O/1196/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003856075

BY BRASS MONKEY HEALTH LTD

TO REGISTER THE TRADE MARK:

BRASS MONKEY

IN CLASSES 11, 24, 25 AND 37

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002806

BY BRASS MONKEY HOLDING LIMITED

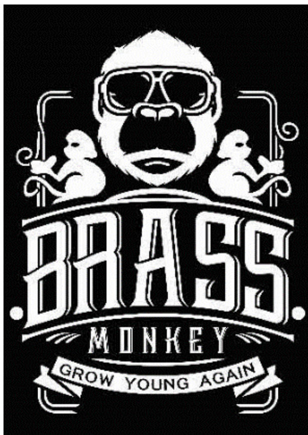
BACKGROUND AND PLEADINGS

1. On 5 December 2022, Brass Monkey Health 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 the 20 January 2023.

2. The application was partially opposed by BRASS MONKEY HOLDING LIMITED ("the opponent") on 20 March 2023. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against the following goods of the application:

Class 25	Clothing; headgear; footwear; hats; beanies; socks; shawls; underwear; skirts; shirts; pullovers; belts [clothing]; jackets; swim suits; sweaters; trousers; jeans; shorts; swimwear; bikinis; beach wraps; scarves; coats; bath robes; bathing suits; sports clothing; headgear for wear; wraps [clothing]; trainers; sneakers; hoodies.

3. Under section 5(2)(b), the opponent relies upon the following trade mark:



UK registration no. UK00003753182.
Filing date 10 February 2022.
Registration date 8 July 2022.

4. The opponent relies upon some of the goods for which its earlier mark is registered, namely:

Class 25 Clothing; footwear; headgear; aprons (clothing); ascots; bandanas (neckerchiefs); beach clothes; beach shoes; berets; bibs, not of paper; caps (headwear); clothing of imitations of leather; clothing of leather; coats; dresses; dressing gowns; fishing vests; football boots and football shoes; gymnastic shoes; half-boots; hat frames (skeletons); hats; headbands (clothing); hoods (clothing); jackets (clothing); jerseys (clothing); jumper dresses; knitwear (clothing); leggings (leg warmers); leggings (trousers); liveries; maniples; mantillas; masquerade costumes; motorists' clothing; muffs (clothing); neckties; pants; sandals; scarfs/scarves; shawls; shirt fronts; shirt yokes; shirts; shoes; short-sleeve shirts; shoulder wraps; skirts; skull caps; sleep masks; slippers; sports jerseys; sports shoes; suits; suspenders and braces; sweaters; teddies (undergarments); tee-shirts; tights; tips for footwear; top hats; underclothing and underwear; underpants; uniforms; waistcoats.

5. The opponent claims that "there is a likelihood of confusion because the marks are highly similar and the goods are identical".

6. The applicant filed a counterstatement denying the claims made.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

8. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions.

9. No leave was sought to file any evidence in respect of these proceedings.

10. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings

requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

11. The opponent is represented by Beck Greener LLP, and the applicant is represented by Mohun Aldridge Sykes Limited. A hearing was neither requested nor considered necessary, however, both the applicant and the opponent filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied 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

13. Section 5(2)(b) 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. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

15. 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

16. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 25 Clothing; footwear; headgear; aprons (clothing); ascots; bandanas (neckerchiefs); beach clothes; beach shoes; berets; bibs, not of paper; caps (headwear); clothing of imitations of	Class 25 Clothing; headgear; footwear; hats; beanies; socks; shawls; underwear; skirts; shirts; pullovers; belts [clothing]; jackets; swim suits; sweaters; trousers; jeans; shorts; swimwear; bikinis; beach

leather; clothing of leather; coats; dresses; dressing gowns; fishing vests; football boots and football shoes; gymnastic shoes; half-boots; hat frames (skeletons); hats; headbands (clothing); hoods (clothing); jackets (clothing); jerseys (clothing); jumper dresses; knitwear (clothing); leggings (leg warmers); leggings (trousers); liveries; maniples; mantillas; masquerade costumes; motorists' clothing; muffs (clothing); neckties; pants; sandals; scarfs/scarves; shawls; shirt fronts; shirt yokes; shirts; shoes; short-sleeve shirts; shoulder wraps; skirts; skull caps; sleep masks; slippers; sports jerseys; sports shoes; suits; suspenders and braces; sweaters; teddies (undergarments); tee-shirts; tights; tips for footwear; top hats; underclothing and underwear; underpants; uniforms; waistcoats.	wraps; scarves; coats; bath robes; bathing suits; sports clothing; headgear for wear; wraps [clothing]; trainers; sneakers; hoodies.

17. 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 for Lernsysterne 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."

18."Clothing, headgear, footwear" in the applicant's specification is self-evidently identical to "clothing", "footwear" and "headgear" in the opponent's specification.

19. I consider that the remaining goods in the applicant's specification fall within the broader categories of "clothing; footwear; headgear" in the opponent's specification. I consider that these goods are identical on the principle outlined in *Meric*.

20. For the sake of completeness, in the applicant's submissions in lieu, I note that they state that "swim suits", "belts", "wraps", and "bathrobes" are not always considered by the average consumer to be "clothing". "Therefore, some of the goods may be considered similar and, as the opponent has opposed the present application on the basis of the goods only being identical, those goods are outside the scope of the opposition". However, the opponent clearly also has the terms "beach clothes", "shawls" and "dressing gowns" which I consider to be *Meric* identical, or self-evidently identical to the applicant's "swim suits", "wraps", and "bathrobes". For the term "belts", I note that specifically the applicant has applied for the term "belts [clothing]" and therefore these goods clearly fall within the opponent's broader term of "clothing". Therefore, nothing turns on this point.

The average consumer and the nature of the purchasing act

21. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

22. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as aesthetics, durability, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

23. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet their online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. However, given that advice may be sought from retail assistants, I do not discount an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

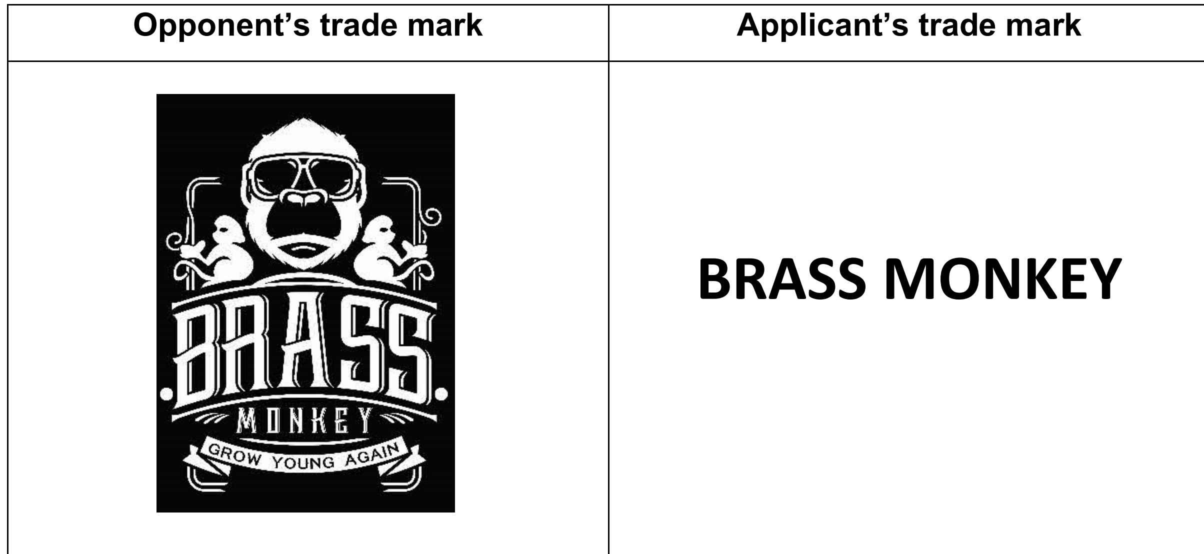
24. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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."

25. 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.

26. The respective trade marks are shown below:



Opponent's trade mark	Applicant's trade mark
	BRASS MONKEY

27. The opponent's mark is comprised of the biggest word element, "BRASS", presented in a slightly stylised, capitalised, white typeface, in the centre of the mark, which is also encased in two lines and has a dot either side of it. Underneath, in a smaller white slightly stylised capitalised typeface, is the word "MONKEY", which also underneath has the strapline "GROW YOUNG AGAIN" in an even smaller typeface, presented in white banner device. Above the word "BRASS" is a white and black monkey face device, which is wearing glasses, facing forwards. Besides this are two white silhouette monkey devices on either side, one facing the left, and the other facing the right, both of which are holding a curved double line element. I note that all of these elements are presented on a rectangular black background. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the monkey face device wearing the glasses, which is at the beginning of the mark, I consider that it plays an equally dominant role in the overall impression as the words "BRASS" and "MONKEY" which are the largest word elements of the mark. I consider that the strapline, due to its reduced size and position, plays a much lesser role in the overall impression of the mark, with the smaller silhouette monkeys, black background and typeface stylisation also playing a lesser role.

28. The applicant's mark is comprised of two ordinary dictionary words; BRASS MONKEY. I consider that the overall impression of the mark lies in the combination of these elements.

29. Visually, the applicant's word mark, "BRASS MONKEY", is fully replicated in the opponent's mark. This acts as a visual point of similarity. However, I note that the wording "BRASS MONKEY" in the opponent's mark is presented in slightly stylised typeface. The opponent's mark also contains additional elements including the monkey devices at the top of the mark, the strapline "GROW YOUNG AGAIN" presented in a banner device and the rectangular black background. These all act as visual points of difference, albeit I note that apart from the sunglasses monkey device, these elements all play a lesser role in the overall impression and therefore I consider that the marks are visually similar to a medium degree.

30. Aurally, the marks overlap in the pronunciation of the ordinary dictionary words "BRASS" and "MONKEY". I note that the three monkey devices in the opponent's mark will not be articulated. I also consider it unlikely that a significant proportion of consumers would articulate "GROW YOUNG AGAIN" because it acts as a strapline. I therefore consider that the marks are aurally identical.

31. However, if the strapline were to be pronounced, it would serve to reduce the aural similarities, resulting in at least a medium degree of aural similarity.

32. Conceptually, both marks share the concept of "BRASS MONKEY", which is composed of two ordinary dictionary words. As a whole, I consider that the average consumer would understand the words together to mean a monkey made of brass. The three monkey devices in the opponent's mark reinforces the concept of "monkey". The opponent's mark also includes the strapline "GROW YOUNG AGAIN", the concept of which is self-evident, and is neither allusive nor descriptive of the goods. Therefore, taking all of the above into account, I consider that the marks are conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

33. *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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

34. 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, 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 that has been made of it.

35. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

36. As highlighted above, the opponent's mark consists of three monkey devices, with the ordinary dictionary words "BRASS MONKEY" underneath, and the strapline

"GROW YOUNG AGAIN" at the bottom of the mark presented in a slightly stylised white typeface on a rectangular black background. The concept evoked by the mark is a monkey made of brass, and the idea of "growing young again". The mark as a whole is neither allusive nor descriptive of the opponent's class 25 goods. On this basis, I consider that the mark is inherently distinctive to a medium degree.

Likelihood of confusion

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

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

- I have found the marks to be visually similar to a medium degree.
- I have found the marks to be identical, or to at least a medium degree, depending on how the opponent's is pronounced
- I have found the marks to be conceptually similar between a medium and high degree.
- I have found the opponent's mark to be inherently distinctive to a medium degree for the goods relied upon.

- I have identified the average consumer to be members of the general public who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

39. Taking all of the factors listed in paragraph 38 into account, considering the principle of imperfect recollection, and bearing in mind that the applicant's mark (BRASS MONKEY) is fully contained in the opponent's mark, I consider that there is a likelihood of direct confusion. This is particularly the case given that the marks are visually similar to between a medium and high degree and the predominantly visual purchasing process. Even where aural considerations play a greater role, the aural identity (or at least a medium degree of aural similarity) between the marks will have the same result. The only differing elements between the marks are the three monkey devices, the strapline "GROW YOUNG AGAIN", the black rectangular background and the stylized typefaces in the opponent's mark. However, I consider that these elements could be easily overlooked by the average consumer. The monkey devices reinforce the concept of the word MONKEY, and the strapline, stylization and background play a lesser role in the overall impression of the mark. Consequently, I consider there to be a likelihood of direct confusion.

40. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., 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 will likely be mistaken as a parent brand of the owner of the earlier mark."

41. 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.

42. I note that the use of sub- brands and brand extensions are common in the clothing trade. The GC stated, in *Zero Industry Sri v OHIM*, Case T-400/06, at paragraph 81:

> " ... it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another.

43. Therefore, taking all of the above into account, I consider that the shared common use of the words "BRASS MONKEY" in both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the monkey devices, which reinforces the concept of "monkey", the strapline "GROW YOUNG AGAIN" and the background device in the opponent's mark as stylistic elements and will perceive it as either an updated version of the same mark, and therefore indicative of re-branding, or a sub-brand mark. For example, the word mark might be only used in the body of promotional materials whereas the composite mark might be used on a store

front or employee uniforms. Therefore, I consider there to be a likelihood of indirect confusion.

CONCLUSION

44. The partial opposition is successful in its entirety in respect of the following goods, for which the application is refused:

Class 25 Clothing; headgear; footwear; hats; beanies; socks; shawls; underwear; skirts; shirts; pullovers; belts [clothing]; jackets; swim suits; sweaters; trousers; jeans; shorts; swimwear; bikinis; beach wraps; scarves; coats; bath robes; bathing suits; sports clothing; headgear for wear; wraps [clothing]; trainers; sneakers; hoodies.

45. The application can proceed to registration in respect of the following goods and services for which the opposition was not directed against:

Class 11 Ice makers; Ice machines and apparatus; Water cooling apparatus; Refrigeration units; Cooling appliances and installations; Combination apparatus for cooling and freezing; Cooling installations for freezing; Freezer installations; Freezers; baths for immersion of humans or animals; ice baths; cooling installations for baths; baths; cold water baths; heating and cooling apparatus and installations.

Class 24 Beach towels; towels of textiles; hand towels; make-up removal towels [textile] other than impregnated with cosmetics; face towels; bath towels; bath linen; towels.

Class 37 Installation of heating and cooling apparatus; Advisory services relating to the installation of heating and cooling apparatus; Maintenance and repair of heating and cooling appliances and installations; Maintenance and repair of ice bath appliances and installations.

COSTS

46. Award of costs in fast track proceedings are governed by TPN 1/2023. The opponent has been successful and is entitled to a contribution towards its costs.

47. I note that in the applicant's submissions it is stated that "the Opponent did not notify the Applicant of their intention to oppose the present application prior to filing the opposition, even if the opposition is successful, or partially successful, the Opponent should not be entitled to an award of costs."

48. I refer to Tribunal Practice Notice (TPN 6/2008) which states that:

> *"3. As from 3 December 2007, costs are not usually awarded against rights holders or applicants who do not defend an action brought without prior notice.*
>
> *6. Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs."*

49. Therefore, in the circumstances, I award the opponent the sum of **£550** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's Counterstatement	£250
Filing submissions	£200
Official Fee	£100
Total	**£550**

50. I therefore order Brass Monkey Health Ltd to pay BRASS MONKEY HOLDING LIMITED the sum of £550. This sum is to be paid within 21 days of the expiry of the

appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of December 2023

J MANCA
For the Registrar