BL O/0860/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3341163 BY LUCABELLA SOURCING LTD TO REGISTER **LUCI** AS A TRADE MARK IN CLASSES 11 & 20

AND OPPOSITION THERETO (UNDER NO. 415682) BY LUCITE INTERNATIONAL, INC.

DECISION

Introduction and background

1. This is an appeal from the decision of the hearing officer, June Ralph, who rejected an opposition to registration of the mark LUCI under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

2. The main focus of the appeal is the appellant's contention that, while the hearing officer referred to the key authorities and law, she failed properly to apply the principles to the facts. The appeal focusses on two issues: (i) the evaluation of the characteristics of the average consumer and the purchasing decision and whether the hearing officer was right to take the view she did in the absence of evidence and (ii) the manner in which she conducted the evaluation of the similarity of the respective marks and the consequential analysis of likelihood of confusion.

3. This appeal was originally to have taken place by way of a full hearing the fixing of which was delayed but the parties ultimately agreed that the decision should be made on the papers as was the decision of the hearing officer. The consequence of this is that no further materials other than the Grounds of Appeal are relied on for the purpose of

the appeal. That is a reasonably comprehensive document which refers to some, albeit not all, of the key case law relevant to the appeal.

The Luci Mark and the opposition

4. Lucabella Sourcing Ltd ("the respondent") applied for the word trade mark Luci ("the Luci Mark") on 26 September 2018.

5. The Luci Mark was published in the Trade Mark Journal on 7 December 2018 in class 11 and 20 for the following goods.

> Class 11: Taps; showers; shower kits; mirrors; bathroom accessories; basin wastes; bath wastes; baths; bath panels.
> Class 20: Bathroom furniture; bathroom cabinets; vanity units; bathroom mirrors; bathroom accessories.

6. The Luci Mark was opposed on the basis of Section 5(2)(b) of the Act 1994, which provides that a trade mark shall not be registered if because "...(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark". Section 5(4)(a) of the Act was also originally relied on but that was not a point ultimately in issue before the hearing officer and no point is made on it on this appeal.

7. The basis for the opposition was an earlier registered trade mark of the appellant namely EU TM No.3368669 registered for the word mark LUCITE. The earlier mark is registered in 12 classes and the appellant relied on goods in classes 1, 11, 17 and 20. Because of the nature of the decision and the appeal, it is not necessary in this decision to set out all of the goods in respect of which the mark is registered. The hearing officer, correctly in this case, said that it was appropriate to focus on the goods which were closest to those for which the applicant's goods were registered. These were in class 11 and the hearing officer made the key comparison of goods as follows.

Opponent's goods	Applicant's goods
Class 11: Baths, showers, shower cubicles, shower trays, sinks, hand wash bowls and hand wash basins; sauna baths, sitz baths, spa baths; bathroom furniture; vanity units; toilet seats; cooking and refrigerating appliances and installations and housings and components for cooking and refrigerating appliances and installations; shelving for cooking and refrigerating appliances and installations including illuminated shelving for cooking and refrigerating appliances and installations; parts and fittings for all the aforesaid goods in class 11.	Class 11: Taps; showers; shower kits; mirrors; bathroom accessories; basin wastes; bath wastes; baths; bath panels. Class 20: Bathroom furniture; bathroom cabinets; vanity units; bathroom mirrors; bathroom accessories.

8. This approach is not criticised on appeal and as explained below, the challenge to the decision is all about the similarity of the respective marks. There is plainly, as the hearing officer found, a significant similarity and, in some cases, identity, between the respective goods (see decision, paras. [16]-[20]) and the case proceeded below and here on that basis. However, the nature of the goods plays some role in the first set of points.

Standard of review

9. Arnold J (as he then was) set out the principles applicable to an appeal of this kind in *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) (10 March 2017) based on *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14]-[52]. So far as relevant to this appeal, they are as follows:

    (i) 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.

    (ii) 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.

(iii) 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.

(iv) 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. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed.

Key aspects of the hearing officer's decision

10. The hearing officer set out the relevant law for evaluating similarity of marks and of goods and that relating to the likelihood of confusion and made findings as to similarity and identity of the goods which are not challenged on this appeal.

11. In so doing, the hearing officer considered the average consumer and the circumstances in which goods of the kind in question were likely to be encountered. Since this aspect of the case runs through the whole appeal it is worth setting out at the start. She said:

> "23. The average consumers in this case are the general public, businesses and tradespeople such as plumbers, bathrooms fitters etc. 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 in question (*Lloyd Schuhfabrik Meyer,* Case C-342/97 refers). Clearly the contested goods will vary in price, but such goods are a considered purchase when fitting out a bathroom even for items such as taps and mirrors when looking for a matching or coordinated finish and, in my view, average consumers will be paying a higher than normal degree of attention during the

purchasing process as these are not goods which are purchased frequently and consumers would need to consider a number of factors such as specifications and functionality as well as style. Consumers will be browsing goods in physical premises such as DIY retail stores or in specialist bathroom showrooms or using primarily visual means such as catalogues, brochures or their online equivalents. However I do not discount an aural factor such as a word of mouth recommendation or if consumers are seeking advice from a salesperson or bathroom fitter."

12. I set out later the other parts of the decision on similarity of the marks and likelihood of confusion.

Grounds of Appeal

13. Although they intersect to some degree, it is convenient to group the grounds of appeal under two broad heads, (i) evaluation of the characteristics of the average consumer and the attention given to the purchasing decision (ii) comparison of marks and likelihood of confusion.

I. Evaluation of the characteristics of the average consumer and the purchasing decision (Grounds of Appeal, esp. para. 9(a))

14. The first set of points focusses on the contention that the hearing officer was wrong to say that the goods in question were a "considered purchase implying a higher degree of attention." This point is made in Grounds of Appeal para. 9(a) and it is said to affect the evaluation of similarity and the likelihood of confusion. A number of points are made by the appellant under this head.

15. First, the appellant contends that there was no evidence on the issue and the hearing officer was not entitled to express the view that she did on it in para [23] of the decision since that was an improper exercise of a discretion to take judicial notice of the facts. Second, the applicant/respondent did not file any evidence on this issue and the appellant contends that it was therefore not in a position to counter any submission that these might be more considered purchases with evidence of its own that they were not. Third, it is said that unlike in *Lancer Trade Mark* [1987] RPC 103, there was no proper

basis in this case, given the nature of the goods in question for the hearing officer's approach to this issue and that the hearing officer's approach to evaluation was flawed.

(i) Judicial notice

16. The appellant/opponent recognises the high bar that must be overcome in overturning the exercise of a discretion to take judicial notice of a fact and refers to UKIPO Decisions O-165-160 and O-048-18.

17. I agree with the appellant that, in general, the standard for interfering with a discretionary decision to take judicial notice of a fact in this context is that it is "manifestly wrong". However, some case must be taken with that proposition since there may be cases (of which this is not one) in which an appellate tribunal can see that full evidence would have been far preferable on a given point to reach a properly grounded decision but in which the tribunal nonetheless took its own view, while describing what it has done as taking "judicial notice" of certain facts. In such cases, it might be said that the standard for appellate review of a decision may be somewhat lower than "manifestly wrong". The respondent, who has not been represented on this appeal, has not made any submissions on the point. I have not considered it appropriate in the circumstances of this case and given the other decisions I have reached, to review the authorities on judicial notice or its equivalents in this context. Assuming in the appellant's favour that the standard for review of the hearing officer's decision in this respect is lower and "manifestly" wrong, I am not persuaded that the hearing officer fell into any error at all in para [23], whether manifest or otherwise.

18. First, the opponent/appellant's submission does not reflect the law or practice under the Act.

19. The correct approach to evaluating the characteristics of the average consumer, including the freedom of a tribunal to reach a view without evidence is well known. It was summarised recently by Mellor J in *Lifestyle Equities CV & Anor v Royal County of Berkshire Polo Club Ltd & Ors (Rev1)* [2023] EWHC 1839 (Ch). The summary reflects long-standing principles, including those to which the hearing officer referred. Mellor J quoted two of the most relevant decisions on this issue as follows, which I cite in full since one is relevant for a point below as well (emphasis added):

57. Based on *Interflora Inc v Marks & Spencer* [2015] FSR 10 ('*Interflora*'), the Cs submitted that a likelihood of confusion exists if any significant number of people with the characteristics of the average consumers of the goods in issue is likely to be confused, citing this passage at [129]:

> '… in light of the foregoing discussion we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.'

58. I consider it is helpful to refer to a distillation of the points made by Kitchin LJ in the slightly later case of *Comic Enterprises*, where he drew together various points made in his earlier judgments in *Specsavers* and *Interflora*. The distillation is set out in Kerly (16th Edition, 2018 and 1st Supplement, 2020) at 3-006. I omit the first three points, because they correspond to paragraphs (a) to (c) cited above:

> '(4) **In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.**
>
> (5) The average consumer is a hypothetical person or, as he has been called, a legal construct; he is a person who has been created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market, and also to provide a

standard, defined in EU law, which national courts may then apply.

(6) The average consumer is not a statistical test. The national court must exercise its own judgment in accordance with the principle of proportionality and the principles explained by the Court of Justice to determine the perceptions of the average consumer in any given case in the light of all the circumstances. The test provides the court with a perspective from which to assess the particular question it has to decide.

(7) In a case involving ordinary goods and services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up its own mind about the particular issue it has to decide in the absence of evidence and using its own common sense and experience of the world. A judge may nevertheless decide that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting the court to come to a conclusion as to whether there is a likelihood of deception.

(8) The issue of a trade mark's distinctiveness is intimately tied to the scope of the protection to which it is entitled. So, in assessing an allegation of infringement under art.5(1)(b) of the Directive arising from the use of a similar sign, the court must **take into account the distinctiveness of the trade mark, and there will be a greater likelihood of confusion where the trade mark has a highly distinctive character either per se or as a result of the use which has been made of it.** It follows that the court must necessarily have regard to the impact of the accused sign on the proportion of consumers to whom the trade mark is particularly distinctive.

(9) If, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such

as to warrant the intervention of the court then it may properly find infringement.'

20. In my view, in para. [23] of the decision, the hearing officer was undertaking the exercise referred to in sub-para. (7) of para. [58] of Mellor J's judgment in the *Lifestyle Equities* case and derived from *Comic Enterprises*.

21. Given the nature of the goods, which are not specialist, she was well able to put herself in the position of the average consumer without requiring evidence (whether from consumers themselves or expert evidence and whether from applicant or opponent) about the context in which the goods and marks would be encountered and considered by the average consumer. This is the kind of case in which a hearing officer is as a matter of law entitled, indeed expected, to make such an evaluation without specific evidence.

(ii) Evidence

22. Second, I am unimpressed by the point made by the appellant that it was not able to file evidence on the characteristics of the circumstances of purchase. Such evidence could have been provided in principle, even if the respondent did not do so. However, in my view, I do not think that such evidence would have made any difference in this case.

(iii) Evaluation

23. Third, the hearing officer's evaluation was not that the goods in question were only bought after the highest level of attention. Her point was a more limited one namely that these were the kinds of goods that were relatively infrequently bought and often as part of a rebuilding, maintenance or refurbishment of property. They were not "everyday" goods, bought casually. The appellant refers to the fact that some of the goods in question may have a purchase price of just a few pounds (in the case of basin wastes/bath wastes) and that some bath tubs may be less than £100. However, the issue in evaluating the average consumers likely degree of attention is not only one of the price of the goods but the overall context in which such goods are likely to be purchased. The hearing officer referred to this and she was, in my view, entitled to take that into account.

24. It is also said by the appellant that consumers do not necessarily purchase matching or co-ordinated goods of the kind in issue and that products of different brands may be bought. That is doubtless true but it does not detract from the hearing officer's point that those looking for goods of this kind will normally be doing so as part of an activity in which the goods in question are likely to have to fit together with other products (functionally or aesthetically) which they may either have already or be considering buying.

25. Taken as a whole, the hearing officer's evaluation in para [23] of the decision was not only one she was entitled to make as a matter of law but, in my view, she was right. More specifically, she was right to say that a higher than normal degree of attention was to be expected, if "normal" connotes a more everyday level attention, applied to frequently bought household goods. In those circumstances, the question of the precise standard required for review of the decision in this respect does not arise.

26. I therefore do not accept the appellant/opponent's argument that the hearing officer applied the wrong test when she came to consider the question of similarity of the marks (see Grounds of Appeal para. 9(f)-(h) and (o)).

II. Approach to evaluation of similarity of marks and likelihood of confusion (Grounds of Appeal para. 9(b)-(o))

27. The second aspect of this appeal involves a more conventional challenge to the hearing officer's evaluation of the similarity of the respective marks and the likelihood of confusion. The opponent/appellant's main point is that, while the hearing officer set out the correct approach to evaluation of similarity and likelihood of confusion, she did not go on to apply it. The approach she set out and which is not questioned on this appeal is as follows (decision para. [24]):

> "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."

28. In view of the appellant's challenges to the decision, it is convenient to set out the key parts of it here. The hearing officer said:

"26. The marks to be compared are

Opponent's trade mark	Applicant's trade mark
LUCITE	Luci

27. The parties both have single word marks and the overall impression rests solely in those words. The title case presentation in the applicant's mark is not a consideration as the mark could be used in any case structure.

28. Taking first the visual comparison, the marks share the letters L-U-C-I and these are in the same order in both marks. These letters comprise the entirety of the applicant's mark and are the first four letters of the earlier mark. The opponent's mark is two letters longer and in its written submissions it contends that, "these letters, being at the end of the mark, are of less significance than the four letters at the beginning of the mark being LUCI".

29. There is case law [reference omitted] to support the view that the beginnings of words have more visual significance than the ends. Notwithstanding this, I must also be alert to the visual impact of the marks in full and their differences. The opponent's mark is noticeably longer, with the letters TE following the letters LUCI. This has no counterpoint in the application and creates a point of visual difference. Taking these factors into account I find there is a medium degree of visual similarity.

30. When making an aural comparison, the most likely pronunciation, in my view, of the applicant's mark will be LOO-SEE, probably as a result of its resemblance to the female forename "Lucy". Whereas the most likely pronunciation of the opponent's mark would be LOO-SITE. I find that the first syllable in both marks is pronounced identically and that the letter C in both marks will be a soft rather than

hard consonant. However, there is a noticeable difference to the ear when the marks are spoken, especially as the last syllable in the opponent's mark is a hard "t" sound which has an aural impact. Nevertheless, taking all factors into account I find there is a medium degree of aural similarity.

31. Finally looking at the conceptual comparison, the opponent submits that, "As both marks are made up of invented words with no obvious and direct meaning, it must be found that the respective marks are conceptually similar to a high degree".

32. The opponent has not made clear why it regards the marks as conceptually highly similar if they are both invented words. It is possible that some consumers may bring the female forename "Lucy" to mind if they encountered the applicant's mark's Luci, especially given its phonetic equivalence. They may also perceive that the opponent's mark has a similar construction to a mineral name. Where the consumer perceives a different conceptual picture from the marks then the marks are likely to be conceptually dissimilar. If consumers simply regard both marks as invented words then they should be considered as conceptually neutral.

Distinctiveness of the earlier mark

33. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. [Case law references omitted].

…

34. No evidence has been filed in these proceedings, so I have only the inherent distinctiveness position to consider. The earlier mark is an invented word which does not describe or allude to the goods. I find the earlier mark to be inherently highly distinctive.

Likelihood of confusion

35. There is no scientific formula to apply in determining whether there is a likelihood of confusion. 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods. In doing

so, I must be aware 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.

36. 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. [Case law references omitted].

…

39. So far in this decision I have found that the respective goods are identical in class 11 and highly similar in class 20. I also found that consumers are likely to pay a higher than normal degree of attention during a primarily visual purchasing process, although I did not discount an aural aspect to any purchase. The earlier mark was found to be highly distinctive. In addition, I found that the marks are visually and aurally similar to a medium degree and conceptually neutral if the marks are considered as invented words or conceptually dissimilar for the reasons I set out in paragraph 32.

40. In my view when there are visual and aural differences between a short mark and a longer mark such as is the case here, those differences will have a bigger proportional impact on the average consumer's perception. I also consider that the conceptually dissimilarity of the marks if consumers have any concept of the marks or the conceptual neutrality if they don't will pay a part as the marks are not conceptually similar. Taking this into account, I do not think it is likely that the average consumer will directly mistake one mark for the other.

41. Having considered and found against direct confusion, I will go on to consider indirect confusion. The letters 'Luci' which make up the application are the first four letters of the earlier mark, but those first four letters are simply part of a longer mark. They do not appear in the mark in a way which would lead the average consumer to see the marks as originating from the 'same stable'. Taking account of Mr Purvis's summation in *L.A. Sugar* above, there is nothing about the applied for mark which leads me to find that it could be taken as a brand extension of the earlier mark, nor do I find that an average consumer is likely to believe that the goods have come from the same undertakings given the higher degree of attention I have found consumers will pay during purchase. I find that the guidance given in *Duebros* is

more appropriate in this case, namely that an average consumer may merely associate the common element in the marks but would not confuse the two. As such I do not find a likelihood of indirect confusion."

The appellant's criticisms and the Grounds of Appeal

29. The opponent/appellant makes several criticisms of this analysis in the Grounds of Appeal.

30. First, the appellant submits (Grounds of Appeal, para. 9(c)) that, in the light of the finding that all of the goods in the respondent's specification in classes 11 and 20 were either identical or highly similar and in view of the fact that the marks were highly similar it is incomprehensible that the opposition failed. This overall submission is best returned to after dealing with the more specific points (see below).

31. Second, the appellant submits (Grounds of Appeal, para. 9(d)) that the hearing officer was wrong to say that LUCITE was "noticeably longer" than LUCI. I disagree. In my view, this is a significant difference which an average consumer would be likely to notice and that as the hearing officer said, this creates a point of visual difference. It had proper basis and is an evaluation which the hearing officer was entitled to make. It does not fall into the category of decisions which entitle this tribunal to interfere with it.

32. Third, the appellant submits (Grounds of Appeal, para 9(e)) that the hearing officer was wrong to dismiss the case law saying that the beginnings of words have more visual significance than the ends.

33. This proposition is commonly referred to and the hearing officer did but it is important to remember that it is not a proposition of law as such but merely an observation that it is often the case. There is no rigid rule which says that a tribunal evaluating two marks must, as a matter of law, give greater significance to the earlier part of a word mark than a later part in its overall decision. However, it may often be appropriate to do so. In my view, the hearing officer in this case was entitled to give weight, albeit not overriding significance, to the fact that the first four letters of the respective marks were the same. She said, correctly, that she had to be alert to the visual impact of the marks

in full and their differences. I do not think that she lost sight of this aspect of similarity. Indeed, in her discussion of indirect confusion she referred to it specifically (see decision, para. [41]). I therefore do not think that she either left this factor out of account or failed to give it appropriate significance. To the contrary, her evaluation of this aspect of similarity is one I would have shared.

34. Fourth, the appellant submits (Grounds of Appeal, para 9(f)) that the hearing officer was wrong to find that the marks had a medium degree of visual similarity.

35. Again, I do not agree. I have rejected the general point that the hearing officer was not entitled to base her evaluation on the fact that a relevant consumer would pay a higher degree of attention to the marks in view of the goods in question. However, to my mind, even leaving that point aside, the marks are similar only to a medium degree for the reasons given by the hearing officer. She was entitled to reach that conclusion.

36. Although there are noticeable similarities, there are noticeable differences, and the differences are such as to make it less likely that the average consumer would think that goods marked with the respective marks came from the same or related trade sources. I do not accept that the hearing officer ought to have found that the marks were highly similar visually. In saying that the marks had medium visual similarity, the hearing officer was drawing attention to the fact that, as is commonly the case, there were not only significant similarities, there were also significant differences.

37. In such cases, the tribunal has to assess (as she later did) whether the similarities pointing to a likelihood that the average consumer would think that the respectively marked goods came from the same or related trade source were outweighed by differences which would make it likely that the average consumer would not think that, notwithstanding the similarities, they did not. She did this both in examining direct and indirect confusion so her evaluation of similarity was fed into the ultimate decision in a reasonable way. Accordingly, I do not think that the hearing officer fell into error in this respect.

38. Fifth, the appellant submits (Grounds of Appeal, paras 9(g)-(h) that the hearing officer was wrong in her assessment of aural similarity because the first part of the marks is

LU- and they are two syllable marks. The appellant makes the same point I have rejected above on evaluation of the degree of attention. On this issue, I think that the hearing officer was entitled to take the view that she did. If pronounced correctly, the marks do not sound particularly similar, and I think it is likely that the average consumer would treat the word LUCI as pronounced like the more conventionally spelled female name. LUCITE sounds more chemical or scientific. In my view, that is so regardless of the degree of attention paid by the average consumer.

39. Sixth, the appellant submits (Grounds of Appeal, paras 9(i) and (m)) that the hearing officer's analysis of the conceptual similarity was flawed and that the marks should both have been treated as invented words.

40. While it is true that LUCITE would probably appear to the average consumer to be an invented word, equally the average consumer would be more likely to regard the sign LUCI as either being or evoking a common female name. To that extent, an average consumer would not think that the respective marks were conceptually related. Nor is there anything to point to a particular conceptual difference. What the hearing officer was getting at (correctly to my mind) was that, in so far as the average consumer considered that the respective marks had conceptual content, he or she would think it was different. But even assuming that the average consumer did not think that, the marks were only conceptually similar at the very abstract level of both being invented words with no conceptual similarity beyond that. I therefore think that the hearing officer was right to treat this as a neutral factor and do not think that the decision was contradictory. It was in accordance with the general approach to conceptual similarity in cases such as *Ruiz Picasso* which make it clear that for a conceptual message to be relevant it must have a clear and specific meaning and be capable of immediate grasp by the average consumer (see *Ruiz Picasso v OHIM* [2006] ETMR 29 and *C-328/18 P European Union Intellectual Property Office v Equivalenza Manufactory* at [74]).

41. Seventh, the appellant submits (Grounds of Appeal, para 9(j)) that the hearing officer should have given much greater weight to the fact that the LUCITE mark was, as she found, "highly distinctive". Again, it is important to remember that the mere fact that an earlier mark is highly distinctive does not automatically (as a matter of law) mean than a later mark will be more likely to be confusingly similar. As the principles in the

case law quoted above show, it is necessary to, "take into account" the distinctiveness of the trade mark, and there will be a "greater likelihood of confusion where the trade mark has a highly distinctive character". The reputation of an earlier mark is often a major factor and can lead to a greater likelihood of confusion. But that general approach is no substitute for a careful analysis of what the similarities and differences are and, in particular, the specific question of whether, given the significant reputation of an earlier mark, the differences between the respective marks as applied to the respective goods would lead the average consumer to think that they were not from the same trade source. Or, at any rate, not to think that they were.

42. The hearing officer conducted this analysis at paras [39]-[41]. Even though it was relatively brief, it was realistic. In essence she was saying that, despite the similarities and the distinctiveness of the earlier LUCITE mark, the differences between the marks were such that the average consumer would not consider that the goods respectively marked had the same or a related trade origin.

43. I have taken account of what she said about indirect confusion and her conclusion that an average consumer "may merely associate the common element in the marks but would not confuse the two." The boundary between association and confusion is not always a clean one. However, here the hearing officer was correctly drawing attention to the fact that, while an average consumer may recognise that there were similarities - and associate them in that sense - he or she would also recognise that, given the differences, those similarities were not such as to signal that goods marked with the respective signs came from the same or a related trade origin.

44. Eighth, the appellant submits (Grounds of Appeal, paras 9(m) and (n)) that the hearing officer contradicted herself on conceptual similarity or went back on her findings of similarity. I do not think she did, for reasons mainly already given. She was trying to reflect the fact that, if anything, analysis of conceptual similarity pointed away from a likelihood of confusion and to make the sensible point that when there are visual and aural differences between a short mark and a longer mark those differences will have a bigger proportional impact on the average consumer's perception. That approach was open to her in this case.

45. Finally, returning to the overall points, the appellant submits (Grounds of Appeal, paras 9(c), (k) and (o)), in essence, that this should have been a clear case for upholding the opposition based on the similarity or identity of the goods and the similarities in the respective marks as well as the reputation of the earlier mark.

46. I do not accept that argument. Apart from the fact that the evaluation the hearing officer was called upon to make was a multifactorial one which this tribunal will respect unless it is sufficiently clear that it was wrong, I do not consider that the hearing officer can properly be criticised for the decision she reached, and it is not incomprehensible. The respective marks are not particularly similar *taken as a whole*, even though there are similarities as to elements. I do not find the hearing officer's decision surprising and do not think that any additional evidence, even if it had been appropriate to file such, would have made a difference to that evaluation.

Overall conclusion

47. I have dealt with the Grounds of Appeal, in so far as they require addressing separately, by combining some points and distilling others. Stepping back from the detail, notwithstanding the skilful attempt to deconstruct the decision by the appellant's representatives, I consider that the hearing officer reached a reasonable decision and made no errors of a kind that would entitle this tribunal to reverse it, applying the principles relevant to appellate review set out above.

48. The appeal must therefore be dismissed.

Costs

49. The applicant was not represented, and costs incurred on this appeal are likely to have been minimal. Like the hearing officer below, I therefore make no order as to costs.

DANIEL ALEXANDER KC
APPOINTED PERSON
11 September 2023