BL O/0910/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3558934
BY MYMALL EUROPE LIMITED
TO REGISTER THE TRADE MARK:

IV PATCH

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427308
BY IV BOOST UK LIMITED

Background and pleadings

1. On 22 November 2020, Mymall Europe Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 2 July 2021. The goods applied for are as follows:

> Class 5: Acne medications; Acne treatment preparations; Adhesive films for medical use; Adhesive patches for medical purposes; Adhesive plaster; Adhesive skin patches for medical use; Mineral nutritional supplements; Nutraceutical preparations for therapeutic or medical purposes; Nutraceuticals for therapeutic purposes; Nutraceuticals for use as a dietary supplement; Nutritional supplement energy bars; Nutritional supplements; Nutritional supplements consisting primarily of calcium; Nutritional supplements consisting primarily of iron; Nutritional supplements consisting primarily of magnesium; Nutritional supplements consisting primarily of zinc; Nutritive substances for microorganisms; Vitamin A preparations; Vitamin and mineral food supplements; Vitamin and mineral preparations; Vitamin and mineral supplements; Vitamin B preparations; Vitamin C preparations; Vitamin D preparations; Vitamin drops; Vitamin preparations; Vitamin supplement patches; Vitamin supplements.

2. The application was opposed on 4 October 2021 by IV Boost UK Limited (the opponent). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

UK3232161

IV BOOST

Filing date: 18 May 2017
Registration date: 18 August 2017

Relying upon the following goods:

Class 5: Pharmaceuticals, medical preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical use, including suppositories and preparations in the nature of vitamins, antioxidant nutrients, amino acid nutrients and anti-ageing products.

3. The opponent claims that the marks both contain the identical two letters at the beginning of the mark as a separate element and that the term 'PATCH' in the applicant's mark is descriptive of the goods. They argue that this results in an extremely high degree of similarity. They also claim that the goods and services at issue are identical or similar.

4. The applicant filed a counterstatement in which they denied the opponent's grounds and said the marks and goods and services are dissimilar.

5. Both parties filed evidence. A hearing was held before me on 19 July 2023. The applicant was represented by Mr Aaron Wood of Brandsmith's instructed by Glenville Walker and Partners and the opponent was represented by Dr Michael Spencer of Bromhead Johnson LLP. I make this decision having taken full account of all the papers, referring to them below as necessary.

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

Evidence

7. The opponent's evidence in chief consists of a witness statement from Joshua Lionel Berkowitz dated 23 August 2022. Mr Berkowitz is the Medical Director of IV Boost UK Limited. The witness statement was accompanied by seven exhibits (JLB1-JLB7). In the hearing, Dr. Spencer confirmed that the purpose of this evidence was to assist with understanding the business and goods concerned. The evidence in

response consists of a further witness statement from Mr Berkowitz dated 28 March 2023 together with one further exhibit. There is also a witness statement from Dr Michael Spencer dated 28 March 2023.

8. The applicant's evidence consists of a witness statement from Ismail Bahadur dated 5 December 2022 together with seven exhibits. Mr Bahadur is the Managing Director of Mymall Europe Ltd. I consider that the evidence does not assist the applicant as it references the goods and services that feature on the opponent's website and their own however, I must compare the marks and their specifications as registered and as per the details of the Form TM7. The earlier mark is not subject to proof of use, as I will detail later in this decision and therefore, the opponent can rely upon their mark as it is registered. It also includes state of the register evidence without any information regarding the use of the marks on the market. At the hearing, Mr Wood did not rely on this state of the register evidence.

9. The applicant submitted further evidence alongside their skeleton arguments just prior to the hearing. The evidence being introduced was information from Companies House showing that the opponent was a dormant company. Following consideration of the principles set out in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) I refused to admit the late evidence as I did not consider it to be material to the case (as the opponent was not required to prove use of their mark) and this information is also publicly available, and was available at the time of the evidence rounds and there is therefore no good reason why it was not filed sooner.

DECISION

10. Section 5(2)(b) is being relied upon and is as follows:

> "5(2) 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".

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6. (1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered".

12. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Case law

13. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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

14. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

17. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. In the applicant's skeleton argument and at the hearing, Mr Wood confirmed that the applicant accepted that there was identity or similarity between the goods. As the applicant did not specify what level of similarity applied for each good, I am still required to undertake an assessment of goods but, as the applicant conceded similarity, I shall keep this relatively brief.

Applicant's goods	Opponent's goods	Level of similarity
Acne medications; acne treatment preparations	Pharmaceuticals, medical preparations	Identical using the *Meric* principles.
Adhesive films for medical use; Adhesive patches for medical purposes; Adhesive plaster; Adhesive skin patches for medical use;	Sanitary preparations for medical purposes	I accept the applicant's submissions that 'preparations' means substances or a mixture thereof. I find these goods to be similar to a medium degree - they will share a purpose and user, and may overlap trade channels but have differing natures and are not in competition or complementary.
Mineral nutritional supplements; Nutraceutical preparations for therapeutic or medical purposes; Nutraceuticals for therapeutic purposes; Nutraceuticals for use as a dietary supplement; Nutritional supplement energy bars; Nutritional supplements; Nutritional supplements consisting primarily of calcium; Nutritional supplements consisting primarily of	dietetic food and substances adapted for medical use, including suppositories and preparations in the nature of vitamins, antioxidant nutrients, amino acid nutrients and anti-ageing products	Identical using the *Meric* principles.

iron; Nutritional supplements consisting primarily of magnesium; Nutritional supplements consisting primarily of zinc; Nutritive substances for microorganisms; Vitamin A preparations; Vitamin and mineral food supplements; Vitamin and mineral preparations; Vitamin and mineral supplements; Vitamin B preparations; Vitamin C preparations; Vitamin D preparations; Vitamin drops; Vitamin preparations; Vitamin supplement patches; Vitamin supplements.		

Average consumer and the purchasing act

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

20. 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. (as he then was) 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

21. I find that the goods at issue are all medical or health related goods and therefore, the average consumer could be either a medical professional or members of the public. In either case, both sets of consumers can be said to be paying a higher than normal degree of attention in the selection of those goods, save for perhaps 'adhesive plasters or adhesive films from the applicant's specification which will attract a normal degree of attention.

22. The selection process is likely to predominantly involve a visual aspect when looking for products in a retail setting or perusing a specialist catalogue or website. There may also be advertisements or presentations of the goods that the consumer will be exposed to. I do not however, discount that there may also be an aural component to the purchase through word-of-mouth recommendations or orders which may be placed by telephone.

Comparison of the marks

23. 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."

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

25. The parties respective marks are shown below:

Earlier mark	**Contested mark**
IV BOOST	IV PATCH

26. Both marks begin with the initialism 'IV' followed by a five-letter word. The parties appear to agree that 'IV' means intravenous and would be understood as such by the average consumer. In the hearing, Mr Wood stated this meaning and said "it is in Mr Berkowitz's witness statement. It is in the evidence. It is in Mr Spencer's written statement". I understand that an IV is a way of delivering fluids into the body- which could include medications, nutrients and other supplements. Therefore, I consider that it could be descriptive of the delivery of some of the goods or at least allusive to their medical nature. The second element of the earlier mark, 'BOOST' could be alluding to the effects of the IV (as I will explain further later). As I consider both elements of the earlier mark to be allusive/descriptive of the goods at issue, I find that neither element is particularly distinctive or dominant and therefore, I consider the overall impression lies in the combination of the two elements. The opponent submitted that 'IV' would be

the most important part of the mark as it is at the beginning however, in *CureVac GmbH v OHIM,* T-80/08 the GC held that whilst it was true that the consumer normally attaches more importance to the first part of the mark, descriptive or weakly distinctive elements will generally not be considered to be a distinctive or dominant element.[1]

27. I believe the same logic applies to the contested mark, both elements are descriptive when separate however, they are somewhat conflicting when put together and therefore, I find the distinctiveness lies in the combination of the two words.

28. Visually both marks begin with the initials 'IV' and are followed by five letter words, 'BOOST' and 'PATCH' respectively. The only letter that is found in both of the five letter words is 'T' and that is placed differently in each word (last in the earlier mark and third in the contested mark). I therefore find these marks to be similar to no more than a medium degree.

29. Next, I will consider the aural comparison. The beginning of both marks will be identical with the average consumer likely saying the letters 'I' and 'V' as, in my opinion, this is a well-known medical initialism. The words 'BOOST' and 'PATCH' will be given their ordinary everyday pronunciations and, in my mind, they do not share any aural similarities. I therefore find the marks to be aurally similar to no more than a medium degree.

30. Conceptually, as I have alluded to above, I consider the term 'IV' to be a fairly recognisably medical term. The average consumer is likely to understand it is an initialism for 'intravenous', or even if they do not know exactly what it stands for, they will understand it still to reference medical terminology - this is something that the opponent has confirmed as their understanding also within the second witness statement of Mr Berkowitz. 'BOOST' will be given its ordinary dictionary definition, that is, to increase, improve, or be more successful.[2] When read together, I believe the average consumer will read 'IV BOOST' to mean a type of IV or medical item that is intended to improve or help something along. 'PATCH' will likely be given its ordinary

[1] Para 49

[2] https://www.collinsdictionary.com/dictionary/english/boost

dictionary meaning of a small piece of something, whether that be fabric or other materials, used as a covering.[3] I consider the juxtaposition of 'IV' and 'PATCH' to be fairly unusual as they don't seem to go together - an intravenous treatment is not applied by a patch, but by injection into the blood stream. I therefore find the marks to be conceptually similar to no more than a medium degree.

Distinctive Character of the Earlier Mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 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 *Windsurfing Chiemsee*, paragraph 51)."

[3] https://www.collinsdictionary.com/dictionary/english/patch

32. No claim of an enhanced level of distinctiveness in its earlier mark was made by the opponent however, they did file evidence. I will review the evidence to see whether it shows that use of the marks can be said to have enhanced the distinctiveness of the earlier mark.

33. In order to do this, first I must consider the level of inherent distinctiveness the earlier mark has. For the most part, words that are descriptive or allusive of the character of the goods and services provided are on the lower end of the scale of distinctiveness whereas invented terms are likely to possess the highest level of distinctiveness.

34. The opponent's mark consists of two terms, 'IV' and 'BOOST'. 'IV' could be said to be descriptive or allusive of the method of delivery of the goods for which the mark is registered. 'BOOST' is likely to be allusive to the effects of the goods. Therefore, I find that the opponent's earlier mark can be said to be inherently distinctive to a low degree.

35. The opponent has provided turnover figures as follows:

2018	£630,634
2019	£530,359
2020	£380,532
2021	£465,474
2022	£283,547

36. It is not clear precisely what the turnover figures relate to. The evidence shows that the mark appears to be used in connection with medical services as well as goods and there is no indication as to what proportion of the turnover is accounted for by the goods for which the mark is registered. Therefore, the evidence falls short of what would be required to show that distinctive character of the mark has been enhanced through use.

Likelihood of confusion

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

38. The following factors must be considered to determine if a likelihood of confusion can be established:

• The opponent's mark consists of the words IV BOOST. I consider that the overall impression lies in the combination of these words.

• The applicant's mark consists of the words IV PATCH and again I consider the overall impression lies in the combination of these words.

• I have found the marks to be visually, aurally and conceptually similar to no more than a medium degree.

• I have found the opponent's mark to be inherently distinctive to a low degree.

• I have identified the average consumer to be medical or members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.

• I have concluded that a higher than normal degree of attention will be paid during the purchasing process (save for 'adhesive plasters or adhesive films from the applicant's specification which will attract a normal degree of attention) .

• I have found the parties' goods to be identical or similar to a medium degree.

39. I bear in mind that it is the distinctiveness of the common element that is important: *Kurt Geiger v A-List Corporate Limited*, BL O-075-13 and that in the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

41. I also acknowledge the decision of Emma Himsworth K.C., sitting as Appointed Person in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, Case O/0368/23 as follows:

> "Taking the guidance from the case law, in circumstances where for present purposes there is no claim to acquired distinctive character and the services are identical or highly similar, the approach can be summarised as follows:
>
> (1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
>
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

42. The marks share the element 'IV' at the beginning which I have already stated above, is descriptive or allusive of the goods provided by both parties. The second elements of the marks are 'BOOST' and 'PATCH' respectively. Although these words contain the same number of letters, and the letter 'T' (albeit in different positions within the word) that is where their similarities end. They are aurally and conceptually very different also. 'BOOST' can be said to be allusive of the effects of the goods. 'PATCH' could also be descriptive, however, as I explained above, its juxtaposition with the word IV makes it unusual as IV's would not come in the form of a patch. Therefore, taking into account all of the above, I do not consider there to be a likelihood of direct confusion.

43. I will now turn to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C.(as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

44. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that a “finding of a likelihood of indirect confusion is not a consolation prize for those who failed to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion.

45. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

46. Mr Purvis in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion tends to fall into one of them.[4] I bear in mind that the examples set out by Mr Purvis are not exhaustive.

47. I have already set out my finding that the common element is not strikingly distinctive; rather it is of low distinctiveness and therefore, the average consumer would not assume that it could only possibly be used by one entity. No non-distinctive elements have been added to the earlier mark which would signify a brand extension or sub-brand. I found that it is the juxtaposition of the words in the applied for mark where the inherent distinctiveness lies. I see no reason why, given this finding, IV PATCH would be a logical extension of IV BOOST so that the average consumer would assume that they came from the same undertaking. I also do not consider that it would be reasonable for a company to change an element which is equally as distinctive as the other part in order to create a brand extension. I see no reason why the average consumer would assume the goods at issue would come from the same undertaking. Especially when IV is low in distinctiveness and following the guidance in

[4] Paragraphs 16 & 17

Face2FaceHR Partners Limited v Peninsula Business Services Limited above. Consequently, I consider there to be no likelihood of indirect confusion.

Conclusion

48. The opposition is unsuccessful and the application may proceed to registration.

Costs

49. The applicant has been successful in this case and is therefore entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016.

50. Mr Wood argued at the hearing that off-scale costs should be awarded as the opponent had 'no real prospect of success' due to the case not being one of confusion as to source but rather confusion as to the nature of the products. owever, I do not agree with this, the Form TM7 was correctly filed and arguments relevant to section 5(2)(b) were made by the opponent within their skeleton and at the hearing. Also, the applicant admitted that there was similarity between the goods and, to some level, between the marks and therefore, this is not a case where there was no real prospect of success.

51. As the applicant's own evidence was of no real material value in deciding the case, I am not awarding costs for its preparation.

52. Using the TPN as a guide, I award the following:

Preparing a statement and considering the other side's statement:	£200
Considering and commenting on the other side's evidence and submissions:	£500

Preparing for and attending a hearing	£500
Total:	**£1200**

53. I therefore order IV Boost UK Limited to pay the sum of £1200 to Mymall Europe Limited. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of September 2023

L Nicholas
For the Registrar