

O-473-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2489766A
IN THE NAME OF
THE ICECREAMISTS LIMITED
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:**

THE ICECREAMISTS
the icecreamists
The Icecreamists
The IceCreamists

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 98160A
BY
BBC ICE CREAM, LLC**

BACKGROUND

1) On 05 June 2008, Matthew O'Connor applied to register the following series of four trade marks, in classes 25, 30 and 43:

THE ICECREAMISTS
the icecreamists
The Icecreamists
The IceCreamists

2) The application was subsequently assigned to The Icecreamists Limited ("the applicant").

3) The application was published on 25 July 2008 in the *Trade Marks Journal* and was later divided into two separate applications; 2489766A in class 25 and 2489766B in classes 30 and 43. For the purpose of this opposition, only application 2489766A is relevant which is made in respect of the four marks listed above and in relation to the following services in class 25:

Class 25:

Clothing, footwear and headgear, t-shirts, sweatshirts, raincoats, shirts, trousers, coats, hats, jackets, caps, ties and scarves, articles of fancy dress and costume.

4) On 27 October 2008 a notice of opposition was filed by BBC Ice Cream, LLC ("the opponent").

5) The opponent originally claimed that the application offended under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") however the notice of opposition was subsequently amended such that the sole ground of opposition is now under Section 5(2)(b) of the Act. The opponent contends that its mark is visually, aurally and conceptually similar to the applicant's mark such that there exists a likelihood of confusion. The opposition is directed against all of the applicant's goods. The opponent relies upon one earlier Community Trade Mark (CTM), the relevant details of which are as follows:

Mark details	Goods relied upon
CTM number: 003317369 ICE CREAM Filing date: 13 August 2003 Registration date: 09 February 2011	Class 03: Pre-impregnated cloths for cleaning spectacles. Class 09: Protective eyewear; sunglasses; eyeglasses; eyeglass frames; eyeglass, sunglass and spectacle cases; eyeglass, sunglass and spectacle straps; eyeglass, sunglass and

spectacle chains; parts and accessories for all the aforesaid goods.

Class 14:

Jewellery and related accessories; items made of precious metal, or coated therewith; pendants; lapel pins; ornamental lapel pins; pins being jewellery; ear clips; tie pins and clips; bolo ties with precious metal tips; cuff-links; badges of precious metal; belt buckles of precious metal; jewellery; costume jewellery; jewellery chains; jewellery pins for use on hats; hat ornaments and pins of precious metal; holiday ornaments of precious metal; jewellery boxes and cases of precious metal; match boxes of precious metal; snuff boxes and serviette rings of precious metal; watches and related accessories; wristwatches; pocket watches; stop watches; watch straps and bands; watch chains and fobs; watch cases; clocks; alarm clocks; clocks incorporating radios; wall clocks; figurines and sculptures of precious metal; piggy banks made of precious metal; book markers of precious metal; precious metal money clips; ashtrays of precious metal; bottle closures of precious metal; coffee services, tea services and toothpick holders of precious metal; vases of precious metal; cruets of precious metal; busts, figures, figurines, statues, statuettes and stirring rods of precious metal; candlesticks, candle holders, candle rings and candle holders of precious metal; non-electric candelabras made of precious metal; cigarette holders and lighters of precious metal; match boxes and holders of precious metal; letter openers of precious metal.

Class 18:

Items made of leather or imitation leather; all-purpose sports and athletic bags, fanny packs, backpacks, knapsacks, sports packs, waist packs, gym bags, duffel bags, tote bags, book bags, change purses, shoulder bags, carry-on bags, travel bags, garment bags for travel, leather shopping bags, beach bags, satchels, luggage, luggage tags, trunks, suitcases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold

	<p>empty, cosmetic bags sold empty, tool bags sold empty, attache cases, briefcases, briefcase-type portfolios, men's clutches, business cases, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key chains, coin pouches, wallets, billfolds, umbrellas.</p> <p>Class 25:</p> <p>Clothing; jackets, coats, parkas, raincoats, blazers, shirts, T-shirts, trousers, jeans, shorts, sweaters, cardigans, scarves and belts; footwear; headwear; jerseys, uniforms, athletic uniforms, pants, cycle pants, slacks, denim jeans, overalls, coveralls, jumpers, jump suits, boxer shorts, under shirts, night shirts, rugby shirts, polo shirts, tops, crop tops, tank tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, vests, fleece vests, pullovers, fleece pullovers, snow suits, anoraks, ponchos, dinner jackets, sports jackets, sportswear, golf and ski jackets, reversible jackets, suits, turtlenecks, swimwear, beachwear, caps, berets, hats, headbands, wrist bands, headwear, ear muffs, aprons, scarves, bandanas, belts, braces for trousers, suspenders, neckwear, neckties, ties, bow ties; babies' wear, cloth bibs, cloth diapers, booties; infantwear; underwear, briefs, trunks, singlets, socks; loungewear, robes, bathrobes, pajamas, sleepwear, hosiery, knit hosiery, gloves, mittens; footwear, shoes, sneakers, boots, galoshes, sandals, zori, slippers and rainwear.</p>
--	---

6) The opponent's mark has a filing date of 13 August 2003 and completed its registration procedure on 09 February 2011; it is therefore an earlier mark within the meaning of Section 6(1)(a) of the Act. As the registration date falls later than the publication date of the contested mark, the earlier mark is not subject to the proof of use provisions (Section 6A of the Act refers).

7) The applicant filed a counter statement in which it contended that the respective marks are not similar and denied that there exists a likelihood of confusion. It also asserts, inter alia, that i) the opponent's goods are luxurious and costly and are aimed at the premium end of the market; accordingly, they will be purchased by a select few wealthy individuals who will pay a high level of attention to the purchase, making confusion with the applicant's mark very unlikely ii) the opponent intends the ICE element of its mark to mean 'Diamonds' and the CREAM element to mean 'Money' and iii) the opponent has previously suggested (in unrelated ex-parte

proceedings) that the likelihood of confusion between the mark ICE CREAM and other trade marks containing the words ICE CREAM combined with other elements would be very unlikely.

8) In an attempt to support its assertions, the applicant makes reference to, and attaches a copy of, a skeleton argument dated 14 March 2007, filed by the opponent in connection with an ex-parte matter concerning its earlier UK trade mark 2355496 for the words „ICE CREAM’ (the mark in question was previously relied upon in the instant proceedings but is no longer due to being successfully opposed by a third party). This skeleton argument, upon which the applicant seeks to rely, was submitted by the opponent in unrelated ex-parte proceedings; it has not been submitted by the opponent in the instant proceedings. As the applicant seeks to rely on this information in the current opposition proceedings, it ought to have been submitted as sworn (formal) evidence in the form of a witness statement and exhibits thereto, in accordance with rule 64 of The Trade Marks Rules 2008. As it has not been so submitted, I am unable to attribute any weight to it. However, it is important to stress that, even if the said information had been submitted as formal evidence, it would have carried little weight or persuasiveness and would not have altered the decision which follows, for reasons which will be explained in due course.

9) The opponent did not file evidence. It follows that neither party has filed *formal* evidence in these proceedings. Nor did the parties request a hearing. I therefore make this decision after conducting a thorough review of all the papers before me and giving full consideration to all submissions provided in the notice of opposition and counter statement.

DECISION

Section 5(2)(b)

10) This section of the Act states:

“5. (2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked

undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

12) The opponent's earlier mark covers goods in class 25 which represent its strongest case under Section 5(2)(b). Accordingly, I will only assess the likelihood of confusion between the applicant's mark and the opponent's mark on the basis of the latter's class 25 goods. If the opposition fails with regard to the opponent's strongest case, as identified, it cannot be in any better position with regard to any of its other goods in different classes which are more dissimilar to the applicant's goods.

Comparison of goods

13) In *Gérard Meric v OHIM*, Case T-133/05, the General Court (GC) held that:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark"

14) The opponent's goods in class 25 include *clothing; footwear; headwear*. These are broad terms which would encompass the applicant's *clothing, footwear and headgear, t-shirts, sweatshirts, raincoats, shirts, trousers, coats, hats, jackets, caps, articles of fancy dress and costume*. Both parties' goods also include *ties* and *scarves*. Accordingly, all of the applicant's goods are identical to those covered by the opponent's earlier mark, as identified.

Average consumer and the purchasing process

15) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). I have found that the respective goods are identical therefore the average consumer for the parties' goods will also be identical.

16) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

17) The applicant has asserted that the opponent's goods are luxurious and aimed at the premium end of the market. It states:

"Lloyd Schuhtabrik Fabric Mayar & Co GbH provides that the level of attention of the consumer will vary according to the category of products in the consideration. In this case the Opponent goods clearly are very high value and bought with a great deal of attention from a select few wealthy individuals."

18) I note the applicant's assertion however, the opponent's specification contains the terms *clothing, footwear, headwear, ties and scarves*. The matter must be assessed on a notional and objective basis in relation to the aforementioned terms;

accordingly, the goods covered by those terms are likely to vary greatly in price and quality.

19) It follows that on the basis of the respective listed specifications, the average consumer for *both* parties' goods is the general public and *both* parties' goods are likely to vary greatly in price (the exact cost being dependant on factors such as the material of which they are made and the manner in which they are made). For example, certain mass produced synthetic items may be at the lower end of the cost scale whereas a bespoke item made from natural fibre/material may be at the upper end. The consumer may try on the goods to ensure that they are the correct fit and suitable for the intended purpose and occasion. A reasonable level of attention will therefore be paid to their purchase, but not the highest level. The purchasing act will be primarily visual as the goods in question are commonly bought based on their aesthetic appeal. However, I do not disregard aural considerations that may play a part.

Comparison of marks

20) In making a comparison between the marks, I must take account of their visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

21) For ease of reference, the respective marks are:

Opponent's mark	Applicant's series of marks
ICE CREAM	THE ICECREAMISTS the icecreamists The Icecreamists The IceCreamists

22) The applicant's four marks differ only in respect of the size of the letters; they are sometimes presented in upper case and sometimes in lower case, in a variety of combinations. However, nothing turns on this. The material particulars and distinctive character of the four marks are identical; they are all, in essence, the same mark. Accordingly, when referring to the applicant's marks, I will refer to them collectively as „**THE ICECREAMISTS**’.

Dominant and distinctive components

23) The opponent's mark consists of the two words, **ICE CREAM**. Given that these two words combine to form a well-known and recognisable phrase, it would be artificial to separate them into two distinct or stand-alone components. The dominance and distinctiveness lies in the mark's totality.

24) The applicant's mark contains the words **THE ICECREAMISTS**. The word „**ICECREAMISTS**’ occupies the greatest proportion of the mark as a whole and is the dominant and distinctive element of the mark overall. The word „**THE**’ appears of less significance in the overall impact of the mark such that it merely serves to introduce and emphasise the word „**ICECREAMISTS**’ which follows it. However, as it is positioned at the beginning of the mark and is clearly visible, it must be given due consideration in the global assessment.

Visual Comparison

25) The opponent claims that the marks are visually similar. The applicant points out that the opponent, in prior unrelated proceedings, has submitted that „the fact that each mark contains ICE CREAM is of little relevance’. I have already stated that if the applicant wished to rely on submissions put forward by the opponent in unrelated proceedings, they ought to have been submitted in evidential format. However, even if they had been so submitted they would have been of no assistance to me in the proceedings at issue. The opponent's submissions, to which the applicant refers, were made in the context of a comparison of its mark to one different to that in the current proceedings; they were not made in the context of a comparison between the mark ICE CREAM and THE ICECREAMISTS. Consequently, I dismiss the applicant's submission as being of no assistance to me in assessing the likelihood of confusion between the respective marks in the proceedings before me.

26) In the instant case, both marks contain the same eight letters, I C E C R E A M, and this is therefore a clear point of visual similarity. However, in the opponent's mark, the letters are presented as two words, **ICE CREAM** whereas in the applicant's mark, the letters appear as part of one word, **ICECREAMISTS**. The four letters, **ISTS**, at the end of the applicant's mark, are absent from the opponent's mark. The word „**THE**’ at the beginning of the applicant's mark is also absent from the opponent's mark.

27) The applicant contends:

“The mark applied for is a very long word consisting of 12 letters preceded by the definite article. The mark is striking and distinguishable visually because it is an invented word which the consumer is not used to seeing. The conjoined nature of the word makes it difficult to pick out the separate words ICE CREAM from a visual perspective”.

28) I do not agree with the applicant's assertion that the average consumer will find it difficult to pick out the phrase **ICE CREAM** in the conjoined word **ICECREAMISTS**. In my view, the absence of a space between **'ICE'** and **'CREAM'** and the addition of **'ISTS'** does little to conceal the recognisable phrase **'ICE CREAM'** that lies within the applicant's mark. Taking into account all of the aforesaid and viewing the marks as a whole, there is, to my mind, a reasonably good degree of visual similarity by virtue of both marks containing the letters I C E C R E A M in a standard font in exactly the same order.

Aural Comparison

29) Turning to the aural comparison, the opponent has contended that the marks are similar. The applicant states:

“Phonetically the marks are also dissimilar. The Earlier Mark consists of just two syllables whereas the later mark consists of four syllables conjoined into one word preceded by the definite article. The lexical creativeness of the conjoined word ICECREAMISTS makes it particularly distinctive and unlikely to be confused with the plain ordinary word ICE CREAM when spoken. It is very unlikely the average consumer would use the suffix -ISTS other than when referring to the Applicant's mark, and as such this element would always serve to distinguish the marks phonetically.”

30) The earlier mark does indeed consist of two syllables and the applicant's mark of four syllables however, two of the four syllables in the applicant's mark are identical to those in the opponent's mark. The opponent's mark will be pronounced as EYESSCREEM (where the SS is soft pronunciation as in „bless’). The applicant's mark will be pronounced as THEE EYESSCREEMISTS (again the SS is soft). A point of aural similarity is clearly that both marks contain the EYESSCREEM element. I note the applicant's comments that its mark contains the definite article and the „ISTS’ element which are absent from the opponent's mark. However, notwithstanding the latter differences, there is nonetheless a good degree of aural similarity as a consequence of half of the syllables in the applicant's mark being the same as those in the opponent's mark.

Conceptual Comparison

31) The opponent has stated that the marks are conceptually similar. The applicant asserts that its mark will be perceived as:

“... a group of persons in the production of formulation of Ice creams or as an “Ice Cream Scientist” for example. Indeed the intended use of the mark (in ice cream parlours and on associated goods) will further emphasise this impression.”

32) My own views regarding the conceptual identity of the contested mark closely mirror those submitted by the applicant. The „**ISTS’** suffix at the end of the mark is a common one used in everyday parlance to refer to specific groups of people who are concerned with a particular activity/thing or specialism. This is likely to lead the average consumer to perceive the mark as a group of people who specialise in or are otherwise involved or concerned with ice cream (being a frozen dessert). „**THE’** at the beginning of the applicant's mark does not alter the aforementioned concept as it merely serves to put further emphasis on the same.

33) Turning to the opponent's mark, the applicant contends that the opponent intends its mark to be perceived as 'diamonds' and 'money' by the average consumer (see my comments at paragraph 7) and as such, there is no conceptual similarity. I dismiss this submission. The matter must be judged from the perspective of the average consumer who will be unaware of any such intentions. The

opponent's mark consists of a highly recognisable English phrase denoting the well-known foodstuff that is a frozen dessert; it is this concept which will immediately be evoked in the mind of the average consumer.

34) In light of the above conclusions, there is, on one hand, a certain level of conceptual consistency between the marks since a general ice cream theme is common to both. On the other hand, whilst this theme is present in both marks, the opponent's mark evokes the concept of *ice cream itself* whereas the applicant's mark evokes the concept of *people involved with ice cream* (as already identified). On the whole, and taking into account all of the aforesaid, there is a moderately high degree of conceptual similarity.

35) In summary, I have found that the respective marks share a reasonably good degree of visual similarity, a good degree of aural similarity and a moderately high degree of conceptual similarity. Overall there is a good degree of similarity between the respective marks.

Distinctive character of the earlier mark

36) I must consider the distinctive character of the opponent's earlier mark. The more distinctive it is, either by inherent nature, or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*).

37) No evidence of use has been filed by the opponent and therefore I have only the inherent level of distinctiveness to consider.

38) The applicant states:

“The words ICE CREAM are normal words with relatively little distinctive character”

39) Whilst the opponent's mark consists of an everyday recognisable phrase, which will immediately evoke the concept of a frozen dessert, this is not a concept which has any connection with the relevant goods; it is not descriptive, allusive or suggestive of them in any way. As such, I do not agree with the applicant's submission. The mark enjoys a high degree of inherent distinctive character in relation to the relevant goods in its class 25 specification.

Likelihood of confusion

40) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v. Puma AG*). I must also take account that the consumer rarely has opportunity to compare marks side by side but rather must rely on the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

41) The applicant asserts:

“The lack of similarity and likelihood of confusion is supported by the UKIPO who, on two occasions, have not deemed the trade mark THE ICECREAMISTS similar to the Earlier Marks.

First, the UKIPO have conducted a search and advisory report at the request of the Applicant. The UK IPO did not believe the Earlier Marks were confusingly similar and they were not cited in the Search and Advisory report.

Secondly, under official Examination the Earlier Marks were again not located by the UK IPO indicating that the marks are not sufficiently similar for a likelihood of confusion to arise.”

42) In this regard, I am mindful of the comments of Geoffrey Hobbs QC sitting as the Appointed Person in *ALLIGATOR* (BL O/333/10), where he stated:

“In point of fact there was no evidence of anyone other than the two Trade Marks Registry examiners having made the presumed conceptual link. They will have done so in the performance of their duty to search for and cite earlier trade marks that might be thought to stand in the way of later applications for registration. Their mindset in that connection is one of comparing and contrasting trade marks. It is not the mindset of an ordinary consumer interested in acquiring goods or services under normal trading conditions.”

43) Accordingly, I dismiss the applicant's submission. The likelihood of confusion must be assessed from the perspective of the average consumer of the goods at issue in a normal trading environment rather than from the perspective of a trade mark examiner.

44) The applicant further submits:

“The Opponent's have no monopoly in the term ICE CREAM when used in conjunction with other dominant elements because it is a normal word of ordinary distinctiveness. Indeed there are a number of trade marks in Class 25 details enclosed which have been allowed to co-exist with each other. These include Community Trade Mark No E264549, UK Trade Mark No 2462925, UK Trade Mark No 2322709 and UK Trade Mark No 2334360...”

45) State of the register evidence is rarely relevant. The register does not give any indication of any potential co-existence agreements that may exist between the proprietors of such marks. Further, no evidence has been provided to illustrate whether the marks referred to are actually in use in the UK or what the relevant consumer's perception of them may be. For these reasons I dismiss this submission. In this regard I refer to the following comments of the court in *Zero Industry Srl v OHIM* Case T-400/06:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word „zero’, it should be pointed out that the Opposition Division found, in that

regard, that „... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‚zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

46) The applicant has also contended that the opponent's goods are aimed at the premium end of the market, are of a high price and that, accordingly, a high level of attention will be paid to their purchase meaning that confusion with the trade mark THE ICECREAMISTS will be very unlikely. However, in line with my earlier findings regarding the average consumer, this argument has little weight. Whether the opponent's goods are or, are not, marketed in such a manner is irrelevant. Marketing strategies come and go and change over time. I must consider *all* notional and objective use in relation to the opponent's specification of goods in class 25 *as listed*. I must also, for the same reasons, consider use of applicant's mark on the same basis. In this regard I note the comments of in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03*:

“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.”

47) The respective goods are identical and the average consumer will be the general public. A reasonable level of attention is likely to be paid during the purchasing act which will be primarily visual.

48) I have found that the respective marks share a reasonably good degree of visual similarity, a good degree of aural similarity and a moderately high degree of conceptual similarity. Overall there is a good degree of similarity between the respective marks. I have also found that the opponent’s mark is possessed of a high degree of inherent distinctive character.

49) Having taken into account all of the aforesaid, it is my conclusion that the differences between the marks militate against a likelihood of direct confusion in the sense that one mark will be mistaken for the other. In reaching this view I have borne in mind that the goods in question are primarily a visual purchase to which a reasonable level of attention will be paid and therefore the visual differences that exist between the marks are unlikely to go unnoticed. However, having given due consideration to *all* relevant factors in the global assessment, it is my view that, given the degree of conceptual consistency that I have identified between the marks, and

bearing in mind the high level of distinctiveness of the opponent's earlier mark for the goods at issue, there is nevertheless likely to be indirect confusion i.e. that the consumer would assume the goods emanate from the same or linked undertaking(s).

50) The ground of opposition based upon Section 5(2)(b) of the Act is, therefore, successful in its entirety.

COSTS

51) The opposition having been successful, BBC Ice Cream LLC is entitled to a contribution towards its costs. I award costs on the following basis:

Preparing notice of opposition (including the official opposition fee) and considering other side's counter statement	£500
--	------

52) I order The Icecreamists Limited to pay BBC Ice Cream LLC the sum of £500. This sum to be paid within seven days of the expiry of the appeal period, or within seven days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 27th day of November 2012

**Beverley Hedley
For the Registrar,
the Comptroller-General**