

O/0828/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004027582
BY AMONTE SERVICES & CO LTD
TO REGISTER:**



AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 448399
BY RDSTR IP 1 AB**

BACKGROUND AND PLEADINGS

1. On 18 March 2024, AMONTE SERVICES & CO LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 05 April 2024 in respect of the following goods:

Class 25: *Clothing for sports; Sports clothing; Footwear for sports; Sports footwear; Sports garments; Sports jerseys and breeches for sports; Jackets being sports clothing; Clothes for sports; Sports jerseys; Sports shirts; Sports clothing [other than golf gloves]; Sports jackets; Articles of sports clothing; Sports wear; Moisture-wicking sports shirts; Sports vests; Sports singlets; Athletic clothing; Sports bras; Sports bibs; Sports pants; Sports socks; Sport shirts; Clothes for sport; Athletic footwear; Sportswear; Moisture-wicking sports bras; Sports headgear [other than helmets]; Sport shoes; Gloves for apparel; Sports over uniforms; Moisture-wicking sports pants; Sports caps; Triathlon clothing; Jerseys [clothing]; Sports caps and hats; Clothing for skiing; Clothing for cycling; Leisure clothing.*

2. On 2 July 2024, the application was opposed in its entirety by RDSTR IP 1 AB (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon, and claiming reputation for, the following mark and goods:

UK00915167562¹

MONTEC

Filing date: 01 March 2016

Registration date: 28 June 2016

¹ This is a comparable mark based on earlier 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 IRs designating the EU. This comparable mark enjoys the same filing and registration dates as its European counterpart.

Class 25: *Clothing, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; none of the above goods are intended for protection against accidents and injuries.*

3. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an earlier mark in accordance with Section 6 of the Act. Although the opponent's earlier mark had been registered for more than five years at the filing date of the contested mark, and would be caught by the use conditions under Section 6A of the Act, the applicant answered 'No' to the question *"Do you want the opponent to provide proof of use?"*. Accordingly, in this opposition, the opponent can rely upon all of the goods it has identified without demonstrating genuine use.

4. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are highly similar and the goods are identical or highly similar.

5. Under Section 5(3) the opponent claims that it has developed a significant reputation in the earlier mark through its extensive use of the mark in the UK. The opponent also submits that the marks are closely similar and that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's mark.

6. The applicant filed a defence and counterstatement denying the claims made. In particular, the applicant referred to the differences between the parties' businesses, and the messages conveyed by their respective brands being sufficient to avoid confusion. It stated as follows:

"Distinctive Market Focus: "MONTE" is firmly positioned within the fitness and lifestyle sector, focusing on products such as activewear (hoodies, thermal leggings, body warmers) and accessories (e.g., water bottles). In contrast,

"Montec" is primarily known for its technical outdoor apparel, designed for extreme weather conditions and outdoor sports. This difference in market focus further reduces the likelihood of confusion, even in cases of phonetic similarity."

....

"Brand Narratives: "MONTE" promotes a narrative centred around personal improvement, wellness, and performance in everyday life, catering to urban dwellers and fitness enthusiasts. On the other hand, "Montec" is associated with overcoming extreme environmental challenges, durability, and adventure sports. This distinct narrative further separates the two brands in the consumer's mind, making confusion less likely."

7. The applicant further referred to the parties' businesses targeting different consumers and distributing their goods through different channels:

"Customer Profiles and Marketing Channels: "MONTE" appeals to urban fitness enthusiasts and those seeking stylish yet functional activewear for daily activities. Its marketing channels likely include fitness influencers, wellness blogs, and urban fashion platforms. In contrast, Montec's products are marketed through outdoor sports platforms, adventure travel magazines, and technical gear reviewers, appealing to outdoor enthusiasts who prioritise durability and performance in extreme conditions."

8. Similar arguments are made in response to the Section 5(3) claim, with the applicant referring to its brand having been developed independently with a clear focus on the activewear market, and the applicant not intending to capitalise on the opponent's reputation in the outdoor apparel sector. Once again, the applicant argued that *"the clear differentiation in product offerings and market focus mitigates any risk of reputational harm"*.

9. The applicant also states that its brand 'MONTE' has yet to be launched; nevertheless, it claims that given the differences in the parties' *"brand identity, visual design, and market focus, there is significant room for coexistence between "MONTE & Device" and "Montec."*

10. Lastly, the applicant states that it is *“open to negotiating a coexistence agreement that could delineate market territories or product categories, ensuring that both brands can operate without confusion”*.

11. These are familiar arguments in trade mark oppositions but, unfortunately for the applicant, they do not assist its case. Therefore, before going any further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

12. The assessment I must carry out under Section 5(2)(b) must be based on the marks and the goods as they are registered and applied-for, respectively. Whilst the extent to which the opponent has used the registered mark ‘MONTEC’ is of relevance to the opponent’s claim under Section 5(3) (but only insofar as the opponent must prove reputation for the goods claimed), the segment of the market in which the parties have so far used the marks (or intend to use the marks) is completely irrelevant for the purpose of assessing the likelihood of confusion under Section 5(2)(b), when the goods to be compared are identical or similar. Likewise, considerations such as the parties’ brand narrative or the message conveyed by the respective brands do not come into play insofar as these are matters which are extraneous to the marks at issue (which must be considered as they are registered and applied-for, respectively). Lastly, whilst the parties are free to negotiate, as far as I am aware, no agreement has been reached and so the argument is neither here nor there to the questions I need to answer.

13. The applicant is represented by Renaldo Amissah for Creative Reign Project Ltd, and the opponent is represented by Morgan, Lewis & Bockius UK LLP.

14. Both parties filed evidence during the evidence rounds.

15. Neither party requested a hearing, but the opponent filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

16. 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

17. The opponent's evidence came in the form of a witness statement from Elin Glommen dated 8 November 2024. Mr Glommen is the CEO at the opponent's company, and his witness statement is accompanied by three exhibits, being those labelled Exhibits EG1 – EG3.

18. The applicant's evidence came in the form of a witness statement from Mario Dos Reis dated 23 March 2025. Mr Dos Reis is a director and the founder of the applicant's company, and his witness statement is accompanied by five exhibits, being those labelled Exhibits A – Exhibit E. Most of Mr Dos Reis' evidence is about the differences in the parties' brands, and is aimed at supporting the applicant's arguments which I have already dismissed – hence, I will not refer to this part of the applicant's evidence.

19. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(b)

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

“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.”

21. 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 Pairs 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

22. When making the comparison, all relevant factors relating to the goods and services 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 of its judgment 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.”

23. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. 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 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 that the responsibility for those goods lies with the same undertaking.”

25. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

26. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

27. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated 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 trade mark application (Case T-388/00 *Institut fur 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.”

28. The competing goods are as follows:

The applicant's goods	The opponent's goods
Class 25: <i>Clothing for sports; Sports clothing; Footwear for sports; Sports footwear; Sports garments; Sports jerseys and breeches for sports; Jackets being sports clothing; Clothes for sports; Sports jerseys; Sports shirts; Sports clothing [other than golf gloves]; Sports jackets; Articles of sports clothing; Sports wear; Moisture-wicking sports shirts; Sports vests; Sports singlets; Athletic clothing; Sports bras; Sports bibs; Sports pants; Sports socks; Sport shirts; Clothes for sport; Athletic footwear; Sportswear; Moisture-wicking sports bras; Sports headgear [other than helmets]; Sport shoes; Gloves for apparel; Sports over uniforms; Moisture-wicking sports pants; Sports caps; Triathlon clothing; Jerseys [clothing]; Sports caps and hats; Clothing for skiing; Clothing for cycling; Leisure clothing.</i>	Class 25: <i>Clothing, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear, clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; none of the above goods are intended for protection against accidents and injuries.</i>

29. The opponent's specification includes the broad terms *clothing* and *headgear*; as well as the term *footwear for use in snowboarding and skiing*.

30. The applicant's goods are various items of clothing and headgear, all of which fall within the opponent's terms *clothing*, *headgear*. These are: *Clothing for sports; Sports clothing; Sports garments; Sports jerseys and breeches for sports; Jackets being sports clothing; Clothes for sports; Sports jerseys; Sports shirts; Sports clothing [other than golf gloves]; Sports jackets; Articles of sports clothing; Sports wear; Moisture-*

wicking sports shirts; Sports vests; Sports singlets; Athletic clothing; Sports bras; Sports bibs; Sports pants; Sports socks; Sport shirts; Clothes for sport; Sportswear; Moisture-wicking sports bras; Sports headgear [other than helmets]; Gloves for apparel; Sports over uniforms; Moisture-wicking sports pants; Sports caps; Triathlon clothing; Jerseys [clothing]; Sports caps and hats; Clothing for skiing; Clothing for cycling; Leisure clothing. These goods are identical on the principle outlined in *Meric*. For the sake of completeness, I should say that even if some of the goods listed are accessories as opposed to items of clothing (i.e. gloves), they are still similar to, at least, a medium degree, as they have a similar nature and purpose (i.e. items which are meant to be worn on the body), target the same users, are sold through the same trade channels, and are complementary.

31. In addition, the applicant's specification includes some items of footwear, namely *Footwear for sports; Sports footwear; Athletic footwear; Sport shoes* which include the opponent's term *footwear for use in snowboarding and skiing*. These goods are identical on the principle outlined in *Meric*. If I am wrong, the goods are nevertheless similar to a high degree as they share trade channels and have the same nature and method of use, inasmuch as all are footwear which are worn on the feet.

32. Lastly, the limitation *none of the above goods are intended for protection against accidents and injuries* does not affect the comparison because, since the goods are in class 25 (as opposed to class 9 which covers protective clothing), it does nothing more than state the obvious.

Average consumer

33. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

34. In *Iconix Luxembourg Holdings* (cited above), 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.

35. The average consumer of the competing goods in class 25 is a member of the general public. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate

the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to word-of-mouth recommendations.

36. The cost of the purchase is likely to vary, depending on the item of clothing, headgear or footwear, but, overall, they will be relatively inexpensive. I find that consideration will be given to the materials used, the fit, the aesthetic appearance, the intended use and the durability of the goods. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods.

Comparison of marks

37. 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.”

38. 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. The respective marks are shown below:

The applied-for mark	The earlier mark
	MONTEC

39. The opponent's earlier mark consists of the single word 'MONTEC' presented in capital letters in a standard font. There are no other elements that contribute to the overall impression, which resides in the word itself.

40. The applied-for mark is a figurative mark which consists of the word 'MONTE' presented in capital letters in a slightly stylised font, in white, within a black rectangular background; the mark also includes a device element positioned above the word 'MONTE' consisting of four white parallelograms in a V configuration. In his evidence, Mr Dos Reis' says that *"the logo, a monogram, was created by stylising the letter "m" into a structure symbolising personal growth and resilience"*. I will proceed on the basis that the black spaces between the white blocks is intended to be an 'M'. Whilst the figurative element is larger in size than the word 'MONTE', bearing in mind the following: (a) the rule of thumb that words speak louder than devices; (b) the nature of the figurative element of the mark which consists of four banal rectangular shapes arranged in such a way that they will be perceived like a stylised letter 'M' (c) the device being banal and perceived as a stylised letter 'M', it will be understood as standing for the initial letter 'M' of 'MONTE' which in turn will reinforce the weight of the word 'MONTE' within the mark, I consider that the verbal element 'MONTE' is the most distinctive component of the mark and it will play the greater role in the overall impression.

Visual similarity

41. Visually, the verbal element of the marks 'MONTEC' (in the earlier mark) and 'MONTE' (in the application) coincide in the first five letters 'MONTE' and differ in the last letter 'C' which appears at the end of the earlier mark but has no counterpart in the application. Bearing in mind that (a) the only difference between the marks is the additional letter 'C' at the end of the earlier mark (b) consumers tend to focus on the beginnings of marks and (c) the beginning and middle part of the marks at issue here are identical, I consider the verbal elements of the marks to be similar to a very high degree. Whilst the figurative element of the applied-for mark has a visual impact, given my findings that the word element is more distinctive and dominant (or at least equally dominant), I find that while the device reduces the level of similarity, it remains between medium and high.

Aural similarity

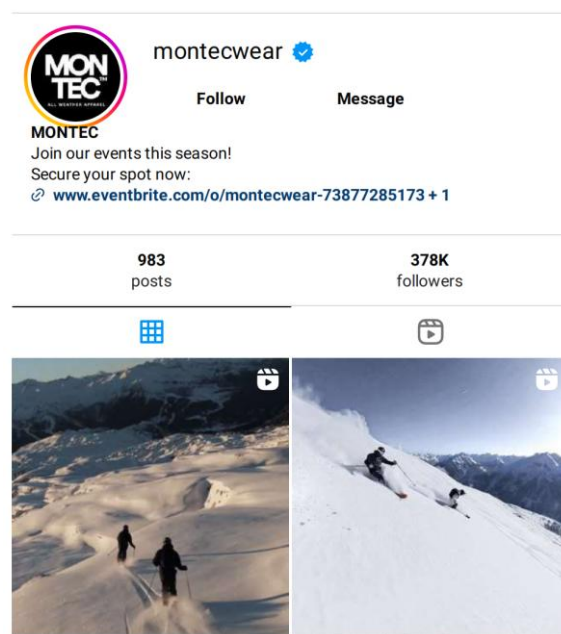
42. Mr Dos Reis filed evidence as to how the verbal elements of the marks will be pronounced. Such evidence suggests that the word 'MONTE' in the application will be pronounced as '*mon-tay*' (with a long -ay) whereas the word 'MONTEC' in the earlier mark will be pronounced as '*mon-tek*'. I agree that this is the way the marks will be pronounced; in my view, this will also give rise to a medium to high degree of aural similarity.

43. In addition, Mr Dos Reis provided further comments about the sound characteristics of 'MONTE' and 'MONTEC' and suggested that 'MONTE' produces a softer sounds associated with the romance language roots (Italian, Spanish and French), it means 'mountain' and it evokes elegance, lifestyle and aspiration, whereas 'MONTEC' is a technical sound which evokes modernity and innovation.

44. Whilst I agree that '*mon-tay*' and '*mon-tek*' have a different ending, I do not think that the sounds alone can evoke concepts such as elegance, lifestyle and aspiration, or modernity and innovation.

Conceptual similarity

45. Mr Dos Reis provided evidence that 'MONTE' means mountain; being also an Italian speaker myself, I am aware that this is the meaning of 'MONTE' in Italian. However, there is nothing to indicate that the UK average consumer is aware of the meaning of the word 'MONTE' in Italian (or in French or Spanish). Instead, Collins online dictionary refers to 'MONTE' as a card game. However, I am not sure that a significant proportion of the average consumers will know that 'MONTE' is a card game as I have no evidence as to the popularity of such a game. Accordingly, I consider that the UK average consumer will conclude that 'MONTE' is word of foreign origin or an invented word. The same goes for the word 'MONTEC' which is not an English word, and I have not been provided with any submission about its meaning. In this connection, whilst Mr Dos Reis filed evidence that 'MONTEC' "derived from "tech" or "technology," signifying advanced engineering for snow gear, the element 'TEC' in the earlier mark is subsumed in the word 'MONTEC' which will be perceived as a whole; as such, I find that it will not evoke the word 'TECH' or the concept of technology. For the sake of completeness, I should say that I have not overlooked Mr Dos Reis' evidence that the opponent uses the earlier mark in a way that it separates the two elements 'MONT' and 'TEC' as shown below:



46. However, this is not the way the earlier mark is registered; it is registered as the word 'MONTEC' and I do not consider that the use shown - which splits 'MONTEC' into 'MON' and 'TEC' - falls within notional and fair use of the earlier mark, because it alters its distinctiveness. I say this because when 'MONTEC' is split into the two words 'MON' and 'TEC' it is likely to convey the clever play on words which uses 'MON' as a French adjective which means 'mine' and 'tec' as an abbreviation which evokes the word 'technology' – such meanings not being conveyed by the trade mark 'MONTEC' when presented as a whole.

47. Accordingly, neither word conveys a concept immediately graspable to a member of the UK general public and the conceptual position is neutral.

Distinctive character of the earlier mark

48. 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-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).”

49. Registered trade marks possess various 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 high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

50. Starting from the inherent position, I have already explained that the earlier mark ‘MONTEC’ is likely to be perceived as an invented word or a word of foreign origin. I consider that it has a high degree of distinctiveness.

51. In addition, the applicant has filed evidence in support of its Section 5(3) claim. I will now consider such evidence as it might be relevant for establishing enhanced distinctiveness.

52. Mr Glommen says that the ‘MONTEC’ brand was founded in 2016 and has grown to be one of the leading brands of snow apparel. He provides the following turnover figures which, he says, relate to goods sold in the UK under the mark ‘MONTEC’ in the five-year period 2020 to 2024:

Date	Sales (exclusive of VAT)
2020	GBP £2,098,953
2021	GBP £799,644
2022	GBP £2,515,686
2023	GBP £3,154,337
2024 (to September)	GBP £1,487,592

53. This equates to a total of approximately £10million.

54. Mr Glommen also provides the following marketing figures which, he says, relate to the mark 'MONTEC' within the five-year period 2020 to 2024:

Date	Marketing Spend on Meta and Google in the UK
2021	€59,007
2022	€537,134
2023	€920,299
2024 (to 27 October)	€599,431

55. This equates to a total of approximately £2.1million.

56. Examples of media coverage are also provided; however, they mostly come from specialised magazines, and there is no indication of their readership.

57. Whilst the evidence indicates a successful business, with a moderate turnover, I consider that a total revenue of £10million over a 5-year period is relatively low, considering the relatively high cost of snow related apparel as shown from the particular examples of clothes offered for sale under the earlier mark (with most goods costing around £200). Further, there is no indication of the market share held by the mark. Accordingly, I consider that the evidence filed is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent in the UK. Certainly it does not elevate the level of distinctiveness that I have already assessed as high on an inherent basis.

Likelihood of confusion

58. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods

(and services if applicable) and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

59. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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)."

60. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

61. 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.

62. Earlier in this decision I found that:

- The marks are visually and aurally similar to a medium to high degree and conceptually neutral.
- The parties' goods are identical; alternatively, some of the goods are similar to a medium degree.
- The average consumer is a member of the general public who will select the goods mainly visually, with a medium degree of attention, but who may also rely on oral recommendations.

- The earlier mark is inherently distinctive to a high degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

63. Bearing in mind the interdependency principle, and in particular, the very high degree of visual similarity between the dominant and distinctive elements of the marks, i.e. 'MONTE' and 'MONTEC', the identity (or medium degree of similarity) between the goods, and the high degree of distinctive character of the earlier mark, I consider that the competing marks would easily become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of them for the class 25 goods of the kind listed in the earlier registration and the contested application for registration. This is all of the more so, given that the only difference between the dominant and distinctive elements 'MONTE' and 'MONTEC' is in the last letter 'C' and the principle that differences at the ends of marks are less noticeable. This also means that even if the average consumer will not overlook the figurative element of the application, once they have directly confused the verbal elements 'MONTE' and 'MONTEC', they will assume that the later mark is a logo version of the earlier mark and will be indirectly confused.

64. There is a likelihood of both direct and indirect confusion.

Section 5(3)

65. I can deal with this ground very briefly. I have already commented on the evidence filed by the opponent and I found that it does not establish enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors.² For the same reasons as those I have outlined above, I find that the opponent's

² General Motors, Case C-375/97

evidence does not establish that the earlier mark benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

OUTCOME

66. The opposition succeeds under Section 5(2)(b) and the application will be refused registration.

COSTS

67. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £1,600, calculated as follows:

Preparing opposition and considering the counterstatement:	£350
Filing evidence:	£700
Submissions in lieu of an oral hearing:	£350
Official fees:	£200
Total:	£1,600

68. I therefore order AMONTE SERVICES & CO LTD to pay RDSTR IP 1 AB the sum of £1,600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of September 2026

TERESA PINTO
For the Registrar