O-0587-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3725132

BY FREE COUNTRY. LTD.

TO REGISTER

AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 431900)

BY

ZALANDO SE

BACKGROUND

1) On 24 November 2021, Free Country, Ltd. ('the applicant') applied to register the following sign as a trade mark in respect of the goods listed below:

Class 25: Jackets, leather jackets, ski jackets, wind resistant jackets, sweaters, coats, overcoats, parkas, pullovers; tank tops, sweat shorts, shirts, T-shirts and vests; pants, shorts, woven shirts, blazers, suits, blouses, skirts, dresses, hats, footwear, raincoats, swimwear, lounge wear; Gloves, belts, topcoats, pajamas and scarves; infants and children's clothing, namely, layettes, slippers, sleepwear, underwear, rompers, shorts, pants; socks and booties; hosiery, panties; underwear, namely, briefs, boxer shorts and undershirts.

2) The application was published in the Trade Marks Journal on 17 December 2021 and notice of opposition was later filed by Zalando SE ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon the following trade mark registrations in respect of certain of the goods/services covered by the same, as shown below:

i) **UKTM No. 918093936 ('Mark 1')**

FREE TO BE

Class 35: Wholesaling and retailing services, in particular mail order services (including online) in relation to… clothes, footwear; Operating of a consumer loyalty programmes for the sale of clothing, footwear.

Filing date: 12 July 2019

Date of entry in the register: 06 May 2020

ii) **UKTM No. 918100002 ('Mark 2')**

TO BE FREE

Class 25: Clothing, footwear, headgear.

Filing date: 25 July 2019

Date of entry in the register: 09 January 2020

3) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As neither of the earlier marks had been registered for five years or more at the date the application was filed, they are not subject to the proof of use conditions as per Section 6A of the Act.

4) The applicant filed a counterstatement, denying the opponent's claims.

5) The opponent is represented by D young & Co LLP. The applicant is represented by Potter Clarkson LLP. Neither party has filed anything in these proceedings beyond the notice of opposition/counterstatement nor did either request a hearing. I now make this decision after considering all the papers before me.

DECISION

6) Section 5(2)(b) of the Act states:

"5. - (2) A trade mark shall not be registered if because –

(a)….

(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

7) The leading authorities which guide me are from the Court of Justice of the European Union ('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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

8) Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Comparison of goods and services

9) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, 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."

10) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

> (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.

11) In relation to the retail services at issue, I note that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

12) Further, in *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the comparison between retail services and goods. He said (at paragraph 9 of his judgment) that:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

However, on the basis of the European courts' judgments in *Sanco SA v OHIM*[1], and *Assembled Investments (Proprietary) Ltd v. OHIM*[2], upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*[3], Mr Hobbs concluded that:

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
>
> iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

13) I also note that in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM* Case T-133/05) ('*Meric*'), where the General Court held that:

> "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 the trade mark application (Case T-388/00 Institut für

[1] Case C-411/13P
[2] Case T-105/05, at paragraphs [30] to [35] of the judgment
[3] Case C-398/07P

Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275,paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

14) The goods and services to be compared are:

Opponent's specification	Applicant's specification
Mark 1: **Class 35:** Wholesaling and retailing services, in particular mail order services (including online) in relation to… clothes, footwear; Operating of a consumer loyalty programmes for the sale of clothing, footwear. Mark 2: **Class 25:** Clothing, footwear, headgear.	**Class 25:** Jackets, leather jackets, ski jackets, wind resistant jackets, sweaters, coats, overcoats, parkas, pullovers; tank tops, sweat shorts, shirts, T-shirts and vests; pants, shorts, woven shirts, blazers, suits, blouses, skirts, dresses, hats, footwear, raincoats, swimwear, lounge wear; Gloves, belts, topcoats, pajamas and scarves; infants and children's clothing, namely, layettes, slippers, sleepwear, underwear, rompers, shorts, pants; socks and booties; hosiery, panties; underwear, namely, briefs, boxer shorts and undershirts.

15) All of the applicant's goods in class 25 are various items of 'clothing' or 'footwear' with the possible exception of 'hats', which are more naturally described as 'headwear'. Insofar as the goods other than 'hats are concerned, I find that the

services covered by mark 1 are complementary to all of those goods on the same basis as in the *Oakley* case referred to above. However, the respective nature, method of use and purpose differs and there is no real competitive relationship in play. Overall, I find a medium degree of similarity between the opponent's services covered by mark 1 and the applicant's various items of clothing and footwear.

16) Turning to 'hats', as the case law above indicates, the fact that the applicant's goods may not be identical to the goods which are the subject of the opponent's retail-type services does not preclude a finding of similarity between the respective goods and services. The applicant's 'hats' will be sold alongside items of clothing. The applicant's goods are therefore likely to be the subject of the same retail services as the clothing connected with the opponent's services. The opponent's services relating to clothing are therefore likely to be important for the sale of the applicant's 'hats'. Consequently, the average consumer is likely to believe that an undertaking selling 'hats' is the same, or connected to, an undertaking providing the opponent's services. There is therefore a degree of complementarity in play between those goods and services. Nevertheless, the nature, purpose and method of use differs and there is no competitive relationship. I find that there is a medium degree of similarity between the opponent's 'Retailing services, in particular mail order services (including online) in relation to… clothes' and the applicant's 'hats'.

17) All of the applicant's goods in class 25 fall within the opponent's 'clothing, footwear and headgear' covered by mark 2. They are therefore identical in accordance with the *Meric* principle.

Average consumer and the purchasing process

18) It is necessary to determine who the average consumer is for the respective goods and services that have been to be either identical or similar and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

19) The average consumer for the respective goods in class 25 is the general public. The purchasing act will be primarily visual for all of those goods as they will be selected after perusal of racks/shelves in high-street stores or from photographs/images on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of those goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be taken account of by the consumer. Generally speaking, I find that at least a medium degree of attention is likely to be paid during the purchase for the aforementioned goods. Similar considerations apply to the opponent's retail-type services in class 35. Those services are likely to be sought out primarily visually by the general public, either on the high street or on-line such that the visual aspect is of most importance. However, again I do not discount the potential for aural use of the marks for those services. The average consumer is likely to take into account factors such as the variety of goods offered under that retail/wholesale service, returns policies etc. such that a medium degree of attention is likely to be paid to their selection.

Comparison of marks

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

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

21) The marks to be compared are:

Opponent's marks	Applicant's mark
Mark 1 FREE TO BE Mark 2 TO BE FREE	

Overall impressions

22) Mark 1 consists of the three words, 'FREE TO BE', and mark 2 consists of the three words, 'TO BE FREE'. Both marks are absent any stylisation or

embellishments. The overall impression of each mark rests in the combination of the three words of which they are comprised.

23) Turning to the contested mark, this naturally breaks down into two elements. The first element consists of an abstract device element. The second element is 'FREE2B' presented in a fairly unremarkable font. Both elements make a substantial visual contribution to the mark (albeit that it is by the word element that the mark will be referred to). I find that both elements make a roughly equal contribution to the mark's overall impression.

Similarity between mark 1 and the contested mark

24) Visually, a point of difference is created by the prominent device element which is present in the contested mark but absent from the earlier mark. In terms of the respective word/number elements, there is similarity in that both begin with the word 'FREE'. This is an important factor because it is usually the first part of a word element that will have the greatest impact upon the consumer's visual perception. That word is followed by the letter and number combination '2B' in the contested mark (such that the full word/number element in that mark is conjoined as FREE2B) whereas it is followed by the words 'TO BE' in the earlier mark (where the three words have spaces between them). I find a medium degree of visual similarity between 'FREE2B' and 'FREE TO BE'. Viewing the marks as a whole, I find a low-medium degree of visual similarity between them (i.e. a degree which is below medium but not low).

25) Aurally, the device element in the contested mark will not be pronounced. The contested mark will be pronounced as 'FREE-TO-BE'. This is the same as the way in which the earlier mark will be pronounced. The marks are aurally identical.

26) Conceptually, as the device in the contested mark is an abstract one, it is unlikely to evoke an immediately graspable concept in the consumer's mind. It's impact on the conceptual comparison is therefore neutral. The comparison is therefore between 'FREE TO BE' and 'FREE2B'. When faced with a combination of words/letters and or numbers, it is a natural instinct to attempt to make sense of it.

Given the aural identity between the letters ‘2B’ and the well-known words ‘TO BE’, I find that the average consumer will immediately perceive ‘FREE2B’ as meaning ‘FREE TO BE’. The marks are therefore conceptually identical.

Similarity between mark 2 and the contested mark

27) Visually, a point of difference is created by the prominent device element which is present in the contested mark but absent from the earlier mark. In terms of the respective word/number elements, the comparison is between ‘TO BE FREE’ and ‘FREE2B’. Both elements contain the word ‘FREE’. However, that word is present at the beginning in the contested mark and is followed by the numeral and letter, ‘2B’, (such that the full word/number element in that mark is conjoined as FREE2B) whereas ‘FREE’ is present at the end in the opponent’s mark and is preceded by the words ‘TO and BE’ (where the three words have spaces between them). I find a low-medium degree of visual similarity between the ‘FREE2B’ and ‘TO BE FREE’ elements. Viewing the marks, as a whole, I find that they are visually similar to a low degree.

28) Aurally, I have already said that the device element in the contested mark will not be pronounced. The contested mark will be pronounced as ‘FREE-TO-BE’. The earlier mark will be pronounced as ‘TO-BE-FREE’. The marks therefore share all of the same syllables but in a different order. In my view, this results in a medium degree of aural similarity overall.

29) Conceptually, as already stated, the device in the contested mark is an abstract one, and is therefore unlikely to evoke an immediately graspable concept in the consumer’s mind. It’s impact on the conceptual comparison is therefore neutral. I have already stated that the ‘FREE2B’ element in the contested mark is likely to be recognised as representing the three words ‘FREE TO BE’. The concept portrayed by those words is likely to be of ‘freedom to exist/live’. The opponent’s mark ‘TO BE FREE’ will immediately be recognised as meaning ‘to have freedom’. There is, in my view, significant overlap between those two concepts. I find a high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

30) The distinctive character of the earlier marks must be considered. The more distinctive each is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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)."

31) The opponent has filed no evidence and therefore I have only the inherent degree of distinctiveness of the marks to consider. Neither 'FREE TO BE' nor 'TO BE FREE' describes or alludes to any characteristic of the earlier services or goods. I find both earlier marks to have a normal degree of inherent distinctiveness.

Likelihood of confusion

32) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and/or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

Mark 1

33) I will first consider the likelihood of confusion between mark 1 and the contested mark. I have found the marks to be visually similar to a low-medium degree and aurally and conceptually identical. The earlier mark has a normal degree of distinctiveness, and the respective goods and services are similar to a medium degree. The average consumer is a member of the general public who are likely to pay a medium degree of attention during the purchase. Weighing all of these factors, and notwithstanding that the purchase will be primarily a visual one, I find that a sufficiently significant proportion of average consumers are likely, through imperfect recollection, to mistake one mark for the other (it is not necessary that all average consumers be confused; it is sufficient if there is a "sufficiently significant" proportion who will be[4]). This is because such consumers are likely to not recall the presence of the device element, and may, at the same time, misremember the word elements for each other owing, in particular, to the conceptual identity between them. There is a likelihood of direct confusion.

34) In case I am wrong about the consumer mistaking one mark for the other, I will also consider the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

[4] *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, [37]

"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)".

I bear in mind that the categories above are, of course, not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it may occur.

35) In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

36) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

37) Even if the consumer realises that the respective marks are not the same, because they recall the presence/absence of the device element, they are, nevertheless likely to believe that the respective goods and services come from the same/linked undertaking(s). This is because, in such circumstances, the respective 'FREE2B' and 'FREE TO BE' elements are also likely to either be misremembered as each other owing, in particular, to their conceptual identity or, if they are perfectly recalled, are nevertheless likely to be perceived as logical and consistent brand extensions/variants of each other which are sometimes used with and sometimes without the device element. There is a likelihood of indirect confusion.

Mark 2

38) I now turn to consider the likelihood of confusion between mark 2 and the contested mark. I have found the marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually highly similar. The earlier mark has a normal degree of distinctiveness, and the respective goods are identical. The average consumer is a member of the general public who are likely to pay a medium degree of attention during the purchase. Weighing all of these factors, and notwithstanding that the purchase will be primarily a visual one, I find that a sufficiently significant proportion of average consumers are likely, through imperfect recollection, to mistake one mark for the other. This is because they may not recall the presence of the device element, and they may misremember the word elements

for each other given the high degree of conceptual similarity between them. There is a likelihood of direct confusion.

39) If I am wrong about there being a likelihood of direct confusion between mark 2 and the contested mark, I find that there would, in any event be a likelihood of indirect confusion. I consider that such confusion is likely to occur amongst a sufficiently significant proportion of average consumers. Such confusion is likely to occur where the presence/absence of the device is recalled (and therefore the marks are not directly mistaken for each other) but the respective word/number elements are, at the same time, misremembered for each other owing, in particular, to the high degree of conceptual similarity between them, notwithstanding that the purchase will be primarily visual. In those circumstances, I find that the average consumer is likely to put the similarities between the marks down to the respective identical goods coming from the same/linked undertaking(s).

OUTCOME

40) The opposition succeeds in full.

COSTS

41) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£200
Official fee (Form TM7)	£100
Total:	**£300**

42) I order Free Country, Ltd. to pay Zalando SE the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of June 2023

Beverley Hedley
For the Registrar,
the Comptroller-General