisation of the other marks on the Registry. This especially because the search was conducted for "precious stones" (jewellery) at large which can reasonably encompass marks with different representations of precious stones. Therefore, I find that the argument put forward by the Opponent does not bear any weight in my assessment and I will not refer to it any further.

[4] Mr Moy's witness statement at [13] and Opponent's submissions in lieu dated 27 October 2025 at [16].
[5] Exhibit DM1EX7.
[6] *Formula One Licensing BV v OHIM*, Case C-196/11P.

DECISION

Section 5(2)(b)

15. Sections 5(2)(b) and 5A of the Act state:

> "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.
>
> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Case law

16. The leading authorities which guide me are from the CJEU: *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

17. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(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

18. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, where the CJEU stated at paragraph 23 of its judgment:

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

19. The relevant factors identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (*"Treat"*) case, [1996] R.P.C. 281, for assessing similarity were:

(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.

20. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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".

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

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

22. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[7]

[7] BL O/399/10.

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

23. The goods in question are as follows:

Opponent's goods	**Applicant's goods**
("the first earlier mark") Class 25: Clothing, belts, clothing for sports, leisure and climbing, ski clothing included in this class, shoes, trainers, hiking boots and shoes, climbing shoes, headgear; all these goods excluding luxury goods. ("*the second earlier mark*") Class 25: Clothing, footwear, headgear; clothing in the nature of sportswear, namely, shirts, sweatshirts, t-shirts, vests, pullovers, jackets, pants, shorts, socks, stockings, gloves, gaiters, hats, mittens, shoes, boots, footwear; parts, components, fixtures and fittings for all the aforesaid goods.	("*the '684 mark*") Class 16: Stickers; Stickers [stationery]. Class 25: Printed t-shirts; T-shirts; Tee-shirts. ("*the '672 mark*") Class 25: Clothing; Jerseys [clothing]; Casual clothing; Clothing for sports; Sports clothing; Athletic clothing.

24. I note that the first earlier mark's specification contains the limitation "excluding luxury goods". In assessing the respective goods' comparison I have taken into account this limitation.

Class 16

25. The '684 mark's specification features the terms "*Stickers*" and "*Stickers [stationery]*". The Opponent argues that such wider terms in the Applicant's specification also encompass goods like "decorative stickers for helmets" and "decorative stickers for soles of shoes" and that these goods would be complementary to the Opponent's "*clothing*", "*shoes*" or "*headgear*" since consumers are accustomed to using decorative stickers for clothing, footwear and headgear.[8] The Applicant did not submit any argument on this point.

26. I appreciate the Opponent's submissions; however, I find the respective goods to be dissimilar. I find the goods have a different nature (clothing versus stickers), method of use (wear clothing versus attach a sticker) and intended purpose (cover the body versus decorate). I also find the respective goods address different consumers (i.e., if someone intends to purchase an article of clothing, they will not seek to buy stickers), are provided by different undertakings, do not share the same trade channels and they are not in competition with each other. With regard to the goods' complementarity, although I note that stickers may be applied to clothing, I do not see how consumers would perceive such a close connection between these goods to believe that one is indispensable or important for the use of the other and believe that they come from the same or related undertakings. Thus, these goods are not complementary.

Class 25

27. The Applicant's class 25 goods for both applications are various types of clothing. I find they all fall within the wider category of "*clothing*" contained in the Earlier Marks' specifications. Thus, they are identical in line with the principle outlined in *Meric*.

Conclusion of the goods comparison

28. Under section 5(2)(b), a degree of similarity between the goods is essential for there to be a finding of a likelihood of confusion.[9] This means that as a result of my

[8] Opponent's submissions in lieu at [32].
[9] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

findings above, opposition number OP000453495 fails for the class 16 goods contained in the specification of the '684 mark. However, both oppositions may proceed for all the class 25 goods in both applications for which I found identity.

The average consumer and the purchasing act

29. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 (or services) in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

30. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) 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.

31. The average consumer for the goods in class 25 for which I found identity (clothing) will be a member of the general public. The Opponent contends that the goods are items with low purchase value and that the average consumer's level of attention will be relatively low when purchasing these goods.[10] I note the Opponent's submissions and I find that the cost of purchase for these goods is likely to vary but not to be excessively high, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance, wearability, durability, and suitability for purpose. Therefore, the degree of attention will be medium (average).

32. I consider the purchase of the goods to be mainly visual with the goods likely being obtained by self-selection from the shelves in retail outlets or selected from online catalogues (i.e., pictures of items on websites); however, I do not discount that aural considerations will play their part, particularly when advice is sought from sales representatives or for word of mouth recommendations.

Comparison of trade marks

33. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph [34] of its judgment in *Bimbo*, that:

[10] Opponent's submissions in lieu at [38].

"[…] 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 relevant 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."

34. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

35. The marks to be compared are as follows:

Opponent's marks	**Applicant's marks**
the first earlier mark BLACK DIAMOND	*the '684 mark* 

the second earlier mark 	*the '672 mark (series)*   BLACK DIAMONDZ

36. As already reported above in this decision, the Applicant contends that the respective marks are different, but it did not particularise further on this point. I note the Applicant's submission, and I will bear it in mind during my assessment. The Opponent filed more particularised submissions, and I will address them in turn below in this decision.

Overall impression

37. The first earlier mark consists of the all-capitalised words "BLACK DIAMOND". The mark's overall impression lies in the combination of the two words as they form a unitary meaning.

38. The second earlier mark is a diamond-shaped geometric device. The device is cut across by two white lines that isolate a smaller diamond shape on the right and a chevron on the left. Jointly the chevron and the smaller diamond shape form a bigger diamond device.

39. The '684 mark consists of a cartoony representation of a humanised black diamond (with arms and legs) wearing a yellow (golden) crown adorned with black and grey

jewels. The figurative device is placed on a black background. The mark's overall impression lies in the figurative device of which the mark is composed.

40. The '672 mark is a series of two marks. The first mark depicts a black diamond with a crown and underneath the words "Black DIAmoNdz" in white. Both the device and the words are placed on a black background. The second mark features a white diamond with a crown and the words "Black DIAmoNdz" in black. Both the device and the words are placed on a white background. Keeping in mind that in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements,[11] the words "Black DIAmoNdz" are the main distinctive element and contribute the most to the marks' overall impression. Nonetheless, in both marks, the figurative device, given its size and position, also contributes to the mark's overall impression although to a lesser degree than the verbal element.

The '684 mark versus the first earlier mark

Visual similarity

41. The Opponent contends that the marks are visually similar in that they share the common element of a black diamond, respectively through verbal elements and a figurative diamond.[12] I appreciate the Opponent's submissions, but I do not see how the marks can be considered to have any visual similarity. The first earlier mark consists of the words "BLACK DIAMOND" whereas the '684 mark features a cartoony humanised (with arms and legs) black diamond wearing a jewelled golden crown. I find the marks to be visually dissimilar.

Aural similarity

42. The Opponent submits that although the '684 mark cannot be voiced, as it does not contain verbal elements, the relevant consumer will be able to deduce that the logo is a black diamond which is aurally identical to the first earlier mark.[13] The first earlier mark "BLACK DIAMOND" is a two-syllable word combination comprised of

[11] *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].
[12] Opponent's submissions in lieu at [25].
[13] Idem at [26].

two English dictionary words. The relevant consumer will voice them according to their dictionary definition. The '684 mark is a figurative device, and the relevant consumer will not attempt to voice it. Accordingly, the marks are aurally dissimilar.

Conceptual similarity

43. The Opponent argues that the marks are conceptually identical in that they are both black diamonds.[14] I agree with the Opponent that the first earlier mark, according to the dictionary meaning of "BLACK DIAMOND", conveys the meaning of a precious stone that is black in colour. The '684 mark depicts a black diamond, therefore, the relevant consumer, although absent any word element, are likely to derive the meaning of a "black diamond" from the mark. However, I note that the '684 mark does not merely portray the image of a black diamond, but it features a cartoony representation of a humanised black diamond (with legs and arms) wearing a jewelled golden crown. Therefore, I find that the meaning the consumer would derive from the mark is not merely of a black diamond as they would derive it from a picture of a real-life black diamond or the words "black diamond", but rather of a humanised black diamond with a crown. This partially detracts from the mark's conceptual similarity. Overall, I find the marks to have a high degree of conceptual similarity.

The '684 mark versus the second earlier mark

Visual similarity

44. The Opponent contends that the respective marks are similar insofar as both marks consist of figurative black diamonds.[15] Although I appreciate that both marks can be defined as diamonds, this is where their similarity ends: on the one hand, the second earlier mark consists of a geometric diamond-shaped device featuring a white line forming an angled division across its centre. This creates the visual impression of a smaller diamond positioned within and to the right of the larger diamond, together with a chevron element on the left-hand side of the device. On the other hand, the '684 mark is a cartoony humanised representation of a black

[14] Idem at [27].
[15] Idem at [25].

diamond wearing a jewelled golden crown. Overall, I find that the marks are visually similar to a very low degree.

Aural similarity

45. Both marks are figurative devices and consumers will not voice them. The Opponent did not file submissions on this point. I find the marks to be aurally neutral.

Conceptual similarity

46. The Opponent argues that the marks are conceptually identical in that they both are black diamonds.[16] Whilst I note that the respective marks depict different figurative devices (leading to a very low visual similarity), I agree with the Opponent that, on a general level, the relevant consumer will perceive both marks as representing a black diamond: one is geometric and minimally styled, whilst the other is presented in a cartoon-like style with additional matter (i.e., arms, legs and a jewelled crown). Therefore, as both marks refer, on a general level, to a black diamond, I find that the marks share an above-medium conceptual similarity.

The '672 mark versus the first earlier mark

Visual similarity

47. The first earlier mark is the all-capitalised words "BLACK DIAMOND". I have already described the visual impression of the '672 mark at paragraph [40]. The Opponent contends that, the respective marks are similar in that they share the words "BLACK DIAMOND" with the '672 mark adding the letter "z" at the end of "black diamond-z" and a figurative element of a black diamond with a crown.[17]

48. As a preliminary point, I appreciate that the letters "BLACK DIAMOND" are all capitalised in the first earlier mark whilst the series of the '672 mark features the word "DIAmoNdz" with an irregular capitalisation. Such difference in capitalisation will not affect my assessment since the words "BLACK DIAMOND" contained in

[16] Idem at [27].
[17] Opponent's submissions in lieu at [20].

the first earlier mark are protected irrespective of their capitalisation or typeface used.[18] Further, consumers will be able to read the word "diamondz" in the series, notwithstanding its irregular capitalisation.

49. The respective marks overlap in the words "black diamond" (irrespective of their capitalisation) and differ in the additional "z" placed at the end of "diamondz" in the contested series. The respective marks also differ in that the '672 marks in the series feature, respectively, a black crowned diamond and a white crowned diamond. I agree with the Opponent's submission that the consumer's eye will be drawn to the elements in the marks that can be read (i.e., "BLACK DIAMOND"/"Black diamondz") rather than the figurative elements.[19] However, I find that given the size and position of the figurative devices in the '672 marks, the relevant consumers will notice them. Thus, they detract from the marks' visual similarity. Overall, I find the respective marks share a medium degree of visual similarity. I reach the same conclusion for both marks in the series depicting, respectively, a black crowned diamond on a black background (with the verbal element in white) and the white crowned diamond on a white background (with the verbal element in black).

Aural similarity

50. The Opponent argues that the marks are aurally highly similar as they share the words "black diamond" and differ in the additional "z" at the end of the verbal elements (i.e., "black diamondz") in both marks of the contested series.[20] I agree with the Opponent that the respective marks have a high degree of aural similarity in that the relevant consumers will voice the words "black diamond-" in the respective marks in the same way according to their ordinary dictionary meanings with the only difference of the additional "z" (or "s") sound at the end of "black diamondz" in the contested series. In the '672 mark the consumer will not voice the figurative device in both marks of the series. (i.e., the black/white crowned diamond).

[18] *LA Superquimica v EUIPO*, Case T-24/17 at [39].
[19] Opponent's submissions in lieu at [23]. Regarding this legal approach also see *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].
[20] Idem at [21].

Conceptual similarity

51. As already found at [43], the first earlier mark conveys the meaning of a precious stone (i.e., a diamond) that is black in colour. I agree with the Opponent that the relevant consumers will perceive the letter "z" in the '672 mark as a reference to the plural form of the word "diamond" (i.e., "diamonds").[21] Although it was not argued by the Opponent, I reach this conclusion because "z" is commonly used as a misspelling for the letter "s" given their high similarity in sound. In the first mark of the contested series, the concept of "black diamonds" is reinforced by the depiction of a black diamond. Although I appreciate that the diamond in the contested mark carries a crown, I find that this figurative detail does not detract too much from the respective marks' shared meaning of a "black diamond" with the difference of the singular form in the first earlier mark and the plural form in the first contested mark of the '672 series of marks. Overall, the marks have a very high conceptual similarity.

52. In the second mark of the contested series, the concept of "black diamonds" is reduced by the depiction of a white (crowned) diamond that creates some tension with the words "black diamondz". Although I appreciate that consumers will pay more attention to the mark's verbal element (i.e., "black diamondz"), I nonetheless find that, given the size and position of the device, this detracts in part from the marks' conceptual similarity. Therefore, with regard to the second mark in the '672 series, I find the marks share a high conceptual similarity.

The '672 mark versus the second earlier mark

53. Neither party filed specific submissions regarding the comparison between these marks.

Visual similarity

54. I have already described the visual impression of the second earlier mark at [38] and of the '672 mark at [40]. I appreciate that both marks share, on a general level, the representation of a diamond with the '672 mark containing the representation

[21] Idem at [20].

of a crowned diamond (black or white) and the second earlier mark consisting of a diamond-shaped geometric figure, either being perceived as a chevron and a smaller diamond shape forming a bigger diamond device or immediately as a diamond with two white lines forming an angle inside it. The addition of the words "black diamondz" in the '672 mark further detracts from the marks' visual similarity. Overall, I find the marks share a very low degree of visual similarity. I reach the same conclusion for both marks in the series of the '672 mark.

Aural similarity

55. As found above at [51], the relevant consumer will read "black diamondz" in the '672 mark as "black diamonds" according to the words' dictionary definitions, perceiving the "z" as the plural form "s". Consumers will not voice the figurative device in the second earlier mark, or the black/white crowned diamonds in the '672 mark. Overall, the marks are aurally neutral.

Conceptual similarity

56. I found at [54] that the consumer is likely to perceive the diamond-shaped geometric figure as a black diamond, notwithstanding its level of stylisation. Thus, although the second earlier mark does not contain verbal elements, the relevant consumer will likely perceive it as representing a "black diamond". The '672 mark features a crowned black diamond (first contested mark in the series) and a white crowned diamond (second contested mark in the series) along with the words "black diamondz". The '672 mark conveys more clearly the meaning of the plural form of "back diamond" given its verbal component. With regard to the first contested series mark, I find both marks share the meaning of "black diamond", although one in singular and the other in plural form; hence, the marks have a high conceptual similarity. With regard to the second contested mark in the series, as already explained at [52] the depiction of a white diamond detracts in part from the mark's conceptual similarity. Therefore, I find the marks have an above-medium conceptual similarity.

Distinctive character of the earlier trade marks

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

> "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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, 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)."

58. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

59. The Opponent did not provide specific submissions regarding the inherent or the enhanced distinctiveness of the Earlier Marks apart from submitting that the distinctive character of an earlier mark must be taken into consideration in the assessment of the likelihood of confusion.[22]

[22] Opponent's submissions in lieu at [38].

60. Dealing first with the inherent distinctiveness of the first earlier mark, I note that the Opponent provided evidence showing extracts from the Registry for the words "black diamond" for class 25 indicating that the results deriving from this search only refer to the Opponent and that they are listed together with the '672 mark.[23] This evidence seems exclusively aimed at showing some likelihood of confusion between the marks at hand.[24] Absent further clarification from Mr Moy or the Opponent in the submissions in lieu, I do not consider that this part of the Opponent's evidence supports an argument concerning the inherent distinctiveness of the first earlier mark.

61. The first earlier mark features two English dictionary words indicating a precious stone which is black in colour. The mark is arbitrary and does not have any semantic correlation with the goods (clothing) for which it has been registered. Therefore, it possesses a medium degree of inherent distinctive character.

62. Turning to the question of whether the inherent distinctiveness of the first earlier mark has been enhanced through use, I note that the Opponent has filed evidence of use. The evidence consists of a few internet extracts showing some of the Opponent's clothing articles offered for sale on third-party platforms (e.g., "BananaFingers.co.uk") with prices in pounds sterling.[25] For the remaining of the evidence, it is unclear whether it targets the UK.[26] In fact, part of such evidence seems to target the USA as it shows prices in US dollars.[27] Mr Moy did not provide revenue figures, the volume of clothing items sold under the first earlier mark, marketing expenditure or examples of marketing activities (including social media advertisements), invoices or any other type of evidence of use. Therefore, whilst I acknowledge the Opponent's evidence, I do not find that the first earlier mark's distinctive character has been enhanced through use.

63. Turning to the second earlier mark, the Opponent did not file any evidence or submissions directly concerning the second earlier mark's distinctiveness (either inherent or enhanced through use). Accordingly, I have only the inherent position to consider.

[23] Exhibits DM1EX3 – DM1EX6.
[24] As argued by the Opponent in its submissions in lieu at [14] and [15].
[25] Exhibit DM1EX1, page 8 and exhibit DM1EX2 pages 11 - 12.
[26] Exhibit DM1EX2B.
[27] Exhibit DM1EX2A.

64. The second earlier mark consists of a diamond-shaped geometric device, as already described above in this decision at [38]. Although it is not particularly complex, the mark is not a simple geometric device. Furthermore, I found that the relevant consumer will perceive the mark as conveying the meaning of a black diamond. Such meaning is arbitrary and does not have any semantic correlation with the goods at hand (clothing). Thus, overall, I find that the mark possesses an above-medium degree of inherent distinctiveness.

Likelihood of confusion

65. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

66. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

67. I found the respective class 25 goods to be identical. The consumer is likely to pay a medium level of attention in the selection of the goods at issue. The purchasing process of the contested goods is considered to be mainly visual but the potential for aural use also bears some relevance. The distinctiveness of the first earlier mark is medium whereas the distinctiveness of the second earlier mark is above medium. The Opponent did not enhance either of the Earlier Marks' distinctiveness through use.

68. I will now turn to consider the likelihood of direct confusion (or lack thereof) of the Earlier Marks in relation to the '684 mark and the '672 mark respectively.

The '684 mark

69. With regard to the first earlier mark, I have found the marks to be visually and aurally dissimilar, and conceptually similar to a high degree.

70. The Opponent contends that given the marks' conceptual identity (i.e., black diamond), the differences between the marks are insufficient to outweigh their overall similarity[28] leading consumers to be confused about the respective marks' commercial origin.[29] The Applicant contends that "*the Names, Mascots and Logos of the two companies are different […]*".[30]

71. Although I appreciate that both marks share the concept of "black diamond" and that the goods at hand are identical, I find that the '684 mark's visual representation and the lack of verbal elements (resulting in the mark not being pronounced) strongly weigh against any finding of direct confusion. The visual dissimilarity between the marks is of particular importance in the global assessment of the likelihood of confusion given that the purchasing act is likely to be primarily visual for all of the goods at issue. In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

> "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

[28] Opponent's submissions in lieu at [27] and [28].
[29] Idem at [39].
[30] Applicant's counterstatement.

72. Furthermore, although I have found that the first earlier mark possesses a medium degree of distinctive character, this is attributable to the lack of semantic correlation between the words “BLACK DIAMOND” and the goods for which it was registered rather than for the mark’s visual representation.

73. Taking into account the relevant consumer’s medium level of attention, and even applying the principle of imperfect recollection, I find that the differences (especially visual and aural) are sufficient to avoid direct confusion. As a result, I find that there is no likelihood of direct confusion.

74. Turning to the second earlier mark, I have found that the marks have a very low degree of visual similarity, they are aurally neutral and they share an above-medium degree of conceptual similarity. Neither party filed specific submissions on the likelihood of confusion for the second earlier mark.

75. I find that the same reasoning outlined above for the first earlier mark applies even more so here. Whilst both marks can be perceived as referring/alluding to a black diamond, the marks’ different stylisation and the lack of verbal elements (resulting in the marks not being pronounced) strongly weigh against any finding of direct confusion. This also takes into account that the purchase of the goods at hand is mainly visual and, thus, any visual similarity (or lack thereof) will be more important.[31] Therefore, even considering the relevant consumer’s medium level of attention, the second earlier mark’s above-medium distinctiveness and even applying the principle of imperfect recollection, I find that the differences (especially visual and aural) are sufficient to avoid direct confusion. As a result, I find that there is no likelihood of direct confusion.

The ‘672 mark

76. Regarding the first earlier mark, I found that the marks are visually similar to a medium degree and that they have a very high aural and conceptual similarity. Neither party filed specific submissions on the likelihood of confusion between these marks.

77. As mentioned above at [60], the Opponent provided evidence showing extracts from the Registry for the words “black diamond” for class 25 goods. The evidence

[31] *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03.

shows that the Registry reports both the first earlier mark and the '672 mark as a result of this search. To this regard, the Opponent contends that the evidence shows that the Registry deems the respective marks to be similar. The Applicant neither commented on this point nor provided further arguments on the marks' likelihood of confusion (or lack thereof) apart from the submissions indicated at [70]. Regarding the Opponent's evidence and the argument of similarity, I do not find the evidence shows any similarity between the marks. The search results derived from the Registry merely list all the marks that contain the words "black diamond-", but the mere fact that two marks are contained in the same list because they share part of the same verbal element (for the same goods), does not necessarily lead to a finding of likelihood of confusion as a series of additional considerations must be made as per the legal test outlined in *Canon*.

78. The respective marks overlap in their verbal elements "black diamond-" and differ in the additional "z" at the end of the '672 mark which is likely to be voiced as indicating the plural form ("s") of the first earlier mark. Thus, the respective marks also almost share the same meaning (respectively in the singular and plural form). Although I appreciate that the consumers' eye is drawn to the elements they can read (i.e., the verbal element "BLACK DIAMOND" and "black diamondz" in the respective marks),[32] the crowned diamond device (both black and white) in the '672 mark, given its size and position, is likely to be noticed by the relevant consumer. This is even more true for the second mark in the '672 mark's series since the white (crowned) diamond creates some conceptual tension with the words "black diamondz". Therefore, taking into account that the purchasing act is likely to be primarily visual, even bearing in mind the principle of imperfect recollection, the consumers' medium degree of attention and the first earlier mark's medium degree of distinctiveness (deriving from its lack of semantic correlation with the goods), I find that given the visual differences between the marks consumers are unlikely to confuse one mark for the other. Therefore, I find there is no likelihood of direct confusion. I reach this conclusion for both contested marks in the series of the '672 mark.

[32] *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].

79. Turning to the second earlier right, I found that the marks have a very low degree of visual similarity, they are aurally neutral and that the second earlier mark shares a high degree of conceptual similarity with the first contested mark in the series of the '672 mark whereas it has an above-medium conceptual similarity with the second contested mark in the series of the '672 mark. Taking into account that the consumers' attention is likely to be drawn to the verbal element "black diamondz" (irrespective of its irregular capitalisation) that can be read and that the marks present striking visual differences, although both marks share the concept of "black diamond(s)" (being this conceptual overlap reduced in the second mark of the '672 mark's series) I find the relevant consumers are unlikely to confuse one mark for the other. Therefore, even taking into account the principle of imperfect recollection, the second earlier mark's above-medium distinctiveness and bearing in mind that the purchase is predominantly visual, I find that direct confusion is unlikely to occur. I reach this conclusion for both marks in the '672 mark's series.

80. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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)".

81. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[33] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[34] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[35]

82. The Opponent contends that "*[…]. It is common practice in the retail industry for new product ranges to launch based on an existing company's brand. Consequently, it is highly conceivable that the relevant consumer will perceive the Applications as sub-brands or variations of the Earlier Mark to denote a new product range produced by the Opponent*".[36] The Applicant did not provide specific submissions on this point. I have borne in mind the Opponent's submissions in my assessment below.

[33] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[34] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.
[35] *Liverpool Gin Distillery*.
[36] Opponent's submissions in lieu at [41].

The ‘684 mark

83. With regard to the first earlier mark, whilst I appreciate that the respective marks share, on a general level, a reference to the concept of “black diamond”, the marks’ visual impressions are too far apart to lead consumers to believe that any commercial association exists between the parties. More specifically, it is unlikely that consumers noticing the differences between the marks, would believe that the ‘684 mark constitutes a brand variation (or different stylisation) of the first earlier mark. This especially because the ‘684 mark does not simply depict a black diamond, but it consists of a cartoony humanised black diamond wearing a jewelled crown. Thus, the ‘684 mark does not plainly recreate visually the image of a “black diamond”, but it features additional matter that is not contained in the first earlier mark. Therefore, I see little reason for consumers to consider that the replacement of the words “BLACK DIAMOND” with the representation of a cartoony humanised black diamond wearing a jewelled golden crown would be an intentional step taken by the same undertaking or economically linked undertakings. Thus, I do not consider it would form a proper basis for a finding of indirect confusion between the marks.

84. Turning to the second earlier mark, the same reasoning applies. Although the marks share the same allusion to the concept of a black diamond, the marks’ different stylisations and the additional matter in the ‘684 mark (i.e., the diamond’s arms and legs and the golden jewelled crown) make it unlikely that the consumers will perceive the ‘684 mark as an intentional step taken by the same undertaking (or economically linked undertakings) to create a sub-brand or a new brand line economically associated with the Opponent. Thus, I do not find indirect confusion between the marks is likely to occur.

The ‘672 mark

85. The ‘672 mark and the first earlier mark overlap in their verbal element “black diamond-” (irrespective of their letter capitalisation) an differ in the additional letter “z” in the ‘672 mark which consumers will perceive as indicating the plural form of the first earlier mark. The ‘672 mark also contains the depiction of a crowned diamond that occupies a significant place (both in position and size) in the mark

reinforcing the meaning of “black diamond” in the first contested mark of the series whilst creating some conceptual tension in the second contested mark of the series as the device is depicted with white hues. As consumers pay more attention to elements they can read,[37] the overlap in the verbal element is more important (the ‘672 mark fully contains the first earlier mark), although the figurative device will not go unnoticed. Overall, I find that the relevant consumer, when confronted with the ‘672 mark, will perceive it as a sub-brand or a new line of the “BLACK DIAMOND” brand (perhaps, a line targeting a younger demographic given the misspelling “z” and the crowned diamond) and perceiving the additional crowned diamond as a decorative element in the mark. I appreciate that the second contested mark of the ‘672 series is of different colour, and it creates some semantic tension with the mark’s verbal component. However, I find that consumers are likely to perceive such stylisation merely as a colour variation of the first mark in the series and as part of the same line. Therefore, from the above considerations, it follows that I find a likelihood of indirect confusion for the ‘672 mark.

86. Turning to the second earlier mark, although it alludes to the meaning of “black diamond”, I do not see any logic for the relevant consumer to notice the marks’ respective different stylisations and the addition of the words “black diamondz” in the ‘672 mark and believe that the ‘672 mark derives from, or is economically connected with the Opponent. I reach the same conclusion for both marks in the series of the ‘672 mark. Therefore, I do not find a likelihood of indirect confusion in this instance.

CONCLUSION

91. The opposition number **OP000453495** under section 5(2)(b) fails in total and application number UK00004140684, subject to any appeal, can proceed to registration.

92. The opposition number **OP000453489** under section 5(2)(b) succeeds in total and application number UK00004140672, subject to any appeal, will be refused for all goods.

[37] *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].

COSTS

93. The parties have had approximately the same degree of success in this case. On that basis, each party will bear its own costs.

Dated this 21st day of April 2026

Andrea Rossi
For the Registrar