

**BLO/162/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3363861  
BY PURPLE ACCOUNTS LTD  
TO REGISTER AS A TRADE MARK:**



**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416079  
BY MAZUMA GB LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 29 December 2018, Purple Accounts Ltd (“the applicant”) applied to register the trade mark displayed on the front page of this decision, under number 3363861 (“the application”). It was accepted and published in the Trade Marks Journal on 18 January 2019 in respect of ‘*accountancy; accountancy services; accounting*’ in class 35.

2. On 18 April 2019, Mazuma GB Limited (“the opponent”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the services in the application.

3. The opponent relies upon a series of trade marks under number 2498471, **PURPLEFORCE, PURPLE FORCE** and **PURPLE-FORCE** (“the earlier marks”). The series of marks was filed on 24 September 2008 and was entered into the register on 9 January 2009. The series of marks is registered in respect of the following services:

Class 35: Accountancy services including provision of information relating to accounts, tax advice, tax assessment, tax consultancy, tax planning, tax return advisory services, taxation consultancy, drawing up of statement of accounts, book-keeping services, payroll preparation, tax preparation, production of financial statements, financial budgeting and forecasting services, and cash management support services, all included in Class 35.

4. For ease of reference, I will refer to the series of marks as the opponent’s ‘mark’, unless it becomes necessary to differentiate between the marks which comprise the series. The opponent’s mark is an earlier mark, in accordance with Section 6 of the Act. While the earlier mark had been registered for more than five years at the filing date of the application and would ordinarily be subject to proof of use provisions contained in Section 6A of the Act, the applicant has not sought to require the opponent to demonstrate proof of use. Consequently, the opponent is entitled to rely upon its services in class 35 for its registration, as specified, without having to establish genuine use.

5. The opponent argues that the marks are visually, aurally and conceptually similar due to the common, dominant element “purple”. The opponent also argues that the contested services are identical. These factors, the opponent contends, will result in a likelihood of confusion.

6. The applicant filed a counterstatement denying the grounds of opposition. The applicant argues that the marks are not similar and denies that there is a likelihood of confusion. The applicant also highlights that the parties operate different trading models and maintains that there has thus far been no actual confusion between the marks by consumers. The applicant argues that there has been long-standing coexistence on the marketplace, which it feels should continue.

7. The opponent has been professionally represented throughout these proceedings by Tennant IP Limited. The applicant has not been professionally represented.

8. Neither of the parties have filed evidence but both filed submissions during the evidential rounds and in lieu of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision. Both parties were given the option of a hearing but neither asked to be heard on this matter. Therefore, this decision is taken following a careful perusal of the papers, keeping all submissions in mind.

### **PRELIMINARY ISSUES**

9. In its counterstatement and written submissions, the applicant describes the different trading models it feels the opponent and the applicant operate, asserting that this defeats any possibility of confusion. For reasons which I will now explain, the applicant’s points about the difference in the actual services offered by the parties will, as a matter of law, have no bearing on the outcome of this opposition.

10. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been

registered for five years, Section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

11. Although the mark relied upon by the opponent had been registered for five years at the date on which the application was filed, the applicant has not requested proof of use. Consequently, the opponent is not required to prove use for any of the services for which the earlier mark is registered. The earlier trade mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of that earlier mark for all the services listed in the register.

12. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

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

13. So far as the applicant's claimed use of its applied for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied

for might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, and the services for which it will be used, my assessment later in this decision must take into account only the applied for mark – and its specification – and any potential conflict with the opponent’s earlier mark. Any differences between the actual services provided by the parties, or differences in their trading styles, are not relevant unless those differences are apparent from the applied for and registered marks. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

14. In its counterstatement and submissions, the applicant also argues that there has been a lack of actual confusion by consumers despite both parties trading for a number of years. While I appreciate the applicant’s comments, I must, at this early stage, clarify that an absence of confusion will not have any bearing on whether there exists a likelihood of confusion between the applied for mark and the opponent’s earlier mark. While evidence of actual confusion may be persuasive where it exists, the absence of confusion on the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that

the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

15. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

16. The provisions in the Act are not merely a reflection of what is happening in the market. As the applicant has not requested proof of use, I must consider notional use of the registered mark. It may be the case that there is an absence of confusion due to the way in which the registered mark has been used or due to reasons extraneous to the mark. In cases where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion. As previously explained, my assessment later in this decision must take into account only the applied for mark – and its specification – and any potential conflict with the opponent's earlier mark. Therefore, the argument that there has been no confusion is not relevant for the purposes of this assessment.

17. Moreover, my decision as to whether there is a likelihood of confusion under Section 5(2)(b) of the Act must be based on an objective assessment of the relevant factors (which will be discussed below). Consequently, the views expressed by the applicant referring to potential passing off by the opponent will not have any bearing on my decision.

18. Finally, Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity of a registered mark. The applicant has not sought to cancel (or 'invalidate' to use the language of Section 47 of the Act) the earlier trade mark on the basis of its claim to an earlier common law right. Consequently, the opponent's trade mark must be regarded as a validly registered mark. In this situation

the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority and a likelihood of confusion between the marks based on their notional use throughout the UK will be enough to justify the refusal of the applicant's later filed trade mark.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

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

“5(2) A trade mark shall not be registered if because -  
[...]

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

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

20. 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 services

21. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 fur 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”.

22. The services to be compared are:

Opponent’s services	Applicant’s services
Class 35: Accountancy services including provision of information relating to accounts, tax advice, tax assessment, tax consultancy, tax planning, tax return advisory services, taxation consultancy, drawing up of statement of accounts, book-keeping services, payroll preparation, tax preparation, production of financial statements, financial budgeting and forecasting services, and	Class 35: Accountancy; Accountancy services; Accounting.

cash management support services, all included in Class 35.	
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23. The specifications of the earlier mark and the application are considered identical, based upon the principle in *Meric*. This is because the applicant's services are broad and worded in such a manner whereby they could reasonably encompass those of the opponent.

### **The average consumer and the nature of the purchasing act**

24. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

25. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

26. The contested services in class 35 are available to the general public but would also be provided to businesses. Therefore, it is necessary to identify two groups of relevant consumers in this instance, namely, the general public and business users.

27. In respect of the general public, these services are likely to be infrequent purchases which are motivated by particular circumstances and needs. In relation to

business users, these services are likely to be more frequent purchases for periodic financial reporting, organisational analysis, tax returns and the like. The cost of such services is likely to vary but would typically require an above average outlay. The act of purchasing these services is not merely casual but is likely to follow a measured thought process as it would be a relatively important choice for both groups of consumers. Both groups of consumers will want to ensure that the services they purchase will be provided professionally, and will be aware of potential consequences if they are not. In my view, the purchasing process for these services would predominantly be visual in nature; they are likely to be purchased after viewing information on the internet or brochures. However, I cannot discount aural considerations such as consultations or word of mouth recommendations. For these services, I feel that the level of attention of the general public and business users would be higher than average.

### **Comparison of trade marks**

28. 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.”

29. 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.

30. The respective trade marks are shown below:

Earlier trade marks	Applicant's mark
PURPLEFORCE PURPLE FORCE PURPLE-FORCE	 The logo for 'purple accounts' features a purple circle containing a white lowercase 'p' on the left. To the right of the circle, the word 'purple' is written in a bold, lowercase, sans-serif font, and the word 'accounts' is written below it in a smaller, lowercase, sans-serif font.

31. The opponent has submitted that the marks are “visually and aurally similar to a very high degree and conceptually identical”, on the basis that the word “purple” is the dominant element of both marks. The opponent has asserted that the stylisation in the applicant’s mark, along with the “p” device, would not be retained by the consumer. The opponent has also argued that the word “accounts” is negligible and ought to be disregarded from the comparison.

32. The applicant denies that there are visual, aural and conceptual similarities between the marks and has submitted that the marks are “clearly very different”. The applicant has contended that the stylisation, colours and device are distinctive elements of their mark and has argued that these are “far from negligible”. The applicant has also highlighted that the earlier mark is in standard font with no stylisation, rendering the marks “completely different”. The applicant has, however, conceded that the marks share the common element “purple”.

33. The series of earlier marks is in word-only format. Each mark within the series comprises the words “PURPLEFORCE”, “PURPLE FORCE” and “PURPLE-FORCE”. Although the first mark is conjoined, they are two common, easily understood words in the English language. This, and their particular formation, means that the average consumer will still identify them as two individual words; with or without a space between them, they will still be perceived as the words “PURPLE” and “FORCE”. In

all three marks, both words have a roughly equal impact. However, as the word “purple” is an adjective describing a feature of the “force”, it will play a slightly lesser role in the overall impression of the marks. In my view, the word “force” is fractionally more dominant and contributes a little more to the overall impression of the marks.

34. The contested mark is a composite, figurative mark comprised of two elements. The mark contains the words “purple accounts” in a slightly stylised font, with grey and purple lettering. The slightly larger word “purple” is placed directly above the word “accounts”, which is presented in a smaller typeface. Preceding the words appears a purple, circular device containing the letter “p”. The letter is white in colour and is presented in the same font as the words “purple accounts”. The overall impression is dominated by the combination of the word “purple” and the circular “p” device. As the word “accounts” will be perceived as a reference to the services provided by the applicant, it plays a lesser role in the impression of the mark. Similarly, the stylisation is minimal and will play a lesser role in the impression of the mark.

35. Visually, the marks are similar insofar as they share the common word “purple”. The marks are different because the applicant’s mark is presented in a stylised font, while the opponent’s marks are in word-only format. Nevertheless, registration of a word-only mark covers use in any standard typeface, and so the differences created by the minimal stylisation and use of lowercase in the applicant’s mark are not significant. Moreover, registration of a mark in black and white covers use in any colour. Therefore, I do not consider that the use of colour in the applicant’s mark creates a point of real difference between them. The applicant’s mark is two separate words, while the first earlier mark “PURPLEFORCE” is conjoined. However, as both words will be identified as ordinary dictionary words by the average consumer, the conjoining does not create a significant difference. There is, of course, the addition of the circular “p” device at the beginning of the applicant’s mark which has no counterpart in the earlier marks. This acts as a point of visual difference between them. Furthermore, the word “FORCE” is not present in the applicant’s mark, while the word “accounts” has no counterpart in the earlier marks. This represents another point of difference between the marks. Bearing in mind my assessment of the overall impressions, I consider the marks to be visually similar to a low to medium degree.

36. Aurally, the earlier marks consist of a two-syllable word followed by a one-syllable word, i.e. (“PUR-PLE-FORCE”). In respect of the applicant’s mark, the average consumer is unlikely to verbalise the letter “p” in the circular device. Moreover, the average consumer is unlikely to verbalise the word “accounts” as it is purely descriptive of the services for which the mark will be used. Based on this finding, I consider the competing marks aurally similar to a medium degree.

37. Conceptually, the word “purple” will be given the same meaning in the contested marks and will be understood by consumers to be the name of the colour. In relation to the earlier mark, the word “force” will generally be understood by consumers as meaning strength, energy, might or power. The resultant combination in the earlier marks creates a concept of energy characterised by the colour purple. In respect of the application, the word “accounts” is descriptive of the services offered by the applicant. Moreover, the circular “p” device is likely to reinforce the meaning conveyed by the word “purple” due to its colour and the fact that this letter is the first of the word “purple”. Both marks contain the word “purple”, though convey somewhat different conceptual messages: the earlier marks refer to some form of purple coloured energy, while the application simply and unambiguously refers to the colour purple. The coincidence of the word “purple” in the competing marks creates some conceptual similarity but this is likely to be at a relatively low level.

### **Distinctive character of the earlier trade mark**

38. 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).”

39. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

41. The opponent has submitted that the earlier marks are comprised of two elements: the distinctive element “purple” and the less distinctive element “force”. The opponent has provided a dictionary definition which, it feels, demonstrates that the word “force” is low in distinctive character in respect of the services at issue. As such, the opponent contends that the distinctive character of the earlier marks predominantly lies with the word “purple”. I note the opponent has not provided any evidence to demonstrate that the word “force” will be perceived by consumers in the way it has asserted.

42. The applicant has suggested that, in contrast to the opponent’s view, the word “force” would dominate in the mind of the consumer and could carry a high degree of distinctiveness. However, the applicant has also contended that, due to the lack of “style or distinctiveness”, neither word would dominate the visual identity of the earlier marks.

43. While the registration process for the earlier marks was completed more than five years before the filing date of the application, the opponent has not been requested to provide proof of use. Neither the opponent nor the applicant have filed evidence in this matter, and the opponent has not pleaded that the earlier marks enjoy an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

44. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

45. The earlier marks consist of two plain words (albeit conjoined in the first mark “PURPLEFORCE”). The words “PURPLE FORCE” are not considered descriptive or allusive to the services for which the marks are protected. There are a number of possible meanings for the word “force”. I do not agree with the opponent’s submission that the word would be understood as meaning a group of people brought together and organised for a particular activity, rendering the word low in distinctive character. I accept that this is a possibility for some consumers. Nevertheless, as noted above,

the word would be understood by an overwhelming majority of consumers as meaning strength, energy, might or power. As such, it has no direct meaning in relation to accountancy services. As for the word “purple”, this has no allusive or descriptive meaning relevant to such services but would be readily understood as the name of the colour. If anything, it is the word “force” which will be more dominant in the opponent’s mark than the word “purple”, since the latter is merely an adjective describing a feature of the former (see, to that effect, *Grey Global Group (UK) Ltd v Roseonly Co. Ltd*, Case BL O/106/20, paragraph 17). The combination of both words is suggestive of some form of energy characterised by the colour purple. In my view, the distinctive character of the earlier marks rests with both elements in roughly equal measure, though the word “purple” plays a slightly lesser role. Overall, I find that the earlier marks have a medium degree of inherent distinctive character.

### **Likelihood of confusion**

46. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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.

47. 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 or services down to the responsible undertakings being the same or related.

48. 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.”

49. Earlier in this decision I concluded that:

- The services of the competing marks are identical under the principle in *Meric*;
- There are two potential groups of average consumers, namely, the general public and business users, both of whom would demonstrate a higher than average level of attention during the purchasing act;
- The purchasing process for the contested services would be predominantly visual in nature, though I have not discounted aural considerations;
- The word “FORCE” would provide a slightly larger contribution to the overall impression conveyed to consumers by the earlier marks, being marginally more dominant than the word “PURPLE”;
- The overall impression of the applicant’s mark would be dominated by the word “purple”, along with the circular “p” device;
- The competing trade marks are visually similar to a low to medium degree, aurally similar to a medium degree, and conceptually similar to a low degree;
- The earlier mark possesses a medium level of inherent distinctive character.

50. I appreciate that I have found the contested services to be identical and I accept that both marks share the word “purple”. However, I must bear in mind that the average consumer of these services would demonstrate a higher than average level of attention during the purchasing act. I must be mindful that the contested services would be a more considered and frequent purchase, in which the average consumer is likely to take note of any differences between the competing trade marks. The purchasing act is likely to be predominantly visual in nature and I have only found the

competing marks to be visually similar to a low to medium degree. Furthermore, I must also pay due regard to the distinctiveness of the earlier mark, which I consider to possess no more than a medium level of inherent distinctiveness.

51. Although the competing marks both contain the word “purple”, there are differences between the marks which would not be overlooked by the average consumer during the purchasing process. I accept that the word “purple” does have a counterpart in the applicant’s mark. Nevertheless, although it does not refer to or describe the services, it is a normal word which will be readily understood as the name of a colour. The word possesses an average level of distinctive character, but it is not so distinctive that consumers would mistake the applicant’s mark for the earlier marks. The word does not have distinctive significance which is independent of the whole. The earlier marks contain the word “force” which has no counterpart in the applicant’s mark. I have found this word to provide a greater contribution to the distinctiveness and overall impression of the earlier marks and, as such, it cannot be considered negligible. As it does not have a counterpart in the applicant’s mark, this works in the applicant’s favour. Moreover, the applicant’s mark contains the “p” device preceding the verbal element of the mark. This element has no counterpart in the earlier marks and is considered distinctive. Reading from left to right, the device would be perceived first by the average consumer. In addition to the word “purple”, this device element contributes to the overall impression of the applicant’s mark and cannot be discounted. The fact that this element has no counterpart in the earlier marks also works in favour of the applicant. Although perhaps more similar aurally, the marks have conceptual differences, resulting in different messages being retained in the mind of the consumer.

52. Taking all of the above factors into account, the various differences between the competing trade marks previously identified are, in my view, likely to be sufficient to avoid the average consumer mistaking one trade mark for the other. Therefore, even when factoring in the imperfect recollection of the consumer and the interdependency principle, it follows that there will be no direct confusion. For the sake of completeness, my conclusion would be the same even if the purchasing act is aural in nature because the other factors point in the applicant’s favour.

53. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.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 is another brand of the owner of the earlier mark.

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

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

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

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

54. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, 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.

55. Applying the principles from the case law, due to the differences between the marks outlined above, I do not believe that the average consumer will assume the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. The differences between the marks are not conducive to a logical brand extension. I am unconvinced that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, merely because of the shared word “purple”. The word “force” is not one routinely used for brand extension and does not refer to the services. I find it unlikely that the competing trade marks would be perceived in this manner. It is possible that the applicant’s mark would bring to mind the earlier marks in the memory of the average consumer, though this would amount to nothing more than mere association. Therefore, in my view, there is no likelihood of indirect confusion.

## **CONCLUSION**

56. The opposition under Section 5(2)(b) of the Act has failed. Subject to any successful appeal, the application will become registered.

## **COSTS**

57. As the opposition has been unsuccessful, ordinarily the applicant would be entitled to an award of costs. However, as it has not instructed solicitors it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given

activities relating to defending the proceedings. It was made clear by letter dated the 28 October 2019 that if the pro-forma was not completed, no costs would be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

**Dated this 13<sup>th</sup> day of March 2020**

**James Hopkins  
For the Registrar,  
The Comptroller General**