

O/513/17

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION UNDER NO. 3199824

BY SMOOTH BOOST LIMITED TO REGISTER:



AND



AS A SERIES OF TWO TRADE MARKS IN CLASS 43

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 600000610

BY PEEL HOLDINGS LAND AND PROPERTY (UK) LIMITED

BACKGROUND AND PLEADINGS

1. On 1 December 2016, Smooth Boost Limited (“the Applicant”) applied to register as a series of trade marks the two figurative marks shown on the front page of this decision, which bear the text “Peel JUICE BAR”. The application is in respect of the following services in class 43: *Cafés; Cafeterias; Catering; Coffee shops; Restaurants; Snack bar services; Preparation of food and drink; Salad bars.*
2. The application was published for opposition purposes in the Trade Marks Journal on 16 December 2016. It is opposed by Peel Holdings Land and Property (UK) Limited (“the Opponent”). The Opponent bases its opposition on its ownership of the three UK trade mark registrations set out below and which I refer to in this decision as Registrations A, B and C:

Registration A

3111768 - a series of 3 figurative marks as shown below.



This series was filed on 4 June 2015 and registered on 4 September 2015.

The series is registered in respect of services in classes 35 – 39 and 41 and 43.

For this opposition, the Opponent relies only on its services in 43, which are as follows:

Class 43: Restaurant services; self-service restaurant services; snack bar services; cafe and cafeteria services; coffee shop services; bar services; public house services; canteen and catering services; preparation of food and drink; hotel and accommodation services; information and advisory and consultancy services relating to all of the foregoing.

Registration B

3116307 - PEEL OUTLETS

This word mark was filed on 6 July 2015 and registered on 9 October 2015.

The mark is registered in respect of services in classes 35 – 39 and 41 and 43.

Again, for this opposition, the Opponent relies only on its services in 43, which are exactly as listed above for Registration A.

Registration C

3111765 - PEEL LOGISTICS

This word mark was filed on 4 June 2015 and registered on 4 September 2015.

The mark is registered in respect of services in classes 35 – 39 and 41 and 43.

Again, for this opposition, the Opponent relies only on its services in class 43, which are as listed above for Registration A.

10. Since each of the Opponent's Registrations A, B and C has a date of application for registration in 2015 - earlier than that of the Applicant's trade mark - they all meet the definition of an "earlier trade mark" under Section 6(1)(a) of the Trade Marks Act 1994 ("the Act"). Since those earlier marks had not been registered for five years or more when the Applicant's mark was published for opposition, they are not subject to the proof of use provisions under section 6A of the Act.
11. The opposition is brought under the fast track opposition procedure and is based on section 5(2)(b) of the Act. The Opponent claims that the application is for a mark that is similar to the Opponent's earlier trade marks and is for identical or similar services to those specified in class 43 under the Opponent's three earlier registrations. The opposition is directed against all the services under the Applicant's mark, which the Opponent claims are "*offered to all members of the public (and not to a relevant public*

with specialist knowledge) and are identical, hence it is highly likely that there will be confusion on account of similarity.”

12. In its statement of grounds as part of its notice of fast track opposition, the Opponent made the following points as to why it considers there to be a likelihood of confusion. In respect of Registration A the Opponent stated:

“the Applicant’s marks comprise three elements, being (i) a device and (ii) the non-distinctive words “JUICE BAR” and (iii) the word “Peel” in stylised form. [The colour-version shows a black background with text in white and the device in three colours.] The word “Peel” is dominant in both versions of the Applicant’s mark. The word PEEL is also dominant in the three registered trade marks of the Opponent.”

13. The Opponent cited the judgment of the General Court in Case T-250/15 (the mark CLAN successfully opposed by CLAN MACGREGOR) as authority for the statement that “..two marks are similar when they are at least partially identical as regards one or more relevant aspects.” And likewise that “a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa.”

14. In respect of Registrations B and C the Opponent stated that “*PEEL is the dominant and distinctive element of PEEL OUTLETS / PEEL LOGISTICS and (assessed globally) “Peel” is the dominant element of the marks applied for.*” It cited Case T-596/15 (the owner of the stylised mark POCKET successfully opposed the stylised mark POCKETBOOK) as authority for the statement that “... *the likelihood of confusion must be assessed globally according to the relevant public’s perception of the signs and ... services in question and taking into account all factors ...*”

15. Although Rules 20(1)-(3) of the Trade Marks Rules - which are the provisions that deal with evidence rounds - do not apply to fast track oppositions, Rule 20(4) does apply. It reads: “(4) *The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit*”. This implies that parties in fast track oppositions are in general required to seek leave from the registrar if they wish to file evidence. Neither party sought leave to file evidence in these proceedings.

16. I note that the Opponent attaches to its notice of fast track opposition and statement of grounds (Form TM7F) three pages that it labelled with the letters A, B and C. The Statement of Grounds mentions that these pages are included “*to reference the public’s perception of PEEL generally and PEEL OUTLETS / LOGISTICS in particular.*” However, as noted above, no leave to submit evidence has been sought or given in this case. I therefore disregard those three pages and take no account of them in this decision.
17. The Applicant filed a notice of defence and counterstatement in which it admits that the services at issue are identical, but argues that its own marks are “*fanciful, distinctive and memorable*” and that there is no similarity with the Opponent’s marks, which means that there is no risk of confusion on behalf of the consumer. The counterstatement includes other points, to which I shall refer as appropriate in this decision.
18. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if the registry requests it, or if either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary in the present case, but both parties provided written submissions in lieu of a hearing, which I bear in mind and shall refer to where appropriate.
19. The Applicant is represented in these proceedings by Dolleymores; Sally Cooper represents the Opponent. I make my decision based on the papers before me and the applicable legal framework.

DECISION

20. In this decision I intend to focus, first, on the Opponent’s case under section 5(2)(b) for its earlier trade mark “PEEL OUTLETS” (Registration B), which I consider the closest of the Opponent’s three registrations in terms of the respective marks themselves.
21. The Opponent’s claim is based on section 5(2)(b) of the Act, which states:

“... *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.”

22. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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.

23. The principles are that:

- (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 the services

24. The parties agree that their respective services in class 43 are identical.
25. Moreover, it is noted that the Opponent is not required to show evidence of use in the UK of the trade mark on its specified services since the Opponent has a period of five years from registration to make use of its trade mark for the purposes registered. My task of comparing the services must be made on the basis of notional and fair use of the goods in the parties' respective specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

“78.the court must... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in Canon at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

26. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (Case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, ... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors ...”

The average consumer and the nature of the purchasing act

27. It is necessary to determine who is the average consumer for the services at issue and how the consumer is likely to select them.
28. 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 relevant person is a legal construct and... the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical....”*
29. 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 (*Lloyd Schuhfabrik Meyer, Case C-342/97*).
30. The Opponent submits that *“the services are offered to all members of the public rather than to a public with specialist knowledge”*. That is plainly true; the average consumer will be a member of the general public. The services specified may vary in price according, for example, to their particular setting and provision, but they certainly include everyday services. I find the average consumer will likely pay perhaps a reasonable level of attention when choosing a café or restaurant or similar, but generally not a high degree of attention.
31. The Applicant’s submissions refer to the trade marks being seen *“on the frontage of a café/bar, on a protruding sign above a café/bar or on menus and point of sale cards within a café/bar..”* I find that the purchasing act for the services will be visual in that the mark will likely be prominently visible on signage on the approach to a food and drink outlet, and once inside, would likely be used on menus and/or staff apparel. Likewise the mark may be seen on websites or in advertising materials. However, word of mouth

recommendations are also likely to play some part in the selection process, so the way the marks sound is also relevant.

Comparison of the marks

32. Before I set out points on comparison of the marks at issue, I note that the Opponent's submissions include references to various trade marks owned by Peel Holdings Land and Property Group Limited, along with related documentation. No leave was sought to provide such evidence and nor can it be relevant to this decision. I disregard any such content within those submissions. I focus here only on the extent to which there is similarity or otherwise between the Applicant's trade marks and the Opponent's Registration B.
33. I note too that the Applicant's submissions refer to the Opponent's reliance on two cases - for the marks CLAN MACGREGOR vs CLAN, and POCKET vs POCKETBOOK. The Applicant submits that "*neither of these cases is a reliable precedent, because in the first case, the mark CLAN is totally subsumed in the earlier mark CLAN MACGREGOR, and in the second case the latter mark POCKETBOOK has taken the entirety of the earlier mark POCKET. However, this does not translate to the subject matter, where the earlier mark contains elements in addition to the word PEEL, and the later mark also contains elements in addition to the word PEEL. The submissions based on these cases are built on poor foundations.*"
34. I note the points made by the parties and take them into account along with the principles from case law that I have outlined earlier in this decision.
35. It is clear from *Sabel* 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 Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.”

36. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<p>Applicant’s contested series of trade marks:</p>		
<p>Opponent’s earlier trade mark - Registration B:</p>	<p>PEEL OUTLETS</p>	

37. Both parties in this case made, within their respective submissions, various points about the marks at issue, which go at least in part to the overall impression of the marks. For that reason I set out those points at this point, although they also inform visual and conceptual considerations.

38. The Applicant has applied for a series of two figurative trade marks; one in black and white, one in colour. As the Applicant notes in its counterstatement, *“the wording, device and stylisation are the same for both marks in the series; the only difference being the colours used.”* The Applicant describes its mark as being for *“PEEL JUICE BAR, with a distinctive device of the peel taken from an orange, with the leaves of the orange still attached to that peel. The wording appears in a stylised script. Whilst the use of the word/element PEEL does lend the average consumer to make the mental link between the provision of healthy food or drink that are derived from fruits or vegetables, the majority of which consist of both peel and flesh, and are peeled prior*

to being consumed, collectively the peel device and together with the wording PEEL JUICE BAR, appearing in either black and white, or in striking colours results overall in a mark that is both fanciful, distinctive and memorable.” The Applicant characterises the overall impression of its mark as *“striking and modern in its feel.”*

39. For its part, the Opponent describes matters as follows: *“the mark applied for (in colour and in black-and-white) is a composite mark where JUICE BAR is descriptive.”* It describes the device component as *“subsidiary (and descriptive) as it serves only to give a meaning to "Peel" that distinguishes it from (say) the word "peel" in the phrase "a peel of bells" or "Peel" in the name "Robert Peel" (once a British Prime Minister). This gives a position where "all the other components" in the mark applied for are "negligible.”* The Opponent says of its own PEEL OUTLETS mark that the word *“outlets" is descriptive and, accordingly, "negligible.”* On that premise, the Opponent asserts that *“in consequence, the Registry is entitled to find (a high degree of) visual similarity on account of PEEL being the dominant element of the Opponent's marks and "Peel" being the dominant element of the mark applied for.”*

40. By contrast, the Applicant's submissions in relation to Registration B include the following:

“The Opponent has protected the mark PEEL OUTLETS in respect of services in Class 43, by way of example they have included cafe and cafeteria services, public bar services, coffee shop services, hotel and accommodation services. The services in Class 43 are not similar or connected to the type of services that the word OUTLET describes, this being the case, the element OUTLET [sic] cannot be said to be descriptive and non-distinctive when used in the manner in which it is protected by the Opponent in Class 43. The Opponent claims in their grounds that the distinctive element of their mark PEEL OUTLET [sic] is the element PEEL. This is inaccurate. The mark needs to be considered in its entirety so PEEL OUTLET should be compared with ..” the whole of the Applicant's mark(s).

41. The Opponent's protection under Registration B is for the words PEEL OUTLETS. In considering the overall impression of that mark, I find that the word “OUTLETS” to be

a rather utilitarian term that has little distinctive character in this context. A dictionary¹ definition of the term OUTLET includes “a point from which goods are sold or distributed” and I find that description to be wide enough to be captured – by broad description or allusion - for example, restaurant services under class 43. In fact the dictionary provides as its example of an outlet “a fast-food outlet.” The term is less naturally applicable in a descriptive or allusive sense to “hotel and accommodation services” – even though accommodation services are often associated with restaurant and public house services. Nonetheless the term retains its inherent degree of utilitarian non-distinctiveness in the sense that the average consumer would view it as encompassing a very wide range of retail and service offerings.

42. In contrast, since PEEL is not at all descriptive of the class 43 services at large (save in the narrow circumstance of their including a juice bar), it is my finding that the word PEEL is the distinctive and dominant aspect of Registration B – although I do not consider OUTLETS to be a negligible component in the mark.
43. As to the Applicant’s mark, I find that the device component is far from negligible. I find that it serves to give unambiguous meaning to the use of the word “peel” and artistically reinforces the nature of the services offered – the provision of fruit drinks. However, the device appears to be an elaboration that is secondary to the word “Peel.”
44. The words JUICE BAR still more directly clarify the nature of the services offered and I find those words to be descriptive and not distinctive in this context. I also find those words to be secondary to the word “Peel” on account of their size and position within the mark.
45. Since the word “Peel” is used in explicit connection with “JUICE BAR” there is clearly a degree of allusion at play, but the word(s) remains somewhat distinctive for the class 43 services at large. Since the juice bar / class 43 services under the Applicant’s mark carry the name “Peel” I find that it is that voiceable single word that plays the dominant role in the overall impression of the mark, and would be most striking to the average consumer, especially given its size and central position within the Applicant’s mark(s).

¹ <https://en.oxforddictionaries.com/definition/outlet>

Visual similarity

46. The marks share the same distinctive first word PEEL, which I also consider to be the dominant component in the marks of both parties. The Opponent's Registration B gives the word in upper case, whereas the Applicant's mark is in title case or possibly lower case. The opponent's mark is applied for in standard characters and therefore includes use in upper and lower case. The Applicant renders the word in a stylised form approximating handwriting, although the word remains clearly Peel – the same word as appears in the Opponent's Registration B. The respective marks further differ by their inclusion of other, different words and by the inclusion in the Applicant's mark of the orange peel and leaf device. I find the Applicant's mark and the Opponent's Registration B to be visually similar to a medium degree at most.

Aural similarity

47. Since the pictorial device in the Applicant's mark will not be voiced, the aural comparison is between "Peel outlets" and "Peel Juice Bar". Given the dominant and distinctive significance attached to the word "Peel" in the marks, I find that the marks are aurally similar to a medium degree. The differing word elements are non-distinctive and it is possible that they may not even be articulated, which would made the marks aurally identical.

Conceptual similarity

48. The Applicant's submissions also include the following:

"The element OUTLETS brings to mind stores selling their finished stock directly to the public, cutting out the middle men. As can be seen by the using the link <https://en.wikipedia.org/wiki/Outlet> store traditionally a factory outlet was a store attached to a factory or warehouse, sometimes allowing customers to watch the production process. In modern usage, outlet stores are typically manufacturer-branded stores grouped together in outlet malls, selling stock directly to the public.

The Opponent themselves supports this by providing a link to their website in particular <http://www.lifestyleoutlets.co.uk> that show the Opponent providing businesses with premises in which to operate and sell their product from. The website reads "Lifestyle Outlets is part of The Peel Group whose motto is "determination, perseverance, patience". We own, develop and manage a variety of successful retail operations and leisure destinations across the UK, including a major shareholding in INTU Properties plc, the UK's leading specialist developer and owner of regional shopping centres; PEEL is the 7th largest Retail Park owner in the country; Peel Retail Parks has over 240 stores".

49. I note the references to websites both by the Applicant and the Opponent – but I consider this to be evidence that neither party has sought leave to admit. I therefore do not give regard to those points. I acknowledge that it is possible that the average consumer could perceive the concept of an outlet in the narrower specific way that the Applicant suggests. However, as I have already found above, I think it at least as likely that the average consumer would understand the term simply to be a point from which goods or services are sold or distributed and would not automatically nuance their understanding in the manner that the Applicant suggests. I therefore find that there is some conceptual similarity between OUTLETS and JUICE BAR, notwithstanding that I have not found those to be the distinctive components of the marks.
50. As to the word PEEL, which I have found to play the dominant and distinctive role in both marks, I note that the Opponent has highlighted various significances that may attach to the word, including a misspelling of a form of bell ringing (“peal”) and a personal surname. However, I find it likely that a significant proportion of the public would perceive the word as signifying the skin of a fruit. Since I find that the average consumer may perceive PEEL in the same way in both marks, there is identity in that aspect. I therefore find that overall the marks are conceptually similar to at least a medium degree.

Distinctive character of earlier trade mark

51. The distinctive character of an earlier mark must be considered. The distinctive character of a trade mark can be appraised only, first, by reference to the goods/services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public.²
52. The more distinctive the earlier mark, either by inherent nature or by use, the greater may be the likelihood of confusion (*Sabel BV v Puma AG*). 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).”*

² *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

53. Registration B comprises two familiar and standard English words. The word OUTLETS may be seen, at least to some degree, as descriptive in relation to the registered services and is therefore lacking in distinctiveness. The word PEEL does not directly describe the relevant services so can be said to have at least a reasonable level of inherent distinctiveness. The level of distinctiveness of a mark may be enhanced through use. Despite submissions by the Opponent suggesting that PEEL “has a high level of distinctiveness among the public”, I do not find that to be so. Overall, I find the earlier mark under Registration B to have an average level of distinctiveness in relation to services in class 43.

Conclusion as to likelihood of confusion

54. I now turn to reach a conclusion as to the likelihood of confusion between the marks if they were used in relation to the services specified.

55. Confusion can be direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,³ where he noted 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

³ Case BL-O/375/10

of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. 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).”

56. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraphs 21 and 22 above.

57. There is identity between the parties’ services and I have found that the relevant average consumer is a member of the public who would pay a reasonable level of attention when choosing the services at issue. I have found a reasonable level of inherent distinctiveness in the earlier Registration B, which is not enhanced by use.

58. In selecting the services at issue, I have found that visual considerations predominate but aural considerations are also relevant. I have found that the Applicant’s mark shares only a medium degree of visual and aural⁴ similarity with Registration B, and at least a medium degree of conceptual similarity. There is a likelihood that the average

⁴ Assuming the marks are voiced in full.

consumer will assume that the services are provided by the same or related undertaking since “Peel Juice Bar” may reasonably be perceived as a particular variety of “Peel outlet”.

59. The Applicant’s submits that the interdependency principle⁵, which allows that a greater similarity between services may offset a lesser degree of similarity between the marks, is “*not a correct approach to take here.*” The Applicant contends that although the services are identical “*the marks are so far removed visually and conceptually that the interdependency principle is not appropriate.*” I do not agree with those submissions. I have found visual, aural and conceptual similarity in the degrees stated previously, and the services are identical.
60. The Applicant also submits that it must be borne in mind that the Opponent does “*not have a monopoly in the element PEEL in respect of services in Class 43.*” The Applicant then lists by way of example four other marks that include the element PEEL and which are protected in respect of services in class 43 on both the UKIPO and EUIPO Registers. It is true that the Opponent does not have a monopoly on the word PEEL, and nor has my assessment proceeded on that basis. Moreover, it should be noted that no relevance⁶ attaches to the fact that other marks that include the word PEEL are registered for class 43, not least because an assessment of likelihood of confusion must be made in respect of particular marks and in light of all relevant circumstances.
61. When I weigh in the balance all of the above factors, I find in this case that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the services at issue. **Consequently, the opposition succeeds on the basis of section 5(2)(b).**

⁵ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

⁶ This is so-called state of the register ‘evidence’ - on which, see, for example, Millett L.J. in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283; the comments of Kitchin L.J. at para 80 *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220; and comments of the General Court at para 73 of *Zero Industry Srl v OHIM*, Case T-400/06.

62. The Opponent has succeeded on the basis of Registration B. In the circumstances I do not consider it proportionate or necessary to consider the Opponent's claim in relation to those marks.

COSTS

63. The Opponent has been successful and is entitled to a contribution towards its costs. In awarding costs I take account of the scale published in Tribunal Practice Notice 2/2016 and of the fact that that scale does not affect the £500 cap on costs in fast track trade mark opposition proceedings such as this. In the circumstances I award the Opponent the sum of £450 (four hundred and fifty pounds) as a contribution towards the cost of the proceedings, calculated as follows:

Official fee for notice of fast track opposition	£100
Preparing a notice of opposition and statement of grounds	£200
Reviewing the Applicant's counterstatement and filing written submissions in reply (<i>this takes account of the fact that the Opponent included material that was irrelevant / inadmissible</i>).	£250
Total	£450

64. I therefore order Smooth Boost Limited to pay Peel Holdings Land and Property (UK) Limited the sum of £450 (four hundred and fifty pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of October 2017

Matthew Williams
For the Registrar
