O/132/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION
No. 3297463 QUIN
BY QUEENIE CHAN

AND

IN THE MATTER OF
OPPOSITION No. 413045
THERETO BY
KAST SERVICES LIMITED

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO O-411-20
OF MR. C. J. BOWEN DATED
27 AUGUST 2020

Ms. Stephanie Wickenden of Counsel, instructed
by Murgitroyd & Co, appeared for the Opponent/Appellant

Mr. Aaron Wood, Chartered Trade Mark Attorney of
Blaser Mills Law, appeared for the Respondent/Applicant

Hearing date: 26th November 2020

DECISION

Introduction

1. This is an appeal against a decision of Mr C J Bowen, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 27th August 2020. By that decision the Hearing Officer rejected Opposition No. 413045 brought by Kast Services Limited ("the Opponent") in its entirely. He ordered the Opponent to pay to Queenie Chan ("the Applicant") £1800 as a contribution towards costs.

2. The Applicant filed an application to register:

QUIN

on 16th March 2018. The application covered the following goods and services:

Class 16
Paper products, namely stationery, prints, books, magazines, cards, diaries, newsletters, catalogues, booklets, leaflets, flyers, promotional cards, newspapers, brochures, leaflets, posters, photographs; stationery.

Class 18
Leather products, namely leather handbags, leather wallets, leather coin bags, leather shoes and leather accessories therefor.

Class 25
Clothing and clothing accessories.

Class 35
Business management in the field of fashion business; professional consultation in the field of fashion business.

3. The Opponent filed a Notice of Opposition on 10th July 2018. The opposition was based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. Under sections 5 (2) (b) and 5 (3) the Opponent relied on the following earlier trade marks:

a) UK Registration No. 1542042 QUIZ/QUIZZ (series of 2) dated 15th July 1993 covering:

Class 25
Articles of outerclothing; articles of leisure clothing; shirts; T-shirts; all included in Class 25.

b) UK Registration No. 2585713 QUIZ ("the 713 mark") dated 24th June 2011 covering:

Class 14
Jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps.

Class 18
Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks; purses, wallets, key cases, pouches; canes, sticks, saddlery, belts.

Class 25
Clothing, footwear, headgear.

Class 35
The bringing together, for the benefit of others, of clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, bracelets, brooches, cufflinks, medals, ornaments, shoe

ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps; leather and imitations of leather, and goods made of these materials, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery, belts, enabling customers to conveniently view and purchase those goods; retail services in the fields of clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps, leather and imitations of leather, and goods made of these materials, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery, and belts.

c) EU Registration No. 8804874 QUIZ dated 12th January 2010 covering:

Class 14
Jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps.

Class 18
Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks; purses, wallets, key cases, pouches; canes, sticks, saddlery, belts.

Class 25
Clothing, footwear, headgear.

Class 35
The bringing together, for the benefit of others, of jewellery, leather goods and clothing (excluding transport thereof), enabling customers to conveniently view and purchase those goods; retail services in the fields of jewellery, leather goods and clothing.

5. The opposition under S. 5 (4) (a) of the Act relied on the claimed use of the trade mark QUIZ throughout the UK since 1993 in respect of:

Jewellery, precious stones, watches, clocks, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; bracelets, brooches, cufflinks, medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips, watch straps.

Leather and imitations of leather, and goods made of these materials and not included in other classes; bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation

leather, handbags, garment bags, haversacks, rucksacks, trunks; purses, wallets, key cases, pouches; canes, sticks, saddlery, belts.

Clothing, footwear, headgear.

The bringing together, for the benefit of others, of jewellery, leather goods and clothing (excluding transport thereof), enabling customers to conveniently view and purchase those goods; retail services in the fields of jewellery, leather goods and clothing.

6. The Applicant duly filed a Form TM8 and Counterstatement. In the Counterstatement the Applicant:

    a. Being apparently aware of actual use of the trade mark QUIZ by the Opponent in relation to class 25 goods, opted – perfectly reasonably – not to put the Opponent to "proof of use", as would otherwise have been her right under S. 6A of the Act.

    b. Under S. 5 (2) (b):

        i. admitted identity of goods in class 25 in respect of the Opponent's EU registration No. 8804874 and UK registration No. 2585713.

        ii. conceded a "low level of similarity" as regards the class 35 services covered by those earlier marks and the goods of the application.

    c. Under S. 5 (4) (a), admitted that the earlier mark QUIZ had been used by the Opponent in relation to clothing, headwear and footwear, and the retail of the same.

7. In all other respects the grounds of opposition were denied by the Applicant, although in its subsequent written submissions identity/similarity as to class 18 was also conceded.

8. Both parties filed evidence. Both parties filed written submissions in lieu of a hearing, the Decision therefore being reached "on the papers".

The Hearing Officer's Decision

9. In summary, the Hearing Officer held as follows:

    S. 5 (2) (b)

    a. The Opponent's best case was on the 713 mark, being that which afforded the widest protection to the Opponent [16].

    b. The Hearing Officer referred to the usual summary of applicable principles gleaned from the case law of the Court of Justice of the European Union [14]. That he did so correctly is not in dispute

    c. For the purpose of comparing goods/services, notwithstanding the Applicant's submissions, in the interests of "procedural economy" he would proceed "on the basis

most favourable to the opponent i.e., that all of the goods and services…are identical" [17]. No issue was taken with that on appeal, although for myself I have reservations about whether it is principled to proceed in this way and I shall return to it later in this decision.

d. As to the average consumer this would be a member of the general public and, in relation to the Applicant's class 35 services, a business user. The goods would typically be obtained by self-selection in retail outlets, from websites or catalogues, and the services from street signage or on-line searches. Visual considerations would be dominant but aural considerations could not be ignored. The degree of attention/care displayed by average consumers would be medium for classes 18/25, medium for a member of the public selecting class 35 services with business users paying a higher degree of attention for them, and for class 16 the level of attention paid would be "somewhat lower" [19].

e. The Opponent's QUIZ mark was a word which together with its meaning would be well-known to the average consumer. Its overall impression and distinctiveness lay in that word [22].

f. The overall impression and distinctiveness of the Applicant's mark was similarly derived from it as a single word, the stylisation being slight and unremarkable [23].

g. Visually, the first three letters of each mark were identical but the final letters were different bearing "no visual similarity to each other" such that there was "at least" a medium degree of visual similarity [24].

h. Aurally, although the endings of the marks differed, the similar pronunciation of the first parts resulted in at least medium aural similarity [25].

i. Conceptually QUIZ was conceptually very familiar to the average consumer [26] but QUIN would evoke either a different concept or none at all [28].

j. QUIZ had at least a medium degree of inherent distinctive character [31] and, for the sake of "procedural economy" and despite the Applicant's submissions, the Hearing Officer assumed it had become highly distinctive though use [32] (again, a point to which I shall return).

k. The "very clear conceptual message sent by the opponent's trade mark is…sufficient to counteract the visual and aural similarities between the competing trade marks" and there was no risk of direct confusion [38].

l. Given the clear conceptual message of the opponent's trade mark, there was no reason a consumer would assume the parties' marks were connected simply because they shared the same first three letters. There was no likelihood of indirect confusion. The S. 5 (2) (b) claim accordingly failed [41-42].

S. 5 (3)

Notwithstanding the Applicant's criticisms of the Opponent's evidence, the Hearing Officer proceeded, yet again, on the basis the qualifying reputation had been made out.

Nevertheless, the conceptual "hook" of the Opponent's mark was sufficient to avoid the establishment of the necessary "link", resulting in the failure of the S. 5 (3) ground of opposition [46].

S. 5 (4) (a)

Whilst assuming goodwill/reputation on the part of the Opponent, given his findings under S. 5 (2) (b) as to the lack of a likelihood of direct or indirect confusion, the Hearing Officer similarly concluded that there would be no misrepresentation. The S. 5 (4) (a) ground of opposition accordingly failed [50-51].

Costs

a. Having accepted, to some degree, the Applicant's criticisms of the Opponent's evidence and the way it ran its case under S. 5 (3), the Hearing Officer awarded the Applicant costs of £1800.

The Appeal

10. Pursuant to S. 76 of the Act, the Opponent filed a Notice of Appeal to the Appointed Person dated 24th September 2020.

11. The Grounds of Appeal, (which implicitly accept the Hearing Officer's decision to assess the matter only on the basis of the 713 Mark) were as follows:

a. **Ground 1**: The Hearing Officer erred in his assessment of the visual similarity between the Contested Marks and the 713 Mark. He should have held that there was a high degree of visual similarity.

b. **Ground 2**: The Hearing officer failed to properly consider the likelihood of confusion from the perspective of the average consumer, including a complete failure to consider how the marks would be used on the 18/25 Goods. Had the Hearing Officer not so erred, he should have found that there was a likelihood of direct confusion with the 713 Mark and the 18/25 Goods.·

c. **Ground 3**: The Hearing Officer incorrectly applied the law when considering the interrelation between visual, aural and conceptual similarity and its effect on the assessment of a likelihood of confusion under section 5(2)(b) of the Act. Had the Hearing Officer not so erred, he should have found that there was a likelihood of direct confusion with the 713 Mark and the 18/25 Goods.

d. **Ground 4**: The Hearing Officer incorrectly applied the law when considering the interrelation between visual, aural and conceptual similarity and its effect on whether the average consumer would draw a link between the marks as required by section 5(3) of the Act. Had the Hearing Officer not so erred, he should have found that the consumer would from such a link between the Contested Mark and the Earlier Marks, and that the use of the Contested Mark (for all of the goods applied for) would take unfair advantage of and/ or be detrimental to the distinctive character of the Earlier Marks.

12. There was no appeal against the Hearing Officer's dismissal of the Opponent's case under S. 5 (4) (a) of the Act.

13. In response, the Respondent filed "Initial Submissions to Appeal", apparently with a view to persuading the Appellant to withdraw the appeal, but it was expressly stated that this document was not to be taken as a Respondent's Notice.

Standard of Review

14. There was no dispute as to the principles and standard to be applied. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. In order to intervene I must be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong - *Reef Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 at [78] to [81].

15. I must be especially cautious about interfering with value judgments: *Actavis* (above) at [80]:

"What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible".

16. In particular, as to findings of fact, in *Fage UK Ltd v. Chobani UK Ltd* [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] Lewison LJ said:

"114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them".

17. In the same case, regarding the first instance judge's duty to "give reasons" for his decision, Lewison LJ also said at [115]

. . . 115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view,

not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations…"

18. To this can be added the observations of Mr Iain Purvis QC observed in *ROCHESTER Trade Mark*, BL O/049/17, paragraph 33:

"… the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence ….

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

19. I bear these principles in mind.

Decision

20. The first three grounds of appeal concern S. 5 (2) (b).

Ground 1

21. The first ground of appeal, as helpfully summarised by Ms Wickenden, was that the Hearing Officer erred in his assessment of visual similarity and made an obvious error in holding that there was no similarity between the letter "Z" and the letter "N". In her submission, this was simply incorrect. Since the finding of "no similarity" between those letters led to the determination that the marks were, overall, at least similar to a medium degree, if the terminal letters were in fact similar to any degree the overall similarity of the marks should be raised to "high".

22. At first instance the Opponent had argued:

"*Visually, the marks are highly similar. They are both short words, each only composed of four letters, three of which are identical.* ***The final letter is visually essentially the same, since a capital letter Z, when turned on either of its sides, is in fact identical to a capital letter N.*** *(emphasis added)*

23. The Applicant, for her part, pleaded in her Counterstatement that the letters Z and N were clearly different and that this pointed away from visual similarity.

24. The Hearing Officer dealt with the comparison of marks from [20-28]. He assessed the visual similarity of the marks at [24]:

"Both parties' trade marks consist of a four letter word in which the first three letters are identical. ***However, the final letter in each trade mark differs and bears no visual similarity to one another****. While I accept that as a rule of thumb the beginning of words tend to have more impact than their endings, bearing in mind that in short words a difference of a single letter can be significant (even if it appears at the end of the trade mark), it results in what I regard as at least a medium degree of visual similarity between the competing trade marks"* (emphasis added).

25. Given that the Opponent had relied specifically on its arguments regarding the similarity of the letters N and Z, it might have been expected that the Hearing Officer would have provided something more by way of reasoning to explain his finding to the contrary. However, the Opponent does not rely for its appeal on a failure by the Hearing Officer to state his reasons for so finding.

26. For the Opponent, Ms Wickenden argued in her skeleton that "*the similarity between these letters is clear*". She went on to say "*In any event, it should have been obvious in any event by looking at the two letters that they share similarities. Below (in plain Calibri font) are a capital "N" followed by a "Z" rotated 90 degrees, and a capital "Z" followed by a "N" at 90 degrees*". An illustration followed.

27. The Opponent's argument, both below and before me, therefore turned (no pun intended) on what a Z – or N - looks like when it is rotated through 90 degrees. That is the only basis on which it was expressly said those letters are essentially the same or obviously similar.

28. To my mind, this demonstrates the Opponent's difficulty – the alleged visual similarity of the symbols/letters involves the introduction of an external factor, namely the independent rotation of the letter N. It also requires the letters to be considered in isolation from the from the reference points provided by the remaining letters Q-U-I-. Both require the consumer to think about these issues in construing the overall impression of the trade marks.

29. This, of course, is not the way to approach the test. What matters is the immediate impression of the mark as a whole on the average consumer, so the comparison is between the mark as applied for and the mark as registered, without dissection and, it follows, without the introduction of other factors such as a mark's potential use or the possible different angles at which it – let alone individual elements of it – may appear. The argument put forward by the Opponent would require the consumer to engage in much greater unprompted analysis and cogitation. This is therefore an unrealistic, artificial comparison, taken out of context.

30. It is also worth noting that (understandably) it was not argued the Hearing Officer should treat the letters N or Z as if they were in some way distinctive or dominant features such that they should be given any greater weight in the comparative exercise. They therefore fall to be considered as the consumer will find them, ordinary letters serving their ordinary function in words.

31. Ms Wickenden also sought to rely for this ground of appeal on the Opponent's submissions below that "it is common in the fashion industry to affix marks at varying angles". The submission was not supported by any evidence of industry practice but by an illustrative table of various vertical versions of the marks:

QUIZ	QUIN
Q U I Z	Q U I N
Q U I Z	Q U I N
Q U I Z	Q U I N

32. As Mr. Wood for the Applicant rightly pointed out, despite the submissions the table was intended to support, all of the illustrations show the symbols N and Z in their ordinary and easily understood upright orientation, as letters forming part of the words/signs QUIZ and QUIN. Thus, it is not at all clear to me how the submission added to the argument on visual similarity.

33. For the Opponent, Ms Wickenden also submitted that there were images in the evidence which showed that the use of the mark was not always the right way up. I was referred to pages 22 and 23 of the evidence of Mr Ramzan, the witness for the Opponent (see the Annex to this Decision). The former showed a shoe box at an angle to the camera of about 45 degrees and the latter showed a label turned horizontally. In the latter case it was said the Z looked like an N. In both cases, though, it is clear the word QUIZ had actually been printed as ordinary horizontal text.

34. Absent some clear indication to the contrary I can assume the Hearing Officer has reviewed the evidence (including those pages) for what it is worth and, indeed, he confirmed this at [8].

35. That said, the difficulty here is two-fold. First, this evidence was not put the Hearing Officer as support for the proposition of similarity or on the basis that it showed anything other than ordinary use of the mark in ordinary orientation. Mr Ramzan simply referred to it as samples of labels and packaging and there was no comment on any other significance it might have had in the Opponent's submissions below.

36. Secondly, in so far as the evidence shows "use" at an angle or use that was not "the right way up" it is wholly artificial – the photographs simply reflect the creative choice of the photographer. This is perfectly normal, of course, but it amounts to a picture of ordinary "right way up" up use, just taken from an angle. Whilst the angle chosen might be relevant to the aesthetic effect of the photograph it does not, absent some express reason for doing so, affect the interpretation of the content. It is part of human experience to see things at an angle and correct for it.

37. There was no reason I can see for the Hearing Officer to have taken this material, or to have been on notice that he should consider it, as anything other than evidence of the ordinary use of the word QUIZ in its horizontal form.

38. Thus, the Hearing Officer was left with assessing/comparing the marks *prima facie*. In my judgment the Hearing Officer correctly instructed himself by reference to the Registrar's accepted list of legal principles, including that: "(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details'". He considered how the marks would be perceived overall by the average consumer [20-23], determined that within the marks the final letters differ and bear no visual similarity and concluded that, overall, they had at least a medium degree of visual similarity [24].

39. This is the kind of finding and evaluation of fact with which an appellate tribunal should not interfere unless compelled to do so. In my judgment the finding that the letters N and Z bear no visual similarity to each other within the marks QUIN and QUIZ is not obviously wrong and that, along with the consequent finding that the marks were visually similar to at least a medium degree, is one which the Hearing Officer was perfectly entitled to make.

40. Accordingly, the first ground of appeal fails.

Ground 2

41. The Opponent pleaded that the Hearing Officer failed to properly consider the likelihood of confusion from the perspective of the average consumer, including the likely use of the mark on the 18/25 Goods and the effect of the purchasing process on confusion.

42. Before the Hearing Officer, the only submission the Opponent expressly directed to the purchasing process and the average consumer was this:

    THE AVERAGE CONSUMER

    The average consumer for clothing and related goods in classes 14 and 18 will be the general public since the items offered for sale and services on offer are aimed at the general consumer. The level of attention will vary according to the particular nature of the item being purchased. Some items of clothing, may well involve little consideration in the purchasing act, being inexpensive and functional. In this instance, it is submitted while the average consumer for these goods is deemed to be reasonably well informed and reasonably circumspect and observant, it is one who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them s/he has kept in his mind".

I note, because it will be referred to later, that there is nothing in this submission which addresses the way goods are arranged, presented to or perceived by average consumers.

43. The Hearing Officer dealt with this issue at [19]:

"The average consumer of the goods and services at issue is a member of the general public or, in relation to the applicant's services in class 35, most likely, a business user. The goods at issue are, for the most part, likely to be obtained by self-selection from bricks and mortar retail outlets on the high street or from the equivalent pages of a website or catalogue. The services at issue are most likely to be self-selected from signage appearing on the high street or having conducted searches on-line. Although visual considerations are likely to dominate the selection process, as such goods and services may also be, for example, the subject of oral requests to sales assistants or word-of-mouth recommendations, aural considerations must not be ignored. As to the degree of care the average consumer will display when selecting such goods and services, the cost of the goods can vary widely in price. However, as the goods in classes 18 and 25 are either personal items or items of clothing, a range of factors such as material, colour, size, cost and compatibility with other similar items are all likely to be in play. As such, I would expect an average consumer to pay a medium degree of attention to the selection of such goods. While I take the same view in relation to the opponent's services in class 35, I think a somewhat lower degree of attention will be paid to the selection of the vast majority of the goods in class 16 and a fairly high degree of attention will be paid by a business user selecting the applicant's services in class 35".

44. The Hearing Officer's assessment is not, in terms, very much different to that put forward to him by the Opponent.

45. The likelihood of confusion was dealt with at [33-41], the key paragraphs of which are reproduced below

"*33. In determining whether there is a likelihood of confusion, 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind.*

34. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

35. Having indicated that for reasons of procedural economy I would proceed on the basis that: (i) the applicant's goods and services are identical to those upon which the opponent relies, and (ii) the opponent's trade mark is highly distinctive, I further concluded that:

• the average consumer is a member of the general public or business user who, whilst not ignoring aural considerations, is likely to select the goods and services at issue by predominantly visual means whilst paying a varying degree of attention during that process;
• the competing trade marks are visually and aurally similar to at least a medium degree;
• while the opponent's trade mark sends a very clear conceptual message, the applicant's trade mark will either send a different conceptual message or no conceptual message at all.

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38. I remind myself that I am proceeding on the basis that the goods and services at issue are identical and the opponent's trade mark is highly distinctive; those are points in the opponent's favour. Notwithstanding the at least medium degree of visual and aural similarity at play, the very clear conceptual message which will be conveyed by the opponent's trade mark will, in my view, fix itself in the mind of the average consumer and act as a "hook" to prompt their recall. Consequently, even if the applicant's trade mark does not convey any conceptual message and even if an average consumer pays a low degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection), the very clear conceptual message sent by the opponent's trade mark is, in my view, sufficient to counteract the visual and aural similarities between the competing trade marks. That conclusion is, of course, even stronger if the average consumer conceptualises the applicant's trade mark in the manner I have suggested and/or if such a consumer pays a higher than low degree of attention during the selection process. In short, there is no likelihood of direct confusion."

46. Ms Wickenden argued, first, that in assessing the likelihood of confusion, the Hearing Officer only mentioned the purchasing process without explaining how he took it into account (notwithstanding the Appeal is not based on a failure to give reasons). In particular, she submitted that there was no mention, in [38], of the average consumer's level of attention or the selection process or retail environment. Therefore, it is not clear he considered these factors in assessing likelihood of confusion, or if he did, he did not adequately explain them.

47. I do not agree. The Hearing Officer set out the nature of the average consumer, the purchasing process and the purchasing environment in some detail at [19] and in most respects it tallies with the Opponent's own submissions below. Having set it out there and reached his conclusion, he reminded himself of the key points of his finding at [35]. He then refers to the average consumer, whose characteristics he has previously identified, as a factor in his assessment at [38], going so far as to give the Opponent the best possible case by allowing for a low degree of attention. He concludes that, nevertheless, there is no likelihood of direct confusion.

48. The nub of the Opponent's complaint seems to be that the Hearing Officer did not repeat all these findings in [38] and explain in detail the "formula" he used to weigh up the various factors. As has been said before, the global assessment is not an arithmetical exercise. The Hearing Officer's role is to reach findings on the various factors and then draw his thinking together to reach an evaluative conclusion. He is not required to record every thought, as long as his conclusion is adequately reasoned. There is little to be gained on appeal by "going down the rabbit hole" to explore the reasoning for each factor further. Taking all of these paragraphs together, I am satisfied the Hearing Officer took everything necessary into account.

49. Secondly, the Hearing Officer was said to have erred in his consideration of "imperfect recollection" within the purchasing process. The criticism derived from this passage in [38]:

"Notwithstanding the at least medium degree of visual and aural similarity at play, the very clear conceptual message which will be conveyed by the opponent's trade mark will, in my view, fix itself in the mind of the average consumer and act as a "hook" to prompt their recall. Consequently, even if the applicant's trade mark does not convey any conceptual message and even if an average consumer pays a low degree of attention during the selection process (thus making him/her more prone to the effects of imperfect recollection), the very clear conceptual message sent by the opponent's trade mark is, in my view, sufficient to counteract the visual and aural similarities between the competing trade marks".

50. The Opponent's argument was that the idea the conceptual message of the Opponent's mark would "act as a "hook" to prompt (the average consumers') recall, was meant to indicate that the average consumer, faced with QUIN, *would* imperfectly recollect – "recall" - QUIZ *after which* counteraction would be (ineffectively) engaged through the conceptual difference, neutralising confusion.

51. I do not accept this interpretation of the Hearing Officer's finding. In my view all he is saying is that the conceptual strength of QUIZ is so strong, imperfect recollection will be avoided altogether because faced with QUIN the consumer will not think of QUIZ. The conclusion might have been better expressed, but that does not detract from its effect.

52. Ms Wickenden developed this in argument to suggest the Hearing Officer had failed to give realistic consideration to imperfect recollection in the purchasing process, in that if visual selection is the primary means of selection, the mistake could occur at a distance and only be conceptually corrected as the consumer gets closer to the notional product.

53. This specific scenario was not put to the Hearing Officer. The legal test he had to apply relates to the average consumer, perceiving a mark as a whole. Absent some situation-specific reason to consider otherwise (which it is for a party to clearly advance, with appropriate evidence, if it wishes it to be taken into account) the test necessarily assumes that all of the various aspects of the marks under consideration are within the scope of the consumer's perception simultaneously and, specifically, that it will be seen properly, in full, in a typical case (see, by analogy, the observations of Mr Daniel Alexander QC sitting as the Appointed Person in *ZOHARA Trade Mark*, BL O/040/20, [33-34].

54. Finally, Ms Wickenden returned to the earlier point concerning the way marks are applied to goods at angles, or seen at angles by consumers, referring to the submissions below and the evidence I have previously referred to at paragraphs [30-36] above.

55. For the Opponent it was said that the Hearing Officer should have expressly taken into account/ the "fact" that these words and logos are displayed at different angles, different sizes, and different orientations on goods and consider how that would affect the average consumer.

56. That might be the case if the point is unequivocally put forward, but here it was not. The Hearing Officer had only to consider the case in the usual way.

57. In any event, as to the point that the submissions below on how marks are affixed in the fashion industry should have been considered, first there was no evidence to that effect, secondly the illustrations supporting the submission did not assist and thirdly it was put forward as regards visual similarity, not the purchasing process.

58. The Opponent argued that this was nevertheless sufficient "notice" to put the point more broadly to the Hearing Officer in the context of the purchasing process but I do not agree. Nowhere in the submissions below was there anything to indicate that this was a point requiring specific attention in that context.

59. As to the "evidence of different usages" relied on by the Opponent, as noted at [36] above, the evidence does not show that at all. If anything, it shows ordinary use. Furthermore, the argument was not put to the Hearing Officer.

60. That said, to my mind such considerations are implicitly taken into account in the assessment of the average consumer and the purchasing process in the retail environment. Hearing Officers have the same experience of shops as the public at large as well as the notional "average consumer" and, indeed, in this case the Hearing Officer made findings as to the way in which the average consumer would encounter the goods in a typical shopping environment and the degree of attention paid, which findings were not criticised of themselves and which essentially matched those submitted by the Opponent. As to how marks can be arranged/displayed by traders on goods, I think it can be assumed that by career experience a Trade Mark Hearing Officer is very well acquainted with the possibility of different angular presentations, both on goods and in displays.

61. Without doubt, in the hustle and bustle of shops marks and labels might be seen at all sorts of angles depending on where the consumer is placed and how the goods are displayed, but it can be assumed that the average consumer is used to dealing with this. This is part of the way marks are seen and perceived in the ordinary course of trade and in the ordinary run of things it makes no difference – the consumer corrects for it, even if it is noticed at all, let alone as a matter of "trade mark" perception. Thus, it can be discounted and it does not require specific mention, or even consideration, unless specific circumstances demand it. Indeed, if it did, analysing all possible ranges of perception would render the test unworkable.

62. Whilst one could envisage theoretical or exceptional situations where there was less clarity, a Hearing Officer needs only consider the typical situation and does not need to take into account speculative, extraordinary circumstances unless there is sufficient evidence/argument to persuade them that it will affect the perception of the average consumer (see, again, Mr Daniel Alexander QC's discussion in *ZOHARA Trade Mark* (*id.*), [24-29]). That was not the case here.

63. In my judgment the Hearing Officer properly considered the likelihood of confusion from the perspective of the average consumer and took into account all relevant factors in the light of the way the case was put to him.

64. The second ground of appeal therefore fails.

Ground 3

65. The third ground of appeal was, in essence, that the Hearing Officer was wrong to find that the conceptual differences outweighed the visual and aural similarities of the marks and that this resulted from a flawed application of the legal principles.

66. Before me this was put in various ways. First, that the Hearing Officer had applied an artificial "trade mark" analysis which gave too much weight to the conceptual differences whilst ignoring the way in which consumers react to visual/aural similarities.

67. This line of argument sought support from the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *PINKIES* BL O-566-19. This involved a comparison of the marks PIMKIE and PINKIES.

68. At [35] Mr Hobbs said:

> *"It can be expected in the context of the Hearing Officer's assessment of the purchasing process for the goods concerned (set out in paragraph 10 above) that the relevant consumers would do as consumers ordinarily do: take the marks PIMKIE and PINKIES as they find them, without pausing to analyse or compare them generally or with reference to the presence or absence of meaning in either case. I see no reason to expect them to think their way through the high degree of visual and aural similarity between the marks by a process of contradistinguishing between the former as a word which has no conceptual connotations of its own and the latter as a word linked to the concept of fingers or colour. That, in my view, is a thought process which involves examination by way of trade mark analysis and comparison of a kind they would not naturally undertake on exposure to marks with this degree of similarity. I consider that the Hearing Officer's observation to the effect that the 'conceptual differences' between PIMKIE and PINKIES are 'too great to be missed' is the product of just such an examination".*

69. Particular emphasis was placed by the Opponent on the extent to which this excluded the average consumer from thinking of marks in a conceptual way, although it was accepted that, in the light of case law, concept could not be ruled out of account.

70. To my mind, *PINKIES* turned on its particular facts and circumstances – the level of visual/aural similarity and distinctiveness was found to be "high". The main point of difference was two visually/aurally similar letters located within the marks in such a way that their impact on overall impression was diminished.

71. Furthermore, I do not understand Mr. Hobbs to be saying that as a rule meaning is left out of account altogether by average (or even real) consumers in this scenario, merely that they do not consciously go through an overly-analytical process. Instead, they rely on first impression (which, despite attempts to codify it, has been a touchstone of likelihood of confusion for many years). In *PINKIES* the Hearing Officer had not looked at it from that perspective and seemed to have overlooked that the marks were *"visually and aurally similar to a degree which would easily enable them to become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of them".*

72. In addition, in that case the Hearing Officer seemed to have omitted any consideration of imperfect recollection from her final assessment. In short, the Hearing Officer in *PINKIES*

seems to have been dazzled by the conceptual differences and failed to see the visual and aural similarities in the glare.

73. One of the problems with the global assessment is that it *is* inherently artificial and takes on the mantle of a "trade mark analysis", simply because it is an attempt to distil into a legal test the psychology of consumers' perception of trade marks. The "average consumer" is a prime example of this. Hearing Officers must do the best they can with the test as it is. There is no "magic formulation" to express the evaluative thought process. As long as the strands are pulled together in a properly reasoned fashion, and the assessment does not over- or under-think how consumers react to marks, that is sufficient.

74. I have reviewed the Hearing Officer's overall assessment of the likelihood of confusion. Whilst [38] is on the brief side, he took into account all the relevant factors and arrived at an evaluative conclusion he was entitled to make. The approach (subject to my comment below) is no more, or less "artificial" than arises from the nature of the test.

75. Where, in some respects, there *is* a degree of artificiality, is in the presumptions the Hearing Officer was prepared to make about the distinctive character of QUIZ and the identity of the goods/services. However, neither party has challenged those presumptions and, in any event, they go wholly in the Opponent's favour. Thus, it makes no difference to my assessment of the Hearing Officer's evaluation.

76. Returning to an earlier theme, the Opponent tried to persuade me that because, on their interpretation of the Hearing Officer's assessment, imperfect recollection would first occur visually/aurally, the impact of conceptual differentiation could be ruled out – in effect, it would occur too late in the process, the damage of the "recall" of QUIZ by the consumer having already been achieved on first sight of QUIN. Having been lulled into imperfect recollection, consumers would not go on to start thinking about conceptual differences.

77. As I noted before, that is not how I interpret the Hearing Officer's decision, which is that imperfect recollection is not likely to occur, despite the medium level of visual/aural similarity and high distinctive character of QUIZ, because the conceptual strength of it (against which stands the neutral or different concept of QUIN) neutralizes those similarities.

78. The Opponent's next criticism was that the Hearing Officer failed to take into account that "to the consumer, QUIZ means a fashion brand". In effect, it was submitted that the ordinary conceptual meaning was somehow displaced by brand use.

79. I do not agree. Yet again, this was not a point advanced to the Hearing Officer. In any event, a mark does not lose its conceptual meaning simply because it is used as a brand. The brand and conceptual meanings can be, and usually are, intermingled until the factual nature of the use can be said to have supressed the conceptual meaning to the point it no longer occurs to consumers in a "trade mark" scenario. That would require appropriate evidence, and in most cases that would go far beyond the type of evidence that is sufficient to show high distinctive character alone. Certainly, high distinctive character - inherent or acquired - does not of itself extinguish the underlying concept of a sign. To a great extent, in fact, it relies on it for its distinctive strength.

80. The Hearing Officer can be taken to have reviewed the evidence for what it was worth, and he was willing to assume it showed high distinctive character. The evidence itself was of the fairly conventional kind amassed to show sales volumes, product ranges, actual use and so on. There was no reason for the Hearing Officer to take it as showing anything more than that and he was not asked to do so. There was certainly nothing to suggest consumers would not perceive the conceptual meaning of QUIZ.

81. Finally, it was pleaded in the Grounds of Appeal that "*There is no basis in the factual findings, nor the evidence, for what the HO describes as a conceptual "hook*"". On the contrary, the Hearing Officer determined the factual meaning of QUIZ at [26]. The meaning was in the Applicant's pleading, in terms, and the Hearing Officer himself referred to an online dictionary definition. Neither his finding, nor his reference to a dictionary, were appealed.

82. If the objection is that he should not have referred to a "hook", I see that as no more than a figure of speech to convey the strength of the conceptual meaning of QUIZ and the way it impacts on consumers. Indeed, it is used fairly commonly in this way in UKIPO Hearing Officers' decisions.

83. I can discern no error of principle in the Hearing Officer's analysis of the likelihood of confusion as pleaded. It follows that the third ground of appeal fails.

Ground 4

84. This concerns the S. 5 (3) ground of opposition. The complaint is that the Hearing Officer approached the assessment of the requisite "link" simply by transposing his findings under S. 5 (2) (b), contrary to principle.

85. The Hearing Officer properly instructed himself as to the principles from [43-45] and there is no challenge to that summary.

86. He dealt with his assessment of the "link" at [46]:

> *"46. Notwithstanding the applicant's criticisms of the opponent's evidence, I shall, once again, proceed on the basis that the opponent is entitled to rely upon such use and that the evidence that has been provided of the use made of the "QUIZ" trade marks has resulted in them achieving the necessary qualifying reputation in relation to all the goods and services claimed. I begin by reminding myself that the trade marks being relied upon are the same as that under section 5(2)(b). However, even if used on identical goods and services, the conceptual "hook" which the opponent's trade mark will create in the mind of the average consumer is, in my view, sufficient to avoid a "link" being established, even if the applicant's trade mark conveys no conceptual meaning. Where a conceptual meaning is attributed to the applicant's trade mark it will, as noted above, be different to that of the opponent's trade mark and will make it even less likely that a "link" will be established. Without a "link" the opponent cannot succeed and the opposition based upon section 5(3) fails and is dismissed accordingly."*

87. It can be seen that, once again he made assumptions putting the Opponent in the best possible position.

88. Ms Wickenden for the Opponent put the case, essentially, on the same basis as she had done for "imperfect recollection", namely that the conceptual differences would only operate *after* the link had been made.

89. Again, this is to misunderstand the position. The Hearing Officer is saying that the conceptual strength of QUIZ is so strong, upon being encountered by the consumer QUIN will not call QUIZ to mind at all. It is simply sufficiently different that the trigger for linkage will not operate.

90. Thus, I see no error of principle here. The fourth ground of appeal therefore fails.

91. The Opponent made further submissions as to "unfair advantage" but these were dependent on my overturning the Hearing Officer's findings as to the requisite "link", so I need not consider them further.

Conclusion on the Appeal

92. The Appeal has failed in its entirety.

The Hearing Officer's approach to "Procedural Economy"

93. As noted above, the Hearing Officer proceeded "in the interests of procedural economy" on the basis that:

    a. *All* the Applicant's goods and services in classes 16, 18, 25 and 35 were identical to those of classes 14, 18, 25 and 35 of the Opponent's 713 registration; and

    b. The Opponent's use of QUIZ had resulted in it becoming highly distinctive for all of the goods and services relied on

       For the purpose of S. 5 (2) (b).

    c. Similarly, that the Opponent had the necessary qualifying reputation for the purposes of S. 5 (3).

94. The net result is that the Hearing Officer substituted assumptions for reasoned assessments of those matters, despite the fact that, save for some of the goods, they were in dispute. The decision to do so appears to have been a unilateral case management decision taken by the Hearing Officer without reference to the parties, although neither complains about it. At least some of those assumptions would have been debatable if normally assessed.

95. The Appointed Person has warned about the potential difficulties taking "shortcuts" can create. Mr Thomas Mitcheson QC sitting as the Appointed Person discussed this at [4-8] of BL O/567/19 *CARRY ON*:

    4. The Hearing Officer accordingly decided only the s.3(6) ground for reasons of procedural economy. See in this regard the decisions of Prof Ruth Annand in airblue TM (BL O/600/18) at §65 and Geoffrey Hobbs QC in MUSLIM MATCH TM (BL O/014/19) at §12. In the former decision Prof Annand cited §23 of Arnold J's decision in Generics (UK) Ltd v. Warner Lambert

Company LLC [2015] EWHC 3370 (Pat) [2016] RPC 16 where he explained the English notion of "procedural economy" as follows:

"…the EPC Contracting States differ not merely in their procedural rules, but also in their procedural philosophies. Thus, there are different conceptions of procedural economy. The traditional English conception is that it requires the first instance court to adjudicate upon all essential points in dispute, certainly all points that require findings of fact or evaluation. In that way, if there is an appeal, the Court of Appeal is in a position to deal with any issues of law that may then arise and dispose of the case without either a re-hearing or remitting it to the first instance court. By contrast, there are many civil law jurisdictions where the view is taken that the correct approach to procedural economy is for the first instance court only to decide the issues which are sufficient to enable that court to dispose of the case, and to leave other issues undecided."

6. This paragraph was cited with approval by Lord Briggs SC in the Supreme Court in Generics (UK) Ltd v. Warner Lambert Company LLC [2018] UKSC 56 [2019] 3 All E.R. 95 at §§116 & 118.

7. In the light of this, whilst I do not consider that it is compulsory for a Hearing Officer always to determine all grounds arising at a hearing before him or her, under the English approach to procedural economy it is customary to do so. Moreover, if a short-cut is being considered, it would normally be appropriate to raise this with the parties in advance so that submissions can be made in relation to it.

8. I acknowledge that this may place an unwelcome burden on hard-pressed adjudicators to write longer judgments than they might otherwise consider necessary on the basis of their perception of the case before them. However, subsidiary points can normally be dealt with more briefly, especially if the reasoning relies on findings already made in relation to earlier issues…"

96. Most cases which have resulted in comment concerned decisions which, like *CARRY ON*, left out of account entire marks and/or grounds, focussing on a "best case" identified by the Hearing Officers which was then nevertheless assessed in full for what remained.

97. This case is somewhat different. The Hearing Officer has gone a step further and unilaterally left out of account any reasoned factual evaluation of whole sections relevant to the legal tests under S. 5 (2) (b) and 5 (3) namely the similarity of certain goods/services of the marks in suit and the factual level of distinctiveness and reputation for 713.

98. Whilst in this case that approach was to the benefit of the Opponent/Appellant and was not in dispute on appeal, it nevertheless seems to me that these are exactly the sorts of matters ordinarily requiring findings of fact or evaluation contemplated by Arnold J's (as he then was) description of "procedural economy" in *Generics* as cited by Mr Mitcheson QC ([95] above). It is easy to envisage the complications which might arise on appeal if such presumptions – rather than reasoned findings - are called into question or have to be re-assessed.

99. I therefore respectfully suggest that in the normal run of things it would be sensible for a Hearing Officer to make a full evaluation of *all* of the relevant factors for any marks on which

he intends to base his decision, at least unless the parties' views have been sought and duly considered.

Costs

100. The Opponent asked that the costs order below be overturned, submitting that the Applicant's approach to the case, particularly as to evidence, had increased costs. The allegation seems to be that the approach was in some way intended to "set a trap" to enable the evidence of Mr Ramzan to be challenged. Further, it is said that an absence of some explanatory context for the Opponent's evidence inhibited the Opponent from addressing points in reply evidence.

101. The Hearing Officer was apparently content with the Applicant's approach and no objection was raised below, notwithstanding the Opponent would have had time to take one after seeing the Applicant's written submissions. I decline to interfere.

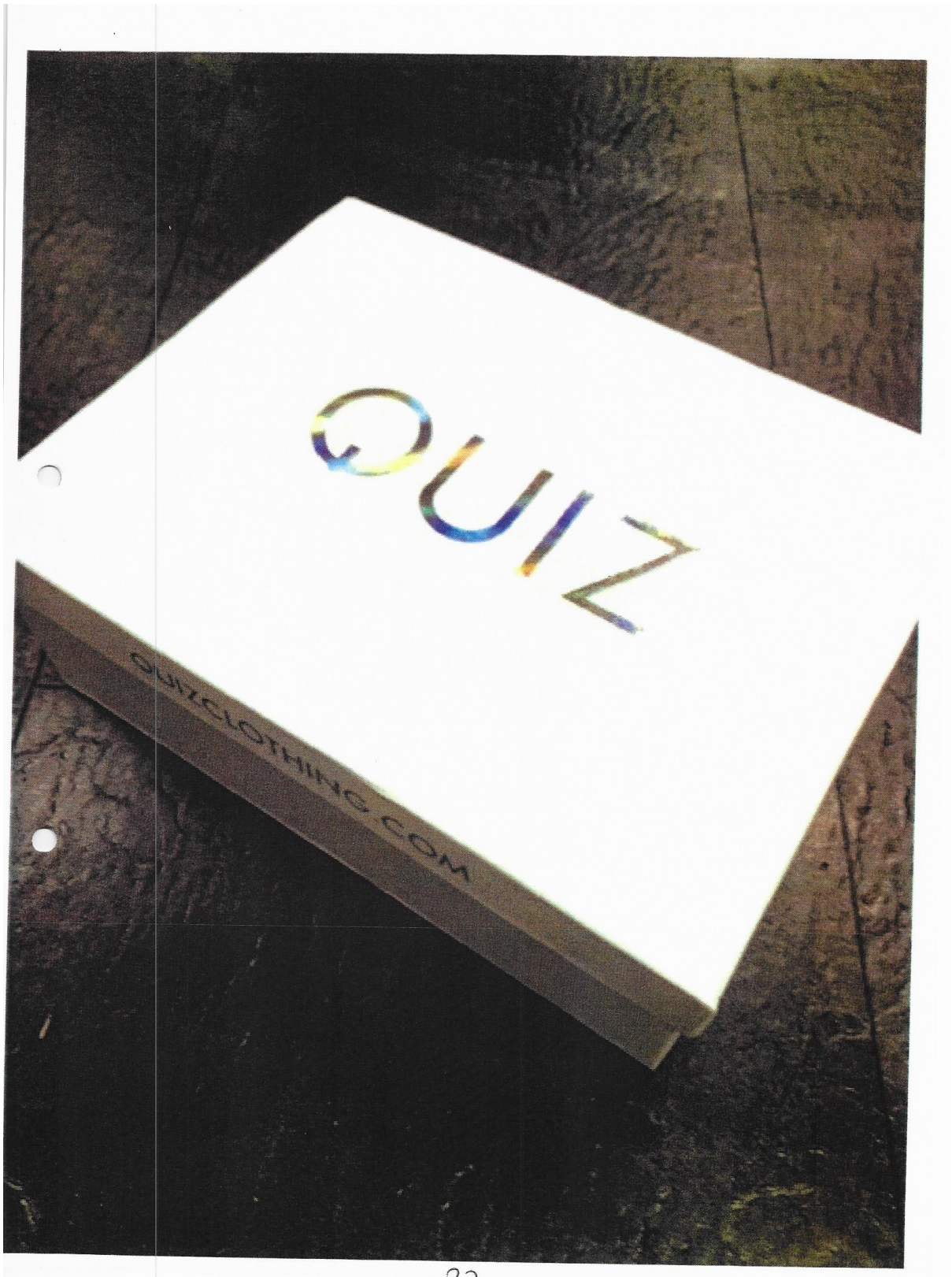
102. The Appeal having failed the Applicant is entitled to her costs. She seeks "off-scale" costs on the basis that the Opponent's case was without merit, that it was a "blunderbuss" and little more than an attempt at securing a re-hearing. I was referred to case BL O/360/20 *SACURE* and the comments of Mr Phillip Johnson sitting as the Appointed Person.

103. It is true that the case on the visual similarity of the marks was very close to the margins of seeking a re-hearing, that the appeal as a whole was wide-ranging and, in some places, tenuous/repetitive. Nevertheless, it was not without merit and not outside the bounds of a typical appeal. I do not consider that off-scale costs are warranted.

104. The Hearing Officer made an award of £1,800 as a contribution towards the costs of the Applicant. So far as the costs of the Appeal are concerned, I order the Opponent to pay £800 by way of contribution to the costs incurred by the Applicant in dealing with this Appeal. Therefore, the Opponent must pay to the Applicant or its representatives the total sum of £2,600 within 21 days of the date of this decision.

Philip Harris
Appointed Person
2 March 2021

ANNEX A



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