

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3731056 BY INDIGO COMMUNE LIMITED FOR THE TRADE MARK

INDIGO COMMUNE

IN CLASSES 5, 41 & 44

AND THE OPPOSITION THERETO UNDER NO. 432445 BY O2 WORLDWIDE LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF JAMES HOPKINS (O/321/23) DATED 31 MARCH 2023

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DECISION  
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**Introduction**

1. This is an appeal by Indigo Commune Limited ("**Appellant**") from decision O/321/23 of Mr J. Hopkins ("**Decision**") concerning the partial opposition by O2 Worldwide Limited ("**Respondent**") to application number 3731056 ("**Application**") for the mark INDIGO COMMUNE, filed by the Appellant on 9 December 2021 in respect of the following goods and services:

Class 5: Homeopathic medicines; medicinal drinks; serotherapeutic medicines; medicinal herbs; medicinal oils; oils (medicinal -); herbal medicine; sulphonamides [medicines]; medicinal clays; medicinal beverages; infusions (medicinal -); mud (medicinal -); medicinal mud; medicinal sprays; medicinal alcohol; drinks (medicinal -); medicinal roots; medicinal ointments; medicinal infusions; antiallergic medicines; roots (medicinal -); tonics [medicines]; medicine tonics; herbs (medicinal -); medicinal tea; dragees [medicines]; sulfonamides [medicines]; sarsaparilla beverages [medicinal]; medicinal herb extracts; sediment (medicinal -) [mud]; medicinal herb infusions; constipation (medicines for alleviating -); medicines for human purposes; medicines for intestinal disorders; ginseng for medicinal use; medicinal hair growth preparations; medicines for alleviating constipation; medicine cases, portable, filled; Chinese traditional medicinal herbs; extracts of medicinal plants; medicinal hair growing preparations; extracts of medicinal herbs; sweets for medicinal purposes; seawater for medicinal bathing; decoctions of medicinal herb; confectionery for medicinal purposes; medicinal preparations and substances; hair growth preparations (medicinal -); herbs for medicinal purposes; alcohol for medicinal purposes; diagnostic reagents for medicinal use; beverages adapted for medicinal purposes; medicines for treating intestinal disorders; herbal tea for medicinal use; herb teas for medicinal purposes; artificial tea [for medicinal use]; herbal beverages for medicinal use; herbal teas for medicinal purposes; medicinal creams for skin care; anti-oxidants for medicinal use; medicinal preparations for stimulating hair growth; medicines for adjusting the menstrual cycle; breath-freshening chewing gum for medicinal purposes; medicinal herbal extracts for medical purposes; medicinal herbs in dried or preserved form; medicines for the treatment of gastrointestinal diseases; medicinal preparations for the treatment of infectious diseases; plant

and herb extracts for medicinal use; medicinal creams for the protection of the skin; dried Chinese boxthorn fruits for Chinese medicinal use.

Class 41: Information (Entertainment -).

Class 44: Dietary advice; nutritional advice; advice relating to cosmetics; advice relating to allergies; advice relating to nutrition; dietary and nutritional advice; alternative medicine services; regenerative medicine services.

2. On 7 April 2022, the Respondent partially opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed against the services in class 41 only. The Respondent relied upon its UKTM No. 3680250 (“**the earlier mark**”):



3. The earlier mark was filed on 11 August 2021 and registered on 1 April 2022 in respect of a wide range of goods and services in classes 9, 29, 30, 32, 33, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45. For the purposes of the opposition, the opponent relied upon all its services in class 41, which include ‘*entertainment information*’ and ‘*information and advisory services relating to entertainment*’.
4. In the Decision, J Hopkins for the Registrar held that the opposition was successful, and the Application was accordingly refused in respect of ‘*information (entertainment -)*’ in class 41.
5. On 17 April 2023 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

#### **The Hearing Officer’s decision**

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
  - a. the Appellant’s ‘*information (entertainment -)*’ is identical to ‘*entertainment information*’ and ‘*information and advisory services relating to entertainment*’ in class 41 of the earlier mark;
  - b. The average consumer would be a member of the general public who would be paying a medium level of attention during the purchasing process;
  - c. The purchasing process would be predominantly visual, although aural considerations in the form of word-of-mouth recommendations or verbal discussions with the provider, for instance, cannot be excluded entirely;
  - d. The earlier mark has a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use;
  - e. The overall impression of the earlier mark predominantly lies in the word ‘indigo’, while the font and colour play much lesser roles;

- f. Both words which comprise the Application provide a roughly equal contribution to its overall impression;
- g. The Application is visually, aurally and conceptually similar to the earlier mark to a medium degree;
- h. The differences between the marks are too great for there to be a likelihood of direct confusion;
- i. The word 'indigo'/'Indigo' dominates the overall impression of the earlier mark and co-dominates that of the Application and plays an independent distinctive role within the Application.
- j. The average consumer is likely to assume a commercial association between the parties, or sponsorship on the part of the Respondent, due to the identical word 'indigo'/'Indigo', such that there is a likelihood of indirect confusion.

### **Grounds of Appeal**

7. In the Statement of Grounds of Appeal, the Appellant made the following criticisms of the Decision:
  - a) The word INDIGO is entirely descriptive of the services provided by the Appellant, and the Hearing Officer was wrong to find otherwise;
  - b) The words INDIGO and COMMUNE combine to form a single unit, and the Hearing Officer was wrong to find otherwise;
  - c) There is only a modest degree of similarity between the Application and the earlier mark, such that there is no likelihood of confusion; and
  - d) There are numerous other marks on the register which contain the word INDIGO, thereby pointing away from a likelihood of indirect confusion.
8. The Appellant's director, Ms Alanamu, expanded upon the above at the hearing. Ms Breheny, Trade Mark Attorney for the Respondent, sought in her skeleton argument to uphold the Hearing Officer's decision, and again expanded upon this in the hearing. I set out below further details of the parties' arguments as are necessary to understand my overall conclusions.

### **Standard of review**

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc. v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:
  - Appeals to the appointed person are by way of review, not re-hearing;
  - It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer's decision, or that the Hearing Officer was wrong;
  - In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a

misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;

- In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation;
- Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;
- The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.

10. In addition to the above, Mr Iain Purvis KC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17, made the following observations at paragraph 33:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence ....

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

11. I shall bear all the above in mind when reviewing the Decision.

## Discussion

12. Looking at the various alleged errors in turn, my analysis is as follows.
  - (a) **The word INDIGO is entirely descriptive of the services provided by the Appellant**
  - (b) **The words INDIGO and COMMUNE combine to form a single unit**
13. I shall consider these grounds together, as they are closely interrelated.
14. The Appellant contends that the word INDIGO “represents tranquility, harmony, confidence and integrity”. During the hearing, the Appellant’s representative explained that within the natural medicine field, INDIGO is well-known as representing tranquillity, spirituality and wisdom.
15. The word INDIGO is of course primarily the name of a particular colour. However, it is certainly the case that the name of a colour can gain a secondary meaning, the most obvious example being “green” to represent environmentalism.
16. In order to persuade a Hearing Officer that a term such as INDIGO has acquired a secondary meaning, a party has in general two options. First, it can contend that the secondary meaning is so well-known to the general public that the Hearing Officer can take judicial notice of the meaning, without the need for the party to file evidence. Secondly and alternatively, it can file evidence to support its contention that the average consumer would understand the word to have a secondary meaning.
17. Whilst the Appellant contended that the secondary meaning of INDIGO would be known to people within the natural medicine field, it did not seek to contend that it would be known by the general public. In my view it was right not to do so - the Appellant’s contention that the word INDIGO has a secondary meaning is simply not “notorious”, or well-known enough, for judicial notice to be taken of it.
18. Accordingly, the only option open to the Appellant was to file evidence in support of the contention. The Appellant’s representative freely accepted that she did not file any evidence at all before the Hearing Officer in this regard. Nor did she seek permission to file any such evidence in this appeal.
19. In summary, therefore, the Appellant did not discharge the burden of proof, which lay on it, to show that the word INDIGO has acquired a secondary meaning beyond being a descriptor for colour. The Hearing Officer was accordingly entitled to conclude that the word INDIGO has a medium degree of inherent distinctive character in relation to *‘information (entertainment -)’*, which services are not of course associated with any particular colour. I accordingly dismiss ground (a).
20. With regard to ground (b), the Hearing Officer held that *“As it is not immediately apparent how a commune could be indigo in any logical sense, the words do not combine to form a unit with a different meaning than the two words taken separately”*. The Appellant contended that, given that INDIGO represents tranquility, harmony, confidence and integrity, it is used to describe the type of commune, and INDIGO COMMUNE is a single unit in much the same way as, say, “Green Travel”. This ground therefore relies upon the contention that INDIGO has acquired a secondary meaning. As I have upheld the Hearing Officer’s conclusion that it does not have a secondary meaning, the Hearing Officer’s decision that the words do not combine to form a unit cannot be challenged, and ground (b) must also be dismissed.

(c) **There is only a modest degree of similarity between the Application and the earlier mark, such that there is no likelihood of confusion**

21. The Appellant set out, in the Grounds of Appeal, the following representations of the marks in contention:



22. The representation on the left is an accurate portrayal of the earlier mark, but that on the right is not the Application. The Application is for the plain words “Indigo Commune”, and that is the comparison which must be made.

23. The Appellant sought to rely on the decision in *Liverpool Gin Distillery & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which the visual representation of the marks was taken into account by the Court of Appeal when assessing similarity. However, *Liverpool Gin* was a trade mark infringement case – where, as here, only registerability is in contention, the comparison is solely between the respective marks as filed, and the manner in which the Appellant may choose to use its mark is not relevant.

24. The Appellant also sought to rely on *Oatly AB and Oatly UK Limited v Glebe Farm Foods Limited* [2021] EWHC 2189 (IPEC). In that decision, however, the comparison was between a sign incorporating the word PUREOATY and the registered mark OATLY. The common element OAT was descriptive of the goods, and the judge held that there is no likelihood of confusion. That is in contrast to this dispute, where the common element – INDIGO – is not descriptive of either party’s services. I do not consider that the *Oatly* decision is of assistance to the Appellant.

25. The Hearing Officer carried out a careful, stepwise analysis of the degree of similarity between the marks. He cited the applicable law correctly, identified the distinctive and dominant components of the Application, considered separately the visual, aural and conceptual similarities, noted the differences between the marks, and ultimately concluded that there is a medium degree of similarity between the marks. That assessment was within the range of reasonable decisions open to him on the facts.

26. He then cited the law correctly in relation to assessment of likelihood of confusion, and having held that there is no likelihood of direct confusion, gave a careful analysis in paragraphs 42-46 as to the likelihood of indirect confusion. His conclusion, at paragraph 46, was:

*“It is my view that the addition of the word ‘Commune’ may be perceived by consumers as indicating a particular subset of the ‘indigo’ brand, constituting entertainment information provided by community of contributors, i.e. a community-led approach to the provision of the services. While the contested mark could notionally be used in the same font and colour as the earlier mark, even where it is not, it is considered that consumers would attribute the presentational differences to a variation of the brand with additional decorative elements. Taking all of the above into account, as well as the parties’ services being identical, I am satisfied that the average consumer – paying no more than a medium level of attention – would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the identical word ‘indigo’/‘Indigo’. Consequently, I consider there to be a likelihood of indirect confusion”.*

27. That conclusion in my view was open to him on the facts, and satisfies the requirement laid down in *Liverpool Gin* that there must be a “proper basis” for finding indirect confusion. Accordingly, he made no error of principle, and was not wrong. I dismiss this third ground of appeal.

**(d) There are numerous other marks on the register which contain the word INDIGO, thereby pointing away from a likelihood of indirect confusion**

28. I can deal with this last ground briefly. The Hearing Officer dealt with the other marks on the register in his preliminary remarks. At paragraphs 17-18 he said:

*“It may also be the case that there are other registered marks containing the word ‘indigo’. However, the applicant has not provided any evidence of them. In any event, and perhaps more importantly, there is a distinct lack of evidence that any of those marks are in use and that consumers have become accustomed to differentiating between them ...*

*Even if it had been established that there are other ‘indigo’ marks on the UK register, the mere fact that the owners of those marks have not opposed the application is not a relevant factor. Whether parties are able to coexist, notwithstanding the existence of any similar trade mark registrations, is a matter for those parties. The same is true in respect of their commercial and/or legal strategies. These matters do not involve the Registrar. It is not open to me to infer the reasons for a party’s decision to oppose or not oppose an application, for example, simply on the basis of the state of the register”.*

29. The Hearing Officer made no error of principle in deciding to give no weight to the other marks on the register relied upon by the Appellant and was not wrong to do so. I do not agree with the Appellant that this decision results in “the word ‘Indigo’, an entirely descriptive word and colour, [being] monopolised by O2 Worldwide Limited”. To the extent that the word INDIGO may be descriptive of goods and services (e.g. paint, colours of clothing and other goods etc), it would not be registerable in relation to such goods and services, so there is no risk of the Respondent monopolising the descriptive use of “indigo” in normal language. I dismiss this fourth ground of appeal.

**Conclusion**

30. The appeal is dismissed, and the Application is therefore refused in respect of ‘information (entertainment -)’ in class 41. The Application will proceed to registration in the UK in relation to the remaining goods and services in classes 5 and 44, which were not opposed..

**Costs**

31. Clearly, the Respondent has been the successful party in this appeal. I order that the Appellant should pay the Respondent £1,200 by way of costs of this appeal, comprising:

- Preparation of skeleton argument: £600
- Attendance at hearing: £600.

32. That is in addition to the £300 costs awarded to the Respondent by the Hearing Officer. The total costs award to the Respondent is accordingly £1,500.

**Postscript**

33. After the hearing had concluded, the Appellant's representative wrote to me with some suggestions as to how oppositions and hearings in the Registry might be made more straightforward for litigants in person to conduct, including in respect of neurodiverse litigants in person who may struggle with the spontaneity of oral hearings. I have arranged for her email to be passed to the Registry for their attention.

**Dr. Brian Whitehead**

**21 August 2023**

**Representation**

Temi Alanamu, director, for the Applicant / Appellant

Ms Claire Breheny, Trade Mark Attorney with Stobbs for the Opponent / Respondent