

O/0334/26

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



BLACK DIAMONDZ

AND

IN CLASS 25

BY BLACK DIAMONDS FAMILY LTD
AND

THE OPPOSITIONS THERETO
UNDER NOS. OP000453488 AND OP000453494

BY
BLACK DIAMOND EQUIPMENT EUROPE GMBH

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 Europe GmbH ("**the Opponent**") opposed the application s 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 mark ("**the Earlier Mark**"):

International trade mark (IR) number WO0000000854462

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 534784)

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.

4. By virtue of its earlier priority date, the registration qualifies as an earlier mark under section 6(1) of the Act. As the 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 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 Earlier Mark.
5. In its notices of opposition, the Opponent states that the competing goods are identical or at least similar. Regarding the '684 mark, it is stated that the marks are highly similar visually and conceptually. For the '672 mark the Opponent contends that the series of marks are highly similar visually, aurally and conceptually to the Earlier Mark. Thus, the Opponent requests the applications be refused for all the applied-for goods.
6. The Applicant filed a defence and counterstatement for both oppositions denying the Opponent's claims.
7. The Applicant is not legally represented. The Opponent is represented by Appleyard Lees IP LLP.

Relevance of EU law

8. 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

9. 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 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

10. 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*”.

11. 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.² 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:

² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

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

12. 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

13. 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.³ To this regard the Opponent filed extracts from the Registry showing results for an image search for “precious stones” (jewellery) for class 25.⁴ 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.⁵ Second, the extracts of the Registry featured in the Opponent’s evidence exclusively indicate that the search gave 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.

³ Mr Moy’s witness statement at [13] and Opponent’s submissions dated 27 October 2025 at [16].

⁴ Exhibit DM1EX7.

⁵ *Formula One Licensing BV v OHIM*, Case C-196/11P.

DECISION

Section 5(2)(b)

14. 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

15. 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

16. 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

17. 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.”

18. The relevant factors identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [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.

19. 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”.

20. 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.”

21. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.⁶

⁶ 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.”

22. The goods in question are as follows:

Opponent’s goods	Applicant’s 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.	<p>(“the ‘684 mark”)</p> <p>Class 16: Stickers; Stickers [stationery].</p> <p>Class 25: Printed t-shirts; T-shirts; Tee-shirts.</p> <p>(“the ‘672 mark”)</p> <p>Class 25: Clothing; Jerseys [clothing]; Casual clothing; Clothing for sports; Sports clothing; Athletic clothing.</p>

23. I note that the Opponent’s specification contains the limitation “excluding luxury goods”. In assessing the respective goods’ comparison I have taken in to account this limitation.

Class 16

24. The ‘684 mark’s specification features the terms “Stickers” and “Stickers [stationery]”. The Opponent argues that such wide 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.⁷ The Applicant did not submit any argument on this point.

25. 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

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

Conclusion of the goods comparison

27. 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.⁸ This means that as a result of my findings above, opposition number OP000453488 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

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of

⁷ Opponent's submissions in lieu dated 27 October 2025 at [33].

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

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.

29. 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 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.

30. 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.⁹ 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).
31. 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


32. 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:

“[...] 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.”

⁹ Opponent's submissions in lieu at [38].

33. 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.

34. The marks to be compared are as follows:

Opponent's mark	Applicant's marks
	<p><i>the '684 mark</i></p> 
	<p><i>the '672 mark (series)</i></p>  

35. 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

36. The Earlier Mark consists of a diamond-shaped geometric device followed by the words "Black Diamond". The verbal element in the mark is the most dominant and distinctive one in the mark and the mark's overall impression predominantly lies in this element. However, also the geometric device, given its size and position, contributes in part to the mark's overall impression although to a much lesser degree.

37. 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.

38. 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,¹⁰ 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.

¹⁰ *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].

The '684 mark

Visual similarity

39. The Opponent contends that both marks are similar in that they both contain figurative black diamonds.¹¹ I acknowledge the Opponent's submission.

40. The Earlier Mark features the words "Black Diamond" preceded by a geometric figurative device consisting of a diamond-shaped device with the left half side bolded and the right side containing a smaller black diamond. The negative space between the smaller diamond and the overall bigger device can also be perceived as giving the impression of a smaller black geometric diamond partially overlapping on the right side of the larger black diamond. The '684 mark features a cartoony humanised black diamond (i.e., with black arms and legs) wearing a jewelled golden crown.

41. Whilst I appreciate that consumers focus more on the beginnings of marks,¹² I already found that the Earlier Mark's main distinctive element is the words "Black Diamond" to which the consumers will pay more attention. I agree with the Opponent that the consumers, when confronted with the Earlier Mark as a whole, are likely to perceive the device as a geometric representation of one (or two partially overlapping) black diamond(s). Therefore, I agree that the respective marks, on a general level, share some visual similarity insofar as they both depict a diamond. However, this is where the visual similarity between the marks ends. The '684 mark is a cartoony humanised black diamond wearing a jewelled golden crown and it is visually far from the minimalistic geometric depiction of the diamond-shaped device in the Earlier Mark. Moreover, the Earlier Mark features the words "Black Diamond" that detract even further from the marks' visual similarity. Overall, I find the marks have a very low visual similarity.

Aural similarity

42. The Opponent argues that the marks are aurally identical.¹³ Although I appreciate the Opponent's submission, I find that, on the one hand, the relevant consumer will

¹¹ Opponent's submissions in lieu at [26].

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹³ Opponent's submissions in lieu at [27].

read the words “Black Diamond” in the Earlier Mark according to their ordinary dictionary meaning and they will not voice the geometric device; on the other hand, the consumers will not voice the ‘684 mark as it exclusively consists of a figurative device. Therefore, I find the marks are aurally dissimilar.

Conceptual similarity

43. The Opponent contends that the marks are conceptually identical.¹⁴ I agree with the Opponent that both marks overlap in their meaning of “black diamond”. In the Earlier Mark the concept of “black diamond” is not only clearly conveyed by its words, but consumers, when seeing the geometric device in combination with the mark’s verbal element, are likely to perceive the device as reinforcing the mark’s meaning of “black diamond”. The ‘684 mark depicts a black diamond, therefore, the relevant consumers, 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 that of a black diamond as they would derive it from a real-life picture of a black diamond, but rather of a humanised black diamond with a crown. This detracts from the mark’s conceptual similarity. Overall, I find the marks to have a high degree of conceptual similarity.

The ‘672 mark

Visual similarity

44. I already described the visual impression of the ‘672 mark at paragraph [37] and of the Earlier Mark at paragraph [40]. The Opponent contends that whilst the Earlier Mark features a geometric device of a black diamond and the ‘672 mark contains the representation of a black diamond with a crown, the respective marks are similar in that they share the words “BLACK DIAMOND” with the ‘672 mark merely adding the letter “z” at the end of the word “diamond”.¹⁵

¹⁴ Idem at [28].

¹⁵ Opponent’s submissions in lieu at [21].

45. As a preliminary point, I appreciate that the words “Black Diamond” are capitalised in the Earlier Mark whilst the series of the ‘672 mark features the word “DIAMONDZ” with an irregular capitalisation. Such differences in capitalisation will not affect my assessment since the words “Black Diamond” in the Earlier Mark are protected irrespective of their capitalisation¹⁶ and consumers are able to read the word “diamondz” in the series notwithstanding its irregular capitalisation.
46. 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 Earlier Mark features a stylised diamond device at the beginning of the mark before the words “Black Diamond” whereas the 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.¹⁷ However, I find that given the size and position of the figurative devices in the respective marks (especially in the contested series), the relevant consumers will notice them. Thus, they detract from the marks’ visual similarity. Overall, I find the respective marks share between a low to 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

47. The Opponent argues that the marks are aurally highly similar as they share the words “black diamond” and differ in the additional “z” placed at the end of the word “diamondz” in both marks of the contested series.¹⁸ I agree with the Opponent that the respective marks have a high degree of aural similarity in that the relevant consumer will voice the words “black diamond-” in the respective marks according to their ordinary dictionary meanings with the only difference of the additional “z”

¹⁶ *LA Superquimica v EUIPO*, Case T-24/17 at [39].

¹⁷ Opponent’s submissions in lieu at [24].

¹⁸ *Idem* at [22].

(or “s”) sound at the end of “black diamondz” in the contested series. In all the marks the consumer will not voice the figurative devices (i.e., the geometric diamond-shaped device and the black/white crowned diamond).

Conceptual similarity

48. As already outlined at paragraph [43], the Earlier Mark conveys the meaning of “black diamond”. I agree with the Opponent that the relevant consumers will perceive the letter “z” in the contested series as a reference to the plural form of the word “diamond” (i.e., “diamonds”)¹⁹. 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 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.

49. Regarding 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.

Distinctive character of the earlier trade mark

50. 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

¹⁹ Idem at [21].

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).

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).”

51. 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.
52. The Opponent did not provide specific submissions regarding the inherent or the enhanced distinctiveness of the Earlier Mark apart from submitting that the distinctive character of an earlier mark must be taken into consideration in the assessment of the likelihood of confusion.²⁰
53. Dealing first with the inherent distinctiveness of the 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.²¹ This evidence seems exclusively aimed at showing some likelihood of confusion

²⁰ Opponent’s submissions in lieu at [39].

²¹ Exhibits DM1EX3 – DM1EX6.

between the marks at hand.²² Absent further clarification from Mr Moy or the Opponent in its submissions in lieu, I do not consider that this part of the Opponent's evidence supports an argument concerning the inherent distinctiveness of the Earlier Mark.

54. The Earlier Mark features two English dictionary words indicating a precious stone of colour black preceded by a diamond-shaped geometric device. Both the device and the words are arbitrary and the mark 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.

55. Turning to the question of whether the inherent distinctiveness of the 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.²³ For the remaining of the evidence, it is unclear whether it targets the UK.²⁴ In fact, part of such evidence seems to target the USA as it shows prices in US dollars.²⁵ Mr Moy did not provide revenue figures, the volume of clothing items sold under the 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 Earlier Mark's distinctive character has been enhanced through use.

Likelihood of confusion

56. 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

²² As argued by the Opponent in its submissions in lieu at [14] and [16].

²³ Exhibit DM1EX1, page 8 and exhibit DM1EX2 pages 11 - 12.

²⁴ Exhibit DM1EX2B.

²⁵ Exhibit DM1EX2A.

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]).

57. 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).

58. 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 Earlier Mark is medium and the Opponent did not enhance the Earlier Mark's distinctiveness through use.

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

60. Regarding the '684 mark, I found the marks to have a very low degree of visual similarity, are aurally dissimilar and they share a high degree of conceptual similarity. The Opponent contends that the marks share the common element of a "black diamond" leading to a high degree of similarity.²⁶ The Applicant contends that "*the Names, Mascots and Logos of the two companies are different [...]*".²⁷ 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 very low visual similarity 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

²⁶ Opponent's submissions in lieu at [26] – [30].

²⁷ Applicant's counterstatement.

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.”

61. Furthermore, although I have found that the 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.
62. 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) are sufficient to avoid direct confusion. As a result, I find that there is no likelihood of direct confusion.
63. Turning to the ‘672 mark, I found that the marks have between a low to medium degree of visual similarity and are highly aurally similar. The marks’ conceptual similarity varies from very high for the first contested mark of the series to high for the second contested mark of the series. As mentioned above at [53], the Opponent provided evidence showing extracts from the Registry for the words “black diamond” for class 25 goods. The evidence shows that the Registry reports both the 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 [60]. 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*.

64. 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 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),²⁸ 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 and the Earlier Mark’s medium degree of distinctiveness, 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.

65. 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,

²⁸ *MigrosGenossenschafts-Bund v EUIPO*, T-189/16 at [52].

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”).

66. 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.²⁹ 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.³⁰ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.³¹

²⁹ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

³⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

³¹ *Liverpool Gin Distillery*.

67. 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*”.³² The Applicant did not provide specific submissions on this point. I have borne in mind the Opponent’s submissions in my assessment below.

68. With regard to the ‘684 mark, whilst I appreciate that the respective marks share, on a general level, a depiction of a diamond and convey the similar meaning of a 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 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 golden crown. Therefore, I see little reason for consumers to consider that the removal of the words “Black Diamond” and the change in stylisation from a minimalistic diamond-shaped geometric device to a 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.

69. Turning to the ‘672 mark, I found that the marks share almost the totality of their verbal element (i.e., “black diamond-”), irrespective of their capitalisation, and that consumers pay more attention to the elements that can be read. I also found that relevant consumers are likely to perceive the additional “z” as a misspelling of the letter “s” and they will understand the ‘672 mark as the plural form of the Earlier Mark (“black diamonds”). Therefore, I find that the relevant consumer, when confronted with the ‘672 mark, will likely perceive it as a brand variation (or sub-brand) deriving from the Earlier Mark, perhaps targeting a younger demographic given the misspelling “z”. With regard to the first mark in the series, the addition of

³² Opponent’s submissions in lieu at [42].

the crowned black diamond is likely to be perceived as reinforcing the meaning of the mark's verbal element (although in the plural form) and the fact that the diamond is adorned with a crown could be perceived in line with the intent to target a younger demographic of consumers. With regard to the second mark in the series of the '672 mark, although the depiction of a white diamond creates some tension with the mark's verbal element, the same reasoning applies and the mark is likely to be perceived 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.

CONCLUSION

91. The opposition number **OP000453488** under section 5(2)(b) fails in total and application number UK00004140684, subject to any appeal, can proceed to registration.

92. The opposition number **OP000453494** under section 5(2)(b) succeeds in total and application number UK00004140672, subject to any appeal, will be refused for all goods.

COSTS

70. 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