O/0945/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003788949
BY EVERYBODIES LTD
TO REGISTER THE FOLLOWING MARK:

Everybodies

IN CLASS 5, 30 AND 32

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436141
BY NALCH INNOVATION LIMITED

Background and pleadings

1. On 17 May 2022, Everybodies Ltd ("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 10 June 2022 and registration is sought for the goods shown below:

> **Class 5:** *Dietary supplements and dietetic preparations; Nutritional supplements; Health food supplements made principally of vitamins; Protein powder dietary supplements.*
>
> **Class 30:** *Confectionary snack bars; Confectionary protein bars.*
>
> **Class 32:** *Sports drinks.*

2. On 8 September 2022, the application was opposed by Nalch Innovation Limited ("the opponent") based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:[1]

> UK00918264393
> EVERY BODY
> Filing date: 30 June 2020
> Registration date: 15 December 2020

3. The opponent relies upon all of the goods for which its mark is registered, namely those set out below:

> **Class 5:** *Dietary and nutritional supplements in all forms including tablets, capsules and powders; vitamin supplements; vitamin supplements in oral spray form; multivitamins; mineral supplements; probiotic preparations; probiotic*

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

supplements; fibre supplements; vitamin gels; food supplements; protein supplements; zinc dietary supplements; selenium dietary supplements; vitamin C tablets; vitamin C preparations; vitamin D tablets; vitamin D preparations.

Class 32: *Non-alcoholic drinks; fruit drinks; fruit juices.*

4. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the date of the application in question, it is not subject to proof of use pursuant to Section 6A of the Act.

5. The opponent claims that the marks are similar and that the goods are identical or similar, meaning that there is a likelihood of confusion.

6. The applicant filed a counterstatement in which it denied the claims.

7. The applicant is represented by Lawdit Solicitors Limited. The opponent is without legal representation.

8. Only the applicant filed evidence. Neither party requested a hearing, but the applicant filed written submissions in lieu. I have taken the evidence and submissions into account in reaching this decision and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

The evidence

9. The applicant filed evidence in the form of the witness statement of Evren Ozkarakasli dated 29 March 2023 which is accompanied by 1 exhibit (EO1). Mr Ozkarakasli is a director of the applicant, and his evidence goes to the similarity of the goods at issue.

EU Law

10. 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 Trade Marks 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.

DECISION

Section 5(2)(b)

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

> "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".

12. 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

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union ("CJEU") stated that:

> "23. 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 complementary."

14. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

15. The General Court ("GC") confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

16. 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."

17. 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."

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"

18. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
Class 5: *Dietary supplements and dietetic preparations; Nutritional supplements; Health food supplements made principally of vitamins; Protein powder dietary supplements.*	**Class 5:** *Dietary and nutritional supplements in all forms including tablets, capsules and powders; vitamin supplements; vitamin supplements in oral spray form; multivitamins; mineral supplements; probiotic preparations; probiotic supplements; fibre supplements; vitamin gels; food supplements; protein supplements; zinc dietary supplements; selenium dietary supplements; vitamin C tablets; vitamin C preparations; vitamin D tablets; vitamin D preparations.*
Class 30: *Confectionary snack bars; Confectionary protein bars.*	
Class 32: *Sports drinks.*	**Class 32:** *Non-alcoholic drinks; fruit drinks; fruit juices.*

19. The applicant argues in its counterstatement that the parties' goods in class 5 are not similar because the opponent's goods relate to vitamin supplements and are purchased to deal with health issues, whereas the applicant's goods are more wellness-focussed rather than for medical use.

20. To support the claim that the goods are not similar, Mr Ozkarakasli filed evidence aimed at establishing that the parties operate within differing industries. In particular, Mr Ozkarakasli states that the applicant specialises in the supply of products for the sports and fitness sector, whereas the opponent operates within the medical and health industry.

21. Mr Ozkarakasli states that the fitness industry in the UK has seen significant growth over the last 10 years and that in 2023, the market size, measured by revenue, of the gyms and fitness industry has been valued at £1.9 billion. On this basis, Mr Ozkarakasli states, it is the applicant's position that the average consumer of fitness goods and services will be more aware of the different brands within the market, due to its rapid growth and sheer scale, and will be clear as to the types of products he seeks out and will be hyperaware as to the functions and intended purpose of goods.

22. As regards the opponent's products, Mr Ozkarakasli states that the medical and health industry produces products that are created to interact with the existence of a medical condition or concern rather than more recreational products used to support consumer's choices. In this connection, he provides evidence that the opponent's website contains the following statement: *"Every Body Health's vitamins and mineral supplements are clinically formulated in the European Union by renowned pharmaceutical chemists"* and states that it is the applicant's position that consumers of the opponent's goods will be hyperaware as to branding, because the impact of the change of medication-based products could be significant and that on this basis, there cannot exist a likelihood of confusion on the part of the public, as it will be clear to the average consumer that there is not sufficient similarity between goods which have different purposes and intended users.

23. Whilst the parties might operate in different segments of the markets, that is completely irrelevant if the distinction is not reflected in the competing specifications.

This is because the opponent's earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for the goods on which the opponent relies for the purposes of this opposition. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*[2] like this:

> "22. ....It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

24. Likewise, the applicant's use of the contested mark is irrelevant because I must conduct the comparison based on the specification for which the mark seeks registration. In this connection, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limite*d,[3] the CJEU stated that when assessing the likelihood of confusion in the context of registering a new mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consequently, I must include consideration of the likelihood of confusion if both parties (and their successors in title to the marks) decide to target the same segment of the market. Therefore, the fact that the parties are currently targeting different segments of the market is irrelevant where the goods at issue are fundamentally the same or similar.

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[2] [2004] RPC 41
[3] Case C-533/06

25. I now turn to assess the similarity of the competing goods based on what the specifications notionally cover.

Class 5

Dietary supplements and dietetic preparations; Nutritional supplements; Health food supplements made principally of vitamins; Protein powder dietary supplements.

26. The applicant's *Dietary supplements; Nutritional supplements* are identical to the opponent's *Dietary and nutritional supplements in all forms including tablets, capsules and powders.* The applicant's *dietetic preparations* fall within the opponent's *Dietary and nutritional supplements in all forms including tablets, capsules and powders;* alternatively, they encompass *probiotic preparations* which are a type of dietetic preparation. These goods are self-evidently identical or identical according to the principle outlined in *Meric.*

27. The applicant's *Health food supplements made principally of vitamins* are encompassed by the opponent's broader term *food supplements.* These goods are identical according to the principle outlined in *Meric.*

28. The applicant's *Protein powder dietary supplements* fall within the opponent's *Dietary and nutritional supplements in all forms including tablets, capsules and powders.* These goods are identical according to the principle outlined in *Meric.*

Class 30

Confectionary snack bars; Confectionary protein bars.

29. Although the opponent's registration is not protected for goods in class 30, it covers protein supplements and dietary and nutritional supplements in class 5 which would include, for example, protein powders. Whilst the goods might belong to different classes, that does not make them necessarily dissimilar. Section 60A of the Act in fact 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 1979."

30. Whilst the applicant's *Confectionary snack bars; Confectionary protein bars* are confectionary products, they include snack and nut bars with a higher protein content which are marketed as protein bars for exercise and might be purchased by gym goers similarly to the opponent's protein supplements and protein powders (as covered by the broad term *Dietary and nutritional supplements in all forms including tablets, capsules and powders).* Further, my experience reflects the applicant's evidence about the growth of the gym and fitness industry, which, in turn, has resulted in the increased offer of sport nutrition food and drink products[4] including high protein bars sold in supermarkets and specialised shops. An extract from the applicant's evidence states:

"In terms of today's usage, the top two sports nutrition products used are protein based. Over the last 3 months around one in ten (9%) Brits have eaten protein bars while the same number (9%) have used protein powders. However, it's not only sports nutrition products that are bulking up with protein. According to Mintel Global New Products Database (GNPD), the number of food and drink products launched in the UK with a high-protein claim rose by 97% between 2014 and 2015 and 498% between 2010 and 2015.

[4] Exhibit EO1.

> Outside of sports nutrition products, 25% of UK consumers have consumed any high protein food and drink in the past three months, rising to 35% of people who exercise at least once a week."

31. This evidence (1) corroborates my perception that the increased demand for high protein products has blurred the line between dietary supplements and high protein food with many specialised outlets selling at the same time both nutritional supplements (i.e. protein powders) and protein bars and (2) demonstrates that gym goers (or those who exercise) use high protein food (which would include the applicant's protein bars) – this, in turn, means that consumers might make a choice between the applicant's protein bars and the opponent's protein powders resulting in the goods being in competition. Hence, although the goods have a different nature (i.e. nutritional supplements *versus* high protein food), they have the same purpose (i.e. increase the consumer's intake of proteins), target the same users (i.e. gym goers), are in competition and might share trade channels. These goods are in my view similar to a medium degree.

<u>Sports drinks</u>

32. The opponent's specification in class 32 covers, *inter alia,* the broad term *Non-alcoholic drinks* which encompasses non-alcoholic drinks of all kinds, including the applicant's sports drinks. These goods are identical according to the principle outlined in *Meric.*

Average consumer

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

34. The average consumer of the goods at issue is the general public. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods would involve oral discussions with sales representatives or word of mouth recommendations. Although consumers who purchase the goods might be particularly attentive to their dietary needs and lifestyle, the goods are relatively low in price and frequently purchased, and the degree of attention is likely to be no more than medium.

Comparison of marks

35. 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."

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

The applicant's mark	The opponent's mark
Everybodies	EVERY BODY

Overall impression

37. Both marks are word-only marks presented in standard fonts. The applicant's mark comprises of the word 'Everybodies' and therefore the overall impression lies in the entirety of the word. Similarly with no other elements to contribute to the overall impression of the opponent's mark, it resides in the word 'EVERY BODY' itself.

Visual similarity

38. The fact that one mark is presented in title case and the other in upper case does not create a visual difference between the marks because both marks are word-only marks and can be presented in any case and font.

39. The applicant states that the ending of the application is sufficient to distinguish the marks and that the strong 's' sound at the end of the application would be enough for the general public to distinguish the marks.

40. Visually, the marks overlap to the extent that each mark begins with the identical first eight letters 'EVERY BOD/Everybod'. However, the marks' endings are different; the letters '-ies' in the applicant's mark, and the letter 'Y' in the opponent's mark. In addition, the applicant's mark is presented as one word, whilst in the opponent's mark

the elements 'EVERY' and 'BODY' are separated. Consequently, I consider that the marks are visually similar to a high degree.

Aural similarity

41. Aurally, the marks are even closer because the sound of the letters '-ie' and the sound of the letter '-Y' are identical, so the only aural difference between the mark is effectively the final letter 's' in the applicant's mark. Consequently, I consider that the marks are visually similar to a very high degree.

Conceptual similarity

42. Conceptually, the applicant states that whilst it notes that the marks are conceptual similar, the general public are unlikely to see this as a significant factor when it comes to confusion although it did not explain why.

43. The word 'everybodies' in the applicant's mark is the plural form of the word 'EVERYBODY' which means *"every person; everyone".* Admittedly, a number of online dictionaries[5] refer to 'everybody' written as one word. Whilst the grammatically correct version of the word 'everybody' is with the elements 'every' and 'body' conjoined, I do not think that the average consumer will pay much attention to the fact that these elements are separated in the opponent's mark. Certainly, I do not think that the average consumer (or a significant number of them) will give the words 'EVERY BODY' in the opponent's mark a different meaning from the ordinary meaning of 'everybody' because 1) the average consumer is unlikely to engage in such a grammatically refined analysis of the opponent's mark and 2) separating the word 'everybody' in 'every body' does not create a well-known word which convey a different meaning capable of immediate grasp by the average consumer, so if the difference in the spelling is noted (which may not), it is likely to be perceived as a misspelling rather than a phrase having a different meaning. The fact that one word is in a singular form and the other is in a plural form does not alter the fact that the marks convey the same

[5] Cambridge and Collins online dictionaries

concept, namely that of a pronoun meaning “every person; everyone” and are conceptually similar to a high degree.

Distinctive character of earlier mark

44. 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).”

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

46. The opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider.

47. The earlier mark consists of the words 'EVERY BODY'. The mark might be understood as alluding to the fact that the goods are suitable for everyone. That said, the mark is not directly descriptive of the goods and, as a registered mark, it must be assumed to have a minimum degree of distinctiveness.[6] In my view the mark is distinctive to a low to medium degree.

Likelihood of confusion

48. 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 marks may be offset by a greater degree of similarity between the respective goods and services 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 services 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (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

[6] *Formula One Licensing BV v OHIM,* Case C-196/11P

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

50. Earlier in this decision I found that:

- Some of the applicant's goods are identical to the goods of the earlier mark, whilst others are similar to a medium degree;

- The average consumer would be a member of the general public who would pay a medium degree of attention during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;

- The marks are visually similar to a high degree, aurally similar to a very high degree and conceptually similar to a high degree;

- The earlier mark has a low to medium degree of inherent distinctive character.

51. Bearing in mind the principle of imperfect recollection, I consider that the marks are likely to be mistakenly recalled or misremembered one for the other. This is particularly so, given the high degree of visual and conceptual similarity between the marks and the even higher degree of aural similarity. The first eight letters of the marks are identical and the differences arising from the separation and between the endings, namely 'ies' and 'Y', are unlikely to be sufficient to distinguish between them. Given that consumers rarely have a chance to compare marks side by side, I am satisfied that the marks will be imperfectly recalled when identical goods are involved. There is sufficient visual, aural and conceptual commonality between the marks for consumers to directly confuse and mistake one mark for the other. Further, although I found that the earlier mark is distinctive to a degree that is less than medium (i.e. low to medium), the degree of distinctiveness is not so low that, combined with the small differences between the marks, would be sufficient to prevent the average consumer from being confused. I come to the same conclusion even for those goods that I found to be similar only to a medium. There is a likelihood of direct confusion.

CONCLUSIONS

52. The opposition has been successful. Subject to any appeal against my decision, the applicant's mark will be refused.

COSTS

53. The opponent has been successful, and ordinarily he would be entitled to an award of costs. As the opponent has not instructed professional representatives, it was invited by the Tribunal by email dated 6 June 2023 to indicate whether he intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities. The opponent was also provided with a cost proforma and given a deadline of 4 July 2023 to respond. However, as the opponent did not file a completed copy of the costs proforma before the deadline given, or indeed at all, I make no order as to costs.

Dated this 4th day of October 2023

Teresa Perks
For the Registrar