O/0894/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3588277, 3712887 & 3713148
IN THE NAME OF NEXT RETAIL LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS:

NEXT GO

NEXTGO

IN CLASSES 16, 35 & 39

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NOS. 424613, 430087 & 430086
BY GO! EXPRESS & LOGISTICS (DEUTSCHLAND) GMBH

Background and pleadings

1. On 1 February 2021, Next Retail Limited ("the applicant") applied to register the trade mark **NEXT GO** in the UK, under number 3588277 ("the first contested mark"). Details of the application were published for opposition purposes on 2 April 2021. Registration is sought for the following services:

> Class 35: Management of online orders in the retail sector.
>
> Class 39: Transportation logistics; transportation, storage, warehousing, packaging, collection and delivery of goods; parcel tracking, forwarding, delivery and returns services; information and assistance in relation to the aforesaid services.

2. On 21 October 2021, the applicant applied to register the trade mark **NEXTGO** in the UK, under number 3712887 ("the second contested mark"). Details of the application were published for opposition purposes on 5 November 2021. Registration is sought for the following goods and services:

> Class 16: Bags and articles for packaging, wrapping and storage being of paper, cardboard or plastics; plastic sheets, films and bags for wrapping and packaging.
>
> Class 35: Management of online orders in the retail sector.
>
> Class 39: Transportation logistics; transportation, storage, warehousing, packaging, collection and delivery of goods; parcel tracking, forwarding, delivery and returns services; information and assistance in relation to the aforesaid services.

3. On 22 October 2021, the applicant applied to register the figurative trade mark shown below in the UK, under number 3713148 ("the third contested mark").

Details of the application were published on 3 December 2021. Registration is sought for an identical list of goods and services as the second contested mark.

4. GO! Express & Logistics (Deutschland) GmbH ("the opponent") opposes all three applications in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act").[1] The opponent relies upon its UK trade mark registration number 3256645, which consists of the following series of trade marks:

GO

5. For ease of reference, as the only differences between the three marks comprising the series are the use of a standardised typeface and colour, I shall refer to them in the singular (i.e. "the earlier mark"), unless it becomes necessary to distinguish between them.

6. The earlier mark was filed on 14 September 2017 and became registered on 6 April 2018. For the purposes of its claims, the opponent relies upon the following services for which the earlier mark is registered:

> Class 35: Business management and administration; arranging contracts for others; mail-order advertising; mail sorting, handling and receiving; business

[1] All three oppositions were also originally based upon section 5(3) of the Act. However, within its written submissions dated 15 August 2022, the opponent indicated that it no longer pursued the oppositions under this ground.

management, administration and consultancy in the field of transport and delivery.

Class 39: Transport excluding passenger transport; transport of goods, including postal consignments and express/courier consignments; packaging and storage of goods; delivery services; postal services; delivery of goods, parcels and letters and transport thereof using vehicles of all kinds; courier services of all kinds; armored-car transport, transport of valuables; provision of information, advisory and consultancy services in relation to the aforesaid services.

7. Given the respective filing dates, the opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. As it had not completed its registration process more than five years before the filing dates of the contested marks, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all the services identified, without having to demonstrate genuine use.

8. The opponent contends that the contested marks are similar to its earlier mark and that the parties' goods and services are identical or similar, giving rise to a likelihood of confusion, including the likelihood of association.

9. The applicant filed counterstatements, denying the grounds of opposition. Whilst it admits that the parties' specifications include the identical services *'transport and delivery of goods'* and *'parcel delivery'*, it disputes that the remaining goods and services are identical or similar. Moreover, it denies that the contested marks are similar to the earlier mark. Based upon these factors, notwithstanding its partial concession in respect of the parties' services, it disputes that there is a likelihood of confusion.

10. On 15 June 2022, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

11. Both parties filed evidence in these proceedings. A hearing was requested and held before me, by videoconference, on 28 June 2023. The opponent was represented by Joshua Marshall of counsel, instructed by J A Kemp LLP. The applicant was represented by Maxwell Keay of counsel, instructed by Marks & Clerk LLP.

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

Evidence and submissions

13. The opponent's evidence is given in the witness statement of Aaron Newell, dated 15 August 2022, and three accompanying exhibits (ABN1 to ABN3). Mr Newell is a Solicitor and Partner of J A Kemp LLP, the opponent's professional representatives. His evidence goes to the parties' use of their marks and perceived overlaps between goods in class 16 and services in class 39.

14. The opponent also filed written submissions during the evidence rounds.

15. The applicant's evidence came in the form of a witness statement of Ian Blackwell, dated 12 October 2022, and four accompanying exhibits (IB1 to IB4). Mr Blackwell is the Legal and Compliance Director of the applicant, a position he has held since July 2019. His evidence goes to the background and commercial activities of the applicant, as well as third-party use of the word 'GO'.

16. I have read all the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

Preliminary remarks

17. I note that, within its written submissions, the opponent referred to several prior decisions to support its position on a number of issues. While I note the excerpts

provided, it suffices to say that these decisions are not relevant to the present proceedings. It is well established that previous decisions, whether that be of this Tribunal or the EUIPO, are not binding on the Registrar. Each case must be assessed on its own merits and, as such, I do not consider it appropriate to derive my findings or conclusions from the decisions to which the opponent refers. For the avoidance of doubt, the determination of the opponent's claims must take into account the relevant factors, following an assessment of the papers before me.

18. In addition, I note that Mr Newell has provided evidence of what he considers to be the applicant's use, or intended use, of the contested marks.[2] Whilst this evidence is noted, it is worth pointing out at this juncture that the assessment I must undertake is a notional one; the provisions of the Act are not merely a reflection of what is happening in the market.[3] Moreover, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark might be used if it were registered.[4] As a result, even though the opponent has suggested the ways in which the contested marks will be used, my assessment must take into account only the contested marks (and their specifications) and any potential conflict with the earlier mark.

Decision

The law

19. Sections 5(2)(b) and 5A of the Act read as follows:

> "5(2) A trade mark shall not be registered if because -
>
> […]

[2] Witness statement of Aaron Newell, §§2-7; Exhibit ABN1
[3] *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41
[4] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97*, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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 and services

21. In *Canon,* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that all relevant factors relating to the goods or services themselves should be taken into account when assessing similarity between them. Those factors were said to include, *inter alia*, their nature, intended purpose, method of use and whether they are in competition or are complementary.

22. Furthermore, the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281 for assessing similarity between goods and services also include an assessment as to their users and the channels of trade.

23. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

24. In *Sky v Skykick* [2020] EWHC 990 (Ch), Arnold LJ set out the following summary of the correct approach to interpretation of terms:

"(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

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

The opponent's services	**The applicant's goods**[5] **and services**
Class 35: Business management and administration; arranging contracts for others; mail-order advertising; mail sorting, handling and receiving; business management, administration and consultancy in the field of transport and delivery. Class 39: Transport excluding passenger transport; transport of goods, including postal consignments and express/courier consignments; packaging and storage of goods; delivery services; postal services; delivery of goods, parcels and letters and transport thereof using vehicles of all	Class 16: Bags and articles for packaging, wrapping and storage being of paper, cardboard or plastics; plastic sheets, films and bags for wrapping and packaging. Class 35: Management of online orders in the retail sector. Class 39: Transportation logistics; transportation, storage, warehousing, packaging, collection and delivery of goods; parcel tracking, forwarding, delivery and returns services; information and assistance in relation to the aforesaid services.

[5] Whilst the specifications of all three contested marks include the services in classes 35 and 39, only those of the second and third contested marks include the goods in class 16.

kinds; courier services of all kinds; armored-car transport, transport of valuables; provision of information, advisory and consultancy services in relation to the aforesaid services.	

Class 16

26. At the hearing, Mr Marshall argued that the applied-for goods in this class are similar to the opponent's *'packaging and storage of goods'* and *'postal services; delivery of goods, parcels and letters'* on the basis that they are complementary. He contended that, as the opponent's services cannot be provided without the applicant's goods, they are indispensable (or at least highly important) to one another in such a way that the average consumer would think responsibility for them lies with the same undertaking. Mr Keay disagreed. He submitted that, although wrapping and packaging articles are used in the transportation and storage of goods, that is not sufficient for a finding of complementarity. Moreover, whilst he accepted the evidence that certain courier businesses also sell packaging products, he argued that it does not demonstrate what consumers generally think. On this basis, Mr Keay argued that there is no more than a low level of similarity between them.

27. Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services.[6] Goods and services may be regarded as complementary and, therefore, similar to a degree in circumstances where their nature and purpose are very different.[7] The correct test for deciding whether goods and services are complementary was established in *Boston Scientific Ltd v OHIM,* Case T-325/06, wherein 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

[6] *Kurt Hesse v OHIM*, Case C-50/15 P
[7] *Sanco SA v OHIM,* Case T-249/11

> may think that the responsibility for those goods lies with the same undertaking."

28. The purpose of examining whether there is a complementary relationship between the goods and services is to assess whether the relevant public are liable to believe that responsibility for them lies with the same undertaking or with economically connected undertakings. For this purpose, I bear in mind the following comments of Mr Daniel Alexander QC, sitting as the Appointed Person in *Sandra Amalia Mary Elliott v LRC Products Limited*, Case 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."

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."

29. Firstly, I agree with Mr Marshall that the packaging, wrapping and storage products in class 16 of the application are of the kind which are important, if not indispensable, to the operation of the opponent's packaging, storage and delivery services. It is undoubtedly common for goods to be packaged, stored or delivered in packaging. Goods cannot be packaged without materials to pack them in; packaging is also required to protect goods in transit or storage. For these reasons, I do not hesitate to find that the first part of the test for complementarity is satisfied. As for the second part of the test, Mr Newell has provided evidence that indicates several undertakings operating in the UK (such as, for example, DHL, FedEx, dpd and Royal Mail) provide packaging products in addition to their delivery services.[8] Whilst the evidence is not overly compelling in respect of the general position in trade, it confirms, rather than contradicts, my own impression of it. I do not doubt that, when confronted with a parcel in packaging bearing a mark which is the same as (or confusingly similar to) that of

[8] Exhibit ABN3

the undertaking delivering that parcel, the relevant public would naturally assume that the responsibility for the packaging rests with the same (or an economically connected) undertaking that is responsible for the delivery service. Taking all of the above into account, I conclude that there is a relatively strong degree of complementarity between the respective services. Balancing this against the absence of the other relevant factors outlined in *Canon* and *Treat*, I find that there is a medium degree of similarity between them, overall.

Class 35

30. At the hearing, Mr Marshall focused upon the opponent's *'mail sorting, handling and receiving'* and *'mail-order advertising'*. In respect of the former, he argued that part of the applicant's services will involve mailing the goods out, i.e. the opponent's services are a step in the process of the applicant's services. For Mr Keay's part, he submitted that these are very different services to those in class 35 of the application.

31. The applicant's *'management of online orders in the retail sector'* refers to a back-end process of capturing, tracking and fulfilling orders placed via online retail stores. When confined to its ordinary and natural meaning, it is my view that the opponent's *'mail sorting, handling and receiving'* does not cover the sending of any goods. As such, I do not accept the argument that the opponent's services are a step in the process of providing the applicant's services. Nevertheless, I agree with the opponent that the respective services are highly similar. This is because the applicant's services are likely to involve the handling of parcels and accepting/receiving returns. Therefore, there is an overlap in nature, intended purpose and method of use between the respective services. Moreover, they are likely to reach the market through shared trade channels and may be provided by the same undertakings. Users will also overlap.

Class 39

32. Within its counterstatements, the applicant conceded that the applied-for services *'transport and delivery of goods'* and *'parcel delivery'* were identical to those in class 39 of the earlier mark. The scope of the concession was widened at the hearing, wherein Mr Keay accepted that each of the applicant's class 39 services are identical

or highly similar to at least one of the opponent's class 39 services. I will, therefore, proceed on that basis.

The average consumer and the nature of the purchasing process

33. The average consumer is deemed to be reasonably well informed, 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.[9]

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

35. It is common ground that relevant consumers of the goods and services at issue in these proceedings will include members of the general public and business users. However, I agree with Mr Keay that some of the services, such as *'management of online orders in the retail sector'*, *'mail sorting, handling and receiving'*, *'transportation logistics'* and *'armoured-car transport, transport of valuables'*, are more likely to be purchased exclusively by business users. I acknowledge that the general public may use some of these services incidentally or indirectly, though, generally, the provision of these services is not directed towards them.

[9] *Lloyd Schuhfabrik Meyer,* Case C-342/97

36. In respect of the general public, the goods and services are likely to be occasional purchases for the purposes of, for example, sending or receiving a letter or parcel. Overall, they are relatively inexpensive purchases. For these consumers, the purchasing of the goods and services will not follow an overly considered thought process. However, it will not be merely casual, with the general public having regard to factors such as the quality and type of packaging, the speed, cost and range of delivery services offered, and the location and security of storage facilities. For these reasons, I find that the general public will demonstrate a medium level of attention during the purchasing process. The goods are likely to be purchased by the general public from retail outlets and post offices, or their online equivalents, after viewing information on shelves or on websites. The services are likely to be purchased directly from the provider, after viewing information in brochures or on the internet. In these circumstances visual considerations will dominate. However, I do not discount aural considerations entirely as it is possible that consumers may wish to discuss goods and services of this nature prior to making their selection.

37. As for businesses, the goods and services are likely to be more frequent purchases for the ongoing operation of, for example, a retail business. They may also be more expensive, since businesses may purchase larger quantities of goods or engage in commercial contracts for the provision of the services. In addition to the factors considered by the general public, these consumers will wish to ensure that they are choosing the right goods or services for the business; they will also be mindful of the potentially negative impact on their business of making an incorrect selection. I acknowledge that the attentiveness exhibited by these consumers is likely to vary considerably, depending on the product or service being purchased (for example, less in respect of inexpensive articles of packaging and much more in respect of transportation logistics and the transport of valuables). However, overall, I find that business users will demonstrate between a medium and high level of attention during the purchasing process. Businesses are likely to purchase the goods from commercial suppliers and the services direct from the provider after viewing information in brochures or on the internet. Visual considerations will dominate this process, though I do not discount that there may be an aural component in the form of word-of-mouth recommendations or discussions with sales representatives.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *WindsurfingChiemsee*, paragraph 51)."

39. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

40. At the hearing, Mr Keay submitted that, in the context of the class 39 services for which the earlier mark is registered, the word 'GO' would be immediately recognised

as referring to the movement or transportation of goods from one place to another. On this basis, he argued that the mark is strongly allusive of those services. He also added that the stylisation in the second and third marks of the opponent's series adds nothing to the distinctive character of those marks. For these reasons, Mr Keay contended that the earlier mark should be considered to have the minimal degree of distinctive character necessary to have achieved registration. In respect of services where the earlier mark is not strongly allusive, he submitted that, as the word 'GO' is still a very simple, ordinary English word, it has a below average degree of distinctive character.

41. Mr Marshall disagreed with Mr Keay's assessment of distinctive character. Whilst he accepted that 'GO' alludes to the idea of movement, he disputed that this meant that the earlier mark should only be afforded minimal distinctive character. He also submitted that some of the services relied upon do not relate to transport and, therefore, the mark would not be immediately recognised as referring to the movement or transportation of goods.

42. As referred to by Mr Keay at the hearing, Mr Blackwell introduced evidence of third-party use of the word 'GO' in the context of delivery/courier services.[10] It is argued that this evidence demonstrates that businesses in the relevant market use the word in a strongly allusive sense. Firstly, the only dates present on the printouts relating to 'Go Service Solutions', 'Go Couriers' and 'Collect 2 Go' are in February 2022. Bearing in mind the latest relevant date in these proceedings is 1 February 2021, they do not assist the applicant. Secondly, there is nothing in the printouts relating to 'goPuff' or 'Go Logistics' which indicates that the websites are directed at UK consumers, or whether those businesses trade in this territory. The former features prices in US dollars, whereas the latter is a '.net' website with no specific reference to the UK. Therefore, they do not assist the applicant either. The remainder of the printouts predate the relevant dates and appear to relate to the UK. They show the existence of websites bearing the marks 'Go Deliver UK', 'GOfers', 'Go Delivery', 'Parcel2Go' and 'GoGetters'. Nevertheless, this is not evidence of the word 'GO' solus; the word forms part of composite marks. Moreover, there is no clear indication that these undertakings are using the word 'GO' in an allusive sense and this has not been adequately

[10] Exhibit IB3

explained; in my view, the word is being used (with additional elements) in a trade mark sense. In any event, in the circumstances I do not accept that the plurality of similar names by which individual undertakings are known, even in the same sector, can support the contention that the word 'GO' lacks distinctive character. Such an argument is reminiscent of *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch), in which Floyd J stated:

> "29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c)."

43. The earlier mark comprises a series of three trade marks. The first is in word-only format and consists of the word 'GO' with no other elements. The second and third marks are presented in a standard font, the former in maroon and the latter in black. I agree with Mr Keay that neither the font nor the colours used impact on the distinctive character of the marks in the series. Accordingly, I will treat all three marks in the series as the word 'GO' for this assessment.

44. The word 'GO' has a number of meanings, such as to travel or move and to leave. In the context of the transport and delivery services, I agree with Mr Keay that the mark is allusive of their nature and intended purpose. This message is clear from the ordinary meaning of the word. I would not go so far as to say that it must be treated as only being distinctive enough to have achieved registration. However, I find that the earlier mark possesses a low level of inherent distinctive character in the context of delivery and transport services. In relation to the other services relied upon, the allusive message is not immediately perceptible and is much less direct. Nevertheless,

the word ‘GO’ is still a common, ordinary word. As such, I find that the earlier mark has between a low and medium level of inherent distinctive character for such services.

45. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, this has not been pleaded by the opponent. Even if it had been, the evidence of the earlier mark in use – comprising printouts of the opponent’s website for Austrian audiences and a brochure which does not refer to the UK – does not demonstrate that the earlier mark was used in the UK prior to the relevant dates at all.[11] Therefore, for the avoidance of doubt, the evidence before me does not support a finding that the inherent distinctiveness of the earlier mark had been enhanced at the relevant dates.

Comparison of marks

46. It is clear from *Sabel* 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 *Bimbo* 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.”

47. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks;

[11] Exhibit ABN2

due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

48. The competing marks are as follows:

<table>
<tr><th>The earlier mark</th><th>The first contested mark</th></tr>
<tr><td rowspan="6">GO

GO

GO</td><td>NEXT GO</td></tr>
<tr><td>The second contested mark</td></tr>
<tr><td>NEXTGO</td></tr>
<tr><td>The third contested mark</td></tr>
<tr><td>NEXTGO</td></tr>
</table>

Overall impressions

49. The first mark in the opponent's series is in word-only format and consists of the word 'GO'. As there are no other elements, the overall impression of the mark lies in the word itself. The second and third marks in the opponent's series are figurative marks and comprise the word 'GO', presented in a standard font. The former appears in maroon, whereas the latter appears in black. The particular font used is unremarkable and is likely to go unnoticed by consumers; the marks essentially present as plain words. The colours used are likely to be perceived as decorative. As such, the overall impression of the second and third marks in the series overwhelmingly rests in the word 'GO', with the font and colours used playing a minimal (if any) role.

50. The first contested mark is in word-only format and consists of the words 'NEXT GO'. Both words co-dominate the overall impression of the mark. However, the word 'NEXT' has slightly more impact as it appears at the beginning of the mark.[12]

51. The second contested mark is a word-only mark and comprises the word 'NEXTGO'. Although the mark presents as a singular word, the words 'NEXT' and 'GO' are instantly recognisable and will be immediately identified by consumers, i.e. the mark will be perceived as 'NEXT GO'. As a consequence, my findings at paragraph 50 are equally applicable here.

52. The third contested mark is figurative and consists of the words 'NEXTGO' in an unremarkable font. For the same reasons given at paragraph 51, it is my view that the verbal element will be perceived as the words 'NEXT GO'. The words are presented in different shades of blue, which assists with the separation of the words. The top of the letter 'G' forms an arrow device. It is my view that the words are overwhelmingly dominant in the overall impression of the mark. Of the two, the word 'NEXT' has slightly more impact than the word 'GO' because it appears at the beginning of the mark. The relative size and position of the arrow device means that it plays a much lesser role in the overall impression. The font and colours used play a minimal (if any) role.

Visual comparison

The first and second contested marks and the earlier mark

53. Visually, the marks coincide insofar as the earlier mark is identically reproduced within the contested marks. They differ in that the contested marks include the additional word 'NEXT' at their beginnings. Bearing in mind my assessment of the overall impressions, I find that there is, at most, a medium degree of visual similarity between the competing marks.

[12] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

The third contested mark and the earlier mark

54. These marks share the same similarities and differences as those described at paragraph 53 above. However, these marks have an additional difference in that the third contested mark contains an arrow device which has no counterpart in the earlier mark. Moreover, whilst it plays a minimal role in the overall impression, it is my view that the use of two shades of blue would not be covered by normal and fair use of a word-only mark. Overall, I find that the competing marks are visually similar to between a low and medium degree.

Aural comparison

55. The words 'NEXT GO' will be identified in all three contested marks and will be pronounced in the ordinary way. None of the figurative elements will be articulated. Therefore, the competing marks aurally coincide in the shared syllable 'GO' but differ in the additional first syllable 'NEXT' in the contested marks. Bearing in mind my assessment of the overall impressions, I find that the competing marks are aurally similar to a medium degree.

Conceptual comparison

56. As noted above, the word 'GO' will be understood as meaning to travel, move or leave. The earlier mark, comprising only this word, will therefore covey this concept to consumers. In the context of transport and delivery services, it will be understood as alluding to their nature and intended purpose.

57. As for the contested mark, Mr Keay submitted at the hearing that the word 'NEXT' will be understood as referring to the applicant's well-known retail business, whereas the word 'GO' will be understood as referring to the provision of goods or services on the go. In combination, it was his position that the contested marks will be perceived as one of the applicant's sub-brands.

58. It is important to point out that reputation and conceptual meaning are not the same thing. Reputation, in a trade mark sense, concerns the factual extent to which a sign

is recognised by a significant part of the public as a trade mark, whereas conceptual meaning is a level of immediately perceptible notoriety or independent meaning, outside of a purely trade mark context.[13] Although there are cases where an extensive reputation has transferred into conceptual meaning, these are the exception rather than the rule and depend on their own facts.[14] Exceptional cases where trade mark reputation evolves into a conceptual meaning need to be properly proven.

59. Mr Blackwell gives evidence that the applicant is a predominantly UK-based retailer which has been providing delivery services in respect of its own branded goods, as well as third-party goods sold through its retail channels, for many years.[15] It first adopted the trade mark 'NEXT' in 1982 in the UK and has since registered many trade marks in the UK and abroad.[16] Mr Blackwell says that 'NEXT' has been used in relation to a wide range of goods; in offering these goods for sale, the applicant is said to have provided retail services and delivery services.[17] Extracts from the applicant's website and from mail-order catalogues have been provided,[18] which show a range of clothing, footwear, bags and accessories offered for sale prior to the relevant dates.

60. Firstly, the mere existence of other registered rights containing the word 'NEXT' does not demonstrate that the applicant has a reputation or that such a reputation had evolved into a conceptual meaning. Secondly, the evidence is very limited in this case. For instance, no details have been provided by the applicant to indicate the size of the relevant market or its share of the same. No turnover information has been provided and there is no evidence of any business conducted in connection with the 'NEXT' mark, such as, for example, invoices or order confirmations. No information regarding the amounts invested in promoting the 'NEXT' mark has been provided and there is no evidence of any such activities taking place. Furthermore, I do not consider the combination of Mr Blackwell's general narrative evidence, printouts from the applicant's website and example mail-order catalogues to be sufficiently solid or

[13] *Retail Royalty Company v Harringtons Clothing Limited,* Case BL O/593/20, paragraphs 74-75
[14] *Retail Royalty Company,* paragraph 76
See, for example, Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini* and *J.M.-E.V. e hijos v Messi Cuccittini*
[15] Witness statement of Ian Blackwell, §§3 and 5
[16] Blackwell, §6; Exhibit IB1
[17] Blackwell, §7
[18] Exhibit IB2

specific to show that the word 'NEXT' refers to the applicant's business outside of a purely trade mark context. I note that an annual report and accounts document for the applicant's business for the year ending January 2022 has been provided by the opponent.[19] This shows that the applicant's total sales were £4.9billion that year, from which a pre-tax profit of £823million was recorded. These are clearly significant sums. However, these are global figures which appear to predominantly relate to the applicant's retail business. Therefore, this evidence could only go to whether the applicant has a reputation in the retail sector (which Mr Marshall appeared to accept at the hearing); it is not relevant to any of the goods or services at issue in these proceedings. As a result, it does not assist in establishing that it had a reputation in the relevant goods and services, or that such a reputation had evolved into a conceptual meaning for relevant consumers. I should add that, although the document refers to the applicant's warehousing, logistics and distribution offering (which was launched in October 2020 and generated a profit of £2.1million for the applicant in the year ending January 2022), this is provided under an entirely different mark, 'Total Platform'. As such, it does not assist in assessing how relevant consumers would perceive the word 'NEXT'. Taking all of this into account, it is my view that the evidence filed in these proceedings does not establish that the alleged reputation in 'NEXT' had evolved into a conceptual meaning.

61. Given this finding, I also reject Mr Keay's argument that the words 'NEXT GO' will be perceived as one of the applicant's sub-brands, notwithstanding Mr Blackwell's evidence of other divisions of the applicant operating under names consisting of 'NEXT' followed by descriptive/secondary terms (such as 'NEXT RETAIL', 'NEXT BEAUTY', 'NEXT ACTIVE' and 'NEXT SIGNATURE').[20] If the word 'NEXT' does not immediately evoke the concept of the applicant's business, I fail to see how the words 'NEXT GO' will be understood as referring to one of its sub-brands.

62. I now turn to the applicant's position regarding the meaning of 'GO' in the contested mark. Mr Keay argued that this word is frequently attached as a suffix to a primary brand to connote goods or services that are provided on the go. Mr Blackwell provided

[19] Exhibit ABN1
[20] Blackwell, §§8-10; Exhibit IB2

evidence of third parties using the word ‘GO’ which, the applicant says, supports this contention.[21] From this evidence, it appears that several undertakings were using the word ‘GO’ prior to relevant dates. Indeed, some of the examples provided appear to be in the context of goods and services which are used ‘on the go’. For example, on 4 August 2021, Lidl was reported to be set to launch scan-as-you-shop technology named ‘Lidl Go’. Moreover, on 4 September 2021, it was rumoured that Aldi would follow suit with its own scan-as-you-shop system called ‘Aldi Go’. There is also evidence of mobile phone applications which use the word, such as ‘ASDA Scan & Go’, ‘Pokémon GO’, which, by their nature can be said to be used ‘on the go’.

63. However, it is my view that, within the examples provided, the word ‘GO’ is being used as a secondary element to words which clearly act as standalone indicators of origin. In addition, the separation between the different verbal elements is clear. On the other hand, the contested mark features the word ‘GO’ preceded by a very common dictionary word. When viewed together, they make grammatical sense and, as a result, consumers are not likely to view the words ‘NEXT’ and ‘GO’ as seemingly unconnected, individual elements (which I say more about below). In these circumstances, I consider it highly unlikely that consumers will immediately understand the word ‘GO’ in the manner argued by Mr Keay.

64. In any event, none of the evidenced marks containing ‘GO’ have been used in relation to the goods and services at issue in these proceedings. Although Mr Keay downplayed the importance of this at the hearing, the assessment as to whether there is a likelihood of confusion must, as the case law stipulates, be conducted through the eyes of the average consumer of the goods or services in question. As no examples have been provided of a naming convention involving the suffix ‘GO’ in relation to the relevant goods and services, there is no basis upon which to conclude that relevant consumers have become accustomed to perceiving ‘GO’ as a reference to the notion of ‘on the go’ or will immediately understand it in this way. For the avoidance of doubt, it is my view that the evidence falls a long way short of establishing that consumers of any and all goods and services would understand ‘GO’ as meaning ‘on the go’.

[21] Exhibit IB4

65. The words ‘NEXT’ and ‘GO’ are common words in the English language which will be readily understood by relevant consumers. Due to the composition of the mark and the two words forming a grammatically correct phrase, it is my view that the words will be seen as a unit. In combination, they convey the concept of the attempt or turn immediately after the present one. Even if it is noticed by consumers, the arrow device in the third contested mark does not impact upon the conceptual identity of the mark as it serves to reinforce the meaning of the words.

66. Whilst I accept that the competing marks all contain the word ‘GO’, it is used in different contexts; the word has a different meaning when used on its own in the earlier mark to when it follows the word ‘NEXT’ in the contested marks. For this reason, I find that the competing marks are conceptually dissimilar.

Likelihood of confusion

67. 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. One such factor 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. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

68. 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 and services down to the responsible undertakings being the same or related.

69. Earlier in this decision, I concluded that:

- The goods in class 16 of the second and third contested marks are similar to the opponent's services to a medium degree;

- The applicant's services in classes 35 and 39 are identical or highly similar to those of the earlier mark;

- Relevant consumers of the goods and services will include the general public and business users;

- The general public will demonstrate a medium level of attention during the purchasing process, whilst business users will exhibit between a medium and high level of attentiveness;

- The purchasing process will be predominantly visual in nature, though aural considerations have not been discounted;

- The earlier mark possesses a low level of inherent distinctive character in relation to services in the field of transport and delivery and between a low and medium level in relation to other services;

- The words 'NEXT GO' co-dominate the overall impression of the first and second contested marks, the word 'NEXT' having slightly more impact;

- The words 'NEXT GO' co-dominate the overall impression of the third earlier mark, the word 'NEXT' having slightly more impact, while the figurative elements play lesser roles;

- The overall impression of the earlier mark is dominated by the word 'GO';

- The first and second contested marks are visually similar to the earlier mark to a medium degree, whereas the third contested mark is visually similar to the earlier mark to between a low and medium degree;

- The competing marks are aurally similar to a medium degree;

- The competing marks are conceptually dissimilar.

70. Within his skeleton argument, Mr Marshall provided the following arguments in support of the opponent's position that there is a likelihood of direct confusion:

> "[…] given that the mark NEXT GO could be interpreted to mean: (1) the subsequent iteration of the Opponent i.e. the new GO, the revised GO or the next GO; or (2) that GO is the entity providing the next step in the delivery supply chain i.e. next up, it's GO, it is highly likely that consumers will confuse those goods and/or services offered under the marks sought in the Applications as being those offered under the Earlier Mark by the Opponent. Alternatively, given the independent distinctive significance of the word GO in NEXT GO, it is highly likely consumers will think the goods and services offered under the NEXT GO mark originate from economically linked undertakings."

71. None of the above is predicated upon consumers mistaking the contested marks for the earlier mark. Rather, these arguments strike me as reasons why the opponent believes an economic link will be made between the parties on the basis of the competing marks. As such, I will consider them below when I come on to discuss indirect confusion.

72. I acknowledge that the competing marks coincide in the shared use of the word 'GO', the only (distinctive) element of the earlier mark. Nevertheless, there are differences between the marks which are not negligible. The contested marks all contain the word 'NEXT', which co-dominates their overall impressions but has no counterpart in the earlier mark. This difference appears at the beginning of the marks, a position which tends to have most impact. The additional word also renders the

contested marks greater in length. Despite there being no special test for 'short' marks, the earlier mark comprises only two characters and, therefore, the addition of four extra characters has a greater impact and is more likely to be noticed by relevant consumers.[22] Moreover, where the meaning of at least one of the marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those marks may counteract the visual and phonetic similarities between them.[23] Although I accept that conceptual differences do not always overcome visual and aural similarities, I certainly consider that to be the case here. Whilst the competing marks share visual and aural similarities arising from shared use of the word 'GO', they are conceptually dissimilar. Each mark conveys a meaning not replicated by the other. Taking all the above factors into account, as well as the relatively low level of distinctiveness of the earlier mark, it is my view that the aforementioned differences between the competing marks are likely to be sufficient for consumers – even when paying no more than a medium level of attention during the purchasing process – to distinguish between them and avoid mistaking one for the other. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even where the services are identical.

73. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting 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,

[22] *Robert Bosch GmbH v Bosco Brands UK Limited*, Case BL O/301/20, paragraph 38; Case T-274/09 *Deutsche Bahn v OHIM*, paragraph 78; Case T-304/10 *dm-drogerie markt v OHIM*, paragraph 42
[23] *The Picasso Estate v OHIM*, Case C-361/04 P, paragraph 20

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).”

74. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.[24] I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[25] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.[26]

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[24] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[25] *Duebros Limited v Heirler Cenovis GmbH,* Case BL O/547/17
[26] *Liverpool Gin Distillery*

75. Having regard to all the above principles, I do not believe that consumers, having noticed the differences between the competing marks, will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that consumers would assume a commercial association or licencing arrangement between the parties, or sponsorship on the part of the opponent, merely because of the shared word 'GO'. The earlier mark is not so strikingly distinctive that consumers would assume that only the opponent would be using it in a trade mark. On the contrary, I have found that it has, at most, between a low and medium level of distinctive character. Moreover, the differences between the competing marks are not simply adding or removing non-distinctive elements. Nor are the differences consistent with any logical brand extensions with which consumers may be familiar. I can see no reason why an undertaking would add the word 'NEXT' to the word 'GO', resulting in a trade mark with a different meaning.

76. I am also not persuaded by the opponent's arguments on the ways in which indirect confusion could arise. Firstly, the rationale that the contested marks would be seen as a subsequent iteration of the opponent presupposes that relevant consumers would, upon encountering the word 'GO', immediately perceive it to be a reference to the opponent's company. I have already outlined that exceptional cases where trade mark reputation evolves into a conceptual meaning need to be properly proven. The opponent's evidence of use in this case falls a long way short for this purpose. Moreover, I find the argument that the contested mark will be perceived as an indication that 'GO' is the entity providing the next step in the delivery supply chain to be contrived. There is no evidence that consumers in the relevant field would be accustomed to such a branding exercise, and it appears to be predicated on use in a conversational, rather than in a trade mark, context. In any event, I consider it highly unlikely that consumers would overlook the meaning of the grammatically correct combination 'NEXT GO' and, instead, immediately understand it to mean 'NEXT [up, it's] GO'. Whilst indirect confusion is not limited to the categories outlined in *L.A. Sugar*, to my mind, there is no other basis for concluding that consumers would assume an economic connection between the parties, even when consumers are paying no more than a medium level of attention.

77. On the topic of indirect confusion, Mr Marshall also referred me to *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH ("Medion")*, Case C-120/04 and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another ("Whyte and Mackay")* [2015] EWHC 1271 (Ch). He argued that, given the independent distinctive significance of the word 'GO' in the contested marks, it is likely that consumers will think the goods and services offered under the competing marks originate from economically linked undertakings or that there has been a co-branding exercise between the parties.

78. In *Whyte and Mackay*, Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion.* The judge said:

> "18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite

mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

79. In *Annco, Inc. V OHIM,* Case T-385/09, the GC found that:

"48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49. Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50. Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is

higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

80. It is clear from the authorities that the principle derived from *Medion* can only apply in situations where consumers would perceive the relevant part of the composite mark to have distinctive significance independently of the whole; it does not apply where consumers would perceive the composite mark as a unit with a different meaning to the meanings of the individual elements. In this case, I have found that the words 'NEXT GO' in the contested marks combine to form a unit with a combined meaning which is different to the meanings of the individual words in isolation. The word 'GO' in the contested marks does not have independent distinctive character and I consider it highly unlikely that consumers would see the contested marks as consisting of more than one sign. Therefore, this line of argument does not assist the opponent and I reject it.

81. In light of all the above, I do not consider there to be a likelihood of indirect confusion between the competing marks, even in relation to services that are identical.

Conclusion

82. The oppositions under section 5(2)(b) of the Act have failed. Subject to any appeal against my decision, the contested marks will become registered in the UK.

Costs

83. As the applicant has been successful, it is entitled to a contribution towards its costs. At the hearing, Messrs Marshall and Keay agreed that such an award should be made in accordance with the scale. These proceedings were commenced after 1 July 2016 but before 1 February 2023, meaning that the appropriate scale is that published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£2,000**, which has been calculated as follows:

Considering the opponent's statements and preparing counterstatements[27]	£700
Considering the opponent's evidence and preparing evidence	£600
Preparing for and attending a hearing	£700
Total	**£2,000**

84. I order GO! Express & Logistics (Deutschland) GmbH to pay Next Retail Limited the sum of **£2,000**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 19th day of September 2023

James Hopkins
For the Registrar

[27] The award for this activity reflects a contribution towards the cost of considering three notices of opposition and preparing three counterstatements.