

O/1026/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION

NO. WO0000001606319 DESIGNATING THE UK

IN THE NAME OF

GOOD DESIGN AUSTRALIA PTY LTD

TO REGISTER THE TRADE MARK:



IN CLASSES 41 AND 42

AND

OPPOSITION THERETO UNDER NO. OP000432832

BY

THE CHICAGO ATHENAEUM MUSEUM

OF ARCHITECTURE AND DESIGN

Background and pleadings

1. Good Design Australia Pty Ltd (“the holder”) is the holder of the international registration (“the IR”) shown below. The IR was registered on 21 June 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR claims a priority date of 17 June 2021.



2. The holder seeks protection of the IR in relation to the following services:

Class 41 Arranging and organising competitions (for entertainment and education).

Class 42 Assessing industrial designs in respect of aspects relating to: quality, safety, efficiency, structural integrity, composition, utility, ingenuity, originality, digitisation, service optimisation, impacts on infrastructure, functionality, sustainability, the communication of information and data, and architectural design; advisory services relating to industrial design; providing information relating to industrial design.

3. The IR was published for opposition purposes on 21 January 2022 and The Chicago Athenaeum Museum of Architecture and Design (“the opponent”) opposes the IR on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In accordance with rule 20(3) of the Trade Marks Rules 2008 the opponent’s section 3(6) claim was deemed withdrawn due to no evidence having been filed.

4. The opponent relies upon the mark detailed below.

UK00003638317, filed on 7 May 2021, registered on 1 October 2021.



5. The opponent opposes all of the holder's services and is reliant upon all of its services as follows:

Class 35 Mail order services, computerised online retail store services and retail store services all featuring giftware, books, videos and apparel.

Class 41 Educational services, namely, providing incentives to product designers by the way of awards to demonstrate excellence in the field of consumer product design; conducting entertainment exhibitions in the nature of consumer product design competitions; sporting and cultural activities; museum services; conducting and hosting museum cultural events and rental of museum facilities for same; organisation of exhibitions and events for cultural and educational purposes; hosting and organising awards; organisation of competitions and awards.

6. In its notice of opposition, the opponent argues that the respective services are identical or similar and that the marks are similar.

7. The holder filed a Form TM8 and counterstatement denying the claims made.

8. The holder filed evidence which is summarised below.
9. The holder filed written submissions in lieu of a hearing. No submissions have been filed by the opponent.
10. The holder is represented by Barker Brettell LLP and the opponent is represented by FRKelly.

Evidence

11. The holder has filed evidence in the form of a witness statement from Martin Darbyshire, the founder and CEO of strategic design consultancy “tangerine”, signed and dated 30 March 2023, together with Exhibit MD1.
12. The holder has also filed evidence in the form of a witness statement from Brandon Gien, CEO of Good Design Australia, signed and dated 20 March 2023, together with Exhibits BG1 to BG5.

DECISION

13. Section 5(2)(b) of the Act reads as follows:

“5(2) 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.”

14. Section 5A of the Act reads 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.”

15. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark for the purposes of section 6 of the Act. Further, as the opponent’s earlier mark was registered less than five years before the priority date of the IR, proof of use is not relevant in these proceedings as per section 6A of the Act.

Section 5(2)(b) – case law

16. Although the UK has left the EU, section 6(3)(a) of the European (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.

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, 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 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 to mind the earlier mark, 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 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 the services

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, 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 are complementary.”

19. 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.

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

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

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

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

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

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

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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, 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 stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think 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 goods/services is to assess whether the relevant public are liable to believe that 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 Amalia 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.”

While 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.”

25. The services in question are as follows:

Opponent’s services	Holder’s services
<p><u>Class 35</u> Mail order services, computerised online retail store services and retail store services all featuring giftware, books, videos and apparel.</p>	
<p><u>Class 41</u> Educational services, namely, providing incentives to product designers by the way of awards to demonstrate</p>	<p><u>Class 41</u> Arranging and organising competitions (for entertainment and education).</p>

<p>excellence in the field of consumer product design; conducting entertainment exhibitions in the nature of consumer product design competitions; sporting and cultural activities; museum services; conducting and hosting museum cultural events and rental of museum facilities for same; organisation of exhibitions and events for cultural and educational purposes; hosting and organising awards; organisation of competitions and awards.</p>	
	<p><u>Class 42</u> Assessing industrial designs in respect of aspects relating to: quality, safety, efficiency, structural integrity, composition, utility, ingenuity, originality, digitisation, service optimisation, impacts on infrastructure, functionality, sustainability, the communication of information and data, and architectural design; advisory services relating to industrial design; providing information relating to industrial design.</p>

Class 41

26. “Arranging and organising competitions (for entertainment and education)” are *Meric* identical to the opponent’s “organisation of competitions and awards” in that the services designated by the holder are included in a more general category designated by the earlier mark.

Class 42

27. I compare “Assessing industrial designs in respect of aspects relating to: quality, safety, efficiency, structural integrity, composition, utility, ingenuity, originality, digitisation, service optimisation, impacts on infrastructure, functionality, sustainability, the communication of information and data, and architectural design” with the opponent’s “Educational services, namely, providing incentives to product designers by the way of awards to demonstrate excellence in the field of consumer product design”.
28. In respect of the holder’s service, assessments of industrial designs are carried out against various criteria such as quality, safety, and so on.
29. In respect of the opponent’s service, use of the word “namely” in specifications is taken to be a limitation such that the service in question is limited specifically to the provision of awards in the field of consumer product design. This service is offered with the intention of incentivising product designers – giving them the goal of winning an award that represents excellence in their field.
30. Considering the two services at issue, both involve utilising design expertise, but the holder’s service is an assessment service and the opponent’s service is an awards service, and so they have different purposes. In the former case, an industrial designer will commission the holder to produce a tailored report on the quality of their design. In the latter case, a product designer will pay a fee to the opponent to enter a competitive process whereby their design is considered for an award. As such, the way the average consumer interacts with the respective services is different.
31. The parties have not provided submissions or evidence as to the definitions of industrial design and product design. However, it is apparent that both are design disciplines. Consequently, the services can be said to be aimed at the same user base – designers – and are operating in the same field of activity. Therefore, the trade channels will converge. Both involve the same skill set and so in theory could be offered by the same undertaking.

However, because both can be carried out independently of each other, they are not strictly complementary. The services are not in competition. Overall, I consider the respective services to be of medium similarity.

32. I compare the holder's "advisory services relating to industrial design" and "providing information relating to industrial design" with the opponent's awards service. While the services differ in nature, purpose, and method of use, they centre around a shared topic – design. The trade channels will overlap: a business that provides awards in the field of product design may also offer advisory or information services in relation to industrial design and will have the relevant expertise to provide all the services at issue. The services are not strictly complementary, nor are they in competition. Overall, I find these services to be of medium similarity.

33. No other of the opponent's services put it a stronger position than those that I have used as comparators.

The average consumer and the nature of the purchasing act

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services 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 was then) described the average consumer in these terms:

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

35. The competing services are competitions, awards for design, and the provision of design-related assessments, advice and information. During the purchasing process, the typical consumer, a designer, would scrutinise the entry criteria or the particulars of the service offered. Costs could range from relatively small to quite high, but they would not generally be extremely high. Overall, the level of attention paid would be of a medium level.
36. The purchasing process would be primarily visual, with details of the services being set out on web pages or in brochures. Verbal factors would play a minor role but may involve such things as follow up questions of the service providers.

Comparison of the trade marks

37. 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.”

38. 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.

39. The respective marks are shown below.

Opponent's trade mark	The IR
	

40. The IR is a figurative mark made up of a black-and-white device, a three-word phrase and an informative strapline. The device will be seen by a significant proportion of average consumers as the letter “D” with a tick inside and by another significant proportion of average consumers as just a geometric shape with a tick inside. The three-word phrase “GOOD DESIGN AWARD” is next to the device, the words being in large block capitals in a column. The strapline “AWARDED BY GOOD DESIGN AUSTRALIA” is in smaller words running along the bottom of the mark. The eye is naturally drawn to the three-word phrase because it can be read and so, while the device is marginally taller, the three-word phrase plays a bigger part in forming the overall impression of the IR. The strapline can also be read, but this factor is offset by the size of the words such that it plays a slightly lesser role in the overall impression compared with the three-word phrase and the device.

41. The opponent's mark is a figurative mark, featuring the words “GOOD DESIGN” in white block capitals on a black circle which is inside a brown

square. The words in the mark are placed one above the other. The shapes and the colours make a minor contribution to the overall impression formed by the mark, the words being the dominant element.

42. Visually, both marks feature geometric shapes, albeit they are different shapes, and there is a tick present in the IR and a colour present in the opponent's mark. There is an extra word in the three-word phrase in the IR and three additional words in the applicant's five-word strapline, but the words "GOOD DESIGN" in the opponent's mark are wholly contained within the phrase and the strapline. Overall, I find the marks to be of medium visual similarity.

43. Aurally, none of the figurative elements would be articulated (including where the device was seen as a "D"). Both marks begin identically as "GOOD DE-ZINE...". However, the IR continues as "... AH-WARDZ. On this basis, the respective marks are of medium aural similarity. The IR also has the strapline, "AH-WARD-ED BY GOOD DE-ZINE OSS-TRAY-LEEAH". If that was voiced, the marks would be of low similarity.

44. Both marks share the principal concept of good design. The IR also gives rise to thoughts of an award in the field of good design and a body based in Australia. The tick in the IR reinforces the word "GOOD". For those average consumers that see a "D" in the IR's device, this simply reinforces the letter "D" in the word "DESIGN". I find the marks to be of medium conceptual similarity.

Distinctive character of the earlier mark

45. 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 *Windsurfing Chiemsee 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).”

46. Registered trade marks possess varying 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.

47. The words in the earlier mark are “GOOD DESIGN”. The following of the opponent’s Class 41 services – its “educational services ...”, “conducting entertainment exhibitions ...”, “organisation of exhibitions and events for cultural and educational purposes; hosting and organising awards; organisation of competitions and awards – I find the mark to be of low inherent distinctive character. This is because these services either reference the word “design” or strongly allude to what these services are for. For the remaining Class 41 services and the Class 35 services, which are not suggestive of the mark, I find it to be of medium inherent distinctive character.

48. I do not consider the shapes the words sit inside to materially add to the distinctiveness of the mark, given that they act as decorative borders/backgrounds for the words, but, in any event, I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks¹, the words "GOOD DESIGN". I confirm that the words alone are inherently distinctive to a low degree for those of the opponent's services detailed above and to a medium degree for the remaining services.

Likelihood of confusion

49. 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 services 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the 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 trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

50. I have found the parties' marks to be of medium visual similarity, of medium aural similarity (or of low aural similarity if the strapline was voiced), and of medium conceptual similarity. I have found the services to be identical or of medium similarity. The typical consumer for the services would be a

¹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

designer who would pay a medium level of attention. The purchasing process would be primarily visual, with verbal factors playing a minor role. The earlier mark is inherently distinctive to a low degree for the opponent's services which are listed at paragraph 47 and to a medium degree for the remaining services.

51. Both marks feature the words "GOOD DESIGN". Both marks also feature relatively unremarkable geometric shapes, albeit they are different shapes. The IR also features a conceptually reinforcing tick and, for some, a conceptually reinforcing letter "D", but the concept that they reinforce is present in both marks, that of good design.

52. What is most significant is that the IR has an additional word in the three-word phrase and an additional three words in the five-word strapline. It is these latter differences that would be noticed by the average consumer and so there is no likelihood of direct confusion in this case.

53. Indirect confusion was described in the following terms by Iain Purvis Q.C., 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 recognised 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.”

54. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is

qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

55. I also remind myself of *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.

56. The earlier mark is of a medium level of distinctiveness for some services, but there are instances where its services render the mark of low distinctiveness. For this reason, I also take note of *L'Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU considered whether a low level of distinctiveness held in an earlier mark will preclude a likelihood of confusion. In this case, the CJEU stated that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or

similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

57. While, as in *Duebros*, I acknowledge that the presence of a common element is not determinative of a likelihood of indirect confusion, equally, as in *L’Oréal*, it cannot be assumed that low distinctiveness on the part of an earlier mark precludes a finding of indirect confusion.

58. I also consider *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, where Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHCW 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(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.”

59. In this case, while the common element between the marks could be considered lowly distinctive, the non-coinciding elements of the marks are of an equally low degree of distinctiveness, or their visual impact is of limited significance.

60. I also take account of *L.A. Sugar* where Iain Purvis Q.C. listed examples of where indirect confusion may be found:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] 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).”

61. Considering the above examples, the respective marks in the case at hand broadly fit with the scenario outlined in example (b) whereby the additional words in the IR are low in distinctiveness and are indicative of a brand extension.

62. While the respective marks feature different shapes, these are not so different that they detract from the average consumer viewing the IR as a brand extension of the opponent’s mark. Furthermore, the conceptually reinforcing tick and, for some, a conceptually reinforcing letter “D” in the IR, simply serve to strengthen the concept that is also present in the opponent’s mark, that of good design.

63. The IR is a plausible brand extension of the opponent’s mark. The average consumer could see the opponent’s mark as a badge of quality issued by an organisation concerned with good design and the IR as a brand extension whereby the Australian branch of that organisation has established a good design awards scheme. They would not see the presence of the words “GOOD DESIGN” as a coincidence. Rather, they would see the common words as indicative of an economic connection – that the two marks belong to the same or related undertakings. There is therefore a likelihood of indirect confusion for all the services at issue, whether I have found them to be identical or of medium similarity.

Evidence put forward by the holder

64. The holder filed evidence with a view to demonstrating that the respective marks would be readily differentiated one from the other and that the marks have existed/could exist on the market without there being a likelihood of confusion.

65. Martin Darbyshire, in his witness statement, says the following: "I am aware of the various GOOD DESIGN awards, and entities, and readily differentiate them from each other, despite the common element "GOOD DESIGN". I consider the element "GOOD DESIGN" to be descriptive.

I am aware of the trade mark identified in Exhibit MD1, which is the trade mark of Good Design Australia Pty Ltd [the IR]. This trade mark is synonymous with Good Design Australia Pty Ltd. and in my view, in the UK, would not be confused or associated with any other entity."

66. Mr Darbyshire's statement comes from someone who has in-depth experience of the design industry around the world, has sat on boards, and has been a juror at design awards. As such, his experience is not that of the average consumer (an ordinary designer who does not sit on boards or awards committees, but who peruses design publications and websites) and so this evidence is of limited value.

67. Brandon Gien's witness statement is more detailed. As the CEO of the holder, he sets out the history of Good Design Australia and its predecessors. He then goes on to comment: "There are various GOOD DESIGN awards that take place overseas and are run by various local entities, such as, for example, the Japan GOOD DESIGN awards (run by the Japan Institute of Design Promotion), Singapore GOOD DESIGN awards (run by the Design Business Chamber Singapore - DBCS), South Korean GOOD DESIGN awards (run by the Korean Institute of Design Promotion - KIDP). Details of these various GOOD DESIGN awards and various local entities are attached at **Exhibit BG2**. Good Design Australia works in

collaboration with many other overseas 'Good Design' organisations, and they currently have an extremely collegial relationship.”

68. Mr Gien further states that: “The trade mark applied for predominantly displays the words AWARDED BY GOOD DESIGN AUSTRALIA to differentiate it from the logos of other GOOD DESIGN establishments – both in promotional material and when used by recipients of the awards (with some entities receiving GOOD DESIGN awards from various international institutes).”
69. While I do not doubt the existence of separate organisations that are focused on good design, that does not preclude the possibility that the average consumer would encounter the marks at issue and conclude that they belong to the same or related undertakings.
70. Mr Gien then states that, “From 2011 onwards, Good Design Australia has promoted its GOOD DESIGN awards in the UK”. He exhibits “Design Award” yearbooks from 2011 to 2015 (Exhibit BG4) and refers to the records of Good Design Australia which show the number of UK entrants and winners “who have used or are aware of the GOOD DESIGN trade mark”. However, the numbers are very small – the number of UK entrants ranging from 4 to 17 and the number of winners ranging from 2 to 9 in the years between 2011 and 2022. In any event, the mark evidenced is not the mark at issue in this case.
71. Mr Gien says that “I believe that the trade mark applied for is distinguishable from the Opponent’s trade mark. There is no scope for confusion in the UK market and indeed as far as I am aware, there has been no confusion. I believe that the respective trade marks can coexist in the market without issue.” However, no specific evidence has been filed of the applied-for mark in use on the market such that a view can be taken on whether there can be said to be concurrent use which points away from a finding of a likelihood of confusion.

72. Mr Gien argues that “The words GOOD DESIGN, as elements within the trade mark applied for, and more generally as dictionary defined words, are entirely descriptive. The words inherently describe and refer to both the quality of manufacture and design, as well as the potential contribution that a product gives to both industry and society. The words GOOD DESIGN also describe a characteristic of the award and offerings.” He exhibits examples of the descriptive use of the words “good design” in the UK (Exhibit BG5) such as dictionary definitions and magazine articles.

73. Both witnesses have put forward their view that the common element “GOOD DESIGN” is descriptive. I have considered the question of the common element in my decision and have concluded that it could be considered lowly distinctive. I am satisfied that I have taken appropriate account of this factor in my multi-factorial analysis.

74. In summary, I do not regard the witness statements and evidence furnished by the holder to be sufficient to set aside my notional assessment of the marks and the services – that there is a likelihood of indirect confusion in this case.

CONCLUSION

75. Subject to any appeal, the opponent has been wholly successful, and the IR may not become protected in the UK.

COSTS

76. As the opponent has been successful, I award costs accordingly in line with Annex A of Tribunal Practice Notice 2 of 2016:

Official fees:	£100 ²
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² The official fee paid at the time of filing the opposition was £200. However, the opponent’s section 3(6) claim was subsequently deemed withdrawn.

Preparing a statement	
and considering the other side's statement:	£200
Considering the other side's evidence:	£500
Total:	£800

77. I order Good Design Australia Pty Ltd to pay The Chicago Athenaeum Museum of Architecture and Design the sum of £800. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of November 2023

JOHN WILLIAMS

For the Registrar