

O/0754/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION  
NO. WO0000001667732 IN THE NAME OF LRP AG  
FOR THE FOLLOWING TRADE MARK:

**T O N E**

IN CLASSES 7, 11 & 21

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600002661  
BY STONE S.R.L.

## BACKGROUND AND PLEADINGS

1. LRP AG (“the applicant”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 19 April 2022 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR is claims a priority date of 18 November 2021, from the applicant’s Swiss trade mark, being that numbered 772622. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 14 October 2022 in respect of the following goods:

**Class 7:** *Electric coffee grinders.*

**Class 11:** *Electric coffee machines, electric tea machines, heating and cooling apparatus for dispensing hot and cold beverages, ice makers; refrigerated beverage dispensing systems.*

**Class 21:** *Cup holders, cup stands, portable beverage dispensers [containers].*

2. On 12 December 2022, Stone S.R.L (“the opponent”) opposed the application in its entirety. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is aimed at all of the goods of the application and is reliant upon the following UK trade mark:



UK registration no. UK00918284432<sup>1</sup>

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<sup>1</sup> The opponent’s mark is a comparable trade mark based on a pre-existing EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

Filing date 5 August 2020; date of entry in register 29 December 2020

Relying on all the goods, namely:

**Class 7:** *Coffee extracting machines; power-operated coffee grinders.*

**Class 11:** *Coffee machines, electric, fittings and accessories; coffee filters not of paper, components for electric coffee machines; reusable pods, not of paper and sold empty, featuring a filter for use in electric coffee machines; parts and fittings for all the aforesaid goods.*

**Class 21:** *Coffeepots, non-electric; coffee grinders, hand-operated.*

3. The opponent claims that the IR is similar to its earlier mark and is to be registered for goods that are identical and/or similar to the goods of the earlier mark. As a result, the opponent claims that there exists a likelihood of confusion, including the likelihood of association.

4. The applicant filed a counterstatement wherein it denied that the marks are similar and any similarity between the goods. The applicant submitted that there should be no likelihood of confusion.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008 ("TMR") but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit".

6. The effect of the above is that parties are required to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. The opponent is represented by Bates Wells & Braithwaite London LLP and the applicant is represented by Greaves Brewster LLP. Only the applicant filed submissions in lieu of a hearing. This decision is taken following careful consideration of the papers.

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.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

9. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

10. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process

less than five years before the priority date of the application and, therefore, is not subject to proof of use conditions. Therefore, the opponent can rely on all the goods for which its mark is registered.

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel 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:

(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 impression 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 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 to mind the earlier mark, 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.

## THE COMPARISON OF THE GOODS

12. The goods and services to be compared are as follows:

The applicant's goods	The opponent's goods
<p><b>Class 7:</b> <i>Electric coffee grinders.</i></p> <p><b>Class 11:</b> <i>Electric coffee machines, electric tea machines, heating and cooling apparatus for dispensing hot and cold beverages, ice makers; refrigerated beverage dispensing systems.</i></p>	<p><b>Class 7:</b> <i>Coffee extracting machines; Power-operated coffee grinders.</i></p> <p><b>Class 11:</b> <i>Coffee machines, electric, Fittings and accessories; coffee filters not of paper, Components for electric coffee machines; Reusable pods, not of paper and sold empty, featuring a filter for use in electric coffee machines; Parts and fittings for all the aforesaid goods.</i></p>

<p><b>Class 21:</b> <i>Cup holders, cup stands, portable beverage dispensers [containers].</i></p>	<p><b>Class 21:</b> <i>Coffeepots, non-electric; Coffee grinders, hand-operated.</i></p>
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13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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.”

14. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

15. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (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 the responsibility for those goods lies with the same undertaking.”

16. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

17. In *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

#### Class 7

18. “*Electric coffee grinders*” in the applicant’s specification, is encompassed by “*power-operated coffee grinders*” in the opponent’s specification. Therefore, I find the goods to be identical on the principle outlined in *Meric*.

#### Class 11

19. Despite the differences in wording, I consider that “*electric coffee machines, [...]*” in the applicant’s specification is identical to “*coffee machines, electric [...]*” in the opponent’s specification.

20. “[...] *Electric tea machines [...]*” in the applicant’s specification is similar to “*coffee machines, electric, fittings and accessories*” in the opponent’s specification. Further, I consider that there may be a general overlap in users, in that a business owner of an electric tea machine may also own a coffee machine for which is seeking parts. The goods may coincide in distribution channels as a store, may offer both parties’ goods. However, I do not consider that the goods will overlap in method of use. The goods share a similar nature and purpose, as they are both to create hot beverages. In addition, I do not consider that the goods are in competition nor are they complementary. Taking this into account, I consider the goods would be similar to a medium degree.

21. I consider that there is some similarity between “[...] *heating and cooling apparatus for dispensing hot and cold beverages [...]*” in the applicant’s specification and “*coffeepots, non-electric*” in the opponent’s specification. I consider that the goods differ in nature, purpose, method of use. However, I do consider that there may be an overlap in users, as the individuals using the applicant’s goods, may be using it to dispense coffee, potentially coffee that is made using the opponent’s goods. In addition, I consider that the goods could be purchased from the same store and therefore share trade channels. However, I do not consider that the goods are in competition nor are they complementary. Taking this into account, I find the goods to be similar to a low degree. Applying this reasoning and considering my understanding, in the absence of any submissions or evidence to the contrary, that the term “*refrigerated beverage dispensing systems*” is a form of cooling apparatus that is used for dispensing cold beverages, my finding of low degree of similarity applies here.

22. In the absence of any evidence or submissions, I am unable to find any similarity between “ [...] *ice makers*” in the applicant’s specification and any of the goods in the opponent’s specification. Whilst I recognise that the goods is an electrical

household good and there may be a general overlap between users with some of the opponent's goods, I do not consider that this is sufficient to substantiate similarity. In light of this, I find the marks to be dissimilar.

### Class 21

23. Whilst I consider that there may be a very general overlap in users between “*cup holders*” and “*cup stands*” in the applicant's specification and “*coffeepots, non-electric*” in the opponent's specification; I consider that these goods differ in nature, method of use, purpose, uses and are neither in competition nor complementary. In relation to the trade channels, I am of the view that the goods may be sold by the same retail outlet. Taking the above into account, I do not consider that a coincidence in goods being sold at the same retail outlet is sufficient for a finding of similarity. Consequently, I consider that the goods are dissimilar.

24. I consider that “*portable beverage dispensers [containers]*” in the applicant's specification encompasses “*coffeepots, non-electric*” in the opponent's specification. In the absence of any submissions or evidence to the contrary, I am of the view that coffeepots, non-electric can include receptacles such as those used at events which dispense coffee when the top is pressed.

### **THE AVERAGE CONSUMER AND THE PURCHASING PROCESS**

25. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”



26. In respect of both parties’ goods at issue, I am of the view that the average consumer of the goods at issue will be the general public at large, which is inclusive of businesses and professionals with specific knowledge or expertise (e.g. wholesale services in relation to coffee). The goods at issue will generally be sold through a range of retail shops, including specialist shops, and their online equivalents. In addition, they may be selected from catalogues or other printed publications. Although I do not discount aural considerations in the form of, for example, advice received from sales staff, orders made via the telephone or word-of-mouth recommendations.

27. The cost of the goods can range from relatively inexpensive (such as cup holders) to expensive (such as electric coffee machines). The frequency of the purchase of the goods is likely to vary dependent on the cost of the goods and the different average consumers, with the more expensive goods being purchased less frequently with limited purchases made by members of the general public, to more frequent purchases made by professionals and business users. In all cases, I consider that various factors will be taken into consideration such as aesthetics, convenience, durability, capacity and speed.

28. I consider that the level of attention paid by the average consumer will vary from low (for cup holders), medium (heating/ cooling apparatus) to high ( for electric coffee machines and coffee grinders) depending on the price, sophistication or specialised nature of the goods.

## **COMPARISON OF THE MARKS**

29. The respective marks are shown below:

	
The applicant's mark	The opponent's mark

30. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) 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 trade marks must be assessed by reference to all the overall impressions created by the trade 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.”

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

32. The applicant's mark consists of the text 'TONE'. I note that the applicant submits in its submissions in lieu that it is a figurative mark. All the letters in the mark are stylised, with the 'E' being slightly more stylised than the rest. In relation to the stylised 'E' I consider that despite its stylisation it will be viewed as an 'E'; the three horizontal lines are positioned directly next to the other letters in the same size and same line and taking into consideration that the eye sees what it wants to see. I

consider the word 'TONE' to have a greater impact on the overall impression of the mark with the stylisation of the mark playing a lesser role.

33. The opponent's mark is of the word 'STONE'. The mark is slightly stylised. I consider that the word 'STONE' has a greater impact on the overall impression of the mark with the stylisation of the mark playing a lesser role.

34. Visually, the marks share the letters 'TONE'. The marks differ in the letter 'S' that comes before 'TONE' in the opponent's mark and the stylisation of the marks. Whilst I appreciate that the marks share the letters 'TONE'; the point of difference is at the beginning of the marks. On this point, I remind myself that this is where the average consumer tends to focus.<sup>2</sup> Further, even though there is no special test which complies with the comparison of 'short' marks,<sup>3</sup> I am of the view that in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Taking all of this into account, I am of the view that the marks are visually similar to a higher than medium degree (but not high).

35. Aurally, I recognise that the applicant submits that due to the difference in the 'S' between the marks, the marks are different. Whilst I agree that the addition/absence of the 'S' between the marks will provide a point of aural difference, there is still a level of similarity between the marks. The applicant's mark will be pronounced as 'TOHN' and the opponent's mark will be pronounced as 'STOHN'. They share the pronunciation of the 'TOHN' element. That being said, the marks are short and the difference is at the beginning of the marks. Taking this into account, I consider the marks are aurally similar to between a medium and high degree with the opponent's mark.

36. Conceptually, I agree with the applicant's submissions. The marks are both ordinary dictionary words and I consider that they will be given their ordinary meanings. In relation to the applicant's mark, the word 'Tone', has multiple meanings; the word can be construed as "sound with reference to quality, pitch or volume", "short for tone colour" or even as submitted by the applicant "the tone of a sound is its

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<sup>2</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02,

<sup>3</sup> BOSCO BL O/301/20, paragraph 44

particular quality”.<sup>4</sup> In relation to the opponent’s mark, it is a hard solid substance found in the ground and often used for building houses.<sup>5</sup> Whilst, I note that there are various definitions for the applicant’s mark, regardless of what definition the average consumer identifies with the applicant’s mark, I consider that the marks refer to different concepts. In light of this, I consider the marks to be conceptually dissimilar.

## **DISTINCTIVE CHARACTER OF THE OPPONENT’S REGISTRATION**

37. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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).”

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<sup>4</sup> [Tone definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/dictionary/english/stone) accessed 3/08/2023.

<sup>5</sup> <https://www.collinsdictionary.com/dictionary/english/stone> accessed 3/08/2023

38. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

39. The opponent has not pleaded that its mark has acquired enhanced distinctive character through use and did not seek permission to file evidence to support such a claim. I have, therefore, only the inherent position of the earlier mark to consider.

40. The opponent's mark consists of the word 'STONE' in slightly stylised text. The word 'STONE' is a recognised English word which has no direct meaning in relation to the goods at issue. Whilst I consider that the mark is not descriptive or allusive, it does not have the highest degree of distinctive character, such as an invented word, because it is an ordinary dictionary word. Therefore, I find that the opponent's registration enjoys a medium degree of inherent distinctive character. Whilst I recognise that the stylisation will add to the distinctive character of the mark, I do not consider that it is sufficient to alter my finding to a higher degree of inherent distinctive character.

## **LIKELIHOOD OF CONFUSION**

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

42. I have found the marks to be visually similar to a higher than medium degree (but not high), aurally similar to between a medium and high degree and conceptually dissimilar. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have found the average consumer to be a member of the general public, business users and professionals. I have found that the goods are likely to be selected visually. However, I do not discount that there will also be an aural component to the purchase of the goods. I have concluded that the average degree of attention will vary between low and high. I have found the goods at issue to vary in similarity from identical to similar to dissimilar.

43. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am not convinced that the parties' marks would be mistakenly recalled or misremembered for one another. While I appreciate the level of visual and aural similarity between the marks, I consider that the conceptual distinction between well-known dictionary words would clearly be noticed. This conceptual difference will, in view, counteract any visual and aural similarities.<sup>6</sup> This is particularly the case given that the marks have a different first letter and, as I have set out above, this is where the average consumer tends to focus. Even taking into account the medium degree of distinctive character of 'STONE', I see no reason why the different beginnings of the marks and concepts would be overlooked or misremembered. Consequently, I do not consider there to be any likelihood of direct confusion. For the avoidance of doubt, this finding applies even where the parties' marks are viewed on identical goods and in situations where the average consumer pays a lower degree of attention.

44. Indirect confusion involves recognition by the average consumer of the difference between the marks. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he was then), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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<sup>6</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

“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 recognised 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.”

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).”

45. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,<sup>7</sup> wherein Arnold LJ referred to the comments of James Mellor QC (as he was then) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no 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.

46. I do not consider that this case falls within any of the categories set out in *L.A. Sugar* (cited above). Dealing with those categories in turn, I appreciate that the opponent’s use of a slightly stylised ‘STONE’ is distinctive to a medium degree. However, the distinctive character lies in the mark as a whole. I do not consider that the shared use of the common letters ‘T-O-N-E’ is something that the average consumer would believe that only the opponent used. The crucial difference between the marks is the absence of the letter ‘S’ and I note the difference in stylisation. While the differences may not be stark from a visual or aural perspective, they are not simply the addition of non-distinctive elements and I see no reason why these are differences that the average consumer would expect to find in a sub-brand or brand extension. Lastly, I see no reason why the absence/addition of the letter ‘S’ and the stylisation are entirely logical and consistent with a brand extension. On the contrary, I consider that the alteration, is completely illogical and it is my view that the average consumer would reach the same conclusion. Put simply, there is no basis for such an alteration. I appreciate that the categories set out in *L.A. Sugar* are not exhaustive, however, I have nothing before me in support of any alternative argument. If such an alternative argument existed, it is for the opponent to bring it. Taking all of this into account and bearing in mind the comments from *Liverpool Gin* in the preceding paragraph, I conclude that there is no likelihood of indirect confusion between the parties’ marks. As was the case above, I consider that this is the case even where the marks are viewed on identical goods and in circumstances where the average consumer may pay a lower degree of attention.

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<sup>7</sup> [2021] EWCA Civ 1207

47. As a result of the above, the opposition reliant upon section 5(2)(b) hereby fails.

## **COSTS**

48. The applicant has succeeded and is entitled to an award of costs based on the scale published in Tribunal Practice Notice 2/2015. In the circumstances, I award the applicant the sum of £500 as a contribution towards its costs. I will award costs to the applicant as follows:

Preparing a statement and considering the other side's arguments

Filing submissions in lieu

£500

**Total**

**£500**

49. I, therefore, order STONE S.R.L. to pay LRP AG the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 8th day of August 2022**

**A Klass**

**For the Registrar,**

**the Comptroller-General**