

o/0919/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3767027

BY ZUBER IBRAHIM

TO REGISTER THE TRADE MARKS:

ZOUD.

ZOUD.



IN CLASSES 1, 3, 4, 21 AND 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 434050

BY OPERA IP LTD

BACKGROUND AND PLEADINGS

1. On 17 March 2022, Zuber Ibrahim (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision (“the contested marks”) in the UK. The application was published for opposition purposes on 8 April 2022, and registration is sought for goods and services in Classes 1, 3, 4, 21 and 35.¹

2. On 8 June 2022, Opera IP Ltd (“the opponent”) filed a notice of opposition. The opposition was brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and was directed at all the goods and services in the application. However, as the opponent failed to file evidence and/or submissions, in support of the section 5(3) ground, this ground was deemed withdrawn, in accordance with 20(3) of the Trade Marks Rules 2008.

3. The opponent relies upon UKTM no. 3236555 for the trade mark ‘SOUD’ which was applied for on 9 June 2017 and was entered in the register on 20 October 2017. For the purpose of these proceedings the opponent relies upon all goods for which the mark is registered.²

4. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

5. The opponent claims that the marks are similar and that the goods and services covered by the marks are either identical or similar, resulting in a likelihood of confusion.

6. The applicant filed a defence and counterstatement denying the grounds of opposition.

¹ See goods and services comparison.

² See goods and services comparison.

7. The applicant is represented by Briffa and the opponent is represented by Barker Brettell LLP. Neither party requested a hearing. Only the applicant filed evidence. Neither party chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

PRELIMINARY ISSUES

8. The applicant has raised points in its submissions which I intend to address before going any further into the merits of this opposition. This is because, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- Goods comparison and the target market

9. In its evidence, the applicant states the following:

“I do not believe that the goods and services represented by both marks would have the same methods of use, target consumers or distribution channels. The goods provided by the Earlier Mark is marketed as high end, they are distributed in luxury boutique stores, and carry a premium price tag. The Opponent is targeting high end consumers. In contrast, our perfume products are sold directly through our own website and priced at nearly half that of the Opponent's goods. We are targeting the public at large by bringing a premium product at a more consumer friendly price tag.

We have worked hard to give the Application a distinctive edge within a very crowded market by producing goods that are vegan, cruelty free and recyclable, we advertise this on our website. To the best of our knowledge we are not aware of any similar claims made by the Earlier Mark. These elements of the perfume industry are not targeted at the public as a whole, despite a high percentage of the public becoming more environmentally-conscious, this is therefore, in my opinion, what makes our Application acquire a unique selling point.”

10. Differences between the goods and services currently provided by the parties, such as particular characteristics of the goods and services, are irrelevant, except to the extent that those differences are apparent from each party's specification. Furthermore, since the opponent's earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods for which it is registered. It is the goods relied upon by the opponent and the goods and services applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods and services is a notional and objective assessment, rather than a subjective one.

11. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time.³ As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods and services at issue.

EVIDENCE

12. The applicant, Zuber Ibrahim, filed evidence in the form of a witness statement, dated 27 March 2023, which is accompanied by 8 exhibits. The applicant's statement contains submissions regarding the similarity of the goods and services and provides their opinion on how the marks at issue will be pronounced along with details regarding the target market of the marks and the manner in which the parties' goods are provided to consumers.

13. I have taken the evidence into account in reaching this decision and will refer to it where necessary.

RELEVANCE OF EU LAW

14. 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

³ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

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. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because—

(a)...

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

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

16. Section 5A of the Act is as follows:

“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.”

17. 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;

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

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

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

k) if the association between the marks creates a risk that the public will wrongly 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

18. The competing goods and services are as follows:

Opponent's goods	Applicant's goods and services
<p>Class 3 Soaps; perfumery; cosmetics and makeup; toiletries, hair lotion, hair conditioners, hair stylers, hair moisturisers, hair spray, toothpaste, perfume, facial cleaning milk, bath lotion, deodorant for personal use, sunscreen preparations, antiperspirants (toiletries), hair dyes, waving preparations for the hair, shampoos; cosmetic preparations for baths, cosmetics for skin care; dentifrices, preparations for the cleaning, care and beautification of the skin, scalp and hair; essential oils; perfumes and colognes; non-medicated skincare preparations; cosmetic wipes.</p>	<p>Class 1 Chemical products for the preparation of perfumes; Alcohol for use in the manufacture of perfumes; Chemical substances for use in the manufacture of perfumes; Synthetic fragrance ingredients.</p> <p>Class 3 Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed powder; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Liquid perfumes; Perfumed powders; Perfumed creams; Perfume water; Aromatics for perfumes; Perfumes for cardboard; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation</p>

	<p>preparations [perfumes]; Extracts of perfumes; Extracts of flowers [perfumes]; Natural oils for perfumes; Perfumes in solid form; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Perfumes for industrial purposes; Sachets for perfuming linen; Linen (Sachets for perfuming -); Room perfumes in spray form; Cushions impregnated with perfumed substances; Perfumed body lotions [toilet preparations]; Perfumed powder [for cosmetic use]; Perfumed oils for skin care; Cushions filled with perfumed substances; Extracts of flowers being perfumes; Oils for perfumes and scents; Perfuming preparations for the atmosphere; Perfumed powders [for cosmetic use]; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations; Fragrances; Fragrance sachets; Room fragrances; Potpourris [fragrances]; Household fragrances; Fragrance preparations; Body fragrances; Fragrance emitting wicks for room fragrance; Air fragrance preparations; Aromatics for fragrances; Room fragrancing products; Geraniol fragrancing compounds; Piperonal fragrancing compounds; Room fragrancing preparations; Fragrances for automobiles; Cleaning and fragrancing preparations; Air fragrancing preparations; Perfumery and fragrances; Geraniol for fragrancing; Heliotropin fragrancing compounds; Fragrance refills for non-electric room fragrance dispensers; wax melts [fragrancing preparations]; Air fragrance reed diffusers; Fragrances for personal use; Fragrance for household purposes; Wax melts [fragrancing preparations]; Fragrance sachets for eye pillows; Refills for electric room fragrance dispensers; Essential oils as fragrances for laundry use.</p>
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	<p>Class 4 Perfumed candles; Candles (Perfumed -); Fragranced candles; Aromatherapy fragrance candles.</p> <p>Class 21 Perfume bottles; Perfume atomisers; Perfume burners; Perfume vaporizers; Burners (Perfume -); Perfume sprayers; Perfume atomizers [empty]; Vaporizers for perfume [empty]; Perfume sprays, sold empty; Perfume bottles sold empty; Perfume sprayers [sold empty]; Perfume burners [other than electric]; Vaporizers for perfume sold empty; Air fragrancing apparatus.</p> <p>Class 35 Brand testing; Brand evaluation services; Brand creation services; Brand positioning services; Brand positioning; Brand strategy services; Brand creation services (advertising and promotion); Advertising services to create brand identity for others; advertising services to create brand identity for others; Advertising services to create corporate and brand identity; Retail services relating to fragrancing preparations; Wholesale services in relation to fragrancing preparations; Retail services in relation to fragrancing preparations.</p>
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19. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“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.”

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

25. 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”

26. With regard to the similarity of the goods and services, the applicant submits:⁴

“There is very little overlap with identical or highly similar goods and services between the Earlier Mark and the Application. For example, I have applied for goods within classes 1, 4, 21, and 35 for 'chemicals substances used in perfumes' 'candles' 'bottles' 'branding and retail services' none of these terms appear within the Earlier Mark on a specific or general level. The nature intended purpose and methods of use within these categories and all the goods and services within classes 1, 4, 21, and 35 are highly different and non-competitive.

Furthermore, the subcategories applied for within class 3 which despite limited similarities still contain several differences, for example the Application contains for [sic] terms for goods relating to hair care, additionally the Earlier mark contains no terms for goods relating [sic] household goods. The only similarity in the goods between the marks is perfume, soap and skin care creams/lotions.”

Class 1 of the contested application

⁴ Witness statement – page 7

Chemical products for the preparation of perfumes; Alcohol for use in the manufacture of perfumes; Chemical substances for use in the manufacture of perfumes; Synthetic fragrance ingredients

27. Broadly speaking, the above contested goods are raw materials and ingredients for use in the manufacture of perfumes and fragrances. As raw materials and ingredients, the contested goods will be used with other ingredients by manufacturers of perfume to create a finished article for onward sale to the end consumer. Similarly, the opponent's *essential oils*, being oils extracted from plants, can also be used as an ingredient for use in the manufacture of perfumes and fragrances. As such, I find that the goods share a similar nature, purpose, channels of trade and users. Accordingly, the goods at issue are similar to at least a medium degree.

Class 3 of the contested application

Perfumes; Perfume; Perfume oils; Amber [perfume]; Perfumed water; Perfumed powder; Solid perfumes; Liquid perfumes; Perfumed powders; Perfumed creams; Perfume water; Aromatics for perfumes; Perfumed toilet waters; Fumigation preparations [perfumes]; Extracts of perfumes; Extracts of flowers [perfumes]; Perfumes in solid form; Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Perfumed body lotions [toilet preparations]; Perfumed powder [for cosmetic use]; Perfumed oils for skin care; Extracts of flowers being perfumes; Perfumed powders [for cosmetic use]; Fragrances; Fragrance preparations; Body fragrances; fragrancing preparations; Perfumery and fragrances; Fragrances for personal use

28. The above contested goods are either directly replicated in the opponent's Class 3 goods, or they fall within the wide terms *perfumery* and *preparations for the beautification of the skin*. Therefore, the competing goods are identical, either because they are identically, or near-identically worded, or are identical, in accordance with the *Meric* principle.

Perfumed soap; Perfumed soaps.

29. The above contested terms are included in the broad term *soaps*, contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Perfumes for cardboard; Perfumes for ceramics; Perfuming preparations for the atmosphere; Perfumes for industrial purposes; Room perfume sprays; Room perfumes in spray form; Room fragrances; Household fragrances; Fragrance emitting wicks for room fragrance; Air fragrance preparations; Aromatics for fragrances; Room fragrancing products; Geraniol fragrancing compounds; Piperonal fragrancing compounds; Room fragrancing preparations; Geraniol for fragrancing; Heliotropin fragrancing compounds; Fragrance refills for non-electric room fragrance dispensers; Air fragrance reed diffusers; Fragrance for household purposes; Refills for electric room fragrance dispensers

30. The above contested perfume and fragrancing goods are used in order to provide a pleasant scent to, for example, objects or living spaces. The opponent's *perfumery* and *perfumes* can also be used to provide a pleasant scent to objects and living spaces, as well as the body. Therefore, as there is a clear overlap between the respective goods, I find them to be identical in line with the principle set out in *Meric*. However, if I am wrong, then *perfumery* and *perfumes* are similar to a high degree to the above contested goods on the basis that the contested goods are scented products and therefore share a similar nature, purpose, channels of trade and users.

Fragrance sachets; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Perfumed tissues; Sachets for perfuming linen; Linen (Sachets for perfuming -); Cushions impregnated with perfumed substances; Cushions filled with perfumed substances; Potpourris [fragrances]; wax melts [fragrancing preparations]; Wax melts [fragrancing preparations]; Fragrance sachets for eye pillows

31. The above contested goods are all products intended to produce a pleasant aroma in a room or on an object like a bed or a clothes cupboard. They are not likely to be considered as *perfumery per se* but as previously discussed, they have a similar

purpose and have the same end users and distribution channels. Therefore, whilst I bear in mind that the respective goods would not be found on the same retail shelves and are not generally in competition nor are they complementary, I find that the contested goods are similar to a medium degree to the opponent's *perfumery*.

Natural oils for perfumes; Oils for perfumes and scents; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations; Essential oils as fragrances for laundry use

32. The opponent's goods include the broad term *essential oils* which are oils extracted from plants. These goods can be used for perfuming, massaging purposes and aromatherapy as well as in the manufacture of perfumes. Accordingly, I find that the respective goods overlap and as such are considered identical in line with the principle set out in *Meric*. However, if I am wrong, the goods at issue are highly similar bearing in mind the similar nature, i.e. perfumed oils, use, ingredients, end users, trade channels and some degree of competitiveness.

Class 4 of the contested application

Perfumed candles; Candles (Perfumed -); Fragranced candles; Aromatherapy fragrance candles

33. The above contested goods are candles that have fragrant oils mixed into the wax, in order to emit a pleasant aroma when burning. Whilst the opponent's goods do not include the contested goods, I find that there is a degree of similarity with the opponent's *perfumery*. *Perfumery* includes scents applied to the body, an object or a room in order to emit a pleasant aroma. It therefore follows that the above contested goods share a similar purpose with the contested *perfumed* and *fragranced candles* which also contain fragrances which emit a pleasant aroma. Therefore, I find that there is an overlap in purpose, end users and trade channels. There is also a degree of competitiveness between the goods in that a user may select a scented candle over another *perfumery* good, such as a household fragrance. Overall, I find these goods are similar to a medium degree.

Class 21 of the contested application

Perfume atomisers; Perfume burners; Perfume vaporizers; Burners (Perfume -);
Perfume sprayers; Perfume atomizers [empty]; Vaporizers for perfume [empty];
Perfume sprays, sold empty; Perfume sprayers [sold empty]; Perfume burners [other
than electric]; Vaporizers for perfume sold empty; Air fragrancing apparatus

34. The above contested goods can all be described as *air fragrance apparatus*, which when used in combination with *perfume* will emit a pleasant aroma into a room, for example. The opponent's goods include *perfume* and *perfumery* which as previously discussed, as wide terms will include *air fragrance preparations* such as room scenting sprays and potpourri, etc. Such *perfume* and *perfumery* goods are indispensable for the use of various air fragrancing apparatus, such as the contested goods listed above, which serve the purpose of diffusing the fragrance to make rooms, etc., smell pleasant. The contested goods and the opponent's *perfume* and *perfumery* goods satisfy the needs of the same consumers and are likely to be sold in the same specialised shops and sections of supermarkets or department stores. Furthermore, they may also be sold as a set, and as such, consumers would have an expectation that the goods are produced by the same undertaking. Accordingly, I find that the goods are similar to a low degree.

Perfume bottles; Perfume bottles sold empty

35. The contested goods are bottles used to store *perfume*. The opponent's goods contain *perfume* and *perfumery*, which are goods that would be added to the bottles, so that the perfume can be sold as a finished product and easily dispensed by the user. Whilst I bear in mind that the respective goods serve a different purpose, on the basis that one is used to contain perfume, and the other is to enhance the smell of an individual, I find that there is a complementary relationship between the competing goods. Furthermore, users and trade channels may overlap. Taking the above into account, I find the goods to be similar to a low degree.

Class 35 of the contested application

36. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

Retail services relating to fragrancings preparations; Wholesale services in relation to fragrancings preparations; Retail services in relation to fragrancings preparations

37. The contested services directly relate to the wholesale and retail of *fragrancings preparations*, such as, *perfumes* and *perfumery* goods, for example. Therefore, I find that there is an overlap between the opponent's *perfumery, perfumes and cologne* goods and the contested services. Taking into account the guidance outlined above in *Oakley*, whilst the nature, purpose and method of use of these goods and services are not the same, I find that they are similar to a degree, because they are complementary, and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public. Accordingly, I find that the contested services are similar to at least a low degree to the opponent's *perfumery, perfumes and cologne* goods.

Brand testing; Brand evaluation services; Brand creation services; Brand positioning services; Brand positioning; Brand strategy services; Brand creation services (advertising and promotion); Advertising services to create brand identity for others; advertising services to create brand identity for others; Advertising services to create corporate and brand identity

38. I find that the respective nature, methods of use and intended purpose of the above services and the opponent's Class 3 goods are different. It is not obvious to me that there would be any convergence of trade channels. The goods and services at issue are not in competition with each other, nor are they complementary. Moreover, they do not coincide in producers or distribution channels. Therefore, the contested services are dissimilar to all of the opponent's goods.

Summary

39. Where there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails in respect of the following services:

Class 35 Brand testing; Brand evaluation services; Brand creation services; Brand positioning services; Brand positioning; Brand strategy services; Brand creation services (advertising and promotion); Advertising services to create brand identity for others; advertising services to create brand identity for others; Advertising services to create corporate and brand identity.

The average consumer and the nature of the purchasing act

40. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

41. 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.”

42. The average consumer of the goods and services at issue is the general public, who is likely to take into consideration various factors when selecting the goods and services at issue, such as, suitability, desired effect, fragrance, colour and ingredients, but I would not expect the degree of attention to be particularly high. Overall, I find that a medium degree of attention is likely to be paid during the purchase of the goods and services. The goods and services are all likely to be sought out primarily by eye, including via websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the goods and services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind.




Comparison of the marks

43. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

45. The trade marks to be compared are as follows:

Opponent's mark	Applicant's marks (series of 3)
SOOUD	(i)  (ii)  (iii) 

46. With regard to the similarity of the marks, the applicant submits:⁵

“The Opponent has failed to provide any explanation as to why in its opinion the Application and the Earlier Mark are either identical or similar in any way.

Conversely, within the counterstatement filed on my behalf it was clearly set out why the visual differences are noticeable. the Earlier Mark is a plain text word for SOOUD whereas the Application is a graphical illustration of the word ZOULD.

Not only do the marks look different but the words themselves are also different and even begin differently. The only similarity in the visual appearance of the word in the Earlier Mark and the Application is in the last three letters O, U and D which as a standalone word is defined in the Collins dictionary as a Persian loot instrument. However, in my industry, it is used as a generic term to describe the resin of the tropical agar tree.

The marks begin completely differently with the Earlier Mark starting 'SO' and the Application starting 'Z' this is [sic] large visual difference between the marks. The high degree of visual differences is only further enhanced by the fact that

⁵ Witness statement – page 2

both marks start differently. I therefore believe that the marks are therefore visually highly different. In terms of phonetic similarities between the marks, The Earlier Mark and the Application consist of a different number of syllables. The pronunciation of the Earlier Mark is 'SO-LOUD', two syllables and sounds like two distinctive separate words, this is clearly evidenced in their logo and in all their packaging where they capitalise the second O 'soOud' which gives the public a very clear indication that they intend this be spoken as two words, examples of this can be seen at Exhibit Z13. This is very different to the Application which is pronounced 'ZLOUD', one syllable and very clearly sounds like one word.

I believe that these phonetic differences make a significant difference in their sound to such a degree that the average consumer will hear the clear distinction between the two when spoken or heard (even when the average consumer does not have an opportunity to compare the sounds of the words and including where the average consumer does not pay very close attention to the sounds of the words). I therefore believe that the marks are phonetically different.

Conceptually the marks are clearly different. The Application is a singular, fictional word. Whilst the Earlier Mark may on first glance appear to be a singular, fictional word, it is in fact used as two words 'SO' and 'LOUD' neither of which would be unfamiliar with the general public, and when used in this nature in the equivalent of saying 'very loud' or 'incredibly loud' or 'a lot like loud'."

Overall impression

47. The opponent's mark comprises the word 'SOUD' presented in standard uppercase letters without any stylisation. The overall impression resides in this single element.

48. The applicant's marks (series of three), comprise the word 'ZLOUD' presented in slightly stylised, uppercase letters, followed by a full stop. Mark (i) is gold in colour; mark (ii) is black in colour; and with regard to mark (iii), the words are gold in colour and are presented on a black background. In all three marks, the eye is naturally drawn

to the element of the marks that can be read and therefore the word 'ZOULD' dominates the overall impression of the marks. Less dominant is the full stop element present in the marks, however this element still contributes to the marks' overall impression. I find that the colour of the marks along with the black background in mark (iii) will have little impact on the consumer.

49. Visually the marks overlap in the presence of the letters 'O-U-D' which appear identically in the same order at the end of the marks. They differ in the letters present at the start of the marks, being 'SO' in the opponent's mark, and 'Z' in the applicant's marks. The full stop, use of colour and the black background in mark (iii) of the applicant's mark act as points of visual difference between the marks. In making my visual comparison of the marks, I bear in mind that the beginnings of marks tend to make more of an impact than the ends⁶ and that the addition of an 'O' in the opponent's mark makes it visibly longer. Taking all this into account, I consider the marks to be visually similar to between a low and medium degree.

50. Aurally, the opponent's mark is likely to be pronounced 'SOO-UD', whereas the applicant's marks are likely to be pronounced 'ZOW-ED'. The full stop and black background in the applicant's mark will not be articulated. Overall, I find that the marks are aurally similar to between a low and medium degree.

51. Conceptually, the words 'SOOUD' and 'ZOULD' are invented words with no clear meaning or obvious connection to the applied for goods and services. Furthermore, contrary to the applicant's submissions, I am of the view that on seeing the opponent's mark 'SOOUD' consumers will perceive it as one word and will not seek to break the word into 'SO' and 'OUD', therefore they will not see 'OUD' as an individual element. I find that the full stop, colours, and black background in mark (iii) of the applicant's marks do not add to the concept of the marks, particularly given that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. Consequently, the conceptual position is neutral.

Distinctive character of the earlier mark

⁶ *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

52. 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 *Windsurfing Chiemsee v Huber and Alternberger* [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).”

53. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

54. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

55. The earlier mark 'SOUD' is an invented word which has no relationship with the goods relied upon. Consequently, I consider the earlier mark to be inherently highly distinctive.

Likelihood of confusion

56. 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 goods may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, 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 act. 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.

57. I have found the marks to be visually and aurally similar to between a low and medium degree and conceptually neutral. I have found the earlier mark to be inherently highly distinctive. I have found the average consumer to be a member of the general public, who will pay a medium degree of attention during the purchasing process. I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I have found the goods and services to vary from dissimilar to identical.

58. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, and that the average consumer will rarely have the opportunity to compare the marks side-by-side, I am not convinced that the marks would be mistakenly recalled or misremembered for one another. Whilst I appreciate that the Applicant's marks contain the letters 'OUD' which are identically present in the

opponent's mark, I am of the view that the differences at the beginning of the marks, namely 'SO' in the opponent's mark and 'Z' in the applicant's marks, and the visual impact created by the double 'OO' in the opponent's mark will allow the average consumer to correctly recall and remember the marks, even when used on identical goods, particularly keeping in mind that the beginnings of marks tend to make more of an impact than the ends.⁷ Notwithstanding that the opponent's mark is inherently highly distinctive, I find that the clear difference presented by the beginnings of the marks will be noticed. Consequently, I do not consider there to be any likelihood of direct confusion.

59. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC (as he then was), as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

60. These examples are not exhaustive but provide helpful focus.

61. Further, 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 fail 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 where there is no likelihood of direct confusion.

62. A finding of indirect confusion should not be made merely because the two marks share a common element, and it is not sufficient that a mark merely calls to mind another mark,⁸ this is mere association not indirect confusion.

63. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will notice the common element ‘OUD’ at the end of the marks, while at the same time recalling the differences between them at the start of the marks and assume that the marks are from the same or related undertaking. However, I do not think this is likely. Whilst I keep in mind that ‘OUD’ is present in both marks, I find that this element has no independent identity or distinctive character within the marks on the basis that it is incorporated within different words. Furthermore,

⁸ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

to my mind, 'ZOUD' is not a logical brand extension, sub-brand or rebrand, etc., of 'SOOUD'. Accordingly, there is no proper basis for a finding of indirect confusion. Nor has the opponent articulated any argument to that effect. I appreciate that the earlier mark, 'SOOUD' is inherently highly distinctive, however I do not consider that use of 'OUD' at the end of the mark is so strikingly distinctive that the average consumer would think no one else would use it. Lastly, even if the average consumer, upon being confronted by the applicant's marks on goods that are identical, were to call to mind the opponent's mark, this is mere association not indirect confusion. Rather, the average consumer would put the presence of the common element 'OUD' in both marks down to coincidence rather than economic connection. Consequently, I do not consider that there is any likelihood of indirect confusion between the marks at issue.

64. The opposition under section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration.

Costs

65. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. I bear in mind that although the applicant filed evidence, this essentially consisted of just written submissions. Accordingly, in the circumstances, I award the applicant the sum of £400 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement	£200
Preparing and filing submissions	£200
Total	£400

66. I therefore order Opera IP Ltd to pay Zuber Ibrahim, the sum of £400. This should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

Dated this 27th day of September 2023

**Sam Congreve
For the Registrar**