

**BLO/254/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3346520  
BY AL-HASSAN MARIUS KAMARA  
TO REGISTER AS A TRADE MARK:**

**ALMA**

Screen Shot 2018-10-11 at 20.34.50

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416185  
BY FFI GLOBAL S.R.L.**

## **BACKGROUND AND PLEADINGS**

1. On 18 October 2018, Al-Hassan Marius Kamara (“the applicant”) applied to register the trade mark displayed on the cover page of this decision, under number 3346520 (“the application”). It was accepted and published in the Trade Marks Journal on 1 February 2019 in respect of ‘*apparel (clothing, footwear, headgear); clothing; footwear; headwear*’ in class 25.

2. On 2 May 2019, FFI Global S.R.L. (“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 goods of the application.

3. The opponent relies upon its European Union trade mark number 10661718, **ALMA LIBRE** (“the earlier mark”). The earlier mark was filed on 21 February 2012 and was registered on 29 January 2014 in respect of the following goods:

Class 25: Clothing, footwear, headgear.

Class 26: Lace and embroidery, ribbons and braid; Buttons, hooks and eyes, needles and pins; Artificial flowers; Zip fasteners; Zipper pulls; Hooks and eyes; Eyelets; Belt buckles and clasps; Shoe buckles; Buckles for clothing; Zip fasteners; Blouse fasteners; Snap fasteners; Fasteners; brassards; Badges for wear not of precious metal; Fasteners; Fastenings for clothing; Fastenings for suspenders.

4. The opponent’s mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within Section 6A of the Act.

5. The opponent claims that the competing trade marks are highly similar due to the common dominant element “ALMA”. The opponent also argues that the goods included in the application are identical to those protected in class 25 by the earlier mark. Furthermore, the opponent submits that that the goods in the application are

similar to those in class 26 of the earlier mark. 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 concedes that the competing trade marks are similar. However, the applicant argues that there are differences in how the parties operate in trade and the actual goods they provide. As such, the applicant maintains that there is no likelihood of confusion. As these are the only comments I have from the applicant, they are reproduced in full, and as written, below:

As per the objection filed by the opposition in form TM7,

I agree that my application trade mark is similar to the opponents earlier trade mark, in that both coincide in the word "Alma"

I disagree that the application covers goods which are identical to those covered by the opponents earlier mark. "Alma Libre" seems to cater for a niche high-end market specialising in creating limited edition collection hand made, which is further protected with each item being characterised by hand written serial number that certifies its authenticity and originality (this extract was taken from their website), where as the mark I have applied for is simply looking to cater for the female sports market. We will not be seeking to expand beyond this sector. I feel this will differentiate us significantly.

I believe the mark should not be refused under 5(2)(b) as there will not exist a likelihood of confusion on the part of the public nor will it include a likelihood of association with the earlier trade mark

7. The opponent has been professionally represented throughout these proceedings by Barker Brettell LLP, while the applicant is unrepresented. Neither party filed evidence, though the opponent filed written arguments during the evidential rounds which I will consider as submissions. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. Neither party filed written submissions in lieu of an oral hearing. Both parties were offered the choice 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**

8. In its counterstatement, the applicant describes the different trading models it feels the parties 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 goods

offered by the parties will, as a matter of law, have no bearing on the outcome of this opposition.

9. 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.

10. The mark relied upon by the opponent had not been registered for five years at the date on which the application was filed. Consequently, the opponent is not required to prove use for any of the goods 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 goods listed in the register.

11. 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”.

12. 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 goods 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 goods 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."

13. Furthermore, in its submissions the opponent has questioned whether the words "Screen Shot 2018-10-11 at 20.34.50" should form part of the application and has argued that its inclusion in the mark is clearly an error. Although I agree that this element would appear to provide details of the date and time of a screen shot, it is not possible to ascertain with any degree of certainty whether this is intended to form part of the application or not. Prior to the examination of the application, the Registry wrote to the applicant on 23 October 2018 seeking clarification as to whether this element was intended to form part of the trade mark. The applicant was provided with the opportunity to submit a new image to the Registry by 23 November 2018. However, no response or replacement image was forthcoming from the applicant. Consequently, the application was examined, as filed. Nonetheless, the words cannot be said to be directly descriptive of the goods at issue in these proceedings and I do not consider

this element entirely non-distinctive. It is not for the Tribunal to assume whether the applicant intended to include this element or not. My assessment later in this decision must be based on the mark that has been applied for, as filed, and I do not consider it appropriate to disregard the element completely.

## **DECISION**

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

14. 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.”

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

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

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

17. 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 für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

18. The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 25: Clothing, footwear, headgear.</p> <p>Class 26: Lace and embroidery, ribbons and braid; Buttons, hooks and eyes, needles and pins; Artificial flowers; Zip fasteners; Zipper pulls; Hooks and eyes; Eyelets; Belt buckles and clasps; Shoe buckles; Buckles for clothing; Zip fasteners; Blouse fasteners; Snap fasteners; Fasteners; brassards; Badges for wear not of precious metal; Fasteners; Fastenings for clothing; Fastenings for suspenders.</p>	<p>Class 25: Apparel (clothing, footwear, headgear); clothing; footwear; headwear.</p>

19. The terms 'clothing' and 'footwear' appear in the class 25 specifications of both competing trade marks. Moreover, the words 'headgear' and 'headwear' are both commonly understood to mean hats and other items worn on the head; they can be used interchangeably.<sup>1</sup> Furthermore, when given their ordinary and natural meanings, the words 'apparel' and 'clothing' are synonymous in denoting items worn to cover the body i.e. clothes.<sup>2</sup> For the avoidance of doubt, the applicant has also specified that in respect of the term 'apparel', it seeks protection for '... (clothing, footwear, headgear)', which appears in the class 25 specification of the earlier mark. The respective goods of the competing trade marks are considered identical, either self-evidently or under the principle in *Meric*.

<sup>1</sup> <https://www.lexico.com/definition/headgear>, <https://www.lexico.com/definition/headwear>

<sup>2</sup> <https://www.lexico.com/definition/apparel>, <https://www.lexico.com/definition/clothing>

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

20. 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).

21. 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.”

22. The contested goods in class 25 are available to the general public and are ordinary purchases consisting of items of clothing, headwear and footwear. Due to the nature of the goods, they are likely to be purchased frequently for the purposes of functionally clothing one's self or as a form of self-expression. The cost of such goods may vary between cheaper items of limited quality at one end of the spectrum, to more expensive fashion pieces at the other. However, on average they would not typically require a significant outlay. The purchasing of these goods is likely to be more casual than careful, factoring upon personal taste, particular style or superficial preference. For this reason, it is not considered to be an immensely important choice for the consumer. In my view, the purchasing process for items of clothing, headwear and footwear would overwhelmingly be visual in nature; the goods are likely to be purchased after they are viewed in physical retail establishments or their online equivalents, brochures, window displays or visual advertising. Nevertheless, I cannot discount aural considerations such as word of mouth recommendations completely. I

find that the level of attention of the general public in respect of these goods would be average.

### Comparison of trade marks

23. 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.”

24. Accordingly, it would be wrong to artificially dissect the trade marks, though, it is necessary to account for 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.

25. The competing trade marks are shown below:

Earlier trade mark	Applicant's mark
ALMA LIBRE	

26. The opponent has submitted that the competing trade marks are highly similar in that both share the word “ALMA”. In respect of the contested mark, the opponent has contended that this word is presented in a significantly larger font than the words “Screen Shot 2018-10-11 at 20.34.50” and ought to be considered the dominant element. In addition, the opponent has highlighted that consumers in the UK read marks from left to right and, as a result, the word “ALMA” (appearing at the beginning of the earlier mark) will leave a greater lasting impression on consumers. This, the opponent has maintained, serves to enhance the visual and aural similarities between the marks. The opponent has acknowledged that there are some differences between the competing marks, though has submitted that these are offset by the identity or similarity of the respective goods.

27. The applicant has conceded that the competing trade marks are similar insofar as the word “ALMA” is common to both. I have no further submissions from the applicant on this issue.

28. The earlier mark is a plain word mark consisting of the words “ALMA LIBRE”. The word “ALMA” is likely to be perceived as an invented term. The word “LIBRE” means ‘free’ in a number of European languages including French, Spanish and Italian. While it is possible that consumers who are more versed in these languages would understand the word to mean ‘free’, I am unconvinced that this would be the case for the vast majority of consumers in the UK. While the average UK consumer is considered to have an appreciation for these more commonly understood European languages, “LIBRE” is not a non-English word for a product which the average UK consumer would be familiar with and it does not resemble its English counterpart. To my mind, it is unlikely that the average UK consumer would identify its English meaning. In my view, it is more reasonable to find that the average consumer would also perceive this word as an invented term.<sup>3</sup> As a result, both words have a roughly equal impact. Neither word is more dominant than the other and both contribute to the overall impression of the mark in roughly equal measure.

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<sup>3</sup> See *Matratzen Concord GmbH v OHIM*, Case C-3/03

29. The applicant's mark is a figurative mark comprising the word "ALMA" in a standard typeface on a white background. Superimposed onto the word is a rectangle, within which appear the words "Screen Shot 2018-10-11 at 20.34.50" in a much smaller font. The rectangular surround is presented with a shadow effect. The bottom portion of the word "ALMA" is concealed by the words "Screen Shot 2018-10-11 at 20.34.50" and rectangular surround. It is, therefore, possible that consumers would perceive it to be the word "AIMA" or "AI MA"; it is not conclusively clear whether the second letter would be seen as an "L" or an "I". However, as all the letters are partially obscured and due to the nature of the relative spacing, I am reasonably satisfied that the average consumer would interpret the word as "ALMA". It is on this basis that I shall conduct the comparison of the competing trade marks. Given that the word "ALMA" is likely to be perceived as an invented term and is presented in a proportionately large font, it will dominate the overall impression of the mark. It will have a much greater impact and contributes more to the identity of the mark. The words "Screen Shot 2018-10-11 at 20.34.50", on the other hand, are displayed in a comparatively small font and consist of ordinary dictionary words as well as indications of a date and time in digital format. This element is likely to be perceived by consumers as a reference to the date and time that an image of data displayed on a screen of a computer or mobile device was captured. Consequently, despite not being wholly descriptive of a characteristic of the goods at issue or totally non-distinctive, it will certainly play a lesser role in the impression portrayed by the mark. Similarly, the rectangle (with shadow effect) within which the words are presented does not bestow the mark with any material amount of distinctive character and plays a lesser role in the impression of the mark.

30. Visually, the competing marks are similar because they have a common four-letter string "A-L-M-A", in the same order, at the beginning of the marks. As outlined above, this word is the dominant element of the application and a co-dominant element of the earlier mark. It is established that the attention of the consumer is usually directed towards the beginning of trade marks. Although the application is a figurative mark, the word is presented in a standard typeface and the earlier mark is in word-only format; registration of a word-only mark covers use in any standard typeface, and so any differences created by the minimal stylisation in the applicant's mark are not significant. The marks are visually different insofar as the application includes the words "Screen Shot 2018-10-11 at 20.34.50" within a rectangular frame. This is not

replicated in the earlier mark, though, this element accounts for only a small proportion of the visual identity of the application. Furthermore, the earlier mark contains the word “LIBRE” which has no counterpart in the applicant’s mark; this word is distinctive and co-dominates the earlier mark. Consequently, this acts as a point of visual difference between the competing marks. Bearing in mind my assessment of the overall impressions, I consider the marks to be visually similar to a medium degree.

31. Aurally, the earlier mark consists of a two-syllable word followed by another two-syllable word, i.e. (“AL-MA-LEE-BRE”). In respect of the applicant’s mark, given the nature of the words “Screen Shot 2018-10-11 at 20.34.50” and the size of this element relative to the whole, I consider it unlikely that the average consumer would articulate them. As such, the application will comprise a two-syllable word, i.e. (“AL-MA”). Based on this finding, and taking into account the overall impressions, I consider that the marks are aurally similar to a medium degree.

32. Conceptually, neither word contained within the earlier mark has any obvious meaning per se and, therefore, would likely be understood by the average consumer as invented terms. Moreover, the combination of the two words does not produce an obvious meaning. As such, the earlier mark is conceptually neutral. In relation to the applicant’s mark, the word “ALMA” does not have any obvious meaning and would likely be understood by the average consumer as an invented term. However, the application also includes the words “Screen Shot 2018-10-11 at 20.34.50”. Although this has no direct connection to the goods at issue, given the average consumer’s familiarity with consumer electronics, this would be understood as a reference to the date and time that an image of data displayed on a screen of a computer or mobile device was captured. The element introduces a new conceptual aspect which is not replicated in the earlier mark. On this basis, and in consideration of my assessment of the overall impressions, I find the marks somewhat conceptually dissimilar.

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

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases 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).”

34. 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.”

35. 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.

36. The opponent has contended that the earlier mark is distinctive in respect of the goods for which it is registered, highlighting that the mark is not descriptive or allusive but is, instead, highly fanciful. Therefore, the opponent has argued that the mark “enjoys a high level of inherent distinctive character” due to it comprising invented terms. I have no submissions from the applicant regarding the distinctiveness of the earlier mark.

37. The registration process for the earlier mark was not completed more than five years before the filing date of the application and, as such, the opponent has not been required to provide proof of use. The opponent has not filed evidence in this matter and, therefore, has not demonstrated that the earlier mark enjoys an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

38. 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.

39. The earlier mark consists of the plain words “ALMA” and “LIBRE”, which are neither descriptive nor allusive of the goods but, rather, appear to be invented terms. Both words are co-dominant in the mark, contributing a roughly equal quantity of distinctiveness. In light of the above, I find that the earlier mark has a high level of inherent distinctive character.

## Likelihood of confusion

40. 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.

41. 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.

42. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given

those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

43. 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.”

44. 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).”

45. Earlier in this decision I concluded that:

- The goods of the competing trade marks are identical, either self-evidently or under the principle in *Meric*;
- Average consumers of the goods at issue are members of the general public, whom would demonstrate an average level of attention during the purchasing act;
- The purchasing process for the contested goods would be overwhelmingly visual in nature, though I have not discounted aural considerations completely;
- The overall impression of the earlier mark would be dominated by the words “ALMA” and “LIBRE” in equal measure;

- The contested mark would be dominated by the invented word “ALMA”, while the words “Screen Shot 2018-10-11 at 20.34.50” and the rectangular device they are presented within would play a significantly lesser role;
- The competing trade marks are visually and aurally similar to a medium degree, and somewhat conceptually dissimilar;
- The earlier mark possesses a high level of inherent distinctive character.

46. I appreciate that the competing marks both contain the invented word “ALMA” and I accept that I have found the words “Screen Shot 2018-10-11 at 20.34.50” to play a lesser role in the applicant’s mark due to the relative size of this element and how it will be perceived by consumers. However, the differences between the marks would not simply be overlooked. Despite playing a lesser role in the application, the words “Screen Shot 2018-10-11 at 20.34.50” would not be completely disregarded by consumers as it cannot be said to be directly descriptive or wholly non-distinctive in relation to clothing, footwear and headwear. Moreover, given that the words and rectangular surround overlap and obscure part of the word “ALMA”, there is a degree of interaction between the elements which, to my mind, would be recognised by consumers. The words “Screen Shot 2018-10-11 at 20.34.50” are not replicated in the earlier mark and, in my view, consumers would still notice them in the contested mark. Furthermore, although it appears at the end of the earlier mark, and it is established that the attention of the consumer is usually directed at the beginning of marks, I do not consider that the word “LIBRE” in the earlier mark would be overlooked by the average consumer; it is distinctive and contributes a roughly equal amount to the overall impression of the mark. It has no counterpart in the application and I am of the opinion that consumers would notice this distinctive word in the earlier mark. It is considered that the differences between the marks will sufficiently enable the average consumer to avoid mistaking one trade mark for the other. Even when factoring in the principle of imperfect recollection, it follows that there will be no direct confusion.

47. Nevertheless, I have found the respective goods of the competing trade marks to be identical and the attention level of the average consumer to be no more than

average. As previously outlined, I feel that the average consumer will recognise that there are differences between the marks in the words “Screen Shot 2018-10-11 at 20.34.50” in the contested mark and the word “LIBRE” in the earlier mark. However, consumers will also recognise the common element “ALMA”, which has a high level of inherent distinctive character. This word dominates the application and co-dominates the earlier mark, while also retaining its independent distinctiveness. Whether consciously or subconsciously, this will lead the average consumer through the mental process described in case law by Mr Purvis, namely, that there is a difference between the marks, but there is also something in common. As an invented word, the common element is highly distinctive. Therefore, particularly when applied to identical goods, the average consumer is likely to assume that no other undertaking but the brand owner would be using it in a trade mark. I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element “ALMA”. Consequently, I consider there to be a likelihood of indirect confusion. For the sake of completeness, given my finding on the basis of including the words “Screen Shot 2018-10-11 at 20.34.50” in my assessment, I would have concluded that there is a likelihood of confusion whether or not I took the words to form part of the contested mark, since the marks are even more similar without the additional words.

## **CONCLUSION**

48. The opposition under Section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal against my decision, the application will be refused.

## **COSTS**

49. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. This decision has been taken from the papers without an oral hearing. The opponent did not file evidence in these proceedings but did file written submissions during the evidential rounds. In the circumstances I award the opponent the sum of **£600** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing written submissions	£300
Official fee	£100
<b>Total</b>	<b>£600</b>

50. I therefore order Al-Hassan Marius Kamara to pay FFI Global S.R.L. the sum of **£600**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of April 2020**

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